

46.01

Administration of Examinations of Designated Goods or Services

Concept for Examination of Designated Goods or Services

1. In cases where the designated goods or designated services described in the written application are unclear and the classification of the goods or services described in the written application cannot be determined to conform to the classification specified by Cabinet Order, the application for trademark registration shall not comply with the requirements provided in Article 6(1) and (2) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

Grounds for not satisfying the requirements provided in Article 6(1) and (2) of the Trademark Act

Article 6(1) of the Trademark Act provides “designate ... goods or services ... to be used,” and the paragraph requires the applicant to designate goods or services for which the trademark will be used when filing an application for trademark registration.

Also, the content and scope of this “designation” must be clear, since the goods or services described in the written application not only determine the scope of the trademark, but also the scope of the application for trademark registration or the trademark right.

Therefore, when the content or scope of the designated goods or designated services is unclear, the application for trademark registration does not comply with the requirement in this paragraph due to an insufficient “designation” of goods or services.

There are cases where, because the designated goods or designated services described in the written application are unclear, it is not possible to determine whether the designated goods or designated services fall under the classification described in the written application. The application for trademark registration does not comply with the requirements provided in Article 6(2) of the Trademark Act in such cases, because it is difficult to determine whether the designation of goods or designated services complies with the classification specified by Cabinet Order (Note).

The main paragraph of Article 3(1) of the Trademark Act provides that trademarks used for “goods or services pertaining to the business of an applicant” can be registered. Therefore, when the designated goods or designated services described in the written application are unclear, it will be deemed that the “goods or services pertaining to the business of an applicant” prescribed in that paragraph are unclear, thus, it will not be illegal to refuse the application for trademark registration for not complying with the requirements prescribed in the main paragraph of Article 3(1) of the Trademark Act.

However, since the provision of this paragraph is not stipulated as directly as that of Article 6(1) of the Trademark Act, it would be more appropriate to refuse the application for not complying with the requirements prescribed in Article 6(1) of the Trademark Act.

Since Article 6(2) of the Trademark Act obligates the applicant to abide by the classification specified by Cabinet Order when designating goods or services based on the provision of paragraph (1) of that Article, the provision of Article 6(2) of the Trademark Act should be applied in cases where the classification of goods or services described in the written application is unclear or different from the actual classification of the goods or services, and not to cases where the designated goods or designated services themselves are unclear.

Even if the same designated goods or designated services are described several times in an overlapped manner in an application, it can be determined that one of those designated goods or designated services have been designated in effect, so the application is treated as satisfying the requirements provided in Article 6 of the Trademark Act in such a case.

(Note) Requirement on administration

In cases where the designated goods or designated services are unclear and the described classification of the goods or services cannot be found to conform to the classification specified by Cabinet Order, and where a notification of reasons for refusal is sent for not complying with the requirement prescribed in only Article 6(1) of the Trademark Act, it will be necessary for the JPO to send another notification of reasons for refusal for not complying with the requirement prescribed in Article 6(2) of the Trademark Act in cases where the classification is found to be different at a later stage.

Nevertheless, if a notification of reasons for refusal is sent for not complying with the requirements prescribed in both Article 6(1) and (2) of the Trademark Act from the very first, it is assumed that the applicant would amend both designated goods or designated services and their classification at the same time. Administering the case in this way is therefore considered desirable for realizing expeditious examination processes.

2. In cases where the designated goods or designated services described in the written application are unclear but the classification of the goods or services described in the request can be found to conform to the classification specified by Cabinet Order, the application for trademark registration shall be deemed not to comply with the requirement prescribed in Article 6(1) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.
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[Explanation]

For example, when the designated goods are described as “Class 12: Automobiles and other goods belonging to this class,” the description cannot be approved as the indication of the designated goods because the content and scope of goods are unclear. In this case,

the scope of designated goods is handled with the stance that the goods within the scope belonging to Class 12 are designated by the term “goods belonging to this class”, of course including the term “automobiles.”

Therefore, in such cases, a notification of reasons for refusal shall be sent to the applicant for not satisfying the requirement prescribed in only Article 6(1) of the Trademark Act.

3. In cases where the applicant submits a written opinion or written submission of materials solely consisting of the explanation of goods, etc. against the notification of reasons for refusal mentioned in 1. or 2. above, the examiner takes into account the written argument or written submission of materials, and orders the applicant to amend the designated goods or designated services by, for example, indicating a draft amendment (order for amendment under the name of the examiner).

When the applicant does not respond to such order for amendment or does not make any appropriate amendment, etc., that application for trademark registration shall be refused based on the earlier reasons for refusal.

[Explanation]

For example, when the designated goods described in the written application are new goods, etc. that have never been distributed on the market, it may often be difficult for the applicant to indicate the goods in his/her application.

In such cases, the applicant may be able to explain the use, function, materials, etc. of the goods, but it is often difficult for the applicant to actually make an immediate accurate amendment of the goods in response to the reasons for refusal. Thus, it may be too harsh to immediately refuse the application for reasons that the applicant has not made the amendment.

Therefore, when the applicant submits a written opinion or written submission of materials solely consisting of the explanation of the goods, and even if documents do not resolve the reasons for refusal, the application will not be immediately refused.

In such cases, the examiner will sufficiently take into account the explanation of the goods described in the written opinion or written submission of materials, and order, under its name, the applicant to amend the designated goods by, for example, indicating a draft amendment.

However, if the applicant does not respond in any way or does not amend the designated goods, the examiner shall refuse the application based on the earlier reasons for refusal.

The examiner shall explain the details related to the reasons for refusal or the order for amendment, or give instruction and advice on how to respond, by interviewing or phoning the applicant or the agents required, and encourage the submission of an appropriate written amendment, etc.

4. In cases where the designated goods or designated services described in the written application are clear, but the classification of goods or services designated in the written application does not conform to the classification specified by Cabinet Order, the application for trademark registration shall be deemed not to satisfy the requirement prescribed in Article 6(2) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

When the designated goods or designated services described in the written application are clear, but there is an error in the classification of the goods or services, for example, when the classification of the goods or services does not conform to the classification specified by Cabinet Order (Article 2 of the Enforcement Order of the Trademark Act (Cabinet Order)), as in the case where the description is “Class 20: Portable telephones” instead of “Class 9: Portable telephones” the application for trademark registration shall be deemed not to satisfy the requirement prescribed in Article 6(2) of the Trademark Act, as in the past, and a notification of reasons for refusal shall be sent to the applicant.

5.
 (i) In cases where there is no description of the materials or use, etc. with regard to the designated goods or designated services described in the application but the materials or use, etc. can be specified by taking the classification into consideration, such application for trademark registration is determined to satisfy the requirements provided in Article 6(1) or (2).
 (ii) In cases where an application satisfies the requirements provided in Article 6(1) and (2) due to (i) above, it is not acceptable to amend or divide the designated goods or designated services into those of another class, as it would be regarded as a case of changing in the gist or dividing goods that are not covered by the original application.

[Explanation]

(1) The meanings of the goods or services designated in an application can be interpreted by taking into consideration information such as the name of the class set forth in the appended table of the Order for Enforcement of the Trademark Act, which has been provided in accordance with the International Classification, the contents and characteristics of the goods or services that are categorized under that class, and the explanation on the goods or services indicated in the explanatory notes of the list of classes constituting the International Classification. Therefore, if an indication of designated goods or designated services does not include a description of the materials or use, etc., but the materials or use, etc. can be specified by taking the classification into consideration, it is reasonable to consider such indication to be a clear indication of goods or services, and there would be no problem in adopting

such an interpretation.¹

For example, in the case where an application is filed for designated goods “letter boxes” under Class 6, given that the classification of letter boxes differs depending on their materials, such as “letter boxes of metal” being categorized under Class 6, “letter boxes of masonry” under Class 19, and “letter boxes, not of metal or masonry” under Class 20, the indication in this case can be considered as a clear indication of goods where the designated goods can be specified as “letter boxes of metal” by taking the classification into consideration. Accordingly, the application is determined to satisfy the requirements provided in Article 6 of the Trademark Act.

- (2) With regard to an indication of designated goods or designated services of which scope can be specified by taking the classification into consideration, an amendment or division to change or expand that specified scope has the risk of causing an unexpected detriment (e.g., the difficulty to foresee the scope of the right relating to that application in spite of conducting a prior search) to third parties, such as rival applicants. In light of such circumstances, it is appropriate not to accept amendment or division.

For example, a procedure to amend or divide “Class 6: Letter boxes” into “Class 19: Letter boxes” or “Class 19: Letter boxes of masonry” cannot be accepted, as it would be regarded as a case of changing in the gist or dividing goods that are not covered by the original application.

6. Unclear designated goods and/or services or unclear classification of goods and/or services in an international application for trademark registration shall be handled as follows.

(i) When the designated goods and/or services are recognized to be unclear, the examiner will send a notification of reasons for refusal on the grounds that the requirement prescribed in Article 6(1) of the Trademark Act has not been satisfied and shall request that the applicant to amend the respective designated goods and/or services so that they are clearly described.

However, when the content and scope of the goods and/or services are clear from the indication of each item of designated goods and/or services, the indication is accepted as the indication of the designated goods and/or services of the respective application, in principle, even if the designated goods and/or services are overlapped.

(ii) The classification of the goods and/or services shall follow the classification described in a notification of designation. When classification is found to be

¹ As the alphabetical list of the International Classification of Goods and Services based on the Nice Agreement is revised annually, it should be noted that the contents and scopes of the goods and services categorized under the respective classes are sometimes changed.

apparently erroneous, the examiner confirms this with the International Bureau.

(iii) Handling described in Item 3. above applies mutatis mutandis to international applications for trademark registration.

[Explanation]

(1) In respect to the indication of the designated goods and/or services, when the content and scope of the designated goods and/or services are unclear from the indication of designated goods and/or services in an international application for trademark registration (including the name of the goods and/or services on the classification table and the alphabetical list of International Classification), the JPO shall send a notification of reasons for refusal on the grounds that the requirement prescribed in Article 6(1) of the Trademark Act has not been satisfied, and shall request that the applicant amend the designated goods and/or services to clarify the content and scope. (In this case, goods and/or services that are found to be unclear, even though published in the alphabetical list of International Classification, shall be the goods and/or services indicated with * in the remark column of the “Japanese translation of the alphabetical list of the International Classification List of Goods and Services (with group codes for similar items)” based on the Nice Classification” for the time being.)

However, since the goods and/or services designated by an international registration have already been classified and examined by the International Bureau, the international registration notified to our country and recognized as an international application for trademark registration shall be basically dealt with in deference to the indicated classification and examination. When the indication of each item of the designated goods and/or services clarifies the content and scope of the goods and/or services, it is recognized as the indication of the designated goods and/or services of the respective application in principle, even if the designated goods and/or services overlap.

(2) Since the International Bureau has already examined whether or not the designated goods or designated services are indicated according to the classification of the goods and services, there is no need to examine this in the designated Contracting Party. Even if the examiner in charge finds doubt in the designated classification, the examiner shall follow the classification specified by the International Bureau and confirm this with the International Bureau only when an obvious error is recognized.

(Note) Of this examination manual the handling mentioned in 5. will be applied to applications for which the examination for first action is launched on or after the date of announcement of this manual.

(Reference)

