

A2.07

Handling of the Description of a Trademark Claimed in an International Trademark Application (Excluding the Detailed Explanation of the Trademark Provided in Article 5(4) of the Trademark Act)

1. When a written application for the basic registration or basic application contains a description of the trademark and the description thereof is also required for an international trademark application, the content identical to the description must be described in column 9(e)(i) "Description of the mark contained in the basic application or basic registration, where applicable" (hereinafter referred to as the "trademark description column") in a written application for the international trademark application (MM2).

Incidentally, if an explanation stating the applicant's intention to obtain application of the proviso to Article 5(6) (*) of the Trademark Act for the trademark is submitted with a written application for the basic registration or basic application, the content identical to the explanation must be described in the trademark description column in complete sentences.

[Example] If the trademark description column is white, describe "The part of the trademark is white."

(*) Article 5(3) of the Trademark Act for registration based on an application or an application based on the Trademark Act prior to the revision in 1996 and Article 5(4) of the Trademark Act for registration based on an application or an application based on the Trademark Act prior to the revision in 2014. The same applies hereinafter.

2. The following matters of basic registration or basic application cannot be described in the "trademark description column."

- The fact that the provision of Article 3(2) is applied;
- The explanation of the purport of the choice of the trademark;
- The fact that the trademark is claimed in a divisional or converted application;
- The fact that the trademark is claimed in an application handled by accelerated examination or an application for which such examination has been requested.

Furthermore, when the constitutional form of a trademark is explained in the basic registration or basic application, there is, in principle, no need to include this in the "trademark description column." However, when such matter is described in a written application for an international trademark application, the office of origin shall confirm that the content of the description is substantially identical to that of the basic

registration or basic application.

3. Since the description in the "trademark description column" is one of the matters that the office of origin must verify as being identical to the description of the basic registration or basic application, the office of origin shall confirm that the description of the trademark in a written application for an international application is identical to the content described in the written application for the basic registration or basic application, and the office of origin shall urge the applicant to replace the written application with the corrected written application if the content is not recognized as being identical.

[Explanation]

(1) When there is a description in the "trademark description column," the written application for an international application must include a description that is identical to the description of the trademark in the basic registration or basic application.

For example, when an applicant wishes to have the provision of the proviso to Article 5(6) of the Trademark Act applied to the basic registration or basic application, the applicant shall write "application of the proviso of Article 5(6) of the Trademark Act" on a written explanation attached to the written application, describe the trademark for which registration is sought next to it and draw a reference line from the part that should be in the same color as that of the trademark description column and also write a description to that effect.

However, since the "trademark description column" shall be described in the "language for international trademark application" when a written application for the basic registration or basic application includes an explanation about the "application of the proviso to Article 5(6) of the Trademark Act," the applicant must simply and clearly describe the parts that are in the same color as the trademark description column and the color (the same as that for the trademark description column) in complete sentences.

For example, when the trademark description column is white, it is appropriate to write that "The xxxxx part in the trademark is white" in English.

Incidentally, since the explanation based on the provision of the proviso to Article 5(6) of the Trademark Act is a description related to the compositional elements of a trademark, it is more appropriately described in the "trademark description column" than in column 8 "COLOR(S) CLAIMED" of the written application.

- (2) It is provided that the "trademark description column",
- i) shall not include the types and categories shown in the form of a written application (three-dimensional trademark, collective trademark, certification trademark, certified trademark, trademark consisting of standard characters); and
 - ii) shall not include descriptions such as statements concerning the use or

famousness of the trademark.

Therefore, for example, matters concerning the basic registration or basic application as mentioned in i) or ii) above or as follows cannot be described in the "trademark description column."

- (i) The fact that the trademark is a registered trademark which has been recognized, based on the application of the provision of Article 3(2), as having distinctiveness acquired through use, or a trademark of an application to which the applicant is claiming that the provision of Article 3(2) should be applied;
- (ii) The explanation of the purport of the choice of trademark;
- (iii) The fact that the trademark is claimed in a divisional or converted application;
- (iv) The fact that the trademark is claimed in an application handled by accelerated examination or an application for which such examination has been requested.

Incidentally, it is understood that matters, which are described in the basic registration or basic application, and are related to the constitutional form of the trademark or directly related to the trademark right (excluding matters that should be described in another column in a written application), shall be described in the "trademark description column." Therefore, when a three-dimensional trademark is explained in the basic registration or basic application, there is, in principle, no need to describe the matter in the "trademark description column." However, when such matter is described in the international trademark application, the office of origin shall not consider the description defective but shall confirm whether it is identical to the description of the basic registration or basic application. When it is confirmed as being identical, the description shall be accepted.

[Remark]

<Description in the "trademark description column" when a trademark is based on a registered trademark with "limitation of color" under the Trademark Act of 1909 or 1921>

In terms of a registration with a description concerning the "limitation of color," when the colors are described not only in column 8 of a written application but also in the "trademark description column," the description shall be handled as described after "Incidentally" in (2) above.

<"Defensive marks">

In accordance with the Trademark Act, an international trademark application may be filed based on a registration or an application concerning a defensive mark. However, the "trademark description column" of the international trademark application shall be recognized as being identical to that of a basic registration or basic application even if there is nothing describing the mark as a defensive mark.

Since it is not required under the defensive mark system to use the mark for goods or services for which protection is sought, when the basic registration or basic application is a "defensive mark," some designated states may not approve it as an international registration of the trademark used due to the fact that it is a defensive mark, and those designated states may refuse protection thereof. Therefore, such cases are handled as above.

(3) When it has been confirmed that the matters to be described are lacking or descriptions are not recognized as being identical, the office of origin shall urge the applicant to replace the written application to make the descriptions identical.