

**Handling of Special Provisions for Time of Filing Application for International  
Trademark Registration under Article 68-10 of Trademark Act**

1. In respect to the special provisions for the time of filing an application under Article 68-10, since the said Article describes that “where a registered trademark based on the international registration of an international trademark application is identical with a registered trademark based on the national registration prior to the date of the international registration ...,” the international trademark application concerned shall be deemed to have been registered (national registration) based on a domestic trademark application effective at the time of decision and such international application shall be deemed to have been filed on the domestic filing date (retroactive date) to the extent of the overlapped designated goods and/or services when all of the following requirements are satisfied.

- 1) Designated goods and/or services with respect to an international application for registration of a trademark overlap with the ones covered by the domestic registration.
- 2) A trademark with respect to the international application for registration of a trademark is identical to the one of the domestic registration.
- 3) An applicant of the international application for registration of a trademark is the owner of a trademark right of domestic registration.

2. The name and the domicile of the applicant are written in Latin characters in the cases of the international application for registration of a trademark, while the name and the domicile of the owner of a trademark right of the domestic registration (when the owner is a foreigner) are transliterated in Japanese *katakana* characters and registered in the Trademark Register. For this reason, in recognizing whether or not the name and the domicile are identical, the examiners shall refer to the Trademark Examination Manual [42.111.01](#) “Handling of identification of the applicant,” etc.

Example: when the domiciles are recognized as identical even if there are differences such as the presence of pause marks, etc.

Example 1 “R, C, A, Corporation”

“アール シー エー コーポレーション”

Example 2 “... 10036 the State of New York New York ...”

“...ニューヨーク州ニューヨーク...”

3. Special provisions for the time of filing an international trademark application are applied to the scope in which the designated goods and/or services are overlapped with those of the national registration. Therefore, the JPO shall decide whether or not the provision can be

applied for each item of designated goods and/or services in the international trademark application.

That is to say, the retroactive date differs for each item of designated goods and/or services, as exemplified in the following cases.

Example: When the designated goods of an international trademark application are “a, b, and c” and the national trademark registration had been effective at the time of the final decision as below, the filing date of the international trademark application retroacts as follows.

Designated goods of an international trademark application	National Registration				Retroactive date of international trademark application
	National Registration	Trademark	Designated goods	Filing date	
a	I	Identical	a	January 1, 1991	Filing date of national registration I
b	II	Identical	b	January 1, 1993	Filing date of national registration II
c	None				No retroaction

4. In respect to an international trademark application to which the special provision provided for in Article 68-10 is applicable, it is necessary to register the following on the Trademark Register, since it can affect third parties' interests:

- 1) a statement that the special provision of Article 68-10 is applicable to the application; and
- 2) the registration number of the respective national trademark registration.

The above 1) and 2) shall be described on the written final decision when deciding to register an international trademark application to which the special provision of Article 68-10 is applicable.

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

Examination Guidelines for Trademarks:

[Article 68 -9, 10, 11, -12, 13, 15, 16, 17, -18, 20, and 28 \(Special Provisions Relating to Application for International Registration\)](#)