

Chapter 14: Article4 (1)(xvi) (Misleading as to the quality of the goods or services)

(xvi) A trademark being likely to mislead as to the quality of the goods or services;
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1. Regarding the expression "quality of goods or services (hereinafter referred to as the "quality of goods, etc." in this item)"

(1) The "quality of goods, etc." refers to the quality indicated by the generic name of the goods or services, the trademark customarily used for goods or services or the "characteristics, etc. of the goods or services" as prescribed in Part I, Chapter 5, Item 1 (Article 3(1)(iii)) of the Guidelines.

(2) Even where the composition of a trademark contains characters representing the quality of goods, if such characters cannot be recognized as the quality of goods, etc. as a whole, such characters will be determined as not representing the quality of goods, etc.

Especially, for those trademarks that contain the name of a foreign state in their composition, such trademark will be determined as not representing the quality of goods, etc. only when it is apparent that the term constitutes part of an established word etc. that is not recognized as a name of a state.

(Example) Case where the trademark contains the name of a foreign state

(i) Case where the trademark is judged to represent the quality of goods, etc.

Trademark "SWISSTEX" for the goods "watches"

(Explanation) Since the trademark does not constitute part of an established word, it allows the persons who look at it to recognize the state name "Swiss Confederation."

(ii) Case where the trademark is determined not to represent the quality of goods, etc.

The trademark "colosseum" (which contains the term and pronunciation "Russia" in Japanese when indicated in Katakana characters) for the goods "medicines"

(Explanation) Since the trademark constitutes part of an established word, persons would not recognize the state name "Russian Federation."

2. Regarding the expression "likely to mislead"

(1) The expression "... likely to mislead as to the quality of the goods or services" refers to the case where the consumers are likely to be misled as to the quality of the goods, etc. but does not require that the manufacture and sale of the goods having the quality of goods, etc. represented by the trademark or provision of is actually conducted.

(2) Whether or not the trademark is "likely to mislead as to the quality of goods or services" is determined based on whether or not the quality of goods, etc. represented by the trademark is related to the designated goods or designated services and whether or not the quality of goods, etc. represented by the trademark differs from the quality of the designated goods or designated services.

(Example 1) Case where the trademark falls under this item

Trademark "JPOポテト" for the goods "vegetables."

(Explanation) In this case, the quality of the goods represented by the trademark is "potatoes as a generic term" and thus such goods are related to the designated goods, "vegetables." Moreover, such quality differs from the quality of "vegetables other than potatoes" included in the designated goods, and thus the trademark is determined to fall under this item.

However, this does not apply when the trademark is appropriately indicated without causing any misleading as to the quality of goods, etc. with the designated goods "potatoes."

(Example 2) Case where the trademark does not fall under this item

(i) The trademark "JPOポテト" for the goods "bicycle"

(Explanation) In this case, the designated goods are "bicycles" that are not related to the quality of the goods represented by the trademark, i.e. "potatoes as a generic name" and thus the trademark is determined not to fall under this item.

(ii) The trademark "JPOイギリス" for the goods "British-made clothing"

(Explanation) In this case, the quality of the goods represented by the trademark, i.e. "Britain as the place of production," is identical with the quality of the designated goods, and thus the trademark is determined not to fall under this item.

(iii) The trademark "JPOフランス" for the services "provision of French dishes"

(Explanation) In this case, the quality of the service indicated by the trademark, i.e. "France as the contents of the dishes" is identical with the quality of the designated services and thus the trademark is determined not to fall under this item.

(3) Even if the trademark contains characters, etc. that represent the quality of goods, etc., if the trademark as applied is well known among consumers as indicating the shop name, etc., trade name or business name, etc. of the applicant and it is unlikely for the consumers to be misled as to the quality of the goods, the relevant trademark is determined not to fall under this item.

3. Case where a trademark carries characters or figures, etc. guaranteeing the quality of goods,

etc.

Where a trademark carries characters or figures indicating the fact of winning awards from exhibitions such as "(... Exhibition Gold Medal Winning)" and "(... Grand Prize Winning)" and the exhibitions, etc. do not satisfy the standards set forth in Article 4(1)(ix), the applicant is required to prove the fact of winning the awards from exhibitions, etc. When the applicant fails to do so, the trademark is determined to fall under this item.

#### 4. Regional collective mark

Regional collective trademarks are determined to fall under this item, where the trademark is used with respect to goods or services other than those having a close relationship with the regional name contained in the trademark, because such use is liable to be misleading as to the quality of goods, etc.

However, this does not apply where the designated goods or designated services are indicated in a proper manner so as to prevent any misleading as to the quality of goods or services, as shown hereunder.

- (i) Indication of "(name of goods) made in ○○ (regional name)" where the regional name is the origin of the relevant goods
- (ii) Indication of "(name of services) provided in ○○ (regional name)" where the regional name is the location of provision of the services
- (iii) Indication of "(name of goods) made mainly of □□ (raw materials) produced in ○○ (regional name)" where the regional name is the origin of the main raw materials used for the relevant goods.
- (iv) Indication of " (name of goods) produced by the method originated in ○○(regional name)" where the regional name is the origin of the method used for the relevant goods, excluding methods such as "Indian curry" and "江戸前すし" [EDOMAE SUSHI] which have become recognized as general methods in the course of losing their close relationship to the relevant region.

The above example does not hinder the application of this paragraph, where the designated goods for a regional collective trademark stating " (name of goods) produced by the method originated in ○○ (regional name)" is liable to mislead the consumers into perceiving the goods as those made in ○○ or those made mainly of □□ (raw materials) produced in ○○.

#### 5. Amendment of trademarks that fall under this item

Refer to Part XIII, Item 1(2)(b) (Article 16-2 and Article 17-2) of the Guidelines for the amendment of trademarks that fall under this item.