

A2.01

Handling Concerning the Identicalness of a Trademark Claimed in an International Trademark Application and the Trademark of the Basic Registration or Application

1. The standards for determining whether or not a trademark claimed in an international trademark application and a trademark of basic registration or basic application are identical to each other are as follows.

(i) The determination on whether or not a trademark claimed in an international trademark application and a trademark of the basic registration or basic application are identical must be made severely, and constitutions and forms of the trademarks must be identical to each other (including those that differ only in scale).

(ii) When there is a difference within the scope in which an amendment can be approved as not changing the gist, and naturally, when there is a difference that is considered to be within the scope of similarity or a difference within the scope of identification based on the generally accepted idea in society: such as when a trademark is recognized as being used in a trial for rescission of a registered trademark not in use, the trademarks shall not be recognized as identical.

2. The determination on whether or not trademarks are identical shall be made by comparing them with a trademark of the basic registration or basic application which the JPO uses to verify an international trademark application.

3. When it cannot be found that a trademark claimed in an international trademark application is identical to that of the basic registration or basic application, the JPO shall urge the applicant to replace the respective written application with a new one.

* When a request is made from the International Design and Trademark Application Office regarding this handling, the International Trademark Application Examination Office will agree to hold talks and based on the result thereof, the International Design and Trademark Office will perform this handling.

[Explanation]

(1) The determination on whether or not a trademark claimed in an international trademark application and a trademark of the basic registration or basic application are identical must be made severely according to the following reasons, and constitutions and forms of the trademarks must be identical to each other (including those that differ only in scale).

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(i) The Protocol Relating to the Madrid Agreement is a treaty consisting of a structure in which trademark protection in a contracting state (state of origin) is extended to other contracting states (designated states) in line with the Madrid Agreement.

(ii) The central attack system (when the basic registration or basic application lapses within five years after the international registration date, the international registration shall lapse) established in the Protocol is also a system based on a premise that the trademark of the basic registration or basic application and the trademark claimed in an international trademark application are identical.

(iii) The trademark claimed in an international trademark application can be described by typing or printing, or reproduced by any means including that of "cut and paste". Also, the method of photocopying a trademark indicated in a written application or official gazette and pasting on the copy is also acceptable. Therefore, even if the trademark claimed in an international application is strictly required to be identical to the trademark of the basic registration or the basic application, difficulty cannot be assumed in indicating the mark as such, thus it will never be unfair to the applicant.

(iv) When using the trademark registered in each designated state, a slightly converted use is accepted within the scope that there is no effect on the distinctive features of the trademark (Article 5C(2) of the Paris Convention), and therefore, it will never be unfair to the applicant even if the trademark claimed an international application is strictly required to be identical to the trademark of the basic registration or the basic application.

(v) Note that an audio file (e.g., MP3 format) or a video file (e.g., MP4 format) submitted as a trademark pertaining to an international trademark application may not be construed as identical to a trademark pertaining to the basic registration or the basic application.

(2) With regard to the determination on whether or not the trademarks are identical, it is sufficient to recognize that the trademarks are identical in comparison to the trademark of the basic registration or basic application used for verification of the international trademark application (Article 3(1) of the Protocol). Even if the trademark of the basic application is amended later and the application is registered according to the amended trademark, it is not permitted to amend the trademark of an international trademark application to that of said amended trademark.

(3) When the trademark claimed in an international trademark application is not found identical to that of the basic registration or basic application, the JPO shall urge the

applicant to replace the trademark with one that can be recognized as identical. This handling applies from A2.02 to A2.04 of the Trademark Examination Manual in the same manner.