

### A3.01

#### **Handling Concerning the Identification of Goods or Services Related to an International Trademark Application**

1. The goods or services that can be described in the column 10 "GOODS AND SERVICES" (hereinafter referred to as the "goods and services") of the written application of an international trademark application are limited to those identical to or contained in the scope of the designated goods or designated services described in the trademark register of the basic registration (limited to those effective now) or in the written application of the basic application (where an amendment has been made, those after the amendment). Therefore, the office of origin shall confirm the goods or services related to the respective international trademark application.

2. When the goods or services related to an international trademark application can be recognized as substantially identical to or contained in the designated goods or designated services of the basic registration or basic application, the goods or services shall be recognized as identical.

In addition, in cases where the goods or services overlap in terms of the indication of the goods and/or services related to the international trademark application, they shall be recognized in the same way.

3. When the designated goods or designated services of the basic registration or basic application are described in a comprehensive manner, the office of origin shall recognize the identification of the goods or services of an international trademark application in line with the "Classification of Goods (and Services)" which is effective at the time of filing the basic registration or basic application. If necessary, the office of origin shall refer to the "Reclassification Guidelines for Reclassifying the Designated Goods of a Trademark Right"

4. With regard to the description of the goods or services of an international trademark application, when the identification of the trademarks is not recognizable, for example, because of the following deficiencies, the office of origin shall urge the applicant to replace the respective written application.

- where the content has been changed or expanded compared with the designated goods or designated services of the basic registration or basic application
- where the description of the goods or services is not clearly indicated.

Furthermore, in cases where the trademark application is based on a certain

application, the description of "the goods or services" is described in a translation that is recognized to be identical to the indication of the designated goods or designated services of the basic application, the descriptions shall be considered as identical in principle.

\* 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) Since the goods or services that can be described in the column "goods or services" are limited to those identical to the goods or services described in the basic registration or trademark register or the written application of the basic application or contained in the designated goods or designated services, the office of origin shall confirm whether or not the description in the written application of an international trademark registration is identical to or contained in the description of the designated goods or designated services of the basic registration or basic application.

(2a) Goods or services which can be described in the written application for an international trademark application are limited to the goods or services practically identical to or contained in the scope of the following designated goods or designated services at the time of verification of the international trademark application.

(i) Where the trademark is based on a registration, the designated goods or designated services registered in the trademark register of said registration and which are currently effective as a trademark right

(ii) Where the trademark is based on an application, the designated goods or designated services described in the written application of said application (where an amendment has been made, the post-amendment, designated goods or designated services)

\* When a request is made from the International Design and Trademark Application Office as to whether the written amendment in which the relevant designated goods or designated services are amended will be handled as being effective, the office in charge of the basic application will agree to hold talks, and based on the result thereof, the International Design and Trademark Office will perform this handling.

(2b) Confirmation of the identification of "the goods or services" and the designated goods or designated services of the basic registration or basic application are handled as follows.

(i) When the correspondence between the goods or services described in the written application of an international trademark application (described in English) and the

designated goods or designated services of the basic registration or basic application (described in Japanese) is identical to that shown in the published "Examination Guidelines for Similar Goods and Services" or "Alphabetical List for the International Classification Table of Goods and Services," they are handled as identical.

(ii) Those not falling under the above item (i) may be recognized to be identical when they are English translations that satisfy the following matters:

- a. The English translation is made by taking into consideration the classification and similar group codes of the goods or services
- b. Since some of the indications of goods and services published in the "Examination Guidelines for Similar Goods and Services" are single indications that are included in comprehensive indications and do not indicate the concept, the English translation must be one where the content and scope of the goods or services can be grasped by elements such as the material, usage, function or shape in the case of goods and usage, efficacy, location of provision or content of provision in the case of services.
- c. The English translation is indicated by italics for goods that are specific to Japan or the East and that have no corresponding English.

The English translation is not necessarily required to stick to the indication in the original language and may prioritize easy-understanding of the actual conditions of the goods or services.

(2c) When each item of goods or services described in the written application of an international trademark application is identical to or contained in the scope of the designated goods or designated services of the basic registration or basic application, even if the goods or services are described in an overlapped manner in the indication of the goods or services of the international trademark application, the description of the goods or services of the application shall not be recognized as deficient.

This handling is based on the consideration that the International Bureau shall not handle the respective description as deficient even if the designated goods or designated services are described in an overlapped manner.

<Example of overlapping indication of the goods and/or services>

cl.9 Television receivers, telecommunication machines and apparatus.

cl.20 Furniture, dining table.

(3) The paragraph confirms that, where the designated goods or designated services concerning the basic registration or basic application are indicated in a comprehensive manner (this includes "OO, OO, and other goods belonging to this class", etc.), the included description shall be recognized by judging the content according to the "classification of goods and services" effective at the time of the application of the

basic registration or basic application.

In addition, where the basic registration is subject to reclassification, the office of origin shall refer to the "Reclassification Guidelines for Reclassifying the Designated Goods of a Trademark Right", etc., if necessary.

(4) When there is a deficiency in the description, such as the case where the description of "the goods and services" changes or expands the content compared with the designated goods or designated services of the basic registration or basic application or where the identification cannot be recognized since the description of the goods or services is indicated unclearly, etc., the office of origin shall allow the replacement of the respective written application and urge the applicant to correct it.

Furthermore, for trademarks based on applications, when the translated description of the "goods and services" is recognized to be practically identical to the designated goods or designated services of the basic application, the description shall not be recognized as deficient, irrespective of the clarity of content and scope.

In addition, when an amendment is made to clarify the designated goods or designated services of the basic application before the office of origin verifies the identification of the matters stated in the international trademark application and those of the basic registration or basic application, the definition of identification shall be made by comparing it with the designated goods or designated services after the amendment.