

Part XVI: Article 68 -9, 10, 11, -12, 13, 15, 16, 17, -18, 20, and 28 (Special provisions relating to application for international registration)

Article 68-9 (1) Any request for territorial extension to designate Japan shall be deemed to be an application for trademark registration filed on the date of international registration provided in Article 3 (4) of the Protocol (hereinafter referred to as the "date of international registration"); provided, however, that in the case of subsequent designation, such request shall be deemed to be an application for trademark registration filed on the date on which the subsequent designation pertaining to the international registration pursuant to Article 3ter(2) of the Protocol(hereinafter referred to as the "date of subsequent designation") is recorded in the International Register of the International Bureau provided in Article 2 (1) (hereinafter referred to as the "International Register").

(2) Matters stated in the left column of the following table contained in the International Register pertaining to the international registration designating Japan shall be deemed to be the matters stated in the right column of the said table contained in the application submitted pursuant to Article 5 (1).

The name and the domicile or residence of the registered holder of international registration	The name and the domicile or residence of the applicant for trademark registration
The trademark subject to international registration	The trademark for which registration is sought
The goods or services listed in the international registration and the class of the goods or services	The designated goods or designated services and the class of the goods or services provided by Cabinet Order as provided for in Article 6(2);
Among matters stated in the International Register, those required for the interpretation of the meanings of statement of the trademark that is a subject of an international registration provided by Ordinance of the Ministry of Economy, Trade and Industry	Detailed description of the trademark

Article 68-10 (1) Where a registered trademark (hereinafter in this article referred to as a "registered trademark based on international registration") pertaining to the request for territorial extension which is deemed to have been an application for trademark registration pursuant to Article 68-9 (1) (hereinafter in this chapter referred to as an "international application for trademark registration") is identical with the registered trademark prior to the trademark registration (except registered trademarks based on international registration, hereinafter referred to in this article as a "registered trademark based on national registration") and the designated goods or designated services pertaining to the registered trademark based on international registration overlap with the designated goods or designated services based on national registration, and further the holder of trademark right of the registered trademark based on international registration is identical with the holder of trademark right of the registered trademark based on national registration, the international application for trademark registration shall be deemed to have been filed on the date of filing of the application for trademark registration pertaining to the registered trademark based on national registration to the extent of the scope which is overlapping.

(2) The provisions of paragraphs (3) and (4) of Article 68-32 shall apply mutatis mutandis to the international application for trademark registration under the preceding paragraph.

Article 68-11 For the purpose of application of Article 9 (2) to an international application for trademark registration, the term "at the time of filing of the application for trademark registration" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

Article 68-12 Article 10 shall not apply to an international application for trademark registration.

Article 68-13 Articles 11 and 65 shall not apply to an international application for trademark registration.

Article 68-15 (1) The provisions of paragraphs (1) to (4), and (7) to (9) of Article 43 of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13 (1) of this Act shall not apply to an international application for trademark registration.

(2) For the purpose of application of Article 43 (1) of the Patent Act as applied mutatis mutandis pursuant to Article 43-3 (3) of the Patent Act as applied mutatis mutandis upon reading the

specified terms in accordance with Article 13 (1) of this Act to the international application for trademark registration, the portion "within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

Article 68-16 (1) For the purpose of application of Article 34 (4) of the Patent Act as applied mutatis mutandis pursuant to Article 13 (2) of this Act to the international application for trademark registration, the portion ", except in the case of general succession including inheritance, without the Commissioner of the Patent Office." in the said paragraph shall be replaced with "without notification to the International Bureau."

(2) The provisions of paragraphs (5) to (7) of Article 34 of the Patent Act as applied mutatis mutandis pursuant to Article 13 (2) of this Act shall not apply to an international application for trademark registration.

Article 68-17 Where all or some of the goods or services listed in the international registration are divided and transferred as a result of a change in the ownership of international registration, the international application for trademark registration shall be deemed to have become applications for trademark registration with respect to each of the registered holders after the change.

Article 68-18 (1) Article 17-3 of the Design Act as applied mutatis mutandis pursuant to Article 17-2 (1) or 55-2(3) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2)) of this Act shall not apply to an international application for trademark registration.

(2) Article 17-4 of the Design Act as applied mutatis mutandis pursuant to Article 17-2 (2) of this Act shall not apply to an international application for trademark registration.

Article 68-20 (1) Where all or a portion of the international registration on which the international application for trademark registration is based has lapsed, the international application for trademark registration shall be deemed to have been withdrawn in respect of all or the portion of the designated goods or designated services that have lapsed.

(2) Where all or a portion of the international registration on which the international registration is based has lapsed, the trademark right based on such international registration the establishment of which has been registered under Article 18 (2) as applied upon reading the specified terms in

accordance with Article 68-19 (1) (hereinafter referred to as the "trademark right based on international registration") shall be deemed to have lapsed in respect of all or the portion of the designated goods or designated services that have lapsed.

(3) The preceding two paragraphs shall take effect as of the date the international registration lapses in the International Register.

Article 68-28 (1) After receiving a notification under the provisions of Article 15-2 (including cases where it is applied mutatis mutandis pursuant to Article 55-2 (1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2))) or Article 15-3 (including cases where it is applied mutatis mutandis pursuant to Article 55-2 (1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2))), any amendment to the designated goods or designated services stated in the international application for trademark registration may be made only while the case is pending in examination proceedings, an appeal or trial, or a retrial.

(2) Article 68-40 shall not apply to an international application for trademark registration, except for matters deemed to be the detailed description of a trademark under Article 68-9 (2).

Regulation for Enforcement of the Trademark Act

Article 4-9 Among the matters described in the international register contained in the table of Article 68-9, paragraph (2) of the Trademark Act, matters specified by the Order of the Ministry of Economy, Trade and Industry in the column to be specified by the Order of the Ministry of Economy, Trade and Industry as the matters necessary to interpret the meaning of the description of the trademark which is subject to the international registration are as follows:

- (i) Information on the allegation of colors (limited to the case of color marks); and
- (ii) Description of the mark.

1. Determination on the identicalness or overlap with the nationally registered trademark

The application of Article 68(10) (Special Provisions concerning Time of Filing of International Application for Trademark Registration) will be handled as follows:

(1) Article 68(10) will only be applied to registered trademarks based on effectively existing national registrations (hereinafter referred to as "nationally registered trademarks") at the time of the examination for the relevant international application for trademark registration, fulfilling the requirements prescribed in this Article. For example, this will not apply to the following trademarks.

(Example) Unapplicable trademarks

(i) Trademark as applied

(ii) Trademark pertaining to the registration based on an international application for trademark registration

(2) Trademarks pertaining to the international application for trademark registration must be identical with the marks pertaining to nationally registered marks (including those different in size)

(3) The determination on whether or not the designated goods or designated services of the international applications for trademark registration and those of national trademark registrations are overlapping will be made as follows:

(i) When it is apparent that the designated goods or designated services of the international application for trademark registration did not exist at the time of the application for nationally registered trademark, even if the designated goods or designated services of the international application for trademark registration are included in terms of concept in the (scope of) designated goods or designated services of the nationally registered trademark at the time of making the judgment under this Article, this will not be considered as overlapping.

(Example) Case where no overlapping is found

The designated goods "telecommunication machines and apparatus" of the nationally registered trademark

The designated goods "navigation apparatus for vehicles" of the international application for trademark registration

(Explanation) This determination is based on the premise that "navigation apparatus for vehicles" does not exist at the time of filing an application for a nationally registered trademark

(ii) Though the designated goods included in the international application for trademark registration may not have existed at the time of filing the relevant application for the nationally registered trademark, regardless of the criteria described in (i) above, taking into account the quality, shapes, intended purpose, functions etc. of the goods and the concept and idea of trade in general to which the designated good should belong, when the good is substantially considered to be identical with the designated good of a nationally registered trademark, the designated good will be considered as overlapping. Furthermore, designated services in relation to the international application for trademark registration will be handled in a manner similar as that for designated goods.

(Example) Case where the goods are found to be substantially identical

The designated goods "telecommunications machines and apparatus" of the nationally registered

trademark

The designated goods "liquid crystal television receiver set" for the international application for trademark registration

(Explanation) Even if the "liquid crystal television receiver set" did not exist at the time of filing an application for nationally registered trademark, a "television receiver set" which has the same intended use and function and is found to be substantially identical with the "liquid crystal television receiver set" existed.

(4) When the more than one good or service is designated in the international application for trademark registration, and when there are one or more nationally registered trademarks relevant to overlapping, whether the application date will retroact in accordance with the provisions of Article 68(10) or not will depend on the examination of the fulfillment of the requirements given in Article 65(10) for each nationally registered trademark case. When the requirements are proven to be fulfilled, the application date will retroact for each designated good or service of each nationally registered trademark.

2. Amendment of a trademark contained in the international application for trademark registration

Trademark of an international application for trademark registration cannot be amended as it is fixed at the time of international registration.