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Part I: Article 3(1) (Requirements for trademark registration)

Chapter 1: Overall Article 3(1)

Article 3

Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

- (i) consists solely of a mark indicating, in a common manner, the common name of the goods or services;
- (ii) is customarily used in connection with the goods or services;
- (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages, the same shall apply in Article 26(1)(ii) and (iii).), the method of time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price;
- (iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person;
- (v) consists solely of a very simple and common mark; or
- (vi) in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

1. Timing of making a judgment

A judgment on whether a trademark comes under Article 3(1) is made at the time of an examiner's decision.

A judgment on whether a trademark is made at the time of an appeal/trial decision if a request for appeal against an examiner's decision of refusal has been filed.

2. Three-dimensional trademark

(1) If it is recognized that a mark consisting of characters, figures or other elements which acquired distinctiveness is connected to a three-dimensional shape and the mark of characters, figures or other elements is used in a mode as a distinctive mark indicating the source of goods or services, the trademark as a whole is deemed to fall under the provisions of each item concerned of Article 3(1).

(2) A three-dimensional trademark which consists solely of a three-dimensional shape formed by merely giving thickness to characters falling under each item of Article 3(1) is deemed to fall under the provisions of each item concerned of Article 3(1).

### 3. Motion mark

(1) In order to judge whether a motion mark falls under the provisions of each item concerned of Article 3(1), a mark consisting of characters, figures or other elements of which the motion mark is composed and how it changes as time proceeds shall be examined together so that the trademark is examined as a whole.

(2) If a mark consisting of characters, figures or other elements of which a motion mark is composed does not fall under any items of Article 3(1)(i) to (vi), it shall be regarded that it is not applicable to the motion mark as a whole.

(3) composed falls under any items of Article 3(1)(i) to (vi), it shall be regarded that it is applicable to the motion mark as a whole in principle.

(4) If changes in time are drawn by a line or other figures as a trajectory, and if the trajectory represents a mark consisting of characters, figures or other elements, it shall be examined whether any items of Article 3(1)(i) to (vi) are applicable to the represented mark as a whole.

### 4. Hologram mark

(1) A mark consisting of characters, figures and other elements of which a hologram mark is composed, and changes caused by visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with another display surface depending on different viewing angles) shall be examined together so that the trademark is examined as a whole.

(2) With regard to effects based on holography and other means, which decorate a mark consisting of characters, figures and other elements, such as those which make a trademark appear to be three-dimensional, those which make a trademark shine by the reflection of light, it shall be examined whether any items of Article 3(1)(i) to (vi) are applicable to the mark consisting of

characters, figures and other elements shown on a display surface.

In this case, if any items of Article 3(1)(i) to (vi) are not applicable to the mark consisting of characters, figures and other elements of which the hologram mark is composed of, it shall be regarded that they are not applicable to the hologram mark as a whole.

(3) If the visual effects, out of the those described in (1) above, are used to show the mark with another display surface depending on different viewing angles, whether any items of Article 3(1)(i) to (vi) are applicable to the marks consisting of characters, figures and other elements shown on each display surfaces, as well as how much areas they occupy on their display surfaces, in what context they are displayed and how they relate to marks on other display surfaces shall be examined together so that the hologram mark is examined as a whole.

(4) If any items of Article 3(1)(i) to (vi) are applicable only to the mark consisting of characters, figures and other elements of which the hologram mark is composed of, it shall be regarded that they are applicable to the hologram mark as a whole, in principle.

#### 5. Color mark

(1) If a color mark is composed of combination of multiple colors, whether it falls under any items of Article 3(1)(i) to (vi) shall be examined as a whole. The same shall apply if colors are prescribed to be attached to specific positions of a color mark.

(2) If colors are prescribed to be attached to specific positions of a color mark, not the positions but the colors shall be examined to determine whether the colors fall under any items of Article 3(1)(i) to (vi), because a mark which constitutes the trademark consisting solely of colors is composed solely of colors.

#### 6. Sound mark

(1) In order to judge whether a sound mark falls under the provisions of each item concerned of Article 3(1), sound elements (musical elements, natural sounds and other elements) as well as linguistic elements (lyrics and other elements) of which the sound mark is composed shall be examined together so that the trademark is examined as a whole.

(2) If any items of Article 3(1)(i) to (vi) are not applicable to the linguistic elements, it shall be

regarded that any items of Article 3(1)(i) to (vi) are not applicable to the trademark as a whole.

(3) If any items of Article 3(1)(i) to (vi) are not applicable to the sound elements, it shall be regarded that any items of Article 3(1)(i) to (vi) are not applicable to the trademark as a whole.

(4) A sound mark recognized as merely reading a mark falling under any items of Article 3(1)(i) to (vi) is judged to fall under any items of Article 3(1)(i) to (vi) as a whole.

#### 7. Position mark

(1) In order to judge whether a position mark falls under the provisions of each item concerned of Article 3(1), a mark consisting of characters, figures and other elements of which the position mark is composed, as well as positions to which the marks are to be attached shall be examined together so that the position mark is examined as a whole.

(2) If any items of Article 3(1)(i) to (vi) are not applicable to the marks of which the position mark is composed, it shall be regarded that any items of Article 3(1)(i) to (vi) are not applicable to the trademark as a whole, in principle regardless of positions to which the marks are to be attached.

(3) If any items of Article 3(1)(i) to (vi) are applicable to only the marks consisting of characters, figures and other elements of which the position mark is composed, it shall be regarded that any items of Article 3(1)(i) to (vi) are applicable to the trademark as a whole, in principle.

Chapter 2: Main Paragraph of Article 3(1)

Article 3

Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

Regulation for Enforcement of the Trademark Act

Article 4 Among trademarks whose characters, figures, symbols, three-dimensional shapes or colors in connection therewith change consisting of the characters, figures, symbols, three-dimensional shapes or colors or any combination thereof before and after the change (hereinafter referred to as “changing trademark”), the description of trademarks that change as time proceeds (hereinafter referred to as “motion mark”) in an application pursuant to the provision of Article 5(1)(ii) of the Trademark Act shall be made by one figure or photograph or two or more different figures or photographs indicating the state of change as time proceeds in an identifiable way.

Article 4-2 Among changing trademarks, the description of a mark that changes by holography or other means (excluding those listed in the preceding Article, hereinafter referred to as “holograph mark”) in an application pursuant to the provision of Article 5(1)(ii) of the Trademark Act shall be made by one figure or photograph or two or more different figures or photographs indicating the state before and after changes in an identifiable way.

Article 4-3 The description of a three-dimensional trademark (hereinafter referred to as “three-dimensional trademark”) consisting of three-dimensional shapes (including a combination with characters, figures, symbols or colors or any combination thereof) in an application pursuant to the provision of Article 5(1)(ii) of the Trademark Acts shall be made by figures or photographs indicating the trademark from one angle or two or more different angles.

Article 4-4 The description of a trademark consisting solely of colors in an application pursuant to the provision of Article 5(1)(ii) of the Trademark Act shall be made by any of the following methods:

- (i) figures or photographs indicating the colors for which trademark registration is sought; or
- (ii) figures or photographs indicating the colors and a position to which they are attached by drawing the colors for which trademark registration is sought with only the colors and other

parts with broken lines.

Article 4-5 The description of a trademark consisting of sound (hereinafter referred to as “sound mark”) in an application pursuant to the provision of Article 5(1)(ii) of the Trademark Act shall be made by entering necessary matters for identifying the sound for which trademark registration is sought using characters or full score or a combination thereof; provided, however, that it may be described using one line stave in addition to the full score, if required.

Article 4-6 The description of a trademark for which a position to which a mark in connection therewith (limited to characters, figures, symbols or three-dimensional shapes or any combination thereof or any combination thereof with colors) is attached is specified (hereinafter referred to as “position mark”) in an application pursuant to the provision of Article 5(1)(ii) of the Trademark shall be made by one figure or photograph or two or more different figures or photographs indicating the way in which the mark and the position to which it is attached is specified by drawing the mark with solid lines and other parts with broken lines.

#### 1. “Business of an Applicant”

The “business of an applicant” shall include the business of the applicant himself/herself as well as the business of any person who is substantially recognized as being under control thereof.

(Examples)

- (i) Business of a stock company of which the majority of voting rights of all shareholders are owned by the applicant;
- (ii) Business of a company which has a capital alliance with the applicant and whose corporate activities are substantially under control of the applicant, although the requirement specified in (i) above is not satisfied.
- (iii) Business of an affiliated store (franchisee) if the applicant is a franchiser in a franchise agreement.

#### 2. “Trademark is used”

(1) The expression of “a trademark is used” includes not only cases where the applicant or any person who is substantially recognized as being under control thereof (hereinafter referred to as “the applicant, etc.”) actually uses the trademark as applied in connection with the designated goods or designated services but also cases where the applicant, etc. has the intention to use the



trademark as applied (hereinafter referred to as the “intention of use”) in the future.

(2) The designated services falling under, for example, the following example will receive a notification of reason for refusal stating that the trademark does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1), because it is likely that it is impossible to use the trademark, and whether the applicant may carry out the designated services or not shall be confirmed.

(Example)

If it is obliged to have any national qualification prescribed in laws and regulations to execute a business in connection with the designated services, it is not able to confirm whether the applicant is a juridical person that may execute the business connected with the designated services from the applicant’s name or other matters described in an application or the applicant has the national qualification as an individual

(3) A designated good or designated service falling under the following (a) or (b) will receive a notification of reason for refusal stating that the trademark does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1), because there is a justifiable doubt as to whether the applicant is using, or planning to use, a trademark connected with the designated good or designated service. The use or intention of use of the trademark will be ascertained in accordance with Item 3 below.

However, this shall not apply where the applicant, at the time of filing an application, was using or planning to use the trademark, by which use or intention of use of the trademark can be ascertained.

(a) Regarding services provided for in Article 2(2) of the Trademark Act (hereinafter referred to as “retail services”)

(i) Where a person (natural person) has designated services falling under the category of “provision of benefits to customers in retail services or wholesale services for a variety of goods in each of the fields of clothing, foods and beverages, and livingware, and taking all goods together” (hereinafter referred to as “general retail services”).

(ii) Where a juridical person has designated services falling under the category of general retail services, and if the investigation as to whether or not the trademark will be “used in connection with goods or services pertaining to his business” found out that the applicant is not conducting

general retail services.

(iii) Where more than one of the retail services have been designated that are not similar to each other.

(b) Regarding overall goods and services other than those mentioned in (a) where the designation of goods or services ranges widely in one classification.

### 3. Ascertaining of whether a trademark will be used

(1) It is required for the applicant to show the “trademark will be used” for each of the similar groups (Similar groups are referred to in the Examination Guidelines for Similar Goods and Services and group goods or services presumed to be similar to each other) in each of the classifications of the designated goods or designated services.

(2) The use or intention of use of the trademark will be ascertained through the fact that the applicant is conducting, or planning to start, business connected with the designated goods or designated services.

(3) Ascertaining of whether the applicant is conducting business The fact that the applicant is conducting business connected with retail services will be confirmed in the following manner.

(a) For retail services belonging to general retail services, it will be proved in a comprehensive manner by referring to the following facts:

(i) that the applicant is a retailer or a wholesaler.

(ii) that the above retailer or wholesaler is providing retail services at one establishment for a variety of goods in each of the fields of clothing, foods and beverages, and livingware, and taking all goods together.

(iii) that the sales of each field of clothing, foods and beverages, and livingware is accounting for around from 10% to 70% of the total sales.

(b) The following, for example, will be accepted as means of proof that the applicant is carrying out business connected with the designated goods or designated services.

(i) Printed matters (catalogs, leaflets, etc. containing the goods handled by the applicant, etc.)

(ii) Photographs of the interior of the store operated by the applicant, etc. and of the goods handled by him

(iii) Business documents showing the goods handled by the applicant, etc.

(order forms, delivery statements, invoices, receipts, etc.)

(vi) Articles on newspapers, magazines, the internet, etc. presenting the content of business of and the goods handled by the applicant, etc.

(v) Documents stating the sales amount of goods in relation to retail services (in cases of general retail services)

(4) The fact that the applicant is planning to start business connected with the designated goods or designated services.

(a) Where the applicant shows his intention of starting to use the trademark within 3 to 4 years from the date of filing the application (within three years following the registration), he is judged to be planning to start business connected with the designated goods or designated services

(b) In order to prove that the applicant is planning to start business connected with the designated goods or designated services, the applicant thus will be requested to submit documents specifying his intention of use of the trademark and documents stating his preparation status.

Where his intention of use of the trademark is uncertain, or there is a doubt as to the relevant preparation status, the applicant will be requested, as needed, to submit further documents supporting the business operation and plan.

#### 4. International application for trademark registration

(1) When the international registered trademark in the application for international registration does not correspond to the trademark the provisions of Article 2(1) of the Trademark Act for the international application for trademark registration, the trademark is judged not to fall within the category of trademarks registrable under the main paragraph of Article 3(1).

(2) A trademark described as corresponding to “a collective trademark” in the application of an international trademark registration is judged not to fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1) when the certificate prescribed in Article 7(3) (certifying the applicant as a juridical person that falls under Article 7(1)) is not submitted.

Furthermore, the application of collective trademark registration (domestic application) will be subject to amendment orders (formality).

#### 5. Collective trademark

An application for registration of a collective trademark not to be used by an organization and

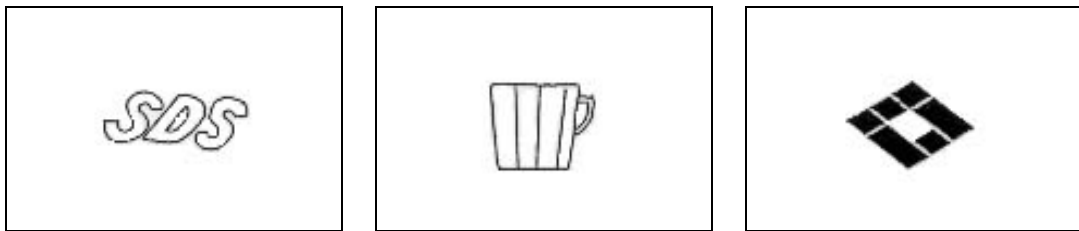
its members or to be used for the designated goods and services only by an organization but not by its members is judged not to fall within the category of trademarks registrable under the main paragraph of Article 3(1) (as applied under Article 7(2)).

#### 6. Three-dimensional trademark

A trademark described as corresponding to three-dimensional trademark but not so recognized in composition and mode from its description given in the column (hereinafter referred to as the “trademark stated in an application”) to describe the trademark seeking to apply for a trademark registration is judged not to fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1).

##### (1) Examples of Trademarks Not Recognized as Three-Dimensional

(a) In case where the trademark stated in an application is not recognized to indicate a three-dimensional shape



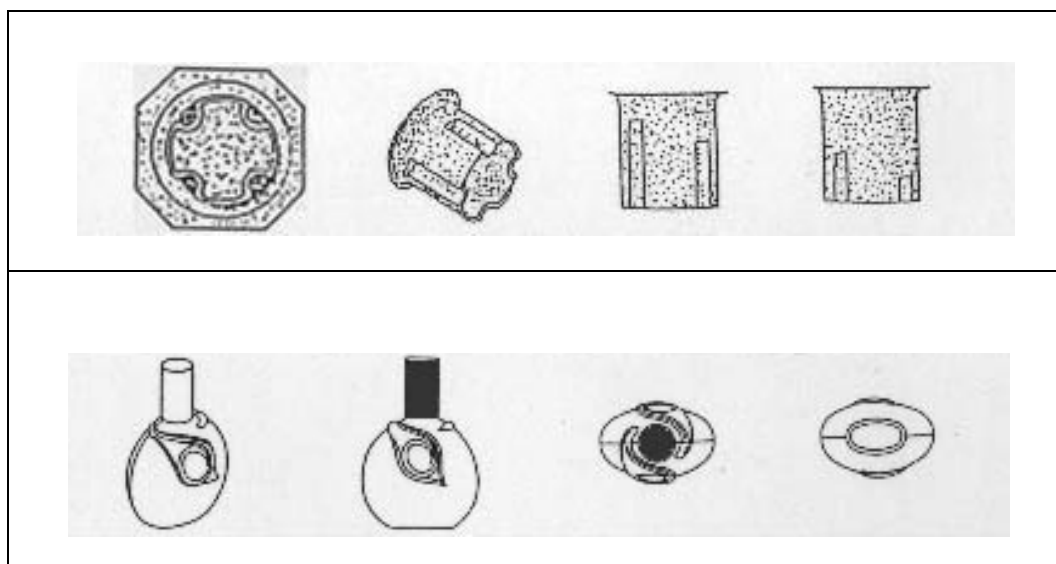
(Note) A shape as an outer appearance of a three-dimensional object such as a thickness, etc. is not described and recognized as characters, figure or symbol.

(b) In case where the trademark stated in an application is recognized to describe a characters, figure or symbol separate from a three-dimensional shape



(Note) As a plain mark does not have a composition or mode with characters, figures or symbols not fitted on the surface of an object connected with a three-dimensional shape but it has a composition or mode separate from a three-dimensional shape, it is not considered overall to indicate a shape as an outer appearance of a three-dimensional object and recognized as a three-dimensional trademark.

(c) In case where more than a single drawing is described in the trademark described in an application, but the marks shown in each figure do not match each other.



(Note) Although the trademark is described in more than a single drawing, three-dimensional shapes and colors indicated in each figure do not match each other and are not identified as a single three-dimensional shape.

(d) In case where the trademark is composed of a shape of some of the designated goods, but it cannot be supposed as a shape of goods, etc. in other designated goods, etc. and its use as advertisement of goods, etc. cannot be supposed naturally.

[Trademark for Which Registration Is Sought]



[Three-dimensional trademark]

[Designated Goods or Designated Services and Classification of Goods and Services] [Class 5]

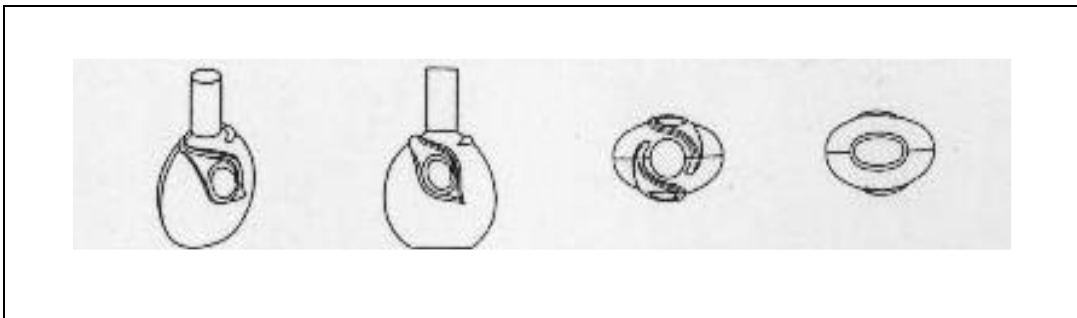
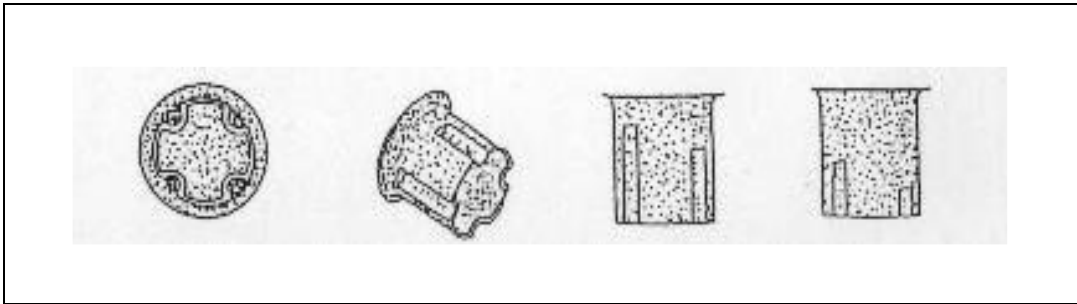
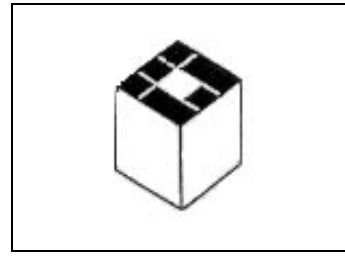
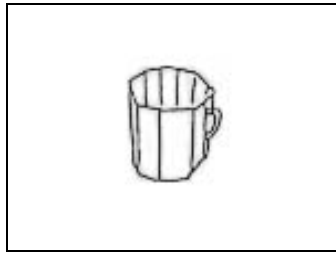
[Designated goods (Designated services)] Pharmaceutical preparations, sanitary masks

(Note) In this case, the trademark will receive a notification of reason for refusal stating that it does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1), since it is not naturally supposed that a designated good other than sanitary masks adopts the three-dimensional shape or is used as advertisement. In response to this notification, it is required to modify designated goods to only “sanitary masks.”

## (2) Examples of Trademarks Recognized as Three-Dimensional

The trademark stated in the application can be recognized to be a three-dimensional shape or a

combination of a three-dimensional shape and characters, figures, symbols or colors.

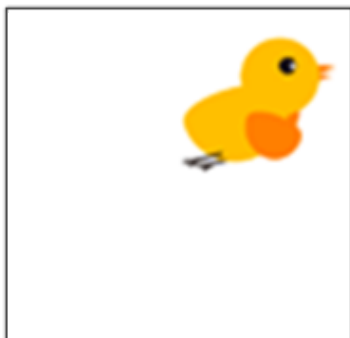


## 7. Motion Mark

A trademark stated as a motion mark but not so recognized from a trademark stated in its application as well as its detailed description shall be judged not to fall within the category of trademarks registerable in accordance with the main paragraph of Article 3(1).

(1) Example not recognizable as a motion mark

Changes of a mark in time cannot be recognized from a trademark stated in its application.



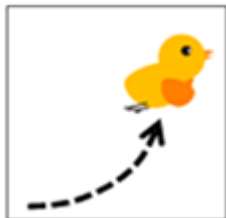
(Note) A trademark is stated in a single figure and changes in time cannot be recognized because no pointing line is provided.

(2) Example recognizable as a motion mark

Changes of a mark in time are recognizable from a trademark stated in its application, and a description is provided in its detailed description of the trademark which makes it recognizable as a motion mark.

(Example 1) Example where one figure is used to state a trademark (Example where the mark moves without changes)

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a motion mark.

It is shown that a bird at the lower left gradually moves to the upper right along the trajectory of a dotted line. This motion mark lasts for 3 seconds in total.

Furthermore, the dotted line in the figure is provisionally provided to indicate how the bird moves along the trajectory, and does not constitute a part of the trademark.

(Example 2) Example where multiple figures are used to state a trademark

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a motion mark.

It is shown that a bird moves gradually to the upper right from Figure 1 to Figure 5 with its wings up. This motion mark lasts for 3 seconds in total.

Furthermore, the numbers indicated at the lower right of individual pages are provisionally provided to show the sequence of the pictures, and do not constitute a part of the trademark.

## 8. Hologram Mark

A trademark stated as a hologram mark but not so recognized from a trademark stated in its application and its detailed description of the trademark shall be judged not to fall within the category of trademarks registerable in accordance with the main paragraph of Article 3(1).

### (1) Example not recognizable as a hologram mark

Changes of its states cannot be recognized from a trademark stated in its application or from its visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with different display surfaces depending on viewing angles).



(Note) Because multiple display surfaces are stated in a single figure, no changes of a mark's states can be recognized from its prior to next states due to an effect by which different display surfaces are seen depending on different viewing angles.

### (2) Example recognizable as a hologram mark

Changes of its states caused by visual effects based on holography and other means can be recognized from a trademark stated in its application, and whose detailed description of the trademark provides a statement which makes it recognizable as a hologram mark.

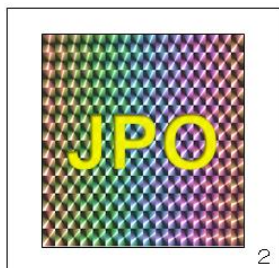


(Example) Hologram mark in which multiple display surfaces are indicated

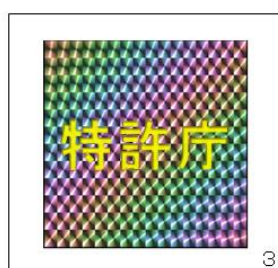
[Trademark for Which Registration Is Sought]



1



2



3

[Hologram Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a hologram mark showing different display surfaces depending on viewing angles.

Its displays seen from the left, the front and the right are shown in Figures 1, 2 and 3, respectively.

Furthermore, the numbers shown at the lower left are provisionally provided to indicate the sequence of the figures, and do not constitute a part of the trademark.

## 9. Color mark

A trademark stated as a color mark but not so recognized from a trademark stated in its application and its detailed description of the trademark shall be judged not to fall within the category of trademarks registerable in accordance with the main paragraph of Article 3(1).

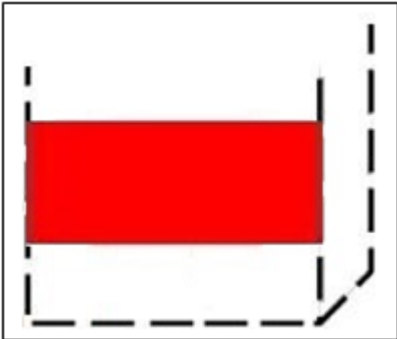
### (1) Example not recognizable as a color mark

(a) A color mark which evidently represents specific characters, figures, etc. from a trademark stated in its application



(b) It is not recognized that the position in goods, etc. to which colors are attached is identified from a trademark stated in its application.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark. The front central part of a packaging container of goods consists of only red (RGB combination: R255, G0, B0).

It must be noted that dotted lines shown are for explanation purposes only, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 5]

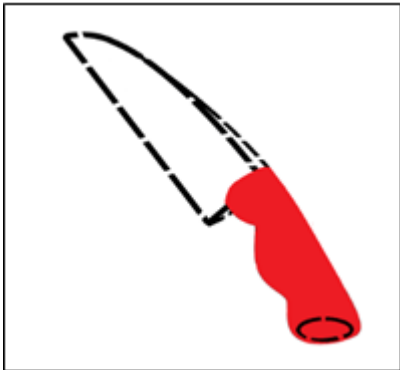
[Designated Goods (Designated Services)] Pharmaceutical preparations

(Note) In this case, because the dotted lines representing the packaging container to which the mark is attached do not show the entire image, the position where the mark is attached is not specified and its position in the goods cannot be identified.

Furthermore, an amendment to change a trademark for which registration is sought falls under the change of gist.

(c) The detailed description of the trademark provides a statement which makes a mark recognizable as a combination of colors and figures.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark whose configuration is such that it consists only of the wave shape of a kitchen knife’s handle colored in red (RGB combination: R255, G0 and B0). It must be noted that dotted lines shown are for explanation purposes only, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

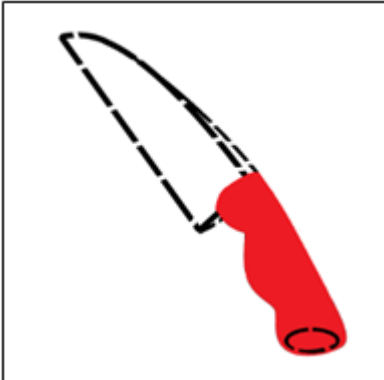
[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Note) In this case, the mark is recognized as a combination of a three-dimensional shape and a color based on the detailed description of the trademark. Therefore, the trademark will receive a notification of reason for refusal stating that it does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1) and Article 5(5). In response to this notification, it is required for the applicant to make an amendment in the detailed description of the trademark to clarify that the mark consists only of colors. For example, it can be explained that “the mark consists of a kitchen knife’s handle colored in red (RGB combination: R255, G0 and B0).”

(d) A shape of goods, etc. described to identify the position to which a color is attached cannot be supposed to be a shape of the designated goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark whose configuration is such that a kitchen knife’s handle is colored in red (RGB combination: R255, G0 and B0).

It must be noted that dotted lines resembling a kitchen knife and a handle of the kitchen knife shown are for explanation purposes only, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife, hand hair clipper

(Note) In this case, the goods “hand hair clipper” are not supposed to be a kitchen knife’s handle part, the trademark will receive a notification of reason for refusal stating that it does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1). In response to this notice, it is required for the applicant to make an amendment to eliminate “hand hair clipper” so that the designated goods are described as only “kitchen knife.”

(2) Example recognized as a color mark

(a) It can be recognized from a trademark stated in its application that a mark consists only of colors and whose detailed description of the trademark provides a statement which seems to make it recognizable as a color mark.

(Example 1) Single color

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought is a color mark which consists of only red (RGB combination: R255, G0, B0).

(Example 2) Combination of colors

[Trademark for Which Registration Is Sought]



[Color Mark]

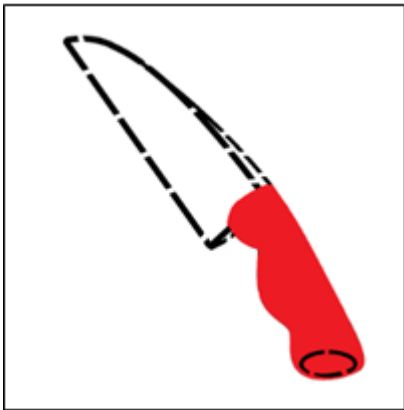
[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is one which consists of only combination of colors. The types of combination are red (RGB combination: R255, G0, B0), blue (RGB combination: R0, G0, B255), yellow (RGB combination: R255, G255, B0), and green (RGB combination: R0, G128, B0), and the percentage values of these colors from the first to the last are 50% for red, 25% for blue, 15% for yellow and 10% for green.

(b) For a trademark consisting of only colors whose positions in goods or others are specified, a trademark stated in its application is displayed whose configuration is such that the said colors and their positions in its goods or others can be specified by drawing colors for which registration is sought with only the said colors and other parts with dotted lines, and whose detailed description of the trademark provides a statement which makes it recognizable as a color mark.

(Example 1) Trademark which specifies specific positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark whose configuration is such that a kitchen knife’s handle is colored in red (RGB combination: R255, G0 and B0).

It must be noted that dotted lines showing a shape of the goods are for explanation purposes only, and do not constitute a part of the trademark.

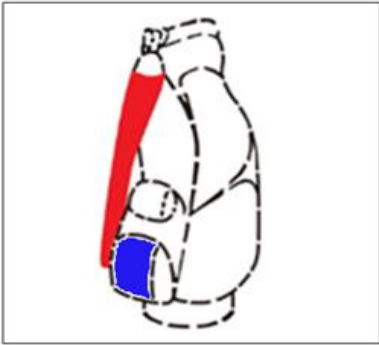
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 2) Trademark which identifies positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark whose configuration is such that a golf club bag’s belt is colored in red (RGB combination: R255, G0 and B0) and the frontal part of its pocket in blue (RGB combination: R36, G26, B240).

It must be noted that dotted lines resembling a golf club bag are only for purposes to explain how a golf club bag might look like, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

## 10. Sound Mark

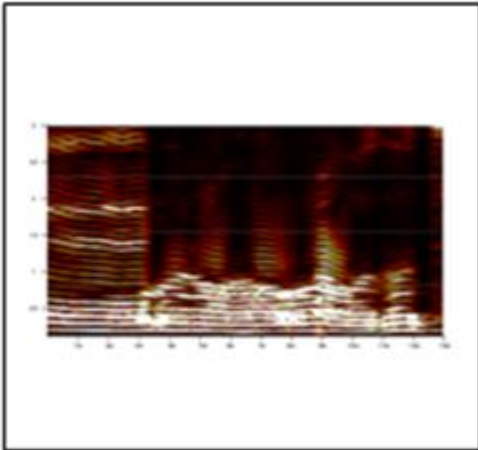
A trademark stated as a sound mark but not so recognized from a trademark stated in its application, its article provided for in an Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as the “article”) and its detailed description of the trademark shall be judged not to fall within the category of trademarks registerable in accordance with the main paragraph of Article 3(1).

(1) Example not recognizable as a sound mark

(a) A trademark stated in its application describes an element other than those necessary for specifying sound such as music titles, names of composers, etc.

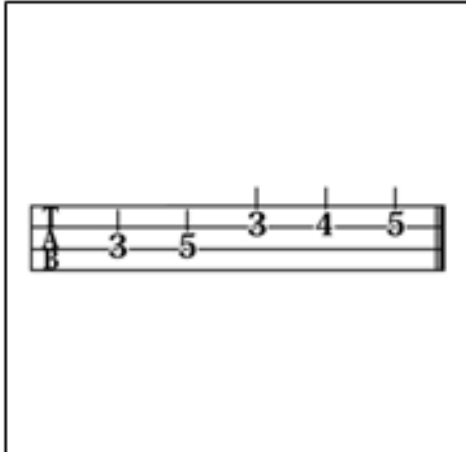
(b) A trademark stated in its application is stated by a method other than those prescribed in Article 4(5) of the Enforcement Ordinance of the Trademark Act.

(Example 1) A trademark is stated by a sound spectrogram (sonogram) notation.



(Note) A sound spectrogram (sonogram) is a method to record and display sound in three dimensions, sound frequencies and distributions of amplitudes and time passage, through a sound analysis device.

(Example 2) A trademark is stated by a tablature notation (tab and playing method notations) or a letter notation.



(Note) A tablature notation is a musical score which uses characters and numerals to show a playing method specific to an instrument, and currently it is frequently used as a musical score for a guitar.

(2) Examples recognized as a sound mark

A trademark stated in its application is described by a method prescribed in Article 4(5) of the Enforcement Ordinance of the Trademark Act and includes all the following items to specify sound.

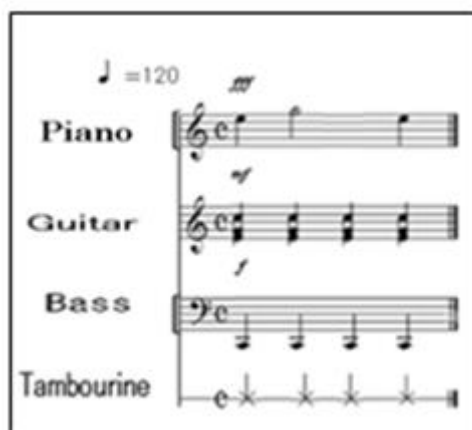


- (a) Where any of the following items is stated in a full score.
- (i) Musical notes
  - (ii) Clefs such as treble clefs
  - (iii) Tempos such as metronomic indications and tempo marks
  - (iv) Time signatures such as four-four times
  - (v) Linguistic elements when lyrics and others are included

(Example 1)



(Example 2)



A musical score for a full band arrangement. It includes four staves: Piano, Guitar, Bass, and Tambourine. The tempo is marked as quarter note = 120. The Piano part has a dynamic marking of *mp* and consists of three quarter notes: G4, A4, and B4. The Guitar part has a dynamic marking of *mf* and consists of three quarter notes: G4, A4, and B4. The Bass part has a dynamic marking of *f* and consists of three quarter notes: G3, A3, and B3. The Tambourine part consists of three quarter notes, each marked with a star symbol. The score ends with a double bar line.

(Note) One line staves can be used, as needed, in addition to a full score.

(Example 3)

[Trademark for which Registration is Sought]



[Sound Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a sound mark whose configuration is such that it is played by using a tambourine which is a percussion instrument without pitch.

The trademark describes the score by using the third line in a full score as one line staves.

(Note) A sound mark can be described as one line staves for a percussion instrument using one line in a full score only if a percussion instrument without pitch is used.

(b) Characters are used to describe the following items in a trademark.

(i) Sound types

Methods such as that to combine onomatopoeic and mimetic words are used to specify a sound mark (for example, sounds such as a cat’s “meow”, human hands’ “clapping”, wind’s “whizzing,” wind’s “roaring,” a machine’s “clicking” and a machine’s “whirring”).

(ii) Other elements required to specify sounds

How long a sound lasts (time), how many times a sound is iterated, in what sequence a sound is generated, how a sound changes and other specifications will be described.

Furthermore, how a sound changes means how a sound volume changes, how strong or weak a sound is, how a sound’s tempo changes and other aspects.

(Example)

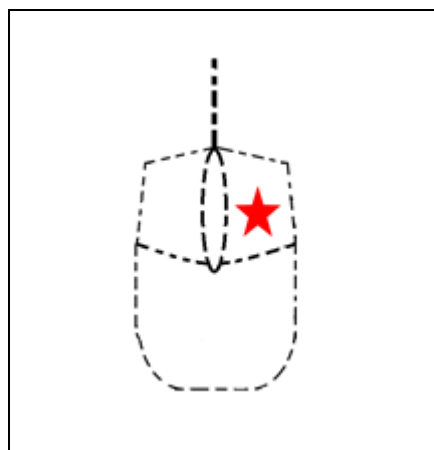
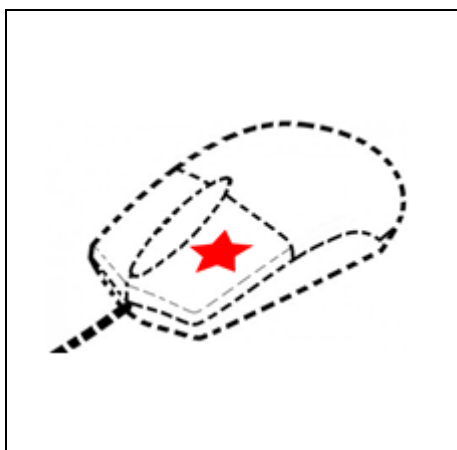
本商標は、「パンパン」と2回手をたたく音が聞こえた後に、「ニャオ」という猫の鳴き声が聞こえる構成となっており、全体で3秒間の長さである。

## 11. Position Mark

A trademark stated as a position mark but not so recognized from a trademark stated in its application and its detailed description of the trademark shall be judged not to fall within the category of trademarks registerable in accordance with the main paragraph of Article 3(1).

(1) Example not recognizable as a position mark

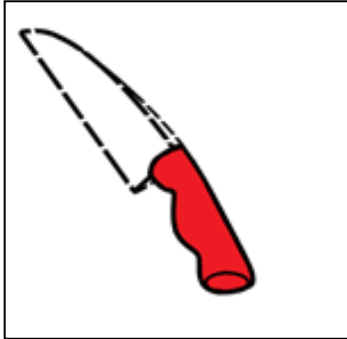
(a) A position to which the mark is attached cannot be recognized from a trademark stated in its application.



(Note) Positions of marks (figures) are different in multiple figures shown, and it cannot be determined to which part in its goods the mark is attached.

(b) The trademark described in its application and the detailed explanation thereof contain a statement which makes it recognizable as that the mark is only composed of color.

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter, referred to as the “trademark”) is a position mark whose configuration is such that a kitchen knife’s handle is colored in red.

It must be noted that dotted lines shown are only provided to show a shape of the trademark’s goods, and does not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

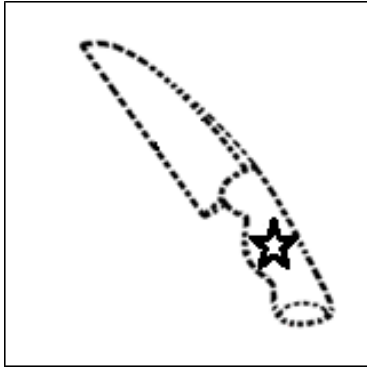
(Note) A position mark is, in accordance with Article 4(6) of the Enforcement Ordinance of the Trademark Act, limited to “characters, figures, symbols or three-dimensional shapes, or a combination thereof or a combination thereof with colors” as a requirement for marks, and it is not allowed that a mark consist of “only colors.” Therefore, it is required to clarify in the detailed description of the trademark what is a mark connected with colors like. In this case, the description of “a kitchen knife’s handle is colored in red” can be interpreted that a mark colored in “red” is attached to the “kitchen knife’s handle, so that the mark can be recognized to be composed of only colors.

Therefore, the trademark will receive a notification of reason for refusal stating that the trademark does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1) and Article 5(5) simultaneously. In this case, it is required for the applicant to make an amendment in the detailed description of the trademark to clarify that the mark consists of a combination of a three-dimensional shape and colors. For example, the detailed explanation of the trademark can say that “the mark consists of a three-dimensional shape whose

kitchen knife's handle is colored in red.”

(c) A shape of a good, etc. stated to specify its position cannot be supposed as a shape of the designated goods, etc.

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter, referred to as the “trademark”) is a position mark whose configuration is such that a position to which a mark is attached is specified and consists of a star-shaped figure attached to the central part of a side of the kitchen knife's handle.

It must be noted that dotted lines are only provided to show a shape of the trademark's goods, and does not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Scissors, kitchen knife, swords, ink bottles

(Note) In this case, a position equivalent to the kitchen knife's handle cannot be specified by the goods “scissors and ink bottles,” Therefore, the trademark will receive a notification of reason for refusal stating that the trademark does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1). In response to this notification, it is required for the applicant to make an amendment to limit the designated goods to “kitchen knife and swords.”

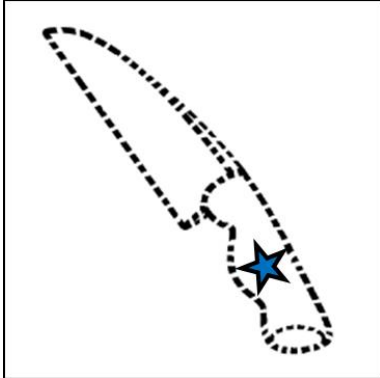
(2) Example recognized as a position mark

It can be recognized that a trademark described in its application is displayed in a way that a mark and a position in its good to which it is attached can be specified by 30 drawing the mark in real lines and other parts in dotted lines, and whose detailed description of the trademark contains

a statement which makes it recognizable as a position mark.

(Example 1)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter, referred to as the “trademark”) is a position mark whose configuration is such that a position to which a mark is attached is specified and consists of a star-shaped figure attached to the central part of a side of the kitchen knife’s handle.

It must be noted that the dotted lines are only provided to show a shape of the trademark’s goods, and does not constitute a part of the trademark.

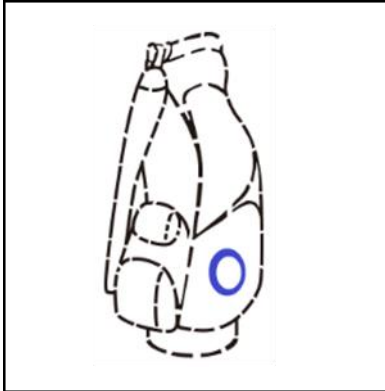
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 2)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the “trademark”) is a color mark whose configuration is such that a position to which a mark is attached is specified and it is attached to the lower part of a side surface of the golf club bag.

It must be noted that the dotted lines are only provided to show a shape of the trademark’s goods, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

Chapter 3: Article 3(1)(i) (Common name of goods or services)

(i) A trademark consisting solely of a mark indicating, in a common manner, the common name of the goods or services;

1. Common name of goods and services

In case where the names of goods or services (including abbreviations and familiar names) are recognized as a name of goods or services which is commonly used by traders, they are judged as “common names of goods or services.”

(Example 1) Customarily used name

Trademark indicating “サニーレタス” (Sunny lettuce) in respect of goods of “サニーレタス” (Sunny lettuce).

Trademark indicating “さんぴん茶” (Sanpin cha (Sanpin tea)) in respect of goods of “さんぴん茶” (Sanpin tea) .

Trademark indicating “電子計算機” (Denshikeisanki (Computer)) in respect of goods of “電子計算機” (Computer).

Trademark indicating “美容” (Biyō (Beauty)) in respect of services of “美容” (Beauty).

(Example 2) Abbreviations

Trademark indicating “スマホ” (Sumaho (Smartphone)) in respect of goods of “スマートフォン” (Smartphone).

Trademark indicating “アルミ” (Alumi (Aluminium)) in respect of goods of “アルミニウム” (Aluminium).

Trademark indicating “パソコン” (Pasocon (Personal Computer)) in respect of goods of “パーソナルコンピュータ” (Personal Computer) .

Trademark indicating “損保” (Sonpo (Non-life insurance)) in respect of services of “損害保険の引受け” (Undertaking Non-life Insurance).

Trademark indicating “空輸” (Kuyu (Air transportation)) in respect of services of “航空機による輸送” (Air Transportation),

(Example 3) Familiar name

Trademark indicating “波の花” (Naminohana (Flower of wave)) in respect of goods of “塩” (Salt),



2. "indicating in a common manner"

(1) Marks of which font or total composition is unique beyond the scope which is customarily-used by traders shall not be deemed as those "indicating in a common manner by giving due consideration to the actual state of transaction of the goods or services.

(Example 1) Marks judged to fall under "indicating in a common manner"

Marks indicated in a font or composition commonly used by traders

(Example 2) Marks judged not to fall under "indicating in a common manner"

Marks indicated by applying special lettering beyond the scope which is customarily-used by traders or in unique composition

(2) Methods of indicating characters

(a) The common names of goods or services indicated in Roman characters or kana characters are judged as "indicating in a common manner."

(b) The common names of goods or services indicated in Chinese characters (phonetic equivalent) which are not commonly used by traders are not judged as "indicating in a common manner."

3. Name of a registered variety which falls under this item

Refer to Part III, Chapter 12, Item 3 (Article 4(1)(xiv)) of the Guidelines for the name of registered varieties.

Chapter 4: Article 3(1)(ii) (Trademarks customarily used)

(ii)A trademark customarily used in connection with the goods or services;
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1. Trademark customarily used in connection with the goods or services

“A trademark customarily used in connection with the goods or services” is one which has become impossible to distinguish own goods or services and goods or services of others as a result of being customarily used among traders.

(Example 1) Trademarks consisting of characters, figures and other elements Trademark indicating “純正” (genuine) and “純正部品” (genuine parts) in respect of goods of “自動車の部品、付属品” (automotive parts, accessories)

Trademark indicating “正宗” [MASAMUNE] (Refined Japanese sake wine) in respect of goods of “清酒” (sake)

Trademark indicating “オランダ船の図形”([ORANDASEN NO ZUKEI] (Figure of cake)) in respect of goods “カステラ” (castella)

Trademark indicating “かきやま”[KAKIYAMA] (rice crackers) in respect of goods “あら れ” (cubic rice crackers)

Service indicating “観光ホテル” [KANKO HOTEL] (tourist hotel) in respect of services “宿泊施設の提供” (Provision of lodging accommodations)

(Example 2) Trademarks consisting of Color marks only

Trademark indicating “color combining red color and white color” in respect of services “execution of wedding ceremonies”

Trademark indicating “color combining black color and white color” in respect of services “execution of funeral ceremonies”

(Example 3) Sound marks

Trademark “Cries of a street seller who sells sweet potatoes baked on hot pebbles” in respect of goods “baked sweet potatoes”

Trademark “Sounds of a flute played by a street vendor who sells noodles on the streets at night (Chinese noodle supply) in respect of services “provision of Chinese noodles in food stand”

Chapter 5: Article 3(1)(iii) (Indication of origin, place of sale, quality and other characteristics of the goods, or indication of location, quality and other characteristics of provision of the services)

(iii) A trademark consisting solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages; the same shall apply in Article 26 (1)(ii) and (iii)), the method or time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price;

Part I Chapter 5: Article 3(1)(iii)

1. “In the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages), the method or time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price” (hereinafter referred to as “the characteristics, etc. of goods or services”)

- If a trademark, when used for its designated goods or services, is generally recognized among consumers or traders as indicating the characteristics, etc. of the goods or services, it is judged to fall under the provision of this item.

- In order to be “generally recognized,” a trademark is not required to be actually used as something that indicates the characteristics, etc. of the goods or services.

(1) Trademarks indicated with prolonged sound symbols such as “コクナール,” “スグレータ,” “とーくべつ,” “うまーい,” and “早ーい” which, when examined with their prolonged sound symbols excluded, are recognized as indicating the characteristics, etc. of goods or services are determined to indicate the characteristics of the goods or services in principle.

(2) Trademarks indirectly indicating the characteristics, etc. of goods or services are determined not to indicate the characteristics, etc. of goods or services.

(3) Trademarks indicating the characteristics, etc. of goods or services by means of figures or three-dimensional shapes are determined to indicate the characteristics, etc. of goods or services.

2. “Origin or Place” and of “Place of Sale” of goods and “Location of Provision” of services

(1) Where trademarks are composed of a geographical name in Japan and overseas (a name or a map indicating a nation, an old nation, a capital, a province, an administrative area (a prefecture, a municipality, a special city ward, etc.), a state, the capital of a state, a county, the capital of a province, an old country, an old area, a busy downtown street, a sightseeing area (including its location and surrounding areas), a lake, a mountain, a river, or a park, etc.), they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services,” where a consumer or a trader generally recognizes that the designated goods will be produced or sold or the designated services will be provided at the place indicated by the geographical name.

(2) Where trademarks are composed of a state name (including abbreviations of state names and former state names of existing countries) or famous geographical names in Japan and overseas, they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services.”

### 3. “Quality” of Goods and Services

#### (1) Contents of articles to be used for the provision of goods or services

In any of the following cases, a trademark which recognizes the content of goods is judged to indicate the quality of goods or services.

Whether a trademark indicates a content of an article to be used for the provision of goods or services or not is determined based on the following criteria.

(a) Where a trademark is recognized to clearly indicate specific contents of works such as their classification and type in respect of such goods as “books,” electronic publication,” “film” recording images, “sound recorded magnetic tapes,” “sound recorded compact disks,” “phonograph records,” etc., it is judged to indicate “the quality” of goods.

(Examples) Trademark “The Trademark Act”, “Novel Collection” in respect of goods “Books”

Trademark “Classic Music” in respect of goods “Sound Recorded Compact Disk”

(b) Where a trademark is recognized to clearly indicate specific contents of broadcast program which is a service to be used for the provision of services, such as their classification and type in respect of such services as “production of broadcast programs” and “distribution of broadcast programs,” etc. it is judged to indicate “the quality” of services.

(Examples) Trademarks “News,” “Music Program” and “Variety Show” in respect of services “Production of broadcast programs”

(c) Where a trademark is recognized to clearly indicate specific contents of articles provided for

use by a person to which the service is provided (“cine films,” “image recorded magnetic tapes,” “sound recorded magnetic tapes,” “recorded compact disks,” “phonograph records,” etc.) such as their classifications and types in respect of such services as the rental of “cine films” “image recorded magnetic tapes” “sound recorded magnetic tapes,” “recorded compact disks,” “phonograph records,” etc., is judged to indicate the quality of a service.

(Examples) Trademark “Japan Folksong Collection” in respect of a service “Rental of sound recorded compact disks”

Trademark “Suspense” in respect of a service “Rental of cine films”

(d) Where a trademark is recognized by consumers as a title of a name of broadcast program (hereinafter referred to as “the title, etc.”) in respect of such goods or services as “books,” “production of broadcast programs,” etc. and the title, etc. is found to recognize specific contents, it is judged to indicate the quality of goods or services, since it recognizes the contents of such goods.

Whether a trademark is recognized as the title, etc. is determined by whether it is widely recognized by consumers as the title, etc. Whether the title, etc. recognizes specific contents is determined by taking the actual state of its transaction into consideration.

For example, the following circumstances are used as the elements to determine that the trademark does not indicate the quality of goods or services.

- 1) A work including different contents is produced regularly for a certain period of time;
- 2) A mark used for the title, etc. is also used as a distinctive mark of origin.

(e) Goods belonging to “regular publication” such as a newspaper, magazine, etc., are determined not to fall under the provision of this item, because the title does not recognize specific contents, although the trademark is widely recognized by consumers as the title.

## (2) Personal names

For example, a trademark is recognized to indicate a personal name, etc., in the following cases;

(a) Where a trademark is widely recognized by consumers as a name of a singer or of a music group in respect of goods “sound recorded magnetic tapes,” sound recorded compact disks,” or “phonograph records,” it is judged to indicate the quality of the goods.

(3) Where a trademark is a state name or another geographical name and recognized to indicate a specific cooking style (such as French, Italian, Beijing, etc.) in connection with a service relating

to the “providing of foods and beverages,” it is judged to indicate the quality of the service.

(4) Name of a registered variety which falls under this item

Refer to Part III, Chapter 12, Items 2 and 3 (Article 4(1)(xiv)) of the Guidelines for the name of registered varieties.

4. “Shape” of “Goods and “Articles for Use for the Provision” of Services

(1) Trademarks per se not recognized as surpassing the shapes of designated goods (including shape of packages) or the shapes of articles for use for the provision of designated services in scope are judged to indicate the “shape” or “articles for use for the provision.”

Moreover, the same principle shall apply to cases where a trademark is recognized as part of the shapes per se of articles for use for the provision of designated goods (including their packages) or the designated services.

(2) A three-dimensional trademark designating a service to handle buildings, etc. such as construction industry, real estate industry, etc. and simply indicating the shape of the building in a common manner without surpassing it in scope, is judged to indicate “articles for use in such a provision” in a common manner.

(Note) Article 2(4) of the Trademark Act interpreting “use” stipulates goods and services shaped into a mark. Including Article 3(1)(iii) and (vi) of the Examination Guidelines for Trademarks, the Trademark Act does not include real estate such as buildings as goods in respect of three-dimensional trademarks. With all this taken into account, trademarks registrable with respect to the shape of a building are substantially limited to cases where they are used for advertisements relating to designated goods or designated services.

(3) In the case of retail services, trademarks which are recognized as marks indicating traded goods are considered those indicating “articles for use in such a provision.”

5. Trademark “indicated in common manner”

If a font or the entire composition of an indication of a mark is determined to be special beyond the generally-used scope by traders taking into account the actual state of transaction of goods or services, the trademark is not judged to be “indicated in common manner.”

(Example 1) Cases where the trademark is judged to be indicated in common manner

The trademark is indicated by a font or composition generally used by traders.

(Example 2) Cases where the trademark is not judged to be indicated in common manner

The trademark is indicated by applying special lettering or by a special composition beyond the generally-used scope by traders.

6. Expression “consist of only---”

A trademark composed of more than a single mark indicating the characteristics, etc. of goods or services is judged to fall under the provision of this item, in principle.

7. Color mark corresponding to characteristics of goods or services

If a color mark only consists of colors which the goods generally have, this item shall be applicable to the trademark in principle.

(1) Colors which goods generally have

(a) Natural colors of goods because of their properties

(Example) “Black color” for the goods of “coals”

(b) Colors generally used or required to secure goods’ functions

(Example) “Black color” for the goods of “automobile tires”

(c) Colors generally used to make goods more attractive in their markets

(Example) “Silver color” for the goods of “mobile phones”

(d) Colors which are not generally used for goods but may be used

(Example) “Yellow color” for the goods of “refrigerators”

(e) Colors used in color patterns and backgrounds

(Example) “Vertical stripes of yellow, green and red colors” for the goods of “cups”

8. Sound mark relating to characteristics of its goods or services

If the trademark only consists of marks which indicate sounds the goods usually generate, or generate when providing the services in a common manner, this item shall be applicable to the trademark in principle.

(1) Sounds which goods commonly generate

(a) Sounds which goods naturally generate

(Example) “Fizzing” sounds generated when bubbles burst for the goods of “carbonated drinks”

(b) Sounds generally used or required to secure goods’ functions

(Example) “Beeping’ alarm sounds” for the goods of “alarm clocks”

Furthermore, as far as alarm sounds of alarm clocks, which are electronically generated to secure their functions of waking up people, regardless of whether they are either very common beeping sounds or flowing melodies, are used as standard alarm sounds, this item shall be applicable to such sounds.

(2) Sounds generally generated when providing services

(a) Sounds generated naturally because of services' properties

(Example) "'Sizzling' sounds generated when meat is barbequed" for the services of "supplying barbecued meat"

(b) Sounds generally used or required when providing services

(Example) "'Clang' sounds generated when gongs are struck" for the services of "holding boxing matches"



Chapter 6: Article 3(1)(iv) (Common surname or name of a juridical person)

(iv) A trademark consisting solely of a mark indicating, in a common manner, a common surname or name of a juridical person;

1. “Common surnames or the names of juridical person”

(1) “Common surnames or the names of juridical person” are those existing in a great number such as, for example, similar surnames or names, in principle.

(2) Trademarks with a Common surname, the name of a business, a famous geographical name combined with characters customarily added to trade names and business names such as “K.K.,” “Co.,” “Co., Ltd.,” “Ltd.,” etc. or characters indicating the name of a business, etc. are considered as a “common surname or name of a juridical person” in the provision of this paragraph, in principle.

However, a company name with the name of a state or an administrative zone combined with the name of a business, however it could be accepted as a common name, does not fall under the provision of this paragraph in case where there is no other identical name existed.

(a) Famous geographical names

For example, the following fall under famous geographical names.

“Japan,” “Tokyo,” “Satsuma,” “France,” etc.

(b) Names of business

For example, the following fall under the name of business.

“Industry,” “Pharmaceuticals,” “Confectionery,” “Broadcasting,” “Transport,” “Life insurance,” etc.

(c) Characters customarily added to trade names and business names such as “K.K.,” “Co.,” “Co., Ltd.,” “Ltd.,” etc. and the name of a business

For example, the following i) and ii) fall under characters commonly added to trade names and business names such as “K.K.,” “Co.,” “Co., Ltd.,” “Ltd.,” etc. and the name of a business

(i) Characters customarily added to trade names and business names such as “K.K.,” “Co.,” “Co., Ltd.,” “Ltd.,” etc.

“Shokai,” “Shoten,” “Ya,” “Ke,” “Sha,” “Do,” “Sha,” “Yoko,” “Kyokai,” “Kenkyusho,” “Seisakusho,” “Kai,” “Kenkyukai,” etc.

(ii) Characters indicating the name of a business, etc.

“Company Limited,” “Limited Company,” “Mutual Corporation,” “General Incorporated

Association,” “K.K.,” “Co.,” “Co., Ltd.,” “Ltd.,” etc.

2. Trademark “indicated in common manner”

(1) If a font or the entire composition of an indication of a mark is determined to be special beyond the generally-used scope by traders taking into account the actual state of transaction of goods or services, the trademark is not judged to be “indicated in common manner.”

(Example 1) Cases where the trademark is indicated in common manner The trademark is indicated by a font or a composition generally used by traders.

(Example 2) Cases where the trademark is not indicated in common manner

The trademark is indicated by applying special lettering or by a special composition beyond the generally used scope by traders.

(2) Method of indicating characters

(a) “Common surnames or the names of juridical person” however indicated in phonetic Japanese katakana characters or Roman characters are judged to fall under this provision, in principle.

(b) “Common surnames or the names of juridical person” however indicated in Chinese characters (phonetic equivalent) which are not commonly used by traders are judged not to fall under this provision.

Chapter 7: Article 3(1)(v) (Very simple and common marks)

(v) A trademark consisting solely of a very simple and common mark;
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1. “Very simple mark”

“A very simple mark” is one whose composition is very simple.

2. “Common mark”

A mark is considered as common when it is commonly used. It is not necessarily required for a mark to be used in a field which handles specific goods or services in order for it to be recognized as a commonly used mark.

(Examples of common marks)

(i) A mark commonly used as a symbol or mark indicating product number, model number, type, form, specifications, etc. of goods or type, grade, etc. of services (hereinafter referred to as “symbols or marks of goods or services”).

(ii) A figure commonly used as an outline

3. Very simple and common mark”

(1) Very simple and common marks include, for example, the following marks;

(a) Numerals

Numerals fall under the provision of this paragraph, in principle.

(b) Roman characters

(i) Trademarks composed of one or two Roman characters;

(ii) Trademarks composed of two Roman characters combined with “-“

(iii) Trademarks to which one or two Roman characters accompanied by “Co.,” “Ltd.,” or “K.K.” are attached

However, this is limited to cases where “Co.,” “Ltd.” or “K.K.” is judged to respectively mean “Company,” “Limited” or “Kabushiki Kaisha.”

(c) Japanese kana characters

(i) Trademarks composed of single Japanese kana character (including modified obsolete katakana characters)

(ii) Trademarks composed of Japanese kana characters recognized to indicate the sound of a single Roman character

(iii) Trademarks composed of Japanese kana characters recognized to indicate the sound of two

Roman characters which are commonly used as symbols or marks of goods or services

(iv) Trademarks with kana characters recognized to indicate the sound a digit or two digits of numerals generate

(Examples) “トウエルブ” (twelve) or “じゅうに” (twelve)

(v) Trademarks recognized to indicate the sound more than two digits of numerals generally generate

(Examples) “ファイブハンドレッドアンドテン” (Five hundred and ten)

(d) Trademarks which include the sound Roman characters or numerals generate

(i) Trademarks which include the sound of a Roman character written in kana characters

(ii) Trademarks which include the sound one-digit or two-digit numerals generate

(e) Trademarks composed of a combination of Roman characters and numerals

(i) Trademarks composed of one or two Roman Characters followed by a numeral

(Examples) A2, AB2

(ii) Trademarks composed of a numeral followed by one or two Roman characters







(Examples) 2A

(iii) Trademarks to which another Roman character is added to the examples mentioned in 1) and trademarks composed of one Roman character to which another numeral is added to the examples mentioned in 2)

(Examples) A2B, 2A5

However, 3) is applicable only to a combination of Roman characters and numerals generally used as symbols or marks of goods or services in a business which handles the designated goods or designated services.

(f) Figures

Figures commonly used as a single straight line, a waved line or an outline (such as , , , ,  and ) , or a shield

(g) Three-dimensional shape


A three-dimensional shape such as globe, cube, rectangular parallelepiped, cylinder, triangular cylinder, etc.

(h) Trademarks with a simple outline encircling characters

Trademarks with a simple outline encircling characters specified from (a) to (e) above fall under “very simple and common marks.”

(2) Marks which do not fall under “very simple and common marks” include, for example, the

following marks

- (a) Trademarks connecting two Roman characters with “&”
- (b) Trademarks with two Roman characters indicated in a monograph like 
- (c) Kana characters recognized to indicate the sound of two Roman characters are judged not to fall under “very simple and common marks” in principle.
- (d) Trademarks with more than two digits of numerals indicated by kana characters representing their sounds but they are not recognized as sounds normally generated

(Examples) Five ten

- (e) Trademarks indicated in a special mode

#### 4. Sound mark

For single sounds or sounds lasting very short similar to them, this item shall be applicable to the trademark in principle.

Chapter 8: Article 3(1)(vi) (Trademarks lacking distinctiveness in addition to those mentioned in each of the preceding items)

(vi) In addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

1. If a trademark does not fall under any of the items (i) to (v) of this Paragraph but can be commonly use and lacks distinctiveness, it is judged to be applicable to this item. For example, trademarks listed in 2. to 11. below are judged to fall under this item.

2. For trademarks composed of only marks indicating advertisement of the designated goods or designated services or corporate philosophy or management policy which have little connection with the designated goods or designated services;

(1) Where a filed trademark is recognized to indicate advertisement of the goods or services or corporate philosophy or management policy in a commonly-used method, this item is judged to be applicable.

Where a filed trademark can be recognized not only as advertisement of the goods or services or corporate philosophy or management policy but also as a coined word, this item is judged not to be applicable.

(2) Whether a filed trademark is recognized only as advertisement of the goods or services is judged by taking a concept generated from the entire goods or services, connection with the designated goods or designated services, the actual state of its transaction, the trademark's constitution and mode, etc. into consideration.

(a) Circumstances in which a trademark is recognized to indicate only advertisement of goods or services

(Examples)

(i) The trademark indicates the explanations of the designated goods or designated services;

(ii) The trademark indicates the characteristics and superiority of the designated goods or designated services;

(iii) The trademark briefly indicates the quality and characteristics of the designated goods or designated services;

(iv) The trademark consists of words commonly used for advertisement of goods or services

(However, it is not required that there is an example of actual use of the designated goods or designated services for advertisement).

(b) Circumstances in which a trademark recognizes something other than advertisement of goods or services

(Examples)

(i) The trademark is not recognized to have a direct or specific meaning in relation to the designated goods or designated services.

(ii) Whereas the applicant uses the filed trademark for a certain period of time as a mark which distinguishes its goods or services from those of others, a third party does not use the words identical with or similar to the filed trademark as advertisement.

(3) Whether the filed trademark is recognized only as corporate philosophy or management policy is judged by comprehensively taking a concept generated from the entire goods or services, connection with the designated goods or designated services, the actual state of its transaction, the trademark's constitution and mode, etc. into consideration

(a) Circumstances in which the trademark is recognized only as corporate philosophy or management policy

(Examples)

(i) The trademark describes the characteristics and superiority of a company;

(ii) The trademark is described with words commonly used to indicate corporate philosophy or management policy.

(b) Circumstances in which the trademark recognizes something other than corporate philosophy or management policy

(Examples)

(i) Whereas the applicant uses the filed trademark for a certain period of time as a mark which distinguishes its goods or services from those of others, a third party does not use the words identical with or similar to the filed trademark as corporate philosophy or management policy.

### 3. Trademarks indicating the unit, etc.

A trademark recognized as indicating the quantity in relation to goods or services in any ordinary commercial practice such as, for example, "Meter," "Gram," "Net" and "Gross," falls under the provision of this item.

4. Trademarks indicating Japanese era names

A trademark recognized as indicating nothing more than a Japanese era name (e.g., “平成” [Heisei]) falls under the provision of this item.

Whether or not a trademark is recognized as indicating nothing more than a Japanese era name is determined based on whether the Japanese era name is generally used as something that indicates, for example, the year of foundation of a company, the year of production of goods, or the year of provision of services.

5. Trademarks indicating a geographical name in Japan and overseas

A trademark indicating the geographical name in Japan and overseas of the foundation place of a business operator and the address of a business place, the delivered place and the temporary storage place of designated goods, or the stop-off place when a designated service is provided (a harbor and an airport, etc.) or the like shall fall under the provision of Article 3(1)(vi).

6. Trademarks indicating the place of origin, etc. of the traded goods

(1) In the case of retail services, trademarks which are recognized as indicating the place of origin, quality, raw materials, efficacy, intended purpose, shape (including shape of packages), the method or time of production or use, other characteristics, or quantity or price of the traded goods fall under this item.

(2) Name of a registered variety which falls under this item

Refer to Part III, Chapter 12, Items 2 and 3 (Article 4(1)(xiv)) of the Guidelines for the name of registered varieties.

7. Trademarks consisting solely of a pattern

Where a trademark is recognized as a mere base pattern, since it consists of continuously repeated figures in pattern, it is judged to fall under this item.

However, even if a trademark is recognized as a base pattern, whether it falls under the provision of this item is determined based on if there is any characteristic mode in its composition.

8. Trademarks consisting of the shapes of shops or offices

Three-dimensional trademarks judged as nothing more than the shapes of shops or offices which deal with designated goods or designated services fall under the provision of this item.



9. Trademarks used in a great number as the name of a shop

Where a trademark is clearly used as the name of a shop in a great number in respect with the designated service (including those having the name of business such as “snack” (restaurant), “coffee shop” combined therewith or removed therefrom)

(Examples of trademarks falling under this provision)

(i) In respect of designated services, providing of foods and beverages mainly with alcoholic beverages served: Trademarks such as “さくら” (cherry blossom), “愛” (love), “純” (pure), “ゆき” (snow), “ひまわり” (sunflower), and “蘭” (orchid)

(ii) In respect of designated services, providing of foods and beverages mainly with tea, coffee, etc. serviced: Trademarks such as “オリーブ” (olive), “フレンド” (friend), “ひまわり” (sunflower), and “たんぽぽ” (dandelion)

10. Trademarks consisting of Color marks only

This item shall be applicable to color marks in principle, excluding those to which Article 3(1)(ii) and (iii) is applicable.

(Applicable Example)

Colors articles used for the provision of services generally have

11. Sound marks

(1) Sound elements (musical elements, natural sounds, etc.) as well as linguistic elements (lyrics, etc.) of which a sound mark is composed shall be examined together so that the trademark is examined as a whole.

(2) If this item is not applicable to the linguistic elements of a sound mark, it shall be regarded that this item is also not applicable to the sound mark as a whole.

(3) If this item is not applicable to the sound elements of a sound mark, it shall be regarded that this item is also not applicable to the sound mark as a whole.

For example, if a sound mark consists solely of the following sound elements, consumers are not able to recognize the trademark as a mark which can distinguish its goods and services from those of others, and therefore, this item shall be applicable to it in principle.

(a) Sounds which consumers recognize as natural sounds

When natural sounds are mentioned, they mean not only sounds existing in nature such as those of blowing wind and thunder, but also those mimicking natural sounds as well as those which are artificial but imitate natural sounds so that they may be recognized as if they existed in nature.

(b) Sounds which consumers recognize only as classical music, popular songs, original tunes and other musical compositions.

(Examples of trademarks falling under this provision) Musical compositions played as the BGM in commercial or other advertisements.

(c) Sounds which may not be generally used or indispensable to secure their goods' functions or furnish their services, but merely enhance their goods' or services' attractiveness

(Examples of trademarks falling under this provision) Squeaking sounds every footstep generates for the goods of "children's shoes"

(d) Sounds used to attract consumers' attention, give certain impressions to them or generate sound effects for advertisements and other purposes

(Examples of trademarks falling under this provision)

Sound effects of "kopokopo" generated when beer is poured for the goods of "sauce for barbecued meat."

"Sounds of 'boink' generated at the end of a TV CM to attract consumers' attention"

(e) Sounds generated by the articles to be used for the provision of the Services

(Examples of trademarks falling under this provision)

Engine sounds of vehicles for the services of "car transport"

Sounds of grinding coffee beans for the services of "providing coffee beverages"

12. If a trademark is listed in 1. to 11. above, but if it has become popular so that consumers are able to recognize its goods or services as those pertaining to a business of a particular person as a result of its usage, this item shall not be applicable to it.

Part II: Article 3(2)

(Distinctiveness acquired through use)

Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.;

1. “Use” of a trademark

(1) Trademark

Where the trademark in an application and the trademark as used are different in appearance, the trademark in an application is not recognized as being used.





Even if the trademark in an application and the trademark as used are not strictly identical to each other in appearance, the trademark in an application is recognized as being used if the difference is recognized as not affecting the identity of the trademark by considering the degree of differences in appearance and the actual state of transaction of the designated goods or designated services.

(Example 1) Trademarks which are recognized as identical

- (i) The only difference between a trademark in an application and a trademark as used is that they are described in vertical writing and horizontal writing;
- (ii) A trademark in an application and a trademark as used are described in commonly-used fonts, and the two trademarks do not have any characteristic which draws attention of traders or consumers, and their fonts are similar with each other.
- (iii) The characteristic parts of three-dimensional shapes of a trademark in an application and a trademark as used are identical and differences in other parts are minor.

(Example 2) Trademarks which are not recognized as identical

- (i) Whereas a trademark in an application is in Chinese characters of the cursive style, a trademark as used is in Chinese characters of either the square type or the semi-cursive style.

- (ii) Whereas a trademark in an application is in Japanese hiragana characters, a trademark as used is in Japanese katakana characters, Chinese characters or Roman characters.
- (iii) Whereas a trademark in an application uses Arabic numerals, a trademark as used uses Chinese numerals.
- (iv) Whereas a trademark in an application is indicated in such a form as , a trademark as used is indicated in such a form as , , and .
- (v) Whereas a trademark in an application is indicated as a three-dimensional trademark, a trademark as used is a plain trademark, or vice versa.

## (2) Goods or Services

Where the designated goods or designated services of a trademark in an application and the goods or services used by a trademark as used are different, the trademark as used is not recognized as being used in respect of the designated goods or designated services.

However, even if the designated goods or designated services and the goods or services to be used are not strictly identical to each other, the trademark in an application is recognized as being used in respect of the designated goods or designated services if the difference is recognized as not affecting the identity of the designated goods or designated services and the goods or services to be used by taking the actual state of their transaction into consideration.

2. The expression “The consumers are able to recognize the goods or services as those pertaining to a business of a particular person”

### (1) Recognition of consumers

“The consumers are able to recognize the goods or services as those pertaining to a business of a particular person” in this paragraph means that the consumers of the goods or services throughout the country are able to perceive the trademark as an indication of trade source.

### (2) Grounds of judgment

Judgment as to whether a trademark falls under this paragraph will be made, taking the following points into consideration.

Specifically, the level of consumers' awareness, which will be estimated through a substantive grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

- (i) The composition and mode of the trademark in an application
- (ii) The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use and areas of use of the trademark
- (iii) The method, period, areas and scale of advertising
- (iv) Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, "the applicant or a person other than its members") and states of its use.
- (v) The characteristics of the goods or services and the actual state of their transaction
- (vi) The outcome of the questionnaire regarding consumers' awareness of the trademark

(3) Method of proving that the trademark is actually used

Facts as to whether a trademark falls under this paragraph will be provided based on, for example, the following evidences.

- (i) Photographs, movies, etc. showing the actual state of use of a trademark
- (ii) Business documents (Order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.)
- (iii) Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving his past record
- (iv) Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application by persons other than the applicant
- (v) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (However, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to the conductor, method, and respondents).

(4) A trademark combined with another trademark

Where a trademark in an application is used in combination with another trademark, judgment as to whether the trademark has come to gain its distinctiveness through use will be made based

on whether only the parts of the trademark in an application have come to gain its distinctiveness independently.

(5) Collective trademark

Judgment as to whether a collective trademark has come to gain its distinctiveness through use will be made with due consideration given to the points stated in (2) above concerning the use by members of the owner of the collective trademark. To prove the use of a collective trademark by a member of a collective trademark, judgment is made by including the fact that the person is proved to be a member.

(6) Trademark in relation to retail services

If a trademark is indicated on goods, their packaging, price lists, business documents and advertisements, judgment as to whether or not a trademark is used in respect of retail services shall be made by examining, according to the form of indication, whether the trademark identifies the individual and specific source of goods or the source of retail services in connection with goods.

3. Identity of trademark as applied and trademark as used in case of motion mark

(1) Example where identity can be recognized

Although an element other than constituent elements of a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

An animated film uses a motion mark in not the total but a portion of a TV commercial, and the animated film is submitted as a trademark as used. A portion identical to the trademark as applied can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

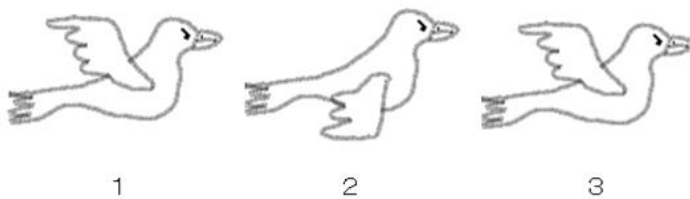
(2) Example where identity cannot be recognized

(i) A trademark as used is different from a trademark as applied (different marks, marks' different change of states with respect to time passage, etc.)

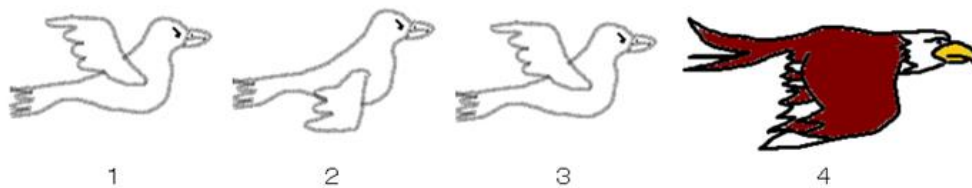
(ii) If an element other than constituent elements of a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied cannot be recognized as a mark which can independently distinguish its goods and services from those of others.

(Example)

- Trademark as applied



- Trademark as used



#### 4. Identity of trademark as applied and trademark as used in case of hologram mark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A credit card uses a hologram mark in a portion of the credit card, and the ycredit card is submitted as a trademark as used. A portion identical to the hologram mark can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

A trademark as used is different from a trademark as applied (different marks, marks' different

change of states (different visual effects) based on holography and other means, etc.)

#### 5. Identity of trademark as applied and trademark as used in case of color mark

##### (1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A pencil case is blue on all of its surfaces and has one small circle figure on its cover, and an evidence of the pencil case is submitted as a trademark as used.

The pencil case's blue color as a color mark identical to the trademark as applied can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

##### (2) Example where identity cannot be recognized

(i) Part or whole of hue (color shade), chroma (vividness of color) or brightness (chromatic luminosity) values of a trademark as used and a trademark as applied are different.

(ii) The color combination ration of an applied color mark and that of a color mark as used are different from each other.

(iii) The color positions of a trademark as applied and those of a trademark as used are different from each other

#### 6. Identity of trademark as applied and trademark as used in case of a sound mark

##### (1) Sound marks which consumers recognize as identical

Even if a trademark as applied is a sound mark, and if the trademark as applied is not strictly identical to a trademark as used, the trademark as applied and the trademark as used shall be judged to be identical when consumers can recognize them as the same sound marks.

When judging whether consumers can recognize trademarks as identical, following points shall be considered.



(i) Whether sound elements (such as melodies, harmony, rhythm or tempos, tones and other natural sounds, etc. which are musical elements) which constitute sound marks are identical to each other.

It is required that at least melodies are the same in order for consumers to be able to recognize that sound marks consisting of musical elements are identical. Whether melodies are the same. Even if melodies are the same, different rhythm, tempos or harmony gives different impression to consumers, and due consideration must be given.

Whether tones are different. For example, if tones are very close although types of instruments played are different, due consideration must be given because consumers may recognize the tones as the identical sound mark in many cases.

(Examples of trademarks falling under this provision)

If a violin is played for an application as applied, and a viola is played for a trademark as used, it shall be assumed that consumers may recognize the trademarks as the identical sound mark because the tones of both instruments are very close.

(ii) Whether linguistic elements (such as lyrics, etc.) which constitute sound marks are identical to each other.

## (2) Example where identity can be recognized

Although a trademark as applied is included in a part of a trademark as used (a mark other than the trademark as applied is included in the trademark as applied), the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A trademark as applied is a sound logo lasting for several seconds, and a motion picture which records a whole commercial advertisement is submitted as a trademark as used. While the sound logo is played at the end of the commercial advertisement, the sound logo can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(3) Example where identity cannot be recognized

(i) Consumers get very different impression from a trademark as a whole because the rhythm, tempo or harmony of the trademark is different from that of another trademark even if their melodies are the same.

(ii) Consumers get very different impression from the tones or trademarks as a whole, for example, a violin is played for a trademark as applied while a piano played a trademark as used or an orchestra plays it.

(iii) Sounds of the trademark as applied are not recognized as a mark which can independently distinguish its goods and services from those of others because elements of a trademark other than sounds of the trademark as applied (such as characters, figures and other sounds) are included in the material submitted as the trademark as used.

7. Identity of trademark as applied and trademark as used in case of position mark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

A trademark as used is different from a trademark as applied (different marks, different positions of marks)

Part III: Article 4(1) and (3) (Unregistrable trademarks)

Chapter 1: Overall Article 4(1)

Article 4 Notwithstanding the preceding article, no trademark shall be registered if the trademark:

(i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;

(ii) is identical with, or similar to, the coats of arms or any other State emblems (except national flags of any country of the Union to the Paris Convention, member of the World Trade Organization or Contracting Party to the Trademark Law Treaty) of a country of the Union to the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967; the same shall apply hereinafter), a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty designated by the Minister of Economy, Trade and Industry;

(iii) is identical with, or similar to, a mark indicating the United Nations or any other international organization (referred to as "international organization" in (b)) which has been designated by the Minister of Economy, Trade and Industry (excluding those listed in the following);

(a) is identical with, or similar to, a trademark which is well known among consumers as that indicating goods or services in connection with the applicant's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto; and

(b) is identical with, or similar to, a mark indicating abbreviation of any international organization, which has been used for goods or services that is not likely to mislead as to connection to the international organization;

(iv) is identical with, or similar to, the emblems or titles in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Act No.159 of 1947) or the distinctive emblem in Article 158 (1) of the Act Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Act No.112 of 2004);

(v) is comprised of a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national or a local government of Japan, a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the

Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if such a trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used;

(vi) is identical with, or similar to, a famous mark indicating the State, a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest;

(vii) is likely to cause damage to public order or morality;

(viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);

(ix) is comprised of a mark identical with, or similar to, a prize awarded at an exhibition held by the national or a local government (hereinafter referred to as the "Government, etc.") or by those who are not the Government, etc. that conforms to the standards specified by the Commissioner of the Patent Office, or at an international exhibition held in a foreign country by the Government, etc. of the foreign country or those authorized thereby (except those used by the recipient of such a prize as part of his/her own trademark);

(x) is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

(xi) is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark(referring to goods or services designated in accordance with Article 6 (1) (including cases where it is applied mutatis mutandis pursuant to Article 68 (1)); the same shall apply hereinafter), or goods or services similar thereto;

(xii) is identical with a registered defensive mark of another person (referring to a mark registered as a defensive mark; the same shall apply hereinafter), if such a trademark is used in connection with designated goods or designated services relating to the defensive mark;

(xiii) deleted

(xiv) is identical with, or similar to, the name of a variety registered in accordance with Article 18(1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto;

(xv) is likely to cause confusion in connection with the goods or services pertaining to a business

of another person (except those listed in items (x) to (xiv) inclusive);  
(xvi) is likely to mislead as to the quality of the goods or services;  
(xvii) is comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by the said member from being used on wines or spirits not originating from the region of the said member, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of the said member;  
(xviii) consists solely of characteristics which its goods, etc. (meaning its goods or packages, or services; the same shall apply in Article 26 (1)(v)) must naturally have and which are specified by Cabinet Order; or  
(xix) is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);

1. If either item of Article 4(1) is applicable to marks of which a motion, hologram or position mark is composed or linguistic elements of which a sound mark is composed, it will be regarded in principle that the items of Article 4(1) are applicable to the trademark as a whole.

Chapter 2: Article 4(1)(i) (National flag and imperial chrysanthemum crest)

(i) A trademark being identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;

1. Regarding the "national flag"

The "national flag" means the flag of the Rising Sun (Article 1 of the Act of National Flag and Anthem (Act No. 127 of August 13 of 1999)).

2. Regarding the "imperial chrysanthemum crest"

The "imperial chrysanthemum crest" means the crest of the imperial family of Japan, which consists of 16 petals of chrysanthemum.

3. Regarding "A decoration, a medal"

"A decoration and a medal" both belong to Japan and are limited to those that are actually in existence at the time when a decision is made.

(1) Major examples of "decorations" (source: Decorations Bureau of the Cabinet Office)



Supreme Orders of Chrysanthemum, Grand Cordon of the Order of the Paulownia Flowers, Orders of the Rising Sun



Orders of the Sacred Treasure, Order of Culture, Orders of the Precious Crown

(2) Major examples of "medals" (source: Decoration Bureau of the Cabinet Office)



Medal with Red Ribbon, Medal with Green Ribbon, Medal with Yellow Ribbon



Medal with Purple Ribbon, Medal with Blue Ribbon, Medal with Dark Blue Ribbon

#### 4. Regarding "foreign flags"

"Foreign flags" not only include those of countries which Japan has recognized but also includes those of countries which Japan has not recognized.

In addition, they are limited to those of countries that actually exist at the time of the decision.

#### 5. Regarding the expression a trademark "is identical with, or similar to"

(1) The similarity of trademarks under this item is judged based on whether the trademarks as a whole are confused with these national flags, etc. from the standpoint of protecting public interest by maintaining the dignity of states, etc.

For example, if the trademark as applied has a part conspicuously showing national flags, etc., the trademark as a whole is judged to fall under this item.

#### (2) Example of judgment made with respect to the "imperial chrysanthemum crest"

In addition to (1) above, the trademark as applied showing a chrysanthemum with its petals numbering between 12 and 24 is judged to be similar to the "imperial chrysanthemum crest."

However, this does not apply when the trademark as applied falls under any of the following cases.

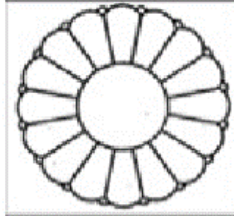
- (i) A chrysanthemum with petals larger than the diameter of its center;
- (ii) A chrysanthemum with more than one-third covered or cut off;
- (iii) A chrysanthemum with its center deviating to a length of more than a quarter of the flower's

radius; and

(iv) A chrysanthemum not clearly constituting a crest and judged to imitate a live flower.

(Example) Marks that fall under any of the cases mentioned in (i) to (iv) above.

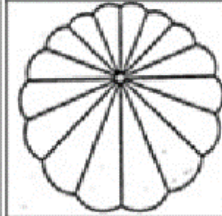
(i)



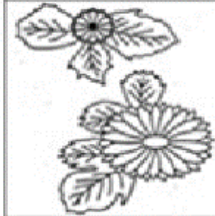
(ii)



(iii)



(iv)



#### 6. Trademarks consisting of combination of colors

If a mark resulting from the combination of colors in a color mark is identical with or similar to a foreign national flag, this item is applicable to the trademark in principle.



Chapter 3: Article 4(1)(ii), (iii) and (v) (State coat of arms and other emblems)

(ii) A trademark being identical with, or similar to, the coats of arms or any other State emblems (except national flags of any country of the Union to the Paris Convention, member of the World Trade Organization or Contracting Party to the Trademark Law Treaty) of a country of the Union to the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967; the same shall apply hereinafter), a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty designated by the Minister of Economy, Trade and Industry;

(iii) A trademark being identical with, or similar to, a mark indicating the United Nations or any other international organization (referred to as "international organization" in (b)) which has been designated by the Minister of Economy, Trade and Industry (excluding those listed in the following);

(a) A trademark being identical with, or similar to, a trademark which is well known among consumers as that indicating goods or services in connection with the applicant's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto; and

(b) A trademark being identical with, or similar to, a mark indicating abbreviation of any international organization, which has been used for goods or services that is not likely to mislead as to connection to the international organization;

(v) A trademark comprised of a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national or a local government of Japan, a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if such a trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used;

1. Regarding marks "which have been designated by the Minister of Economy, Trade and Industry"

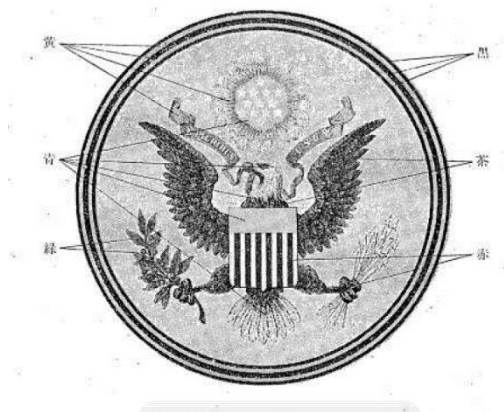
Marks "which have been designated by the Minister of Economy, Trade and Industry" are all published in the official bulletin together with the number and date of the notification as the Notification of the Ministry of Economy, Trade and Industry.

For example, these marks including the following.

(1) Item (ii)

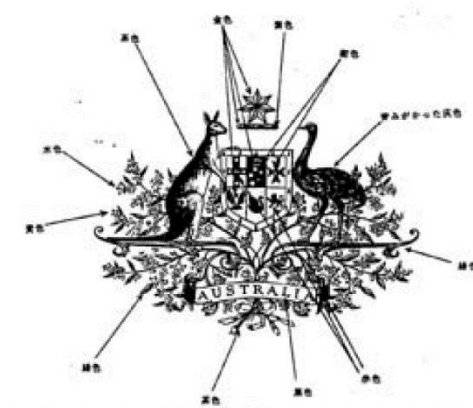
(Example 1) Emblem of the United States of America

(Notification No. 356 of the Ministry of International Trade and Industry of 1976; Notification of August 6, 1976)



(Example 2) Coats of arms of the Commonwealth of Australia

(Notification No. 74 of the Ministry of International Trade and Industry of 1994, Notification of February 16, 1994)



(2) Item (iii)

(Example 1) Mark of the United Nations

(Notification No. 253 of the Ministry of International Trade and Industry of 1994, Notification of April 26, 1994)



(Example 2) Mark of the World Intellectual Property Organization

(Notification No. 275 of the Ministry of International Trade and Industry of 1994, Notification of April 26, 1994)



(3) Item (v)

(Example 1) An official hallmark or sign indicating control or warranty by Malaysia

(Notification No. 196 of the Ministry of Economy, Trade and Industry of 2014, Notification of September 26, 2014, Goods or services: Transportation, meat, fish and others)



(Example 2) An official hallmark or sign indicating control or warranty by the Republic of Korea

(Notification No. 241 of the Ministry of Economy, Trade and Industry of 2014, Notification of December 12, 2014, Goods or services: Wood products)



## 2. Regarding item (ii)

### (1) Regarding the expression the "trademark is identical with, or similar to"

The similarity of trademarks under this item is judged based on whether the trademarks as a whole are confused with the state coats of arms, etc. from the standpoint of protecting public interest by maintaining the dignity of states, etc.

For example, if the trademark as applied has a part conspicuously showing state coats of arms, etc., the trademark as a whole is judged to fall under this item.

## 3. Regarding item (iii)

### (1) Regarding the expression "is identical with, or similar to"

The similarity of trademarks under this item is judged based on whether the trademarks as a whole are confused with the mark indicating these international organizations from the standpoint of protecting public interest by maintaining the dignity of international organizations.

For example, if the trademark as applied has a part conspicuously showing the mark indicating the international organization, the trademark as a whole is judged to fall under this item.

### (2) Regarding the expression "well known among consumers" as prescribed in sub-item (a) of this item

(a) The scope of consumers not only includes the case where the trademark in question is well known by ultimate consumers but also the case where the trademark in question is well known among traders.

(b) Part II, Item 2(2) and (3) (Article 3(2)) of the Guidelines apply mutatis mutandis to the matters to be taken into consideration and the method of evidence in determining whether or not the trademark in question is "well known among consumers."

(3) Regarding the expression a trademark "is identical with, or similar to, a trademark which is well known among consumers" as prescribed in sub-item (a) of this item

In the judgment on the similarity under sub-item (a) of this item, trademarks that are well known among consumers and thus would not mislead as to connection to international organizations are excluded from the scope of application of this item and each element such as the appearance, sound and concept of the relevant trademark must be taken into consideration in a comprehensive manner from the standpoint of protecting the trademark.

(4) Regarding the expression "goods or services that are not likely to mislead as to connection to the international organization" as prescribed in sub-item (b) of this item

The judgment on whether or not the trademark "is not likely to mislead" is made by taking into consideration the relationship between the services provided by the international organization and the designated goods or designated services of the trademark as applied.

(Example) Case where the trademark in question is not likely to mislead

The case where the service provided by the international organization is related to food, while the designated goods of the trademark as applied are automobiles.

#### 4. Regarding item (v)

(1) Regarding the expression a trademark "is comprised of a mark identical with, or similar to"

The similarity of trademarks under this item is judged based on whether the trademark as applied is, in whole or in part, comprised of a mark that causes confusion with an official hallmark, etc. indicating control of a state, from the standpoint of preventing misleading as to the quality of goods or services and maintaining the authority of the control or warranty office.

(2) Regarding the expression "goods or services identical with, or similar to"

Part III, Chapter 10, Item 11(1) to (3) (Article 4(1)(xi)) of the Guidelines apply *mutatis mutandis* to the judgment on similarity of goods under this item.

(Note) The contents of the notification stated herein are those as of the time when the Guidelines were created.

Chapter 4: Article 4(1)(iv) (Mark or title of the red cross)

(iv) A trademark being identical with, or similar to, the emblems or titles in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Act No.159 of 1947) or the distinctive emblem in Article 158 (1) of the Act Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Act No.112 of 2004);

1. Regarding the "emblems" and "titles" as prescribed in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others

(1) "Emblems" are as follows.

[1]



(A red cross on a white background)

[2]



(A red crescent on a white background)

[3]



(A red lion and sun on a white background)

(2) "Titles" are as follows.

(i) "赤十字" [SEKIJUJI] (Red cross)

(ii) "ジュネーブ十字" [JUNEBUJUJI] (Geneva cross)"

(iii) "赤新月" [SEKISINGETSU] (Red crescent)

(iv) "赤のライオン及び太陽" [AKANORAION OYOBİ TAIYO] (Red lion and sun)

2. The model of the distinctive emblem as prescribed in Article 158(1) of the Act concerning the Measures for Protection of the People in Armed Attack Situations, etc. is as follows.



(Equilateral blue triangle on an orange background)

3. Regarding the expression a trademark "is identical with, or similar to"

The similarity of trademarks under this item is judged based on whether the trademark as a whole causes confusion with the emblems, etc. of the Red Cross from the standpoint of protecting public interest by maintaining the authority of the Red Cross. For example, if the trademark as applied has a part conspicuously showing the marks or names shown in 1. or 2. above, the trademark is judged to fall under this item.

Chapter 5: Article 4(1)(vi) (Famous mark indicating a state or a local public entity)

(vi) A trademark being identical with, or similar to, a famous mark indicating the State, a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a non-profit business for public interest;

1. Regarding the expression “The State, a local government or an agency thereof”

(1) The State shall refer to Japan.

(2) “Local governments” shall refer to an “ordinary local public government” mentioned in Article 1(3) of the Local Autonomy Act (Prefectures and Municipalities) and a “special local public government (a special ward, an association of a local public government and a property ward).

(3) An “agency thereof” refers to each of the legislative, judicial and administrative agencies in the case of the state, and agencies equivalent to them (excluding legislative agencies) in the case of local governments.

2. Regarding the expression “A non-profit organization undertaking a business for public interest”

Whether an organization falls under “a non-profit organization undertaking a business for public interest” is judged by taking its purpose of establishment, organization and the state of enforcement of business for public interest into consideration. In this case, it is not questioned whether the organization is a national or overseas organization or has corporate entity.

(Examples of organizations falling under the provision of this paragraph)

(i) Public interest incorporated associations and public interest incorporated foundations approved by the Act on Authorization of Public Interest Incorporated Associations and Public Interest Incorporated Foundations (e.g. The Japan Olympic Committee)

(ii) Social welfare corporations, incorporated educational institutions, medical corporations, religious corporation, specified non-profit organizations, incorporated administrative agency, etc. established based on special laws (e.g. The Japan International Cooperation Agency)

(iii) Political parties

(iv) The International Olympic Committee

(v) The International Paralympic Committee and the Japan Paralympic Committee



(vi) The Young Men's Christian Association

3. Regarding the expression “A non-profit business for public interest”

Whether a business falls under a non-profit business for public interest is judged by taking its purpose and contents, the purpose of establishment and organization of an entity responsible for the business into consideration. In this case, it is not questioned whether the business is undertaken in Japan or overseas.

(Examples of organizations falling under the provision of this paragraph)

- (i) Water supply business, transportation business and gas supply business undertaken by local governments and local public enterprises
- (ii) Businesses (measures) carried out by the State and local governments
- (iii) The Olympic Games organized by the International Olympic Committee and the Japan Olympic Committee
- (iv) The Paralympic Games organized by the International Paralympic Committee and the Japan Paralympic Committee

4. Regarding the expression “A mark indicating the State, etc.”

A “mark indicating” the State, a local government, an agency thereof, and a non-profit organization undertaking a business for public interest (hereinafter referred to as “the State, etc.”) include not only official names of the State, etc. but also abbreviations, commonly-used names, symbols and other indications which reminds consumers of the State, etc.

(Example 1) A mark indicating a non-profit organization undertaking a business for public interest

- (i) Abbreviation of the International Olympic Committee “IOC”
- (ii) Abbreviation of the Japan Olympic Committee “JOC”

(Example 2) A mark indicating a non-profit business for public interest

- (i) “オリンピック” and “OLYMPIC” as the marks indicating the Olympic Games held by the International Olympic Committee and the Japan Olympic Committee, characters of “五輪” as a commonly-used name of the Olympic Games, “the figure indicating the Olympic Games (Olympic symbol)”

(ii) Abbreviations of businesses (measures) undertaken by the State and local Governments

5. Regarding the expression “famous mark”

(1) For the level of famousness of a mark, it is not necessarily required that the mark is recognized by consumers throughout the country taking the purpose of protecting public interest, the interest of consumers, into consideration by respecting the authority and trust of the State, etc. and by preventing confusion over the source with the State, etc.

(2) Whether or not a mark is famous is judged by comprehensively taking the fact of use, for example, the following facts (i) to (iv), into consideration. In this case, care should be taken, because the mark may be recognized as being likely to be famous in a short period time.

(i) A mark actually in use

(ii) The start of its use, the length of its use, or the area where it is used

(iii) The method, frequency and contents of advertising or announcement of a mark

(iv) The number of times of appearance in general newspapers, trade journals, magazines and the Internet, and contents thereof

6. Regarding the expression “A trademark identical with, or similar to another trademark”

The similarity of trademarks as prescribed in this item is judged based on whether they are confused with marks indicating the State, etc. from the perspective of protecting public interest, the interest of consumers, by respecting the authority and trust of the State, etc. and by preventing confusion over the source with the State, etc.

Chapter 6: Article 4(1)(vii) (Contravention of public order or morality)

(vii) A trademark being likely to cause damage to public order or morality;
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1. Trademarks that are "likely to cause damage to public order or morality" are, for example, the trademarks that fall under the cases prescribed in (1) to (5) below.

(1) Trademarks which are, in composition per se, characters or figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds that are unethical, obscene, discriminative, outrageous, or unpleasant to people.

It is judged whether characters, figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds are unethical, discriminative or unpleasant to people, with consideration given to their historical backgrounds, social impacts, etc. from a comprehensive viewpoint.

(2) Trademarks which do not have the composition per se as prescribed in (1) above but are liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for the designated goods or designated services.

(3) Trademarks with their use prohibited by other laws.

(4) Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith.

(5) Trademarks whose registration is contrary to the order predetermined under the Trademark Act and is utterly unacceptable for lack of social reasonableness in the background to the filing of an application for trademark registration.

2. Examples that fall under this item

(i) Trademarks that contain characters such as "university" and are likely to be mistaken for the name of universities, etc. under the School Education Act.

(ii) Trademarks that contain characters such as "士 (shi) " which are likely to mislead that they represent national qualifications.

(iii) Trademarks of the name of a well-known or famous historical personage which are

determined to have the risk of taking a free ride on public measures related to that personage and damage the public interests by inhibiting the performance of such measures.

(iv) Trademarks with figures indicated in a manner that may impair the dignity and honor of national flags (including foreign national flags)

(v) A sound mark related to the services of "medical treatment" which causes people to recognize siren sounds generated by ambulances that are well known in Japan.

(vi) A sound mark which causes people to recognize national anthems of Japan and other countries.

(vii) A trademark that is identical with, or similar to, the name of a variety under an application for variety registration and is used for seeds and seedlings of the variety or goods or services similar thereto, or for harvest of the variety or goods or services similar thereto, for which it is found from the information the JPO received from the public that the application for registration of the trademark has been filed after the filing of the application for registration of the variety, in an attempt to hinder the registration of the name of the variety.

Chapter 7: Article 4(1)(viii) (Name of another person)

(viii) A trademark containing the portrait of another person, or the name (limited to those that are well known among consumers in the field of goods and services for which the trademark is used), famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned), or a trademark containing the name of another person that does not satisfy the requirements specified by Order for Enforcement;

Order for Enforcement of the Trademark Act

Article 1 The requirements specified by Cabinet Order under Article 4, paragraph (1), item (viii) of the Trademark Act shall fall under both of the following items;

- (i) there is a reasonable relationship between the name of another person contained in the trademark and the applicant for the trademark registration,
- (ii) the applicant does not seek to register a trademark for unfair purposes.

1. Regarding the expression "another person"

"Another person" means a person who actually exists other than the applicant him/herself and includes not only natural persons (including foreigners) and corporations but also associations without capacity.

2. Regarding the expression "name well known among consumers in the field of goods and services for which the trademark is used"

(1) Regarding the expression "field of goods and services for which the trademark is used"

In determining the "field of goods or services for which the trademark is used," not only the designated goods or designated services of the trademark, but also the goods or services that are related to the other person shall be considered from the perspective of protecting moral rights.

(2) Regarding the expression "name well known among consumers"

In determining the "name well known among consumers," when the name is used in the goods or services, whether the other person may be evoked or associated with the name shall be taken into account from the perspective of protecting moral rights, with due consideration of the geographical and business scope in which the other person's name is recognized.

3. Regarding "abbreviations"

(1) Trademarks created by removing the type of corporations such as a stock company or general incorporated associations from the "name" of a corporation fall under the category of "abbreviation." The name of an association without capacity does not include the type of corporation, etc. and thus will be handled according to "abbreviations."

(2) "Names" of foreigners fall under the category of "abbreviations" if they do not have middle names.

4. Regarding "famous" abbreviations, etc.

It is not necessarily required to determine whether or not the trademark in question falls under the "famous" pseudonym, professional name or pen name of another person, or "famous" abbreviation thereof based on solely the consumers of the designated goods or services of said trademark from the perspective of protecting moral rights of authors.

5. Regarding the expression "contains"

The judgment on whether or not the trademark in question is a trademark which "contains" the name, etc. of another person will be made based on the determination on whether the relevant part will be objectively recognized as the name, etc. of another person and will evoke or remind of the other person.

(Example) The trademark "TOSHIHIKO" does not evoke or remind of another person's famous abbreviation "IHI."

6. Regarding trademarks representing the applicant's own name

Trademarks that are representing the name, pseudonym, professional name or pen name of the applicant's own name or abbreviations thereof and fall under the "the name (limited to those that are well known among consumers in the field of goods and services for which the trademark is used), famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned)," or trademarks containing the name of another person and whose applicant seeks to register a trademark for unfair purposes, fall under this item for damaging the moral interest of the other person.

7. Regarding the expression "has been approved by the person concerned"

The registration of the trademark must have been "approved by the person concerned" at the time of decision to grant trademark registration.

8. Regarding the expression "requirements specified by Order for Enforcement"

(1) Regarding the expression "there is a reasonable relationship between the name of another person contained in the trademark and the applicant for the trademark registration"

For example, if the name of another person contained in the trademark applied for is the applicant's own name, the name of the founder or representative, or the name of a store that has been in continuous use since before the application was filed, the trademark will be determined to have a reasonable relationship.

(2) Regarding the expression "the applicant does not seek to register a trademark for unfair purposes"

For example, if publicly available information or materials obtained by providing information, etc. indicate that the purpose is to harass or induce others to preemptively purchase a trademark, it will be determined that there is an unfair purpose.

Chapter 8: Article 4(1)(ix) (Prize awarded at an exhibition)

(ix) A trademark comprised of a mark identical with, or similar to, a prize awarded at an exhibition held by the national or a local government (hereinafter referred to as the "Government, etc.") or by those who are not the Government, etc. that conforms to the standards specified by the Commissioner of the Patent Office, or at an international exhibition held in a foreign country by the Government, etc. of the foreign country or those authorized thereby (except those used by the recipient of such a prize as part of his/her own trademark);

1. Regarding the term "exhibition"

"Exhibitions" would not be limited to those bearing the name of exhibitions and include events bearing other names such as trade fairs, competitive shows, collections, trade shows, fairs and messe.

2. Regarding the expression "conforms to the standards specified by the Commissioner of the Patent Office"

"Standards specified by the Commissioner of the Patent Office" are shown in Notification No. 6 of the JPO of 2012 (see below) and judgment is made based on whether or not the trademark in question conforms to such standards.

Notification No. 6 of JPO of 2012 (extract of the requirements)

- "(i) The events are held for the purpose of contributing to the development of industry wherein articles, etc. related to the industry are disclosed and displayed regardless of the name of the event such as "exhibition" or "trade fairs."
- (ii) The venue and time of the event, qualifications of exhibitors and visitors, number of exhibitors as well as the kind and quantity of the articles on exhibition are deemed appropriate in light of the purpose of that item.
- (iii) The events are exhibitions co-sponsored or aided by the government, etc. or are equivalent thereto."

(1) Regarding (i) above

Even if the events bear the name of exhibitions, etc., an exhibition and sale of various kinds of goods or exhibitions of paintings or work of arts, etc. held by department stores or retail stores, etc. as part of a mere merchandise sale is determined not to conform to the "standards specified by the Commissioner of the Patent Office" as prescribed in this item.



(2) Regarding (ii) above

For example, in the following cases prescribed in (a) through (c) below, it will be determined that the "standards specified by the Commissioner of the Patent Office" as prescribed in this item have not been conformed to.

(a) With respect to the "venue and time of the event," [i] cases where the capacity of the venue is extremely small, [ii] cases where the exhibition is held at a place difficult to access; or [iii] even if the exhibition is not held at a place difficult to access, it is held at a mountainous area and is held when the place becomes difficult to access.

(b) Cases where restrictions are imposed on the "qualifications of the exhibitors and visitors." However, this does not apply to cases where such restrictions are imposed for the purpose of the exhibition, size of the venue or any other justifiable grounds. For example, [i] cases where the articles on exhibition are "tobacco" or "alcoholic beverages" and restrictions are imposed on the age of the visitors in the case of exhibiting and offering said articles for public inspection or purchase; and [ii] cases where the venue has a respectable degree of capacity but certain limitations are imposed considering the safety and convenience of visitors.

Collecting exhibition fees or entrance fees from exhibitors or visitors does not constitute the act of restrictions.

(c) Cases where, with respect to the "number of exhibitors" and "type and volume of articles on exhibition," the event can by no means be recognized to have been held for publication or exhibition to the general public such as the case where the number of exhibitors is extremely small or limited.

3. Regarding the expression "a trademark is comprised of a mark identical with, or similar to"

The similarity of trademarks under this item is judged based on whether the trademark as applied is comprised in whole or in part of a mark confused with a prize awarded at an exhibition from the standpoint of maintaining the authority of the prize awarded at the exhibition and preventing any misleading as to the quality of goods or services.

4. Regarding the expression "the recipient of such a prize"

"The recipient of such a prize" includes the business successor of such recipient.

(Note) The contents of the notification stated are those as of the time when the Guidelines were prepared.

Chapter 9: Article 4(1)(x) (Well-known trademark of another person)

(x) A trademark being identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

1. Regarding the expression "trademark which is well known among consumers as that indicating goods or services in connection with the person's business"

(1) Regarding the consumer's recognition

"A trademark which is well known among consumers" includes not only a trademark which is well known among end consumers but also a trademark which is well known among traders in the industry and also includes not only a trademark which is known throughout the country but also a trademark which is well known in a certain area.

(2) Regarding the determination on the degree of being well known

Part II, Items 2(2) and (3) (Article 3(2)) of the Guidelines apply *mutatis mutandis* to the judgment on whether or not the trademark "is well known among consumers." For example, the judgment is made by sufficiently taking into consideration the following circumstances.

(a) Cases of goods or services with special form of transaction

For example, "medicines and drugs for medical use" and "test, examination or research of drugs" are goods distributed or services provided only in specific markets.

(b) Cases of trademarks that are mainly used in foreign countries

Trademarks that are mainly used in foreign countries refers to (i) those that are well known in a foreign country, (ii) goods on which the relevant trademark is used that are exported to several countries or (iii) services bearing the trademark that are provided in several countries.

2. Regarding the approval of a "trademark which is well known among consumers"

Determination regarding trademarks that have been approved as trademarks well known among consumers in trial decisions and decision on objections or judgments is made by sufficiently taking into consideration the facts found.

3. Regarding the expression "a trademark which is similar to"

(1) Part III, Chapter 10, Items 1 to 10 (Article 4(1)(xi)) of the Guidelines apply *mutatis mutandis*

to the judgment on the similarity of trademarks under this item.

(2) A combination of another person's unregistered trademark "well known among consumers" and other characters or figures are considered "similar" to the unregistered trademark including those trademarks whose description of the composition of appearance is well united or conceptually related.

However, in cases where it is clear that the unregistered trademark constitutes part of an established word or other cases, the unregistered trademark will be excluded.

(Example) Examples of trademarks are the same as those mentioned in Part III, Chapter 10, Item 4(2)(a)(ii) (Article 4(1)(xi)) of the Guidelines.

#### 4. Regarding the timing of making determinations

A trademark to be cited for the application of the provision of this item must be well known among domestic consumers in Japan at the time when an application for trademark registration is filed (refer to Article 4(3))

#### 5. Regarding the judgment on the similarity of goods or services

Part III, Chapter 10, Item 11 (Article 4(1)(xi)) of the Guidelines apply mutatis mutandis to the judgment on the similarity of goods or services under this item.

#### 6. Treatment in the case where there is a controlling relationship between the applicant and the other person under this item

Part III, Chapter 10, Item 13 (Article 4(1)(xi)) of the Guidelines applies mutatis mutandis to the judgment on whether the relevant case fall under this item.

Chapter 10: Article 4(1)(xi) (Another person's registered trademark applied for prior to the filing date of the trademark application concerned)

(xi) A trademark being identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark(referring to goods or services designated in accordance with Article 6 (1) (including cases where it is applied mutatis mutandis pursuant to Article 68 (1)); the same shall apply hereinafter), or goods or services similar thereto;

#### 1. Regarding the method to judge the similarity of trademarks

##### (1) Comprehensive observation in judging similarities

Judgment on the similarity of trademarks is made by observing in whole the trademark as applied and the cited trademark by taking into consideration the impression, memory, association, etc. given to consumers by the appearance, sound or concept, etc. of such marks and then considering whether or not the trademark as applied is likely to cause confusion as to the source of goods or services with respect to the cited trademark when the trademark as applied is used for its designated goods or designated services.

In making the judgment, the general and regular state of transactions of the designated goods or services will be taken into consideration while the state of transactions that is only special or limited with respect to the goods or services for which the trademark is currently used will not be taken into consideration.

(Examples of general and regular state of transactions)

Trade practice of the designated goods or services

(Example of special or limited state of transactions)

- (i) Specific mode and manner of the trademark actually used
- (ii) Difference in the specific goods or services for which the trademark is actually used

##### (2) Method to observe the trademark

(a) Judgment on the similarity of trademarks is not only made by making an overall observation but also by comparing part of the composition of the trademark with another person's trademark.

(b) Judgment on the similarity of trademarks is made by remote observation based on different times and places.

(3) Standards for the attentiveness used in judging the similarity of trademarks

A judgment on the similarity of a trademark needs to, with consideration given to a class of main users (for example, difference in expertise, age and gender, etc.) of the designated goods or services on which the trademark is used and other actual state of transactions of the designated goods or services, be made based on attentiveness usually possessed by the user.

2. Regarding the identification of the trademark in the judgment on the similarity of trademarks

(1) Identification of the appearance, sound and concept

(a) Identification of the appearance

Appearance means the external form recognized by the consumers who look at the trademark through their eyes.

(b) Identification of the sound

Sound means the pronunciation naturally recognized in the course of trade by the consumers who look at the trademark.

For example, the sound is identified as follows.

(Example)

(i) The trademark "竜田川" only produces the natural sound "Tatsutagawa" but not unnatural sounds such as "Ryudensen."

(ii) A trademark "红梅" combined with the phonetic kana "BENIUME" also produces a natural sound [KOBAL].

(iii) A trademark composed of Chinese characters such as, for example, trademark "白梅" which produce two or more natural sounds like [HAKUBAL] and [SHIRAUUE] produces, if it is combined with only one of their sounds, the other natural sounds in addition.

(iv) A trademark composed of a colored part may produce a sound or concept from that part (for example, a figure of a "white" horse or "red" flag).

(c) Identification of the concept

Concept means the meaning or implications naturally recalled in the course of trade by consumers who look at the trademark. For example, concept is identified as follows.

(Example)

(i) In cases where the meaning of a foreign language constituting the trademark is published in a dictionary, etc. but it is determined that the consumers who look at the trademark would not promptly understand and recognize such meaning, the trademark is considered not to produce the

concept deriving from such meaning.

(ii) A trademark composed of a colored part can be judged to produce a sound or concept from that part (for example, a figure of a "white" horse or "red" flag)

### 3. Regarding the similarity of appearances, sounds and concepts


#### (1) Regarding the similarity of appearances

(a) The similarity of the appearances of the trademarks are determined by comparing the appearances of the relevant trademarks that give strong impression to the consumers who look at them and considering whether the overall impressions recognized by the consumers through their eyes from the appearances are confusing.

(Example) Cases where the appearances of the trademarks are similar

(Note) The following example shows the judgment on the similarity of appearance but not the similarity of the overall trademarks.

[1]

The image shows the trademark 'Japax' enclosed in a square box. The text is in a black, serif font.The image shows the trademark 'JapaX' enclosed in a square box. The text is in a black, serif font, where the 'X' is significantly larger and more stylized than the 'x' in the previous trademark.

(Explanation) The two trademarks differ in the size of the last character, but since such difference is minor, the two trademarks give similar impressions in terms of the overall appearance.

(Example) Cases where the appearances are not similar

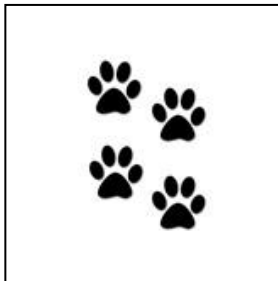
(Note) The following example shows the judgment on the similarity of appearance but not the similarity of the overall trademarks.

[1]



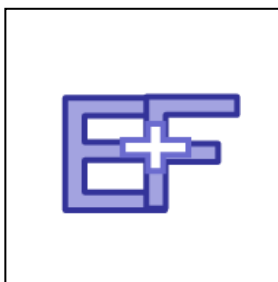
(Explanation) The figures of the horses of the two trademarks have a clear difference in terms of their constitution and thus they give different impressions from the overall appearance.

[2]



(Explanation) While four roundish animal footprints are drawn as if the right and left legs are walking alternately in the left figure, human footprints are drawn in the right figure and thus the two figures give a different impression from the overall appearance.

[3]



(Explanation) Both trademarks are composed of alphabetic characters "E" and "F" but they give a different impression from the overall appearance due to the existence or non-existence of the sign "+" and difference in the font and color.

## (2) Regarding the similarity of sounds

In judging the similarity of sounds of trademarks, whether or not common or similar parts are found in each judging factor on the tone quality, volume, tune and syllables of both sounds to be compared, is compared. Then, it is judged depending on whether or not such trademarks are likely to cause confusion with each other, from the overall impression of the sounds that may be given to listeners when both trademarks are pronounced and heard.

(Note) The examples shown in (a) to (e) below show the judgment on the similarity of sounds but not the similarity of the overall trademarks.

(a) Judging factors related to the quality of the sound (nature of the tone that is produced from qualitative rules on vowels and consonants)

(i) Whether vowels of the different sounds are common or similar

(Example) When both trademarks consist of the same number of sounds, and one of the different sounds has a common vowel.

"ダイラマックス" [Dairamakkusu]	"ダイナマックス" [Dainamakkusu]
"セレニティ" [Sereniti]	"セレリティ" [Sereriti]

(Explanation) For example, in the different sound, in the case where (i) the sound is positioned in the middle or at the end of the word and its vowels are common, or (ii) its consonants are similar in the position and method of the articulation (meaning the case where consonants are in identical or similar intonation positions or in methods in the consonant chart, such that both are labials or frictional sounds. However, it may differ in accordance with the position, intonation or the total number of sounds), and their vowels are in common, etc., the overall impression is often heard as similar.

(ii) Whether consonants of the different sounds are common or similar

(Example) When both trademarks consist of the same number of sounds, and one of the different sounds is on the same line of the table of the Japanese syllabary

"プリロセッティ" [Purirosetti]	"プレロセッティ" [Purerosetti]
"ビスカリン" [Bisukarin]	"ビスコリン" [Bisukorin]

(Explanation) There are differences in sound, where (i) the consonants of the different sounds are in the same line of the table of the Japanese syllabary, and their vowels are similar (for example, a vowel [e] is similar to [a] and [i], and a vowel [o] is similar to [a] and [u] according to how a mouth is opened and the position of a tongue. However, this may vary according to the position or intonation of the different sounds and the total numbers of sounds)

(Example) When both trademarks consist of the same number of sounds, and one of the different



sounds is only a difference of a voiceless sound, voiced consonant or Japanese voiceless bilabial plosive consonant

"ビュープレックス" [Byupurekkusu]      "ビューフレックス" [Byufurekkusu]

"バーテラックス" [Baterakkusu]      "バーデラックス" [Baderakkusu]

(Explanation) Such different sounds simply consist of the difference in a voiced consonant (sound of [ga], [za], [da] or [ba] lines), voiceless bilabial plosive consonant (sound of [pa] line) or a voiceless sound (sound of [ka], [sa], [ta] or [ha] lines), etc., in such cases, the overall impression is often heard as similar;

(b) Judging factors relating to the length of a sound (whether the sound is long or short)

(i) When one difference consists of whether or not there is a long sound, and whether or not there is a geminated consonant, or whether or not there is a difference between a long sound and a geminated consonant or a long sound and a weak sound.

(Note) Weak sound refers to sound without auditory clarity such as sounds pronounced without the mouth being widely opened ("i" and "u"), sounds pronounced without the mouth being opened ("mu" and "n") or sounds pronounced without vibrating the vocal chords ("fu" and "su").

(Example) Where a different sound is a long sound or not.

"モガレーマン" [Mogareman]      "モガレマン" [Mogareman]

(Example) Where a different sound is a geminated consonant

"コレクシット" [Korekushitto]      "コレクシト" [Korekushito]

(Example) Where a different sound is nothing but the difference between a long sound and geminated consonant

"コロネート" [Koroneto]      "コロネット" [Koronetto]

"アドポーク" [Adopoku]      "アドポック" [Adopokku]

(Example) When the different sound is nothing but the difference between a long sound and weak sound

"タカラハト" [Takahato]      "タカラート" [Takarato]

"イースタパック" [Iistapakku]      "インスタパック" [Insutapakku]

(Explanation) As to the length of the sound, this relates to the articulation (strength of the sound) since a long sound and a geminated consonant are heard comparatively weakly (the sound preceding a long sound or geminated consonant is generally heard strongly), and it also relates to a judging factor relating to the syllable since a long sound and a geminated consonant, when pronounced, give an impression as being one unit and as constituting one syllable.

(c) Judging factors relating to the articulation (strength of the sound and position of its accents)

(i) Whether different sounds are both weak sounds, whether or not there is nothing more than a weak sound, or simply whether there is a long sound or a geminated consonant (a weak sound is generally heard weakly, as it is absorbed in its preceding sound);

(Example) When the different sounds are both weak, and whether there is a weak sound or not.

"ダンネル" [Danneru]

"ダイネル" [Daineru]

"シーピーエヌ" [Shipienu]

"シーピーエム" [Shipiemu]

(Example) When the difference is nothing more than the existence or non-existence of a weak sound

"ブリテックス" [Buritekkusu]

"ブリステックス" [Burisutekkusu]

"デントレックス" [Dentorekkusu]

"デントレック" [Dentorekku]

(ii) Whether the different sounds are placed in the middle or end.

(Example) When both trademarks consist of the same numbers of sounds in a relatively long sound, and only one sound is different.

"サイバトロン" [Saibatoron]

"サイモトロン" [Saimotoron]

"パラビタオミン" [Parabitaomin]

"パラビタシミン" [Parabitaashimin]

(Explanation) A sound in the middle or end of a word is generally heard comparatively weakly

(iii) Whether the in-common sounds are the same strong sounds (sounds that sound strongly) in the beginning or end of their respective words

(Example) Where the in-common sounds are the same strong sound in the beginning of their respective words

"アプロトン" [Apuroton]

"アクロトン" [Akuroton]

"バンヴェロル" [Banveroru]

"バンデロル" [Banderoru]

(Explanation) If such are strong sounds, their respective overall auditory feelings are similar, and they are often heard as similar

(iv) In the case where there is a strong accent in the sound of a trademark comprised of Roman characters, whether or not the place of that accent is common

(Example) Case where the place of the strong accent in the sound of the trademarks is common.

"SUNRICHY"

"SUNLICKY"

(Sound of "sunricchi")

(Sound of "sunrikki")

"RISCOAT"

"VISCOAT"

(Sound of "riscoat")

(Sound of "biscoat")

(Explanation) The relative strength of a sound is often heard not only by the sound itself, but also by the respective positions of the different sounds, the total number of sounds, etc. (for example,

even if one of the different sounds is a weak sound as above in terms of the sound itself, there are cases where that sound cannot be said to be a weak sound when its preceding and succeeding sounds are also weak sounds).

(d) Judging factors relating to syllables

(i) With regard to the comparison of the number of syllables (the number of sounds), whether or not both sounds are plural sounds

(Note) One Japanese kana character constitutes one syllable, and a contracted sound (e.g. "kya," "sha" and "pyo") constitutes one syllable by two characters. A long sound (symbol), a geminated consonant ("ttu"), and a syllabic nasal ("n") respectively constitute one syllable each.

(Example) When both trademarks are relatively long, and one is longer in only one sound

"ビプレックス" [Bipurekkusu]                      ビタプレックス" [Bitapurekkusu]

(Explanation) Even if there is one different sound, the overall impression is often heard as being similar when there are relatively many sounds

(ii) Whether or not there is a commonality in the way the sounds are divided or separated (at the syllabic or breathing-pause stage) when the sounds are each felt in their entirety

(Example) Where the sounds are divided in their entirety

"バーコラルジャックス"                      "バーコラルデックス"  
[Bakorarujakkusu]                      [Bakorarudekkusu]

(Explanation) In many cases, where there is such a commonality, the sounds are heard similarly with a similar overall impression

(e) Other factors by which the overall impression would be found to be similar

(i) When two sounds are different but factors of (a) through (e) as above are combined.

"コレクシット"[Korekushitto]                      "コレスキット" [Koresukitto]  
"アレジエール"[Arejieru]                      "アリジエール" [Arijeru]

(ii) When one of the different sounds is only in a contracted sound or an ordinary sound.

"シャボネット" [Shabonetto]                      "サボネット" [Sabonetto]

(iii) When one of the different sounds is one used in a foreign language which is similar to the other's vowel or consonant.

"TYREX"	"TWYLEX"
(Sound of "tairekkusu")	(Sound of "twyrekkusu")
"FOLIOL"	"HELIOL"
(Sound of "foliol")	(Sound of "heliol")

(iv) When a vowel or consonant of one of the different sounds is similar.

"サリージェ" [Sariju]

"サリージー" [Sariji]

"セレラック" [Sererakku]

"セレノック" [Serenokku]

(v) When there are common portions which are strong in terms of their pronunciation and/or auditory impression.

"ハパヤ" [Hapaya]

"パッパヤ" [Pappaya]

(vi) When there are slight differences in the sounds in the anterior half but the overall impression is similar

"ポピスタン" [Popisutan]

"ホスピタン" [Hosupitan]

(f) Even if a case falls under the cases described in (a) through (e) above, factors by which the overall impression would not be found to be similar

(i) The quality or articulation in the beginning of the words are extremely different.

(ii) Although the different sounds are not located at the beginning of their respective words, when the quality (for example, one different sound is in the same line but its vowel is not similar) or intonation (for example, there is a strong accent on different sounds) of the sounds are extremely different.

(iii) Among the judging factors concerning syllables,

[i] when the sounds consist of smaller numbers of sounds

[ii] when the division or separation of the respective words are clearly different (at the syllabic or breathing pause stages).

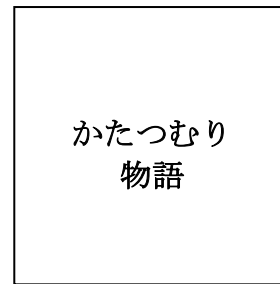
(3) Regarding the similarity of concepts

The similarity of concepts of the two trademarks are determined by considering whether or not the meaning or implications recalled by the consumers from the characters or figures, etc. constituting the trademark are almost identical to each other.

(Example) Case where the concepts are similar

(Note) The following example shows the judgment on the similarity of concept but not the similarity of the overall trademarks.

[1]



(Explanation) Both the terms "でんでんむし" and "かたつむり" are generally understood and recognized as representing the same meaning, "snail."

(Example) Case where the concepts are not similar

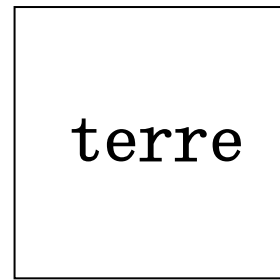
(Note) The following example shows the judgment on the similarity of concept but not the similarity of the overall trademarks.

[1]



Designated goods: Class 9

"TV"

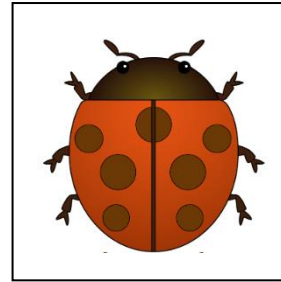
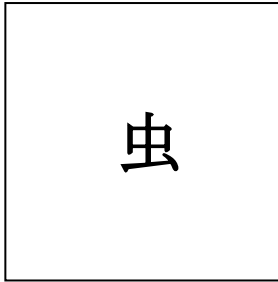


Designated goods: Class 9

"TV"

(Explanation) In light of the domestic consumers' level of understanding of foreign language with respect to the relevant designated goods, the trademark "EARTH" gives rise to the concept of "earth" but the French term "terre" does not give rise to the concept of "earth," and thus the two trademarks differ in terms of the concept. In the field of goods where French is generally used for trade names, etc., such concept may be produced.

[2]



(Explanation) Since the right figure will be recognized as a "ladybug" instead of a "bug," the concepts differ.

[3]



(Explanation) The left figure will be recognized as a "guitar" while the right figure will be recognized as a "violin," and thus the concepts differ.

4. Regarding the identification of the sound and concept of composite trademarks as well as the judgment of the similarity thereof

(1) Regarding the identification of the sound and concept of composite trademarks

(a) With respect to a composite trademark, when each constituent part cannot be found to have been combined strongly enough to consider that it is unnatural to observe them separately by taking into consideration the strength of the combination of each constituent part, only part of the composite trademark gives rise to the sound and concept.

(b) Regarding the factors taken into consideration with respect to the strength of the combination

With respect to trademarks composed solely of characters, judgment is made by taking into consideration the constitutional difference of the trademark such as the difference in the size, color, font, and type of characters (Hiragana or Katakana) as well as other factors such that the trademark is written in an extremely separated manner, the trademark has a long sound or the trademark has no conceptual relationship.

(Example) Case where there is a conceptual difference or the trademark has a long sound.

"富士白鳥" (difference in size of the characters)

"**サン**ムーン" (difference in the font)

"鶴亀                  万寿" (the characters are written in an extremely separated manner)

"chrysanthemumbluesky" (long sound)

"ダイヤフロンティア" (no connection in terms of concept)

(c) A trademark composed of a trade name (including a trademark composed of an abbreviation of a trade name)

When characters such as "Co.," "K.K." "Ltd.," etc. that are customarily used as part of a trade name are contained in the structure of a trademark, such trademark still produces a sound and concept with such characters being removed.

(d) A three dimensional trademark

(i) A three-dimensional trademark produces a sound and concept in correspondence to not only its whole but also its appearance in a specific angle.

(ii) A three-dimensional mark, which is combined with characters, produces a sound and concept in correspondence to the characters.

(e) A regional collective trademark

In consideration of the situation that trademarks registered as a regional collective trademark are, in consequence of the use, well known among the consumers as carrying inseparable features, the judgment of similarity with respect to a regional collective trademark is made by assuming that the features of the trademark are inseparable.

(2) Judgment of the similarity of a composite trademark

(a) Similarity of composite trademarks must be judged, for example, as follows. However, this does not apply where such a trademark obviously produces a remarkably different appearance, sound and concept.

[i] When the composition of a trademark contains indistinctive characters

A composite trademark having characters normally used or customarily used in relation to the designated goods or designated services, indistinctive characters indicating the quality, raw materials, etc. of goods or indistinctive characters indicating the quality of services, the location of its provision, quality, etc is judged as similar to a trademark without such characters as a general rule.

(Example) Similarity recognized between

"スーパーライオン" [SUPER LION] and "ライオン" [LION] in respect of the designated service "photography"

(Explanation) "スーパー" [SUPER] indicates the quality of the service.

"銀座小判" [GINZA KOBAN] and "小判" [KOBAN] in respect of the designated goods "confectionery"

(Explanation) "銀座" [GINZA] indicates the place of origin or place of sale of the goods.

"グリーンジャイス" [GREEN JICE/JAISU] and "ジャイス" [JICE/JAISU] in respect of the designated goods "clothing"

(Explanation) "グリーン" [Green] indicates the quality (color) of the goods.

"男山富士" [OTOKOYAMA FUJI] and "富士" [FUJI] in respect of the designated goods "sake"

(Explanation) "男山" is a customarily used trademark for refined sake.

"黒潮観光ホテル" [KUROSHIO KANKO HOTEL] and "黒潮" [KUROSHIO] in respect of the designated service "providing lodging accommodations."

(Explanation) "観光ホテル" [KANKO HOTEL] is a customarily used trademark for "providing lodging accommodations."

[ii] When the composition of a trademark contains a trademark well known among consumers.

A combination of another person's registered trademark that is well known among consumers in respect of the designated goods or designated services and other characters or figures is, in principle, including those trademarks for which the description of the composition of appearance is well united or conceptually related, judged as similar to said another person's trademark, in principle.

However, cases where a part of another person's trademark has become an established word are excluded.

(Example) Similarity recognized between:

"ラブロリアル" [LOVE L'OREAL] and "L'OREAL" and "ロリアル" [L'OREAL] in respect of the designated goods "cosmetics"

"PAOLOGUCCI" and "GUCCI" in respect of the designated goods "bags"

"JALFLOWER" and "JAL" in respect of the designated service "air transportation service"

"東宝白梅" [TOHO HAKUBAI] and "東宝" [TOHO] in respect of the designated service "film making"

"SONYLINE" or "WALKMAN LINE" and "SONYWALKMAN" in respect of the designated



goods "tape recorders"

(Example) Similarity not recognized between:

"TOSHIHIKO" and "IHI" in respect of the designated goods "metal working machinery and tools"

"アルバイト" [ARUBAITO] and "ALBA/アルバ" [ARUBA] in respect of the designated goods "watches and clocks"

"セガレ" [SEGARE] and "セガ" [SEGA] in respect of the designated goods "playing machines and tools"

(Note) Part III, Chapter 9, Item 2 (Article 4(1)(x)) of the Guidelines applies mutatis mutandis to judgments as to whether or not the trademark is well known among consumers.

[iii] A trademark having a distinctive part conspicuously small compared with its indistinctive part is judged to produce a sound or concept from that distinctive part.

[iv] A trademark with its part not distinctive itself and lacking in its function to distinguish an applicant's goods or services from those of others but that has come to gain its distinctiveness through use is judged to produce a sound and concept from that part which has come to gain distinctiveness.

(b) A regional collective trademark

A trademark which includes characters identical with or similar to those of another person's registered regional trademark is deemed as similar to that trademark.

## 5. A three-dimensional trademark

Because of its special nature of presenting a different appearance when seen from a different angle, a three-dimensional trademark has its similarity judged in the following manner. However, this does not apply in the case where a three-dimensional trademark is not recognized as presenting a specific appearance characterizing the trademark, when viewed from a specific direction.

(1) A three-dimensional trademark is judged, in principle, as similar in appearance to a plain trademark indicating an appearance (including similar one) which it presents when viewed from a specific angle.

(2) Three-dimensional trademarks that are common (or similar) in appearances as viewed from respectively specific angles are judged, in principle, as similar in appearance.

## 6. Similarity of Motion Marks

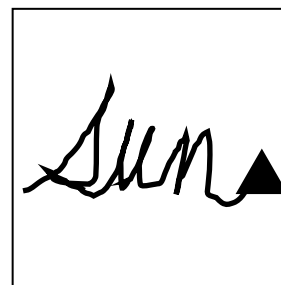
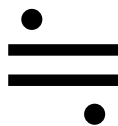
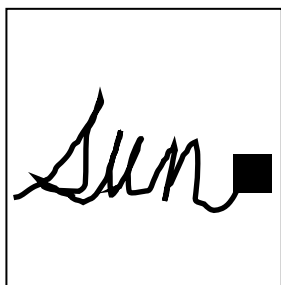
(1) When the similarity of a motion mark is to be examined, marks which constitute the motion mark, as well as each judging factor such as its external appearances, sounds and concepts resulting from changing states of the trademark as time passes are examined together so that the trademark will be examined as a whole.

(2) In principle, how a moving part of a motion mark moves will not be extracted as a part which can serve the function as a sign to independently distinguish its goods and services from those of others (hereinafter referred to as the "primary part").

### (3) Similarity of Motion Marks

(a) If one motion mark has a moving mark which is not recognized as having the function to distinguish its goods and services from those of others, but its trajectory draws lines and forms a mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other trademark has a mark consisting of a trajectory identical with or similar to one formed by the trajectory of the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other as a whole.

(Example) Trademarks which are similar in principle.

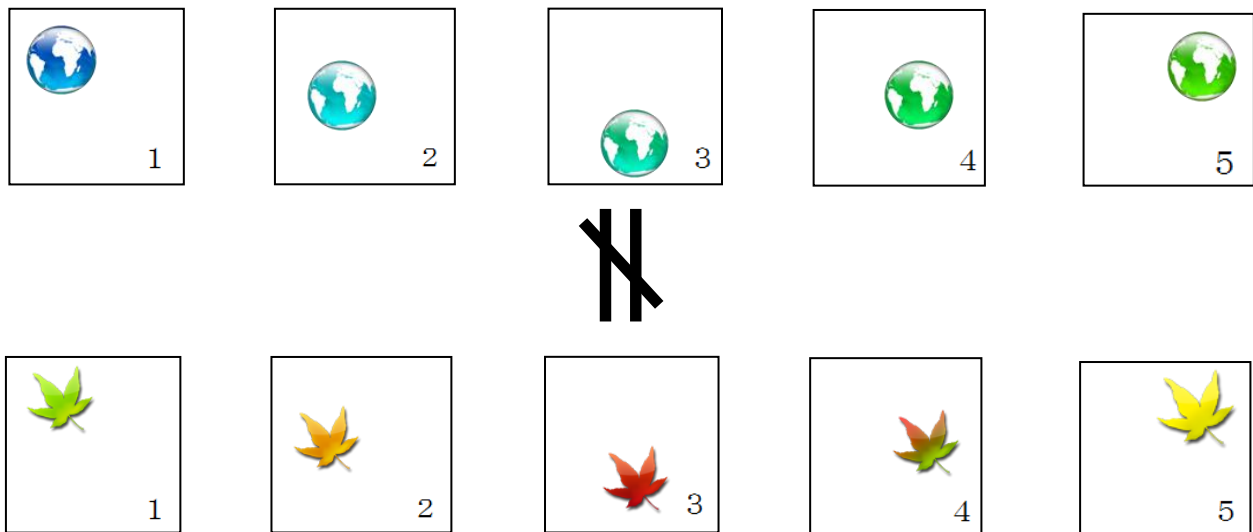


(motion mark ■ its trajectory draws lines of the characters for "sun")

(motion mark ▲ its trajectory draws lines of the characters for "sun")

(b) If trademarks are recognized as having functions which can distinguish their respective goods and services from those of others, and are not similar to each other, and if they move along trajectories identical with or similar to each other, but the trademarks do not paint any lines, then, in principle, the two trademarks are not regarded as similar to each other as a whole.

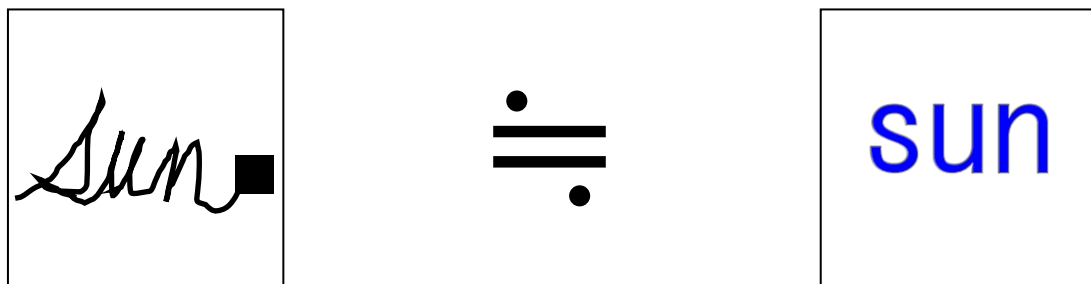
(Example) Trademarks which are not similar in principle



(4) Similarity of motion marks and character marks

(a) If one motion mark has a moving mark whose trajectory draws lines and forms a character or other mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other character or figure trademark is composed of a mark identical with or similar to one formed by the trajectory of the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other as a whole.

(Example) Trademarks which are similar in principle



(Motion mark ■ its trajectory draws lines of characters "sun")

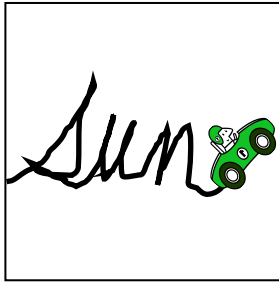
(Character mark)

(b) If one motion mark has a moving character, figure or other mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other figure or other trademark consists of one which is identical with or similar to the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other.

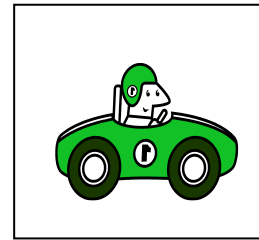
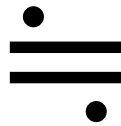
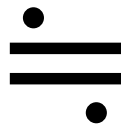
If one motion mark has a mark whose trajectory draws lines and forms a character or other

mark which is recognized as having functions which can distinguish its goods and services from those of others, and if the other character or other trademark consists of a mark which is identical with or similar to one formed by the trajectory of the former motion mark's mark, then, in principle, the two trademarks are regarded as similar to each other.

(Example) Trademarks which are similar in principle



(Motion mark: figure trademark of a car, the trajectory of which draws lines of the characters "sun")



(Figure trademark of car)



(Character mark)

(5) If one motion mark has a changing mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other figure trademark consists of those before and after the former motion mark's changes and the mark itself, then, in principle, the two trademarks are regarded as similar to each other.

## 7. Similarity of hologram marks

(1) When a hologram mark's similarity is to be judged, marks consisting of characters, figures and other elements as well as changes caused by visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with different viewing angles) are examined together so that the trademark is examined as a whole.

(2) If a hologram mark has visual effects to decorate a mark consisting of characters, figures and other elements such as those to make it appear to be three-dimensional and those which make it shine by the reflection of light, its similarity is judged based on external appearances, sounds and

concepts resulting from characters, figures and other marks shown on a display surface.

(3) If a hologram mark has a visual effect to show marks with different viewing angles, and if it consists of multiple display surfaces, its similarity is judged based on external appearances, sounds and concepts resulting from characters, figures and other marks shown on individual display surfaces.

In this case, the ratio of one of such display surfaces to the trademark's total area, the context under which it is shown and its relation with other display surfaces need to be examined together so that the trademark is examined as a whole.

(4) Similarity of hologram marks and character marks

(a) If marks shown on multiple display surfaces are regarded as inseparably connected because words and idioms are divided and shown on the multiple display surfaces, or because of other reasons, and if a character, figure or other trademark consists of a mark which is identical with or similar to that shown on one of the multiple display surfaces, such as a character mark consisting of a part of the words or the idioms, then, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle

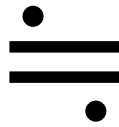
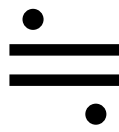


(Hologram marks have a visual effect to show marks with different viewing angles)

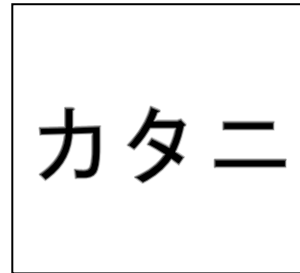
(Character marks)

(b) When it is not unnatural as a business practice to separately observe marks shown on multiple display surfaces due to reasons such that coined words or other marks with no specific meanings are shown on multiple display surfaces and the ratio of each display surface to the trademark's total area is not small, character or figure trademarks consisting of a mark identical with or similar to the mark shown on each display surface are, in principle, regarded as similar to each other.

(Example) Trademarks which are similar in principle



(Character mark)



(Character mark)

(Hologram marks have a visual effect to show marks with different viewing angles)

## 8. Similarity of color marks

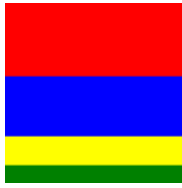
(1) For a color mark, its overall appearance composed of its hue (color shade), chroma (vividness of color), brightness (chromatic luminosity) and colors must be examined comprehensively so that the trademark is examined as a whole.

(2) With respect to color marks composed of a combination of colors, in addition to (1) and overall appearance of the whole constituted by the combination of colors, it is necessary to consider the overall trademark.

(3) Similarity of "single-color mark" and color mark composed of a combination of colors

With regard to examining whether a color mark and a single-color mark are similar to each other, if the single-color mark consists of a single-color mark extracted from the color mark, then, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle



(Color mark composed of a combination of colors)



(Single-color mark)

(4) Regarding the similarity of "single-color mark" and a "trademark with characters and colors combined"

A "single-color mark" and a "trademark with characters and colors combined" are not regarded as similar to each other, in principle.

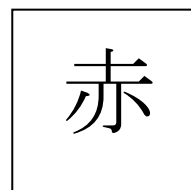
(5) Regarding the similarity of "single-color mark" and "character trademark"

When whether a single-color mark is similar to a character trademark is judged, even if the color mark has sounds and concepts identical with or similar to those of the character trademark, the color mark's color appearance is mainly an important factor to judge its similarity, and therefore, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle



(Single-color mark)



(Character mark)

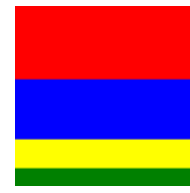
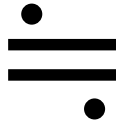
(6) Regarding the similarity of "mark with figures and colors combined" and "registered color mark composed of a combination of colors"

If a "mark with figures and colors combined" and a "registered color mark composed of a combination of colors" have color arrangements and ratios identical with or similar to each other, then, in principle, the two trademarks are regarded as similar to each other.

(Example) Trademarks which are similar in principle



(Figure mark)



(Registered color mark composed of a combination of colors)

#### 9. Regarding the similarity of sound marks

(1) When whether a sound mark is similar to another one is examined, sound elements (such as its melody, harmony, rhythm, tempo, instrument played, and varying sound color and other natural sounds based on the range of voice and other factors) and linguistic elements (such as lyrics), of which the sound mark is composed, are examined together so that the trademark is examined as a whole.

(2) If sound and linguistic elements contained in a sound mark are not connected so indispensably that it seems unnatural as a business practice to separately observe them, each element is observed separately, and extracted as a primary part.

(3) When whether separate observations should be conducted and whether a primary part should be extracted are to be decided, the sound and linguistic elements and the level of functions of the elements' parts to distinguish its goods and services from those of others are considered.

#### (4) Regarding the similarity of sound marks consisting of only sound elements

(a) If a sound mark's part does not have the function to distinguish its goods and services from those of others, it is not extracted as a primary part, and is not used for comparison when whether the sound mark is similar to another is examined.

(b) If a sound mark's part has functions to distinguish its goods and services from those of others, and the part is extracted as a primary part, it is necessary that another sound mark's melody is identical with or similar to the sound mark's when whether the another sound mark is similar to the sound mark is examined.

#### (5) Regarding the similarity of sound marks containing linguistic elements

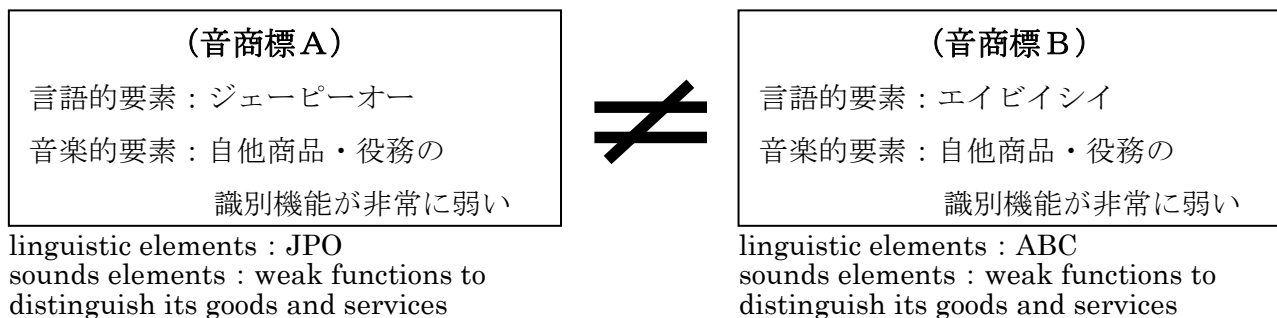


(a) If a sound mark's part does not have the function to distinguish its goods and services from those of others, it is not extracted as a primary part, and is not used for comparison when whether the sound mark is similar to another is examined.

(b) If both sound and linguistic elements of a sound mark can be regarded as having the function to distinguish its goods and services from those of others, the level of the elements' functions to distinguish its goods and services from those of others is taken into consideration.

(c) If the linguistic element of a sound mark is coined words, the names of famous companies or others, and has very strong functions to distinguish its goods and services from those of others, and if its sound element has weak functions to distinguish its goods and services from those of others when compared with the linguistic element, only the linguistic element may be extracted as a primary part.

(Example): Cases where the two trademarks are not similar to each other, in principle (Sound marks whose linguistic elements are dissimilar and whose sound elements are similar to each other)



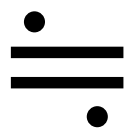
(Note) The sound elements of both trademarks are assumed to be the same.

(d) If the sound element of a sound mark is famous and has very strong functions to distinguish its goods and services from those of others, and if its linguistic element has considerably weak functions to distinguish its goods and services from those of others when compared with the sound element, only the sound element may be extracted as a primary part.

(6) Regarding the similarity between sound mark with linguistic element and character trademark

If a sound mark has a linguistic elements, and the linguistic element is to be extracted as a primary part, whether the linguistic element is similar to a character trademark is also be examined.

(Example) Trademarks which are similar in principle

<div style="border: 1px solid black; padding: 10px; text-align: center;"> <p>(音商標)</p> <p>言語的要素：ジェーピーオー</p> <p>音楽的要素：自他商品・役務の識別機能が非常に弱い</p> </div>		<div style="border: 1px solid black; padding: 10px; display: inline-block;"> <p style="font-size: 2em; color: blue;">JPO</p> </div> <p>(Character mark)</p>
<p>linguistic elements : JPO</p> <p>sounds elements : weak functions to distinguish its goods and services</p>		

## 10. Similarity of position marks

(1) When whether a position mark is similar to another trademark is to be judged, the characters, figures and other marks of the position mark, and positions to which those marks are attached must be examined together so that the trademark is examined as a whole.

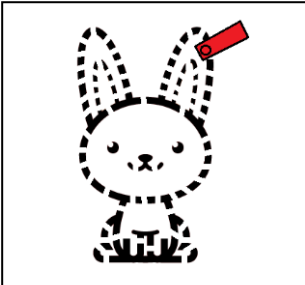

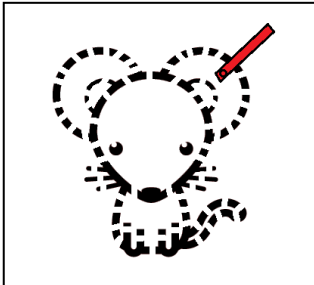

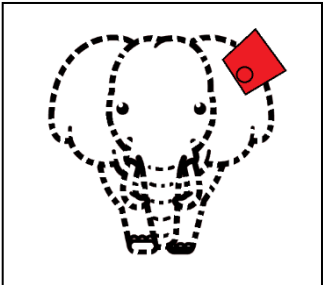
(2) In principle, the positions themselves are not extracted as a primary part to judge whether the position mark is similar to another trademark.

(a) Regarding the similarity of position marks

(i) Mark not regarded as having the function to distinguish its goods and services from those of others

Impressions, memories, associations and other factors given to consumers and traders by the positions in its goods to which the mark is attached must be comprehensively examined together so that the trademark is examined as a whole.

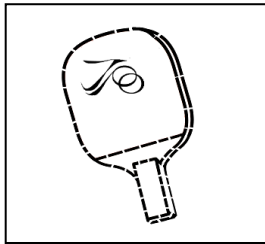
(Example) Trademarks which are similar in principle (designated good class 28 of "stuffed animals")

				
(Position Mark)		(Position Mark)		(Position Mark)

(ii) Mark regarded as having the function to distinguish its goods and services from those of others

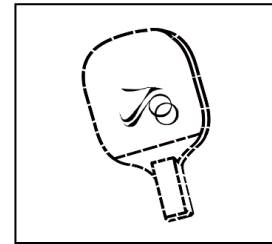
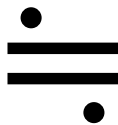
If the mark is identical with or similar to that of another mark, then, in principle, the trademark is regarded as similar to said another mark as a whole, regardless of whether the mark's position is different from that of said another mark.

(Example) Trademarks which are similar in principle



(Position Mark)

Goods of Class 28 "table tennis racket"



(Position Mark)

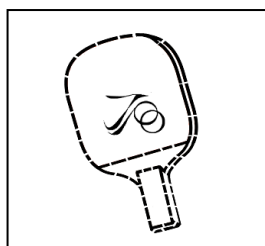
Goods of Class 28 "table tennis racket"

(b) Regarding the similarity between position mark and character or figure trademark

(i) If a position mark is composed of a mark, and if the mark is not extracted as a primary part, the same applies as provided for in (a)(i) above.

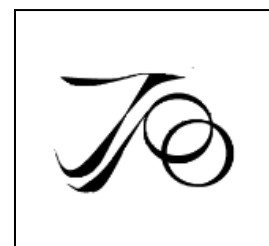
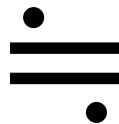
(ii) If a position mark is composed of a mark, and if the mark is extracted as a primary part, then, in principle, the position mark as a whole is identical with or similar to a character or figure trademark which has the same mark.

(Example) Trademarks which are similar in principle



(Position Mark)

Goods of Class 28 "table tennis racket"



(Figure Trademark)

Goods of Class 28 "table tennis racket"

## 11. Regarding the judgment of the similarity of goods or services

Similarity of goods or services is judged based on whether or not the relevant goods or services

are likely to cause confusion as if they are goods manufactured and sold or services provided by the same business entity, when an identical or similar trademark is used for the designated goods or designated services of the trademark as applied and the cited trademark due to circumstances such that normally the goods are manufactured and sold or services are provided by the same business entity.

(1) Similarity of goods

To judge the similarity of goods, the following criteria are comprehensively taken into consideration. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether they correspond in production stage.
- (ii) Whether they correspond in stage of sales.
- (iii) Whether they correspond in materials and quality.
- (iv) Whether they correspond in intended purpose.
- (v) Whether they correspond in a range of consumers they are targeted at.
- (vi) Whether they are in a finished-product-and-parts relationship.

(2) Regarding the similarity of services

To judge the similarity of services, the following criteria are comprehensively taken into consideration. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether they correspond in the manner, purpose and place of their provision.
- (ii) Whether they correspond in articles connected with their provision.
- (iii) Whether they correspond in the range of consumers and customers they are targeted at.
- (iv) Whether they correspond in the category of their business.
- (v) Whether they correspond in laws regulating business relating to the services concerned and their business operators.
- (vi) Whether they are provided by business operators in the same category of business.

(3) Regarding the similarity of goods and services

In judging the similarity of goods and services, a substantial decision is made on a case-by-case basis with consideration generally given to the following criteria. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether it is common for the same business operator to engage in the production and sales of

goods and in the provision of services.

(ii) Whether the goods and services correspond in intended purpose

(iii) Whether the goods and services correspond in the points of sales of the goods and provision of the services.

(iv) Whether the goods and services correspond in a range of consumers and customers they are targeted at.

(4) Consideration of the actual state of transactions in judging the similarity of goods or services

When the holder of a registered trademark cited in the notice of reasons for refusal stating that this item is applicable (hereinafter referred to as the "holder of cited registered trademark") makes a statement to the effect that the designated goods or designated services of the cited trademark are not similar to the designated goods or designated service of the trademark as applied, the similarity of goods or services may be judged by taking into consideration the actual state of transactions of the goods or services as alleged by the applicant (provided that this will be limited to the circumstances listed in (1) to (3) above) notwithstanding the Examination Guidelines for Similar Goods and Services.

In the following cases, the actual state of transactions cannot be taken into consideration.

(i) When the holder of a cited trademark has only approved the registration of the trademark for which an application for trademark registration has been filed.

(ii) When the holder of a cited trademark has only made a statement to the effect that only part of the designated goods or designated services presumed to be similar under the Examination Guidelines for Similar Goods and Services is not similar.

(iii) In the case where the establishment of an exclusive license or non-exclusive license is registered with respect to the trademark right of a cited trademark, when the holder of the exclusive license or non-exclusive license has failed to make a statement to the effect that the goods or services are not similar.

## 12. Treatment of cited trademarks after the duration has expired

(1) Treatment until six months pass from the expiration of the duration

(a) When the cited trademark is a registered trademark based on a national application

The six-month period after the expiration of the duration of a trademark right or the six-month period after the passage of the time limit by which the later-installment registration fee must be paid in the case where the registration fee is to be paid in installments is determined to fall under

this item (refer to Article 20 (3) and Article 41-2(5) and (8)).

(b) Case where the cited trademark is a registered trademark based on international registration

The six-month period after the expiration of the duration of the international registration is determined to fall under this item (refer to Article 7(4) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks)

(2) Treatment after the passage of the six-month period mentioned in (1)(a) and (b) above

When the expiration of the duration has become final in the trademark registry, etc. after the passage of the six-month period mentioned in (1)(a) and (b) above, this item does not apply.

However, when the holder of the relevant trademark has confirmed by the trademark registry as to whether or not the duration of the trademark right of the cited trademark has been renewed and an application for registration of renewal has been filed based on the provisions of Article 21(1), this item is determined to be applicable.

13. Treatment in the case where there is a controlling relationship between the applicant and the holder of a cited trademark

When the applicant has submitted the evidence mentioned in (3) below in addition to alleging that the applicant and the holder of the cited trademark are in a relationship mentioned in (1) or (2) below, the applicant will be treated as not falling under this item.

(1) The holder of the cited trademark is under the control of the applicant;

(2) The applicant is under the control of the holder of the cited trademark;

(3) Evidence showing that the holder of the cited trademark has approved the registration of the trademark as applied.

(Example of cases that fall under (1) or (2) above)

(a) When the applicant holds a majority of the voting rights of the holder of the cited trademark;

(b) When the requirement mentioned in (a) above is not satisfied but there is a capital cooperation relationship between the applicant and the holder of the cited trademark, and the business activities of the company of the holder of the cited trademark are, in effect, under the control of the applicant.

Chapter 11: Article 4(1)(xii) (Registered defensive mark of another person)

(xii) A trademark being identical with a registered defensive mark of another person (referring to a mark registered as a defensive mark; the same shall apply hereinafter), if such a trademark is used in connection with designated goods or designated services relating to the defensive mark;

1. Trademarks prescribed in this item are limited to those identical with registered defensive marks (including those with the difference in scale).

Even when the relevant mark is judged not to fall under this item, such mark may fall under Article 4(1)(xv).

Chapter 12: Article 4(1)(xiv) (Name of a variety registered under the plant variety protection and seed act)

(xiv) A trademark being identical with, or similar to, the name of a variety registered in accordance with Article 18 (1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto;

1. Regarding the expression a trademark which "is similar"

In judging the similarity under this item, each judging factor such as the appearance, sound and concept of the trademark must be taken into consideration in a comprehensive manner from the perspective of preventing any specific person from having a monopoly on the name of a registered variety.

2. When an application for trademark registration has been filed for the name of a registered variety

(1) When the designated goods are the harvest pertaining to the relevant variety, Article 3(1)(iii) is determined to be applicable.

(2) When the designated goods are the processed products pertaining to the relevant variety, the relevant trademark will be judged as to whether or not it falls under Article 3(1)(iii) based on the relation with the designated goods.

(3) When the designated services are retail services (provision of benefits for customers conducted in the course of retail or wholesale business) whose line of goods are harvests or processed products of harvest pertaining to the variety, the trademark will be judged as to whether or not it falls under Article 3(1)(vi) of the Trademark Act based on the relation with the designated services.

3. The name of a registered variety does not fall under this item after the extinction of the plant breeder's right due to reasons such as the lapse of the duration of its registration, and it will be determined whether or not such name falls under the provisions of Article 3(1)(i), (iii) or (vi) of the Trademark Act based on the relationship with the designated goods or designated services.



4. The name of a variety registered in accordance with Article 12-4(1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998) prior to the amendment at the time of enforcement of that Act will be handled in the same manner as that mentioned in 3. above.

Chapter 13: Article 4(1)(xv) (Confusion over the source of goods and services)

(xv) A trademark being likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);

1. Regarding the expression "likely to cause confusion in connection with the goods or services pertaining to a business of another person"

(1) This item applies not only in the case where the consumers of goods or services (hereinafter referred to as "goods, etc.") are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as those connected with the business of other persons but also in the case where the consumers of the goods, etc. are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as connected with the business of a person who has a certain economic or organizational relationship with the other persons.

(Example) Cases that fall under this item

(i) In the case where a trademark ㊟ used by a business operator X with respect to the service "provision of ramen" connected with its own business has become well known throughout Japan, the use of the trademark ㊟ by a business operator Y with respect to goods "soba noodles" (although not similar to the service "provision of ramen") connected with its own business leads consumers to mistakenly recognize the goods "soba noodles" as goods connected with another business of business operator X and such consumers would be confused over the source of the goods.

(ii) In the case where a trademark "JPO" used by a business operator P with respect to goods "telecommunication machines and apparatus" connected with its own business has become well known throughout Japan, the use of the trademark "JPO" by a business operator R with respect to goods "toys" (although not similar to the goods "telecommunication machines and apparatus" and having no relationship with the goods in respect of their manufacturer, seller, distribution route, materials, intended purpose, etc.) connected with its own business leads consumers to mistakenly recognize the goods "toys" not as goods connected with the business of the business operator P but as goods connected with the business of an affiliate of business operator P and to be confused over the source of the goods.

(2) Matters to be taken into consideration.

For example, the following facts are taken into consideration in a comprehensive manner in

determining whether or not this item is applicable.

- (i) The degree of similarity between the trademark as applied and the other person's mark;
- (ii) The degree to which the other person's trademark is well known;
- (iii) Whether the other person's trademark consists of a coined word or has a distinctive feature in its composition;
- (iv) Whether the other person's trademark is a house mark;
- (v) Whether there is the possibility of multiple management in the company;
- (vi) Whether there is any relationship between goods, services or goods and services;
- (vii) Whether there is any commonality between the consumers of goods, etc. and other actual states of transactions.

In determining the degree of being well-known as prescribed in (ii) above, Part II, Item 2(2) and (3) (Article 3(2)) of the Guidelines applies *mutatis mutandis* but it is not necessarily required that the other person's mark is well known across the country.

### (3) Famous marks in foreign countries

When a mark famous in a foreign country is well known by Japanese consumers, determination is made by sufficiently taking into consideration such facts.

## 2. Trademarks with parts indicating another person's famous trademark

(1) A combination of another person's famous trademark and other characters or figures are, in principle, handled based on the presumption that it may cause confusion over the source of the goods, etc., including those trademarks for which the description of the composition of appearance is well united or conceptually related.

However, exemptions will be made when another person's well-known trademark constitutes part of an established word, or, when it is clear that the source will not be confused in relation to the designated goods or designated services.

(Example) Cases that fall under this item

- (i) The trademark as applied "arenoma/アレノマ" for the goods "clothing" and the famous trademark "renoma" and "レノマ" for the goods "bags"
- (ii) The trademark as applied "パー・ソニー" [PER SONY], "PER SONY" or "PERSONY" for the goods "toys" and the famous trademark "SONY" for the goods "electric machinery and apparatus"

(Example) Cases that do not fall under this item

The trademark as applied "POLAROID" for the goods "cameras" and the famous trademark "POLA" for the goods "cosmetics"

(Explanation) It will be determined that the two trademarks are unlikely to cause confusion in relation to the designated goods or designated services.

(2) The items of Article 4(1) must be handled in the following manners in relation to a trademark with its part indicating a famous trademark of another person:

(i) Case where the trademark is determined to fall under Article 4(1)(x)

When the relevant trademark is found to be similar to another person's famous unregistered trademark and to be used for goods, etc. identical with or similar to the goods, etc. for which the unregistered trademark is used.

(ii) Case where the trademark is determined to fall under Article 4(1)(xi)

When a trademark is found to be similar to another person's famous registered trademark and to be used for goods or services identical with or similar to the designated goods or designated services pertaining to that registered famous trademark.

(iii) Case where the trademark is determined to fall under Article 4(1)(xv)

When a trademark is recognized as not similar to another person's famous trademark or is similar to another person's famous trademark but goods or services are not similar to each other, the trademark is liable to cause confusion over the source of goods or services.

(iv) Case where the trademark is determined to fall under Article 4(1)(xix)

When a trademark is similar to another person's famous trademark but the goods or services are not similar to each other and the trademark is not liable to cause confusion over the source of goods or services, the trademark is used for unfair purposes.

### 3. Three-dimensional trademarks indicating the shape of buildings

If the shape of a building is well known among Japanese consumers as the shape of another person's building before an application is filed for it, the relevant three-dimensional trademark falls under this item.

4. In determining whether or not the relevant mark is famous, trademarks registered as a defensive mark or trademarks found to be famous in trial decisions, objections or judgments (note) are handled as famous trademarks according to such registration or finding.

(Note) These trademarks can be searched from the page "Searching Japanese Well-Known

Trademarks" on the website "Japan Platform for Patent Information (J-PlatPat)."

(Reference) For other materials related to "trademarks well known among consumers," refer to Examination Manuals for Trademarks.

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.

Chapter 15: Article 4(1)(xvii) (Indication of origin of wines or spirits)

(xvii) A trademark comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by the said member from being used on wines or spirits not originating from the region of the said member, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of the said member;

1. Regarding "Marks indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office" and "marks indicating a place of origin"

These marks include not only marks indicating a place of origin by the characters used in that place of origin but also, for example, marks indicating a place of origin by Katakana characters or other characters which are recognized to be the translation thereof.

(Example) Marks indicating the place of origin in Katakana characters

"ボルドー" for "BORDEAUX"

"シャンパーニュ" for "CHAMPAGNE"

"リュウキュウ" for "琉球" [RYUKYU]

(Example) Marks indicating the place of origin by other characters that are recognized to be the translation of the original language

"BURGUNDY" (English) for "BOURGOGNE" (French)

2. Regarding the expression "is comprised of"

Regardless of whether or not the relevant trademark misleads the consumers as to the place of origin, judgment is made based on whether or not the trademark formally contains such place of origin in its composition.

(Example) Case where the trademark "is comprised of"

The trademark "琉球の光" [Ryukyu no Hikari] for the goods "Shochu" (Japanese white liquor)

The trademark "山梨産ボルドー風ワイン" [Yamanashi-made Bordeaux style wine] for the goods "wines"

The trademark "CHAMPAGNE style" for the goods "wines"

3. Regarding "wines" and "spirits"

"Wines" as prescribed in this paragraph include alcohol-added wines. "Spirits" include, for example, Awamori (distilled spirits of millets), Shochu (Japanese white liquor), whiskey, vodka, brandy, rum, gin, Gaoliangjiou (distilled spirits of kaoliang), Baiganr (distilled spirits of kaoliang), etc. but do not include liquors.

Chapter 16: Article 4(1) (xviii) (Characteristics which goods, etc. must naturally have)

(xviii) A trademark consisting solely of characteristics which its goods, etc. (meaning its goods or packages, or services; the same shall apply in Article 26(1)(v)) must naturally have and which are specified by Cabinet Order; or

Order for Enforcement of the Trademark Act

Article 1 The characteristics specified by Cabinet Order as referred to in Article 4(1)(xviii) and Article 26(1)(v) of the Trademark Act are three-dimensional shapes, colors or shapes (in the case of services, the three-dimensional shape, color or sound of the article used for the provision of the service)

1. Case where this item applies

"Characteristics" which the trademark's goods or packages, or articles used for the provision of its services (hereinafter referred to as the "goods, etc.") "must naturally have" are in principle included in the characteristics of goods, etc. to which Article 3(1)(iii) is applicable. Therefore, a problem arises in the examination as to whether Article 4(1)(xviii) is applicable to a trademark that falls under Article 3(1)(iii), but in reality, the question is whether or not Article 3(2) is applicable.

2. Regarding the expression "characteristics" which goods, etc. "must naturally have"

With respect to "characteristics" which goods, etc. "must naturally have", the elements prescribed in (1), (2) or (3) below will be verified in determining whether Article 3(2) is applicable to a trademark, by the means of evidence submitted.

(1) Three-dimensional trademarks

(a) A trademark as applied consists solely of three-dimensional shapes spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of three-dimensional shapes which are essential to secure the functions of the trademark's goods, etc.

(2) Color Mark

The elements prescribed in (a) and (b) below will be verified.

(a) A trademark as applied consists solely of colors spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of colors which are essential to secure the functions of the trademark's goods, etc.

(3) Sound marks

The elements prescribed in (a) and (b) below will be verified.

(a) A trademark as applied consists solely of sounds spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of sounds which are essential to secure the functions of the trademark's goods, etc.

(4) When the elements prescribed in (1)(b), (2)(b) or (3)(b) above are verified, the elements prescribed in (a) and (b) below are taken into consideration.

(a) Whether alternative three-dimensional shapes, colors or sounds exist otherwise to secure the functions of a trademark's goods, etc.

(Example)

(i) Whether the relevant sounds are those inevitably generated because of structures or mechanics of a trademark's goods, etc.

(ii) Whether or not the relevant sounds are those artificially added.

(b) Even if alternative three-dimensional shapes, colors or sounds exist, whether a trademark's goods, etc. can be produced at the same (or lower) cost with these alternatives.

Chapter 17: Article 4(1)(xix) (Trademark identical with or similar to another person's well-known trademark which is used by the applicant for an unfair intention)

(xix) A trademark being identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);

1. Regarding "a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person"

(1) Regarding the recognition of consumers

Part III, Chapter 9, Item 1 (Article 4(1)(x)) of the Guidelines applies *mutatis mutandis* to the determination on whether or not the relevant trademark is well known among consumers.

(2) Regarding "trademarks well known among consumers abroad"

The trademark must be well known in one country other than Japan but is not necessarily required to be well known in several countries. In addition, when the trademark is well known abroad, the fact as to whether or not the trademark is well known in Japan is disregarded.

2. Regarding the expression "a trademark is identical with or similar to"

A combination of another person's trademark "well known among consumers" and other characters or figures are judged to be similar to the unregistered trademark including those trademarks for which the description of the composition of appearance is well united or conceptually related.

However, in cases where it is clear that the other person's trademark constitutes part of an established word or other cases, the trademark will be excluded.

(Example) Examples of trademarks are the same as those mentioned in Part III, Chapter 10, Item 4(2)(a)(ii) (Article 4(1)(xi)) the Guidelines.

3. Regarding "unfair purposes"

(1) Matters to be taken into consideration

A judgment on an "unfair purposes" must be made with full consideration given to the following facts, if materials mentioned in (i) to (vi) below are available.

- (i) Materials proving a fact that another person's trademark is well known among consumers
- (ii) Materials showing that a well-known trademark is composed of a coined word or has a distinctive feature in composition
- (iii) Materials proving a fact that the owner of a well-known trademark has a concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)
- (iv) Materials proving a fact that the owner of a well-known trademark has a plan to expand its business in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.)
- (v) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc. or a fact that the applicant is seeking to prevent foreign right holders from entering the Japanese market
- (vi) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark

(2) Case where the trademark is presumed to be used for unfair purposes

A trademark contained in an application for trademark registration which satisfies the requirements mentioned in (i) and (ii) below is treated by presuming them as those using another person's trademark for unfair purposes.

- (i) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.
- (ii) The above-mentioned well-known trademark is composed of a coined word or has a distinctive feature in composition.

4. Regarding the determination on the applicability of this item

Applicability of this item is determined by taking into consideration in a comprehensive manner the judging factors such as the degree of being well known, the relevant trademark's degree of being identical with or similar to another person's trademark and unfair purposes.

(Example) Case where the trademarks fall under this item

- (i) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract

(ii) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of goods.



## Chapter 18: Article 4(3) (Time of judgment concerning each item of Article 4(1))

(3) Paragraph (1)(viii), (x), (xv), (xvii) and (xix) shall not apply to a trademark falling under any of the said items which does not fall under the said item at the time of filing of an application for trademark registration.

## 1. Regarding the time of judgment concerning each item of Article 4(1)

(1) The time of judgment concerning whether or not the trademark falls under Article 4(1)(i) to (vii), (ix), (xi), (xii), (xiv), (xvi) or (xviii) will be the time of decision.

(2) Trademarks are subject to Article 4(1)(viii), (x), (xv), (xvii) or (xix) only in case where they fall under these items at the time of filing of their applications and an examiner's decision on them.

## 2. Regarding the expression "at the time of filing of an application for trademark registration" in the case of international applications for trademark registration, etc.

The "time of filing of an application for trademark registration" which is the time of judgment of applicability of Article 4(1) (viii), (x), (xv), (xvii) or (xix) for the international application for trademark registration are as follows:

Application	Time of judgment
International applications for trademark registrations	The date of international registration or the date of subsequent designation
International application for trademark registration falling under the special provisions for time of filing of application provided for in Article 68(10)	<p>The date when the application for national trademark registration was filed.</p> <p>The special provisions under Article 68(10) apply to the scope of goods or services that are overlapped with the scope of designated goods or designated services relating to the trademark based on the national registration. Therefore, the date of filing of an application for national trademark registration may be different for each designated goods or</p>

	designated services.
Application for trademark registration falling under Article 68(32) (Domestic Application Subsequent to Central Attack) or Article 68(33) (Application for Trademark Registration Subsequent to Denunciation of Protocol).	The date of international registration or the date of subsequent designation

Chapter 19: Article 4(4) (Exceptions to another person's registered trademark applied for prior to the filing date of the trademark application concerned)

Chapter 19: Article 4(4) (Exceptions to another person's registered trademark applied for prior to the filing date of the trademark application concerned)

Paragraph (1), item (xi) does not apply to a trademark falling under the item, if the applicant for a trademark registration has obtained the consent of the other person of the item to register the trademark, and there is no likelihood of confusion between the goods and services for which the trademark is used and those pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark of the item.

1. Regarding the application of the paragraph

The paragraph applies to a trademark which is judged to be similar by considering the general and regular actual state of transactions of the designated goods or services pursuant to Part III, Chapter 10 (Article 4(1)(xi)), 1.(1) of the Examination Guidelines, if the consent of the holder of the cited trademark right is obtained, and it can be said that there is no likelihood of confusion as to the source of the goods or services as a result of considering the specific circumstances (refer to 4.(3) below) with respect to the trademark as applied and the cited trademark (hereinafter referred to as "both trademarks").

2. Regarding the expression "consent of the other person"

The "consent of the other person" is the declaration of intention of the holder of the cited trademark right that the other person consents to the registration of the trademark for which an application for trademark registration has been filed, and it must have been obtained at the time of decision to grant trademark registration.

3. Regarding the expression "the goods and services for which the trademark is used and those pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark of the item"

The "goods and services for which the trademark is used and those pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark of the item" means the goods and services (hereinafter referred to as "goods, etc.") for which the applicant uses or will use the trademark as applied and the goods, etc. for which the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark of the item uses or will use the registered trademark, among the designated goods or designated services relating to both trademarks which are deemed to be identical or similar to each other pursuant to Article 4(1)(xi).

#### 4. Regarding the expression "no likelihood of confusion"

##### (1) Regarding the expression "likelihood of confusion"

The expression "likelihood of confusion" means not only the likelihood of being mistaken as the goods, etc., pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark pursuant to Article 4(1)(xi) resulting in confusion among consumers of the goods, etc. as to the source of the goods, etc., but also the likelihood of being mistaken as the goods, etc., pertaining to the business of a person who has some economic or organizational relationship with the holder of the trademark right, exclusive right to use or non-exclusive right to use of the another person's registered trademark resulting in confusion among consumers of the goods, etc., as to the source of the goods, etc.

##### (2) Time and period when "no likelihood of confusion" is required

In order to fall under "no likelihood of confusion," it must be determined that there is no likelihood of confusion not only at the present time of the examiner's decision, but also in the future, based on the time of the examiner's decision.

##### (3) Reasons for consideration

In judging whether or not it falls under "no likelihood of confusion," specific circumstances relating to both trademarks, such as (i)-(viii) below, will be comprehensively considered. Note that a trademark that is identical with the cited trademark (including those that differ only in scale) and used for the identical designated goods or services is, in principle, considered high likelihood of confusion.

- (i) The degree of similarity between both trademarks
- (ii) The degree of familiarity of the trademark
- (iii) Whether the trademark consists of a coined word or has a distinctive feature in its composition
- (iv) Whether the trademark is a house mark
- (v) Possibility of multiple management in the company
- (vi) Relationship between goods, between services, or between goods and services
- (vii) Commonality of consumers of goods, etc.
- (viii) Mode of use of the trademark and other actual state of transactions

For example, "(viii) Mode of use of the trademark and other actual state of transactions" includes the following matters. If the applicant submits evidence showing the specific mode of use of the trademark or other actual state of transactions, the content of such

Chapter 19: Article 4(4) (Exceptions to another person's registered trademark applied for prior to the filing date of the trademark application concerned)

evidence will be considered.

a. Constitution of the trademark to be used

(Example) The figures and letters constituting the composite trademark are always used in the same positional relationship.

Particular colors and fonts are always used.

b. The manner in which the trademark is used

(Example) The trademark is used only in a specific position on the packaging of the product.

Other trademarks, such as the company name, company emblem, etc., are always used in combination with the trademark.

An indication for avoiding confusion (an indication denying that the product is the goods, etc., pertaining to the business of the other person) is always added.

c. Goods etc. used for

(Example) One uses the cited trademark only for the product "computer programs for games" among the designated goods "computer programs," the other uses the trademark as applied only for the product "computer programs for medical use."

One is used only for goods in the higher price range than a certain amount, and the other is used only for goods in the lower price range than a certain amount.

d. Method of sale/supply

(Example) One is sold to an unspecified number of people through retail stores, etc., and the other is made to order only through individual sales.

e. Season of sale/supply

(Example) One is sold only in the spring season, and the other is sold only in the fall season.

f. Region of sale/supply

(Example) One is sold only at stores in Hokkaido, and the other is sold only at stores in Okinawa Prefecture.

g. Measures to be taken by the parties to prevent confusion

(Example) If it is recognized that there is a likelihood of confusion between both trademarks, the other party shall be notified and, after consultation with the other party, take measures to prevent or eliminate the confusion.

(4) Circumstances that may be considered in the direction of denying the likelihood of future confusion

Specific circumstances relating to both trademarks that are considered in determining "no likelihood of confusion" include those that are expected to change after the examiner's

decision. Thus, if trademarks are co-registered on the basis of the circumstances that may change after the examiner's decision, the likelihood of confusion between both trademarks cannot be denied in the future due to the use of those trademarks. Therefore, the circumstances that may be considered in the direction of denying the likelihood of future confusion shall be those of the above circumstances that are recognized as not changing in the future. For example, the content is considered in the following cases.

(i) Cases where it is agreed that the circumstances will not change in the future

Where the applicant submits a document containing an agreement between the parties that the specific circumstances relating to both trademarks will not change in the future (e.g., an agreement not to change the specific circumstances listed in (3)(viii) a.-g. above, such as always using the company name together), or a summary of such an agreement.

(ii) Cases where the evidence shows that the circumstances will not fluctuate in the future

In addition to the cases based on the above agreement, cases where there are reasonable grounds to recognize that the specific circumstances regarding both trademarks will not fluctuate in the future based on the submitted evidence, etc.

(5) Cases where a likelihood of confusion is recognized

Where, as a result of the examination under (1)-(4) above, a likelihood of confusion is recognized by an examiner, the application for trademark registration shall be refused in accordance with Article 4(1)(xi). Even in such a case, the Office will not, in principle, immediately refuse the application, but will request the applicant to submit additional materials, etc.

## Part IV: Article 5 (Applications for trademark registration)

Article 5 (1) Any person who desires to register a trademark shall submit an application to the Commissioner of the Patent Office accompanied by the required documents. The application shall state the following matters:

- (i) the name and the domicile or residence of the applicant for trademark registration;
- (ii) the trademark for which registration is sought; and
- (iii) the designated goods or designated services and the class of goods or services provided by Cabinet Order as provided for in Article 6(2).

(2) Where a person desires to register a trademark listed in the following, the application shall contain a statement indicating thereof:

- (i) consists of any character(s), figure(s), sign(s) or three-dimensional shape(s) or colors, or any combination thereof, where the said character(s), figure(s), sign(s) or three-dimensional shape(s) or colors in connection with the said trademark change;
- (ii) consists of three-dimensional shape(s) (including the combination with any character(s), figure(s), sign(s) or three-dimensional shape(s) or colors, or any combination thereof) (excluding those listed in the preceding item);
- (iii) consists solely of colors (excluding those listed in item (i));
- (iv) consists solely of sounds; or
- (v) in addition to those listed in each of the preceding items, trademarks provided by Cabinet Order of the Ministry of Economy, Trade and Industry.

(3) Where a person desires to register a trademark consisting solely of characters designated by the Commissioner of the Patent Office (hereinafter referred to as "standard characters"), the application shall contain a statement indicating thereof.

(4) Where a person desires to register any trademark provided by Cabinet Order of the Ministry of Economy, Trade and Industry, the application shall state the detailed description of the trademark in the application pursuant to Ordinance of the Ministry of Economy, Trade and Industry, or affix materials provided by Ordinance of the Ministry of Economy, Trade and Industry to the application.

(5) The statement and materials in the preceding paragraph shall specify the trademark for which a registration is sought.

(6) Where a portion of the trademark for which a registration is sought is in the same color as that of the column in which a trademark for which a registration is sought is required to be stated, the said portion of the trademark shall be deemed not to be a part of the trademark;

provided, however, that this shall not apply to an area specified and identified as an area to be colored in the same color as that of the column.

#### Regulation for Enforcement of the Trademark Act

Article 4-7 The trademarks provided by Order of the Ministry of Economy, Trade and Industry as referred to in Article 5(2)(v) of the Trademark Act (including the case where applied *mutatis mutandis* pursuant to Article 68(1) of that Act) are position marks.

Article 4-8 (1) The trademarks provided by Order of the Ministry of Economy, Trade and Industry as referred to in Article 5(4) of the Trademark Act (including the case where applied *mutatis mutandis* pursuant to Article 68(1) of that Act; the same applies hereinafter) are as follows.

- (i) motion marks;
- (ii) hologram marks;
- (iii) color marks;
- (iv) sound marks; and
- (v) position marks

(2) The statement or affixing as referred to in Article 5(4) of the Trademark Act is to be made pursuant to the provisions of the following items according to the classification set forth in the respective item:

- (i) motion marks: statements of the detailed description of the trademark;
- (ii) hologram marks: statements of the detailed description of the trademark;
- (iii) color marks: statements of the detailed description of the trademark;
- (iv) sound marks: statements of the detailed description of the trademark (limited to the case where it is necessary to specify the trademark for which trademark registration is sought) and affixing of the materials provided by Order of the Ministry of Economy, Trade and Industry; and
- (v) position marks: statements of the detailed description of the trademark.

#### 1. Regarding the "required documents"

The "required documents" as referred to in Article 5(1) are, for example, the following documents. All of the documents are not required to be submitted in every application but ought to be submitted when necessary.



(Example)

- (a) A document concerning the use or intention of use of a trademark;
- (b) A document describing the relevant portion in the case of coloring the portion in the same color as that of the column in which the trademark for which a registration is sought is required to be stated;
- (c) A document describing the material, method of production, structure, method of use, intended purpose, etc. of the designated goods or the quality, efficacy, intended purpose, etc. of the designated services; and
- (d) A document describing the three-dimensional trademark stated in the written application.

(Note) For a motion, hologram, color, sound or position mark, what is stated in the detailed description of the trademark provided for in Article 5(4) (hereinafter referred to as the "detailed description of the trademark") need not be duplicated and submitted in a "required document" provided for in this paragraph.

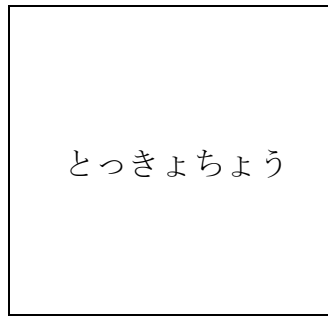
2. In cases where the written application contains no statement to the effect that it has been filed for a trademark prescribed in the items of Article 5(2), such application is treated as a normal application.

### 3. Regarding "standard characters"

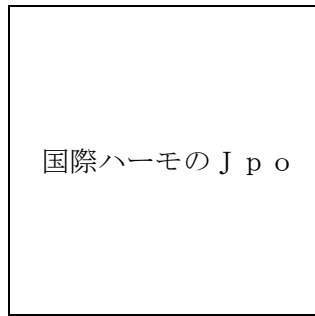
(1) A trademark with respect to which an application is recognized as that for a trademark composed of standard characters is considered as written with standard characters instead of being stated in the written application.

(2) A trademark for which an application is filed with a description stating that the trademark is composed of standard characters is treated as a normal trademark application in the case where the trademark is not recognized to be composed of standard characters from its composition described in the written application.

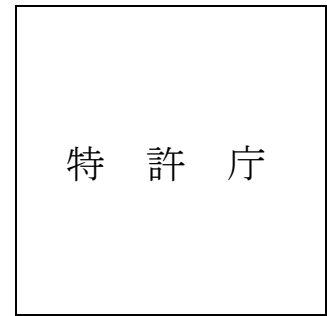
(a) Examples of descriptions of trademarks recognized to be composed of standard characters



Characters are different in size but characters representing geminated consonants and contracted sounds are the same in the number of points.



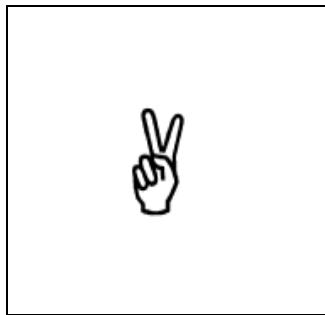
Chinese characters, kana, alphabetic characters, etc. can be used in combination. The capital letter and small letters are the same in the number of points.



Multiple spaces can be used unless continuously repeated.

(b) Examples of descriptions of trademarks not recognized to be composed of standard characters

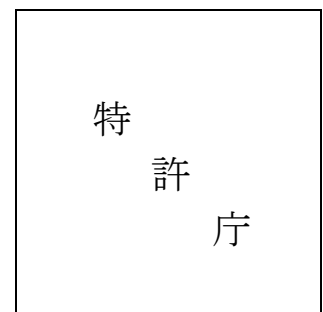
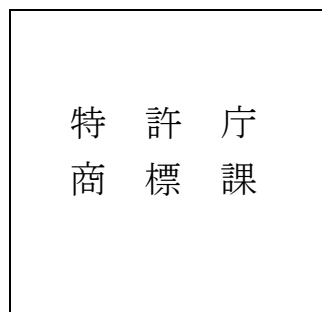
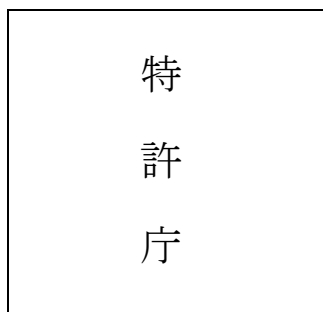
(i) Trademarks consisting solely of a figure and a figure and characters combined;



(ii) Trademarks including characters other than designated characters;

(iii) Trademarks exceeding the wordage limit of 30 characters (counting in spaces);

(iv) Vertically-written trademarks and trademarks composed of more than one row of characters

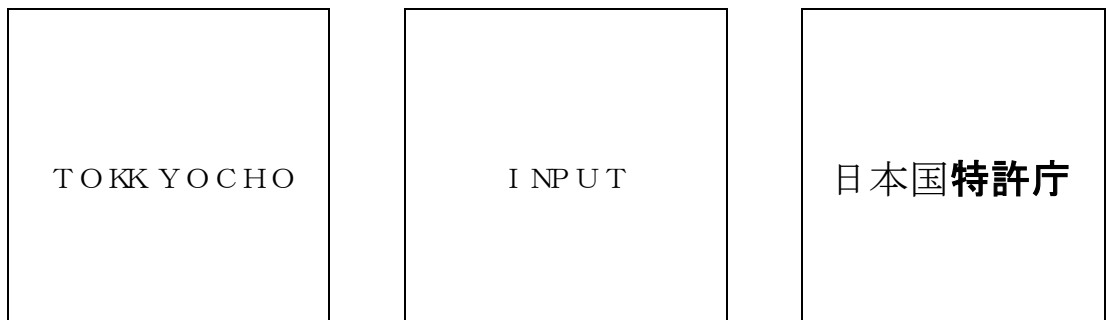


(v) Trademarks including characters different in the number of points;

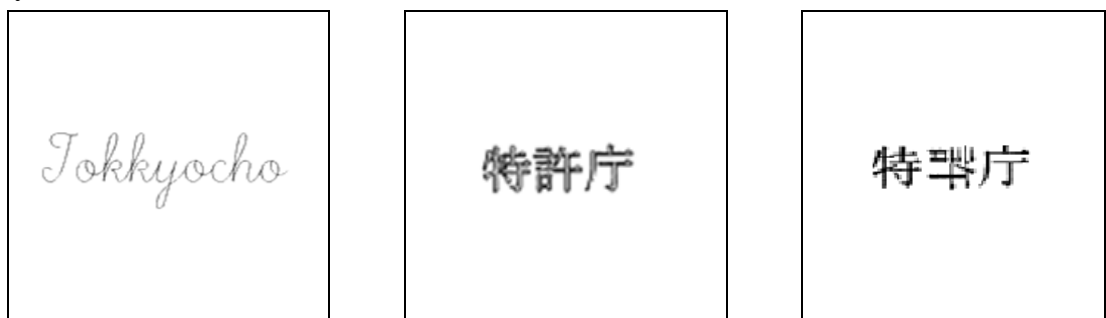


(vi) Colored trademarks;

(vii) Trademarks having a figure as their part or composed of characters written in different fonts;



(viii) Trademarks composed of ornate letters or characters written in the sosho (hand-written) or other special styles;



(ix) Trademarks composed of characters other than those listed in (i) to (viii) above, which can hardly be specified

#### 4. Regarding the "detailed description of the trademark" and "materials"

In order to verify whether a detailed description of the trademark and materials provided for by the Order of the Ministry of Economy, Trade and Industry (hereinafter referred to as the "materials") can specify a trademark for which registration is sought, it is judged whether the detailed description of the trademark or the structure and mode of a trademark of the materials is identical with the trademark which is stated in the column where a trademark whose registration is sought as either of the motion, hologram, color, sound or position mark is stated (hereinafter referred to as the "trademark stated in an application").

If they are identical with each other, the detailed description of the trademark or the materials is regarded as specifying the trademark.

Even if they are not identical with each other, it is judged whether the detailed description of the trademark or the materials is covered by the structure and mode stated in the application, and if the detailed description of the trademark or the article is covered by the structure and mode, the detailed description of the trademark or the materials is regarded as specifying the trademark.

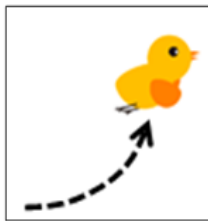
#### (1) Motion marks

##### (a) Example regarded as specifying a motion mark

A specific and clear statement is provided to explain a mark constituting a motion mark and how the mark changes its state as time passes (the sequence of its change, the time required for the whole change, etc.).

(Example 1) Example where a single figure is used to state a trademark (example where the mark moves without any change)

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

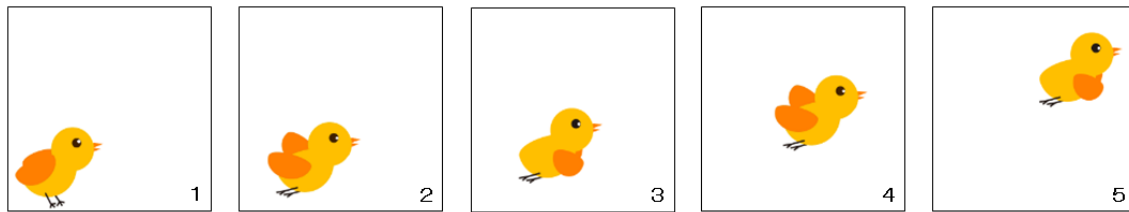
A trademark for which registration is sought (hereinafter referred to as the "trademark") is a motion mark.

The mark shows a bird gradually moving to the upper right from the lower left in accordance with the trajectory in dotted lines. This motion mark lasts for 3 seconds in total.

The arrow in the dotted lines is used for convenience to show the trajectory along which the bird moves and does not constitute the trademark.

(Example 2) Example where multiple figures are used to state a trademark

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a motion mark.

This mark shows a bird gradually moving to the upper right by flapping its wings from figure 1 to 5. This motion mark lasts for 3 seconds in total.

Numbers at the lower right of each figure are provisionally provided to show the sequence of the pictures, and do not constitute a part of the trademark.

(b) Example not regarded as specifying a motion mark

(i) A trademark stated in an application is not identical with a mark stated in a detailed description of the trademark (including a case when a mark is not stated in the trademark stated in the application, but it is stated in a "detailed description of the trademark" column, and one when a mark is stated in an application, but it is not stated in a "detailed description of the trademark" column).

(ii) When the state of changes of a trademark stated in an application is not identical with the state of changes of a mark stated in a detailed description of the trademark; for, example, their sequences of change.

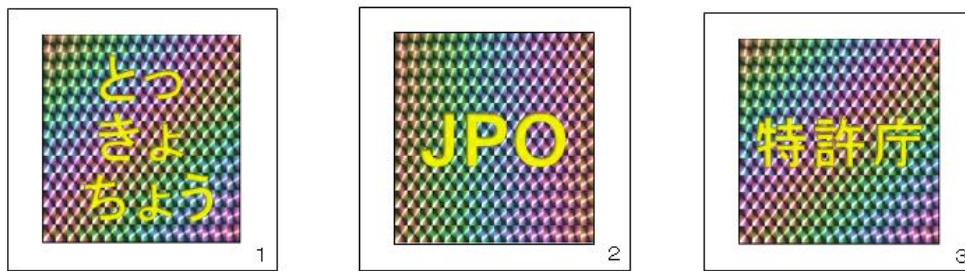
(2) Hologram marks

(a) Example regarded as specifying a hologram mark

A specific and clear statement is provided to explain a mark which constitutes a hologram mark and changes caused by visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with different viewing angles; hereinafter referred to as "visual effects").

(Example)

[Trademark for Which Registration Is Sought]



[Hologram Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a hologram mark which displays different contents depending on viewing angles. Its displays seen from the left, the front and the right are shown in Figures 1, 2 and 3, respectively.

Numbers shown at the lower left are provisionally provided to indicate the sequence of the figures, and do not constitute a part of the trademark.

(b) Example not regarded as specifying a motion mark

- (i) A trademark stated in an application is not identical with a mark stated in a "detailed description of the trademark" column (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the "detailed description of the trademark" column, and one when a mark is stated in an application, but it is not stated in the "detailed description of the trademark" column).
- (ii) The visual effects of a trademark stated in an application are not identical with those of a mark stated in the "detailed description of the trademark" column.

(3) Color marks

(a) Example regarded as specifying a color mark

A specific and clear statement is provided to explain color names, the combination ratio of the three primary colors (RGB), a number used to refer to a color sample book, how to combine colors (positions to which individual colors are paced and their ratios when the colors are combined), and other conditions to specify the colors constituting a color mark.

(Example 1) Single color

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought is one which consists of only red (RGB combination: R255, G0, B0).

(Example 2) Combination of colors

[Trademark for Which Registration Is Sought]



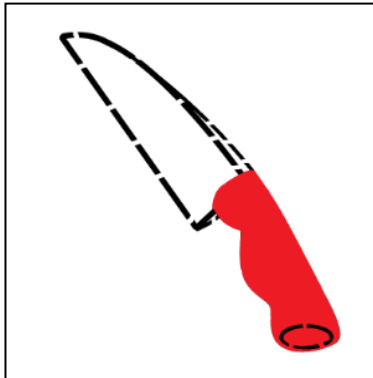
[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is one which consists of only combination of colors. The types of combination are red (RGB combination: R255, G0, B0), blue (RGB combination: R0, G0, B255), yellow (RGB combination: R255, G255, B0), and green (RGB combination: R255, G128, B0), and the percentage values of these colors from the first to the last are 50% for red, 25% for blue, 15% for yellow and 10% for green.

(Example 3) Trademark which specifies specific positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark whose configuration is such that a kitchen knife's handle is colored in red (RGB combination: R255, G0 and B0).

It must be noted that dotted lines resembling a kitchen knife and a handle of the kitchen knife shown are for explanation purposes only, and do not constitute a part of the trademark.

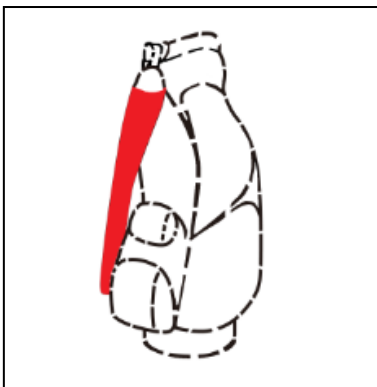
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 4) Trademark which identifies positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark whose configuration is such that a golf club bag's belt is colored in red (RGB



combination: R255, G0 and B0).

It must be noted that the dotted lines resembling a golf club bag are only for purposes to explain how a golf club bag might look like, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

(b) Example not regarded as specifying a color mark

(i) A trademark stated in an application is not identical with a mark stated in the detailed description of the trademark (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the detailed description of the trademark, and one where a mark is stated in the application, but it is not stated in the detailed description of the trademark).

(ii) When color combinations are to be specified, the positions of colors, their ratios and other conditions of a trademark stated in the application are not identical with those of a mark stated in the detailed description of the trademark.

(iii) When positions to which colors are to be placed are specified, the positions to which colors are to be placed of a trademark stated in the application are not identical with those of a mark stated in the detailed description of the trademark.

(4) Sound marks

For a sound mark, if a matter is not stated in a trademark stated in an application (for example, the sound tones of an instrument played and the range of voice, etc., excluding lyrics and other linguistic elements), materials and the detailed description of the trademark (limited to the case where it is necessary to specify the trademark for which registration is sought) are used to identify the matter.

(a) Sound mark stated in a staff notation

(i) Example regarded as specifying a sound mark

[a] A piano is depicted in a trademark stated in an application as the musical instrument, and its material is a sound file recording sounds which seem to be generated by a piano.

[b] No musical instrument is depicted in a trademark stated in an application, but its materials are a sound file recording sounds which seem to be generated by a piano.

(ii) Example not regarded as specifying a sound mark

[a] A piano is depicted in a trademark stated in an application, and its material is a sound file

recording sounds which seem to be generated by a guitar.

[b] No instrument is depicted in a trademark stated in an application, but its material is a sound file recording sounds which seem to be generated by a guitar while its detailed description of the trademark states that the trademark is generated by a violin.

(b) Sound mark stated by characters (natural sounds, etc.)

(i) Example regarded as specifying a sound mark

A trademark stated in an application is a statement that "this trademark is structured such that a cat's meow call is heard after two clapping sounds are heard, and it lasts for 3 seconds," and its material is a sound file generating 2 clapping and then one meow sounds and lasts for 3 seconds.

(ii) Example not regarded as specifying a sound mark

A trademark stated in an application is the same as that in (i) above, but its material is a sound file generating 2 clapping sounds and lasts for 2 seconds.

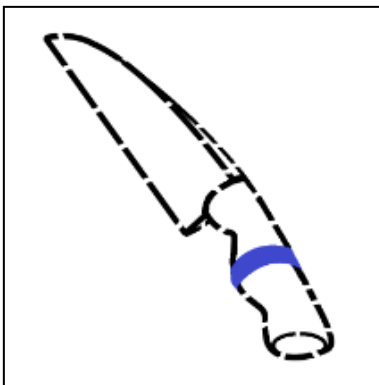
(5) Position marks

(a) Example regarded as specifying a position mark

A specific and clear statement is provided to explain a mark constituting a position mark and the position of its goods, etc. to which the mark is placed (the name, shape, characteristics and other information of a part).

(Example 1)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter, referred to as the "trademark") is a position mark wherein the position to which the trademark is to be attached is identified and which consists of a figure attached to the periphery of the central part of a kitchen knife's handle.

It must be noted that the dotted lines are only provided to show an example of the trademark's goods, and do not constitute a part of the trademark.

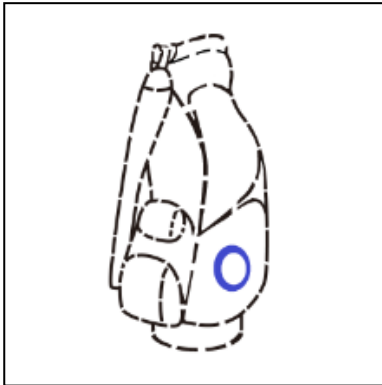
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 2)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark wherein the position to which the trademark is to be attached is identified and which consists of a figure attached to the lower part of the lateral side of the golf club bag's belt.

It must be noted that the dotted lines are only provided to show an example of the trademark's goods, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

(b) Example not regarded as specifying a position mark

(i) A trademark stated in the application is not identical with a mark stated in the detailed description of the trademark (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the detailed description of the trademark, and one where a mark is stated in the application, but it is not stated in the detailed description of the trademark).

(ii) What is stated in the application as the position to which a trademark is attached is not identical with what is stated in its detailed description of the trademark.

5. Treatment of a declaration to the effect that the characters are "standard characters" in relation to the international application for trademark registration

Though the characters are declared to be "standard characters" in relation to the international application for trademark registration, the characters will not fall under the standard characters as stated in Article 5(3).

6. Treatment of the statements of the type of trademarks in an international application for trademark registration

Whether a trademark for which an international application for trademark registration is filed is either a "motion mark," "hologram mark," "three-dimensional trademark," "color mark," "sound mark" or "position mark" is judged as follows in principle.

(1) If the statement "Indication relating to the nature or kind of marks" is stated in territorial extension which designates Japan (hereinafter referred to as a "designation notification"), it is judged in principle as follows based on what is stated there.

(i) If a statement "three-dimensional mark" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "three-dimensional trademark."

(ii) If a statement "mark consisting exclusively of one or several colors" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "color mark."

(iii) If a statement "sound mark" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "sound mark."

(2) Depending on what is stated in the column "Description of the mark" of the designation notification, it is judged as follows in principle.

(i) If a statement "moving," etc. is written in the column "Description of the mark," the trademark is judged as a "motion mark."

(ii) If a statement "hologram," etc. is written in the column "Description of the mark," the trademark is judged as a "hologram mark."

(iii) If a statement "positioning of the mark," "position mark" or other relevant statement is written in the column "Description of the mark," the trademark is judged as a "position mark."

(3) If there is no description as specified in (1) above, or if it is not possible to make a judgment

based on what is written in accordance with (2) above, judgment is to be made based on what is stated in the trademark for which registration is sought.

For example, if a staff notation is stated in a column where a trademark for which registration is sought must be stated, but if a statement "sound mark" is not written in the statement "Indication relating to the nature or kind of marks" and statements such as "moving," "hologram," "positioning of the mark" or "position mark" are not stated in the column "Description of the mark," then it is treated as a figure trademark where the staff notation is the trademark for which registration is sought.

#### 7. Treatment of the column "Detailed description of the trademark" in an international application for trademark registration

For a trademark for which an international application for trademark registration is filed, the detailed description of the trademark for which registration is sought is to be as follows.

(1) For a "color mark," entries to the columns "Colours claimed" and "Description of the mark" in its designation notification will be the detailed description of the trademark.

(2) For a "sound mark," "motion mark," "hologram mark" or "position mark," an entry to the column "Description of the mark" in its designation notification will be the detailed description of the trademark.

#### 8. Treatment of "materials" in an international application for trademark registration

For a trademark for which an international application for trademark registration is filed, because no procedure exists to attach its material to the International Register, the material is not attached when its territorial extension designates Japan. Therefore, Article 5(5) is applied so that the submission of the article will be facilitated.

Part V: Article 6 (Single trademark on each application)

Article 6 (1) An application for trademark registration shall be filed for each trademark and designate one or more goods or services in connection with which the trademark is to be used.

(2) The designation provided for in the preceding paragraph shall be made in accordance with the class of goods and services provided by Cabinet Order.

(3) The class of goods and services provided for in the preceding paragraph shall not be perceived as prescribing the scope of similarities of goods or services.

1. Regarding the single application on each trademark rule

Single application for trademark registration "shall be filed for each trademark" and thus when an application is found to have been filed for multiple marks, such application does not satisfy the requirements set forth in Article 6(1).

2. Case where the trademark does not satisfy the requirements set forth in Article 6(1)

(1) The description of designated goods or designated services needs to be so made that the content and scope of goods or services may be clearly grasped as, for example, indicated in the appended table of the Ministerial Order (Article 6 of the Regulation for Enforcement the Trademark Act) and the Examination Guidelines for Similar Goods and Services. Where the descriptions of the designated goods and services are not clear, a reason of refusal will be notified for not satisfying the requirements under Article 6(1).

(Example) Class 29 "Meat and other goods contained in this class"

Class 39 "Transport by freight cars and other services contained in this class"

(2) In the case where the indication of designated goods or designated services includes a registered trademark indicating specific goods or services, a reason for refusal will be notified for not satisfying the requirements under Article 6(1).

3. Case where the application does not satisfy the requirements under Article 6(2)

Where the descriptions of the designated goods and designated are is clear, but may be judged not to be conforming to the classifications of the goods and services provided in the Cabinet Order (Article 2 of the Order for Enforcement of the Trademark Act), a reason of refusal will be notified for not satisfying the requirements under Article 6(2).

(Example)

Class 9 "Clocks"

This may be amended as: "Class 14 Clocks"

Class 36 "Employment agencies"

This may be amended as: "Class 35 Employment agencies"

(Example)

Class 16 "Magazines, Advertising agency through magazines"

This may be amended as: Class 16 "Magazines," Class 35" Advertising agency through magazines"

#### 4. Case where the application does not satisfy the requirements under Article 6(1) and (2)

When the description of the designated goods and designated services is not clear and the classification of the goods and services does not conform to that specified by the Cabinet Orders, a reason for refusal will be notified for not satisfying the requirements under Article 6(1) and (2).

(Example 1)

Indications of designated goods and designated services as follows where the goods or services may be allotted to more than one class

Class 5 "Sanitary masks and goods similar thereto"

Class 40 "Treatment for hazardous substances and related services"

(Explanation) Indications of "other similar goods" and "related services" could belong to multiple classes and thus are unclear.

Class 7 Machinery and appliances

(Explanation) The indication of "machinery and appliances" could, for example, be recognized as referring to Class 10 "Medical machines and apparatus" or Class 11 "Freezing machines and apparatus" and thus is unclear.

Class 37 "Lease for machinery and appliances"

(Explanation) The indication of "lease for machinery and appliances" could, for example, be recognized as referring to Class 39 "Rental of packing or wrapping machines and apparatus" or Class 40 "Rental of chemical processing machines and apparatus" and thus is unclear.

(Example 2)

Goods and services designated as r "store" (the name of facility).

Class 25 "Department store"

Class 42 "General rental business"

(Example 3) Goods and services designated using the indications shown in the attached table of the Cabinet Order.

Class 12 "Vehicles and other apparatus for locomotion"

Class 32 "Non-alcoholic beverages and beer"

However, cases where the contents and scope of the goods or services or the classification of goods or services is clear, for example where the indication of the designated goods or designated services shown in the attached tables of the Cabinet Order and that of the Ministry Ordinance are identical, will be excluded.

#### 5. Regarding the order for amendment

Where, in response to the notice of reasons for refusal mentioned in the above Items 2(1) and 4, the applicant submits a written opinion or written submission of materials in which the contents include only the explanation of the designated goods or designated services, the examiner will, in consideration of the submitted written opinion or written submission of materials, order the applicant to make amendments to the designated goods or designated services by suggesting a draft amendment (order concerning amendment by the examiner).

When the applicant does not make any correspondence to the order concerning amendment, or when adequate amendments are not made, the application for trademark registration will be refused according to the earlier reasons for refusal.

#### 6. Regarding retail services

Retail service (provision of benefits for customers conducted in the course of retail or wholesale business) is considered as follows.

(1) Retail services means comprehensive service activities conducted in the business of retail or wholesale (activities that will result in making profits by sales of the products, such as the bringing together of a variety of goods, set out, service to customers).

(2) Retail services do not include retailers' sales of products to customers nor wholesalers' sales of products to retailers



Part VI: Article 7 (Collective trademarks)

Article 7 (1) A general incorporated association or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto shall be entitled to obtain a collective trademark registration with respect to a trademark to be used by their members.

(2) For the purpose of the application of Article 3 (1), in the case of the preceding paragraph, "applicant" in the said paragraph shall read "applicant or its members."

(3) Any person who desires to register a collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1).

1. Regarding the subjects

The phrase "any other association (except those which are not juridical personalities and enterprises)" in Article 7(1) includes, for example, chambers of commerce and industry based on the Chambers of Commerce and Industry Act, commerce and industry associations based on the Commerce and Industry Association Act, and specified nonprofit organizations based on the Act on Promotion Specified Non-profit Activities (i.e. incorporated nonprofit organizations), etc.

2. Regarding the expression "trademark to be used by the members"

In case where a trademark seeking a registration as a collective trademark is not intended for use by "members," its registration cannot be granted under the provision of the main paragraph of Article 3(1) (Refer to Part I, Chapter 2, Item 5 (main paragraph of Article 3(1)) of the Guidelines.).

3. Regarding the expression "a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1)"

(1) Invitations to amend (formality) are applicable to applications for trademark registration (domestic application) for collective marks when "a document certifying that the applicant for

trademark registration is a juridical person that falls under paragraph (1)" is not submitted.

(2) In cases where a "collective mark, certification mark, or guarantee mark" is indicated in the international application for trademark registration but "a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1)" has not been submitted, the trademark cannot be registered as a collective trademark pursuant to the main paragraph of Article 3(1) (refer to Part I, Chapter 2, Item 4(2) (main paragraph of Article 3(1)) of the Guidelines).

Part VII: Article 7-2 (Regionally collective trademarks)

Chapter 1: Main Paragraph of Article 7-2 (1)

Article 7-2 (1) Any association established by a special Act, including a business cooperative (those which do not have juridical personality are excluded, and limited to those which are established by a special Act providing, without a just cause, that the association shall not refuse the enrollment of any person who is eligible to become a member or that the association shall not impose on any of its prospective members any condition that is heavier than those imposed on its existing members), a commercial transaction, commercial and industrial association or specified non-profit corporation specified in Article 2 (2) of Act on Promotion of Specified Non-profit Activities (Act No. 7 of 1998), or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regional collective trademark registration with respect of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):

1. Requirements for subject

(1) In the case of associations established by a special Act, including a business cooperative (hereinafter referred to as "a business cooperative, etc.")

The following matters described in (i) and (ii) below will be confirmed:

(i) In any document issued by a public organization, including a certificate of registered matters submitted as of filing an application (hereinafter referred to as a "certificate of registered matters", etc.), the applicant is an association which has juridical personality.

(ii) The corresponding Article of a basis law for the establishment described in a copy of the basis law for the establishment or a written application, which are submitted as of filing the application, has a "provision regulating, without a just cause, that the association will not refuse the enrollment of any person who is eligible to become a member or that the association will not impose on any of its prospective members any condition that is heavier than those imposed on its existing members" (hereinafter referred to as a "provision of free enrollment").

(Example)

Small and Medium-Sized Enterprise Cooperatives Act Article 14

Agricultural Cooperatives Act Article 20

Act on Securing of Liquor Tax and on Liquor Business Associations Article 10

(2) In the case of a commerce and industry association, a chamber of commerce and industry (hereinafter collectively referred to as the "commerce and industry association, etc.") or a specified non-profit activities corporation

By the certificate of registered matters, etc. submitted as of filing an application, it is confirmed that the applicant is a commerce and industry association established under the Commerce and Industry Association Act, or a chamber of commerce and industry established by the Chambers of Commerce and Industry Act, or a specified non-profit corporation provided in Paragraph 2, Article 2 of the Act on Promotion of Specified Non-profit Activities.

(3) In the case of a foreign juridical person equivalent to a business cooperative, etc., a commerce and industry association, etc., or a specified non-profit corporation

(a) Regarding a foreign juridical person equivalent to a business cooperative, etc., the following matters described in (i) to (iii) below are confirmed:

(i) In the corresponding article of the basis law for the establishment described in the copy of the basis law for the establishment or the written application, submitted as of filing an application (it is possible to substitute the article with other documents specified by public organizations, including a statute, a notification, and a judicial precedent; hereinafter referred to as "the copy of the basis law for the establishment, etc."), there must be a provision aiming at improvement of member's common profits.

When the copy of the basis law for the establishment, etc. does not exist in terms of the system of an interested state, the applicant is demanded to submit the articles of association (the fundamental rules concerning the purpose, the internal constitution, and the activities, etc. of the juridical person; the same applies hereinafter) which fulfil the abovementioned requirements.

(ii) There is a provision of free enrollment in the copy of the basis law for the establishment, etc.;

(iii) In a document (for example: corporation certificate, etc.) in which a public organization proved that the applicant is a juridical person, the applicant must have juridical personality;

(b) Regarding a foreign juridical person equivalent to a commerce and industry association, etc., the following matters described in (i) to (iii) below are confirmed:

(i) In the copy of the basis law for the establishment, etc., there is a provision aiming at improvement and development of commerce and industry and not aiming at profit.

When the copy of the basis law for the establishment, etc. does not exist in terms of the system of an interested state, the applicant is demanded to submit the articles of association which fulfils the abovementioned requirements.

(ii) In a document (for example: corporation certificate, etc.) in which a public organization proved that the applicant is a corporation, the applicant needs to have juridical personality.

(iii) There is a provision of free enrollment in the copy of the basis law for the establishment, etc.

(c) Regarding a foreign juridical person equivalent to a specified non-profit corporation, the following matters described in (i) to (iii) below are confirmed:

(i) In the copy of basis law for the establishment, etc., there is a provision not aiming at profit and intending to conduct an activity corresponding to any of the activities listed in the items of appended table, Article 2 of the Act on Promotion of Specified Non-profit Activities with an aim to contribute to the improvement of benefits for the general public.

When the copy of the basis law for the establishment, etc. does not exist in terms of the system of an interested state, the applicant is demanded to submit the articles of association which fulfil the abovementioned requirements.

(ii) In a document (for example: corporation certificate, etc.) in which a public organization proved that the applicant is a corporation, the applicant needs to have juridical personality.

(iii) There is a provision of free enrollment in the copy, etc. of the basis law for the establishment.

## 2. Regarding the expression "Trademark used by its members"

When, like a case where the applicant is an association (for example, a consumer cooperative, a ship owner's mutual protection and indemnity association, and an agricultural mutual relief association), thereby, it is assumed that the trademark is not used by the members of the association, it is clear that the trademark claimed in the application concerned is not used by the members, the trademark for which a regional collective trademark registration is sought is treated as not being a "trademark used by its members".

3. An ex officio investigation will be conducted to determine whether the statement "well known among consumers as indicating goods or services pertaining to its or its members' business" is relevant to the trademark in question. However, if a "document certifying that the trademark is well known among consumers as one provided for in Article 7-2(1)" as provided for in Note 4 of Form 3-2 of the Regulation for Enforcement of the Trademark Act is submitted, the document is also referred to in order to verify the following matters described in 4. to 9. below.

#### 4. Indenticalness of trademarks

It is required that a trademark for which registration is sought (hereinafter referred to as a "trademark as applied") and a trademark actually used (hereinafter referred to as a "trademark as used") have appearances identical with each other (including a case where their identity is not affected very much so that their appearances can be regarded as the same).

Even if the appearance of a trademark as applied is different from that of a trademark as used, it is judged that their identity is not affected very much so that their appearances can be regarded as the same if their difference is limited to those shown in (1) or (2) below.

##### (1) Mincho and Gothic Types

When font type difference such as one between cursive and square types is judged, how much characters are deformed must be considered well.

##### (2) Vertical and Horizontal Writing

On the other hand, appearances of examples shown in (3) below are significantly different from each other, and they are not judged as identical with each other.

##### (3) (i) Marks written in hiragana and katakana

(ii) Marks written in hiragana and Chinese characters

(iii) Marks written in katakana and Chinese characters

5. The matters described in (1) and (2) below will be examined to judge whether a trademark is "indicating goods or services pertaining to its or its members' business."

##### (1) When a trademark indicates goods or services pertaining to its (an applicant's) business

For example, an applicant's title, a trademark as applied, and goods or services for which the trademark is used are described in photos of the goods or their packages (such as delivery cardboard boxes), advertising brochures, and other materials.

##### (2) When a trademark indicates goods or services pertaining to its member's business

(i) For example, a member's name or title, a trademark as applied, and goods or services for which the trademark is used are described in photos of the goods or their packages (such as delivery cardboard boxes), advertising brochures, and other materials.

(ii) A person or entity using the trademark as applied is its member.

6. Regarding the expression "well known among consumers"

(1) It depends on the types of goods or services, classes of consumers, actual state of transactions and other factors and a trademark is not required to be known by consumers all over Japan.

However, for example, a trademark is required to be well known among a certain class of consumers that fall under the following categories (a) to (d) below classified in accordance with types of goods or services, distribution channels and other factors.

Please be reminded that for "beef cattle," "stones" and other goods or services whose main consumers are traders, consumers include not only end users but also traders.

(a) Goods which can be sold in relatively wide regions because their prices are relatively low and they are consumed on a daily basis.

(Example) Vegetables, rice, meat, seafood and processed food whose prices are relatively low and which are consumed on a daily basis.

Wide range of consumers may purchase these goods. It suffices if such goods are known by many consumers in regions wider than prefectures to which the regions provided for in Article 7-2(2) (hereinafter referred to as "regions") belong.

In addition, if the national government, a local government or a public organization selected the goods for awards as quality merchandise, such a fact is taken into account accordingly.

If a special state of transactions exists for goods or services, i.e. goods whose production volumes are small such as vegetables and fruits whose trade prices in markets are high, the matters described in (b) and (c) below will be confirmed.

(b) Goods which are not sold at places of their production but are mainly sold out in their major consuming regions because of their high prices and other reasons

(Example) High-quality fish merchandises, etc.

If regions where goods or services in question are sold seem to be limited, or for example, if the distribution of their major consumers is limited to major consuming regions and other large cities, the goods must be known at least by many consumers in prefectures to which places where they are sold belong.

In addition, due consideration must be paid especially to how they are introduced by advertisements or media in major consuming regions, how advertisements and introductory articles are written in trade journals, professional journals or other media.

(c) Goods which are mainly produced for local consumption and only sold in places where they are produced, or services which are provided in their limited places

(Example) Traditional vegetables, Japanese cake whose durable life is short, etc.

Because the distribution of customers who purchase such goods is assumed to be limited to a certain area, it is required that such goods or services are well known among many consumers at least in a prefecture to which their region belong.

In addition, with respect to the place where goods are produced or sold, or services are provided, due consideration is to be paid to what are advertisement effects by sightseeing brochures, sightseeing maps and other materials distributed to sightseers visiting the place of the goods or services, the number of visitors to the place, the result of a questionnaire survey conducted among visitors to the place and other relevant factors.

(d) Artifacts and other goods

(Example) Because the distribution of customers who purchase drawers, jars or other goods produced in a specific region is assumed to be limited to a certain area, it is required that such goods are well known among many consumers at least in a prefecture to which their region belong.

In addition, if the Minister of Economy, Trade and Industry designated such goods as traditional artifacts, such facts will be taken into account accordingly.

For dishes, chopsticks and other goods which are used routinely, (a) above will be confirmed because their main customers are general consumers.

(2) Goods or services whose advertisements, sales and other activities are conducted through TV broadcasting, newspapers, the Internet and other media

(Example) Goods whose sales activities are conducted through home shopping programs

(i) If TV broadcasting programs and other mass media are used for the large-scale advertisements and sales of goods or services, their customers are assumed to be distributed in a wide area, and thus the goods or services must be well known among the considerable number of consumers in multiple prefectures, including those in local areas, or places where the goods are sold or the services are provided.

Especially, due consideration is to be paid to the state of advertisements or introductory programs of goods or services through TV broadcasting, websites and other mass media, their sales ranking, purchasers and sales qualities cited on websites, the types of websites (famous shopping sites, applicants' website, etc.) and other relevant facts.

(ii) If sales and other activities are conducted through TV broadcasting and other mass media for goods or services classified to either one of types listed in (1) above, judgment is made based on



whether they are well known among many customers of such types, or whether they are well known among the considerable number of consumers in multiple prefectures, including those in local areas, or places where the goods are sold or the services are provided.

7. How to prove and judge goods or services are "well known among consumers"

To verify conditions (1) to (4) below, materials submitted and other relevant information as indicated for respective conditions below are examined.

(1) Usage facts

Photos, brochures, websites' copies and other materials showing a trademark as applied is used to its goods, the goods' packages (such as delivery cardboard boxes) or its services

(2) Scale of business (production volume, sales area, quantity transferred, sales amount, period of use, etc.)

(i) Order slips (purchase orders), shipping slips, delivery slips (delivery notes and vouchers), bills, receipts, invoices or account books, etc. on which sales quantities and other information are written

(ii) Certificates and other official documents on which production volumes are written and which are issued by public organizations (such as the national government, local governments, foreign embassies in Japan, etc.) and other third parties

(3) The method of advertisements, contents and times of advertisements, and contents and times of articles published in general newspapers, trade journals, magazines or websites

(i) Copies of brochures, posters and websites, and copies of sightseeing brochures and sightseeing maps on which advertisement contents are written

(ii) Trade documents, certificates, etc. which are concluded with advertising agencies and on which volumes, frequencies, etc. of advertisements (where and how many brochures are distributed, and how long advertisements are cited on websites) are written

(iii) Introductory articles published in general newspapers, trade journals, magazines, PR brochures published by local governments or on websites

(4) Other facts

(i) Reports about the results of questionnaire surveys conducted among consumers to investigate how popular a trademark is to consumers

However, due consideration must be paid to the objectivity of who conducted the surveys, how the surveys were conducted and among whom the surveys were conducted

(ii) Facts that goods were certified or awarded as quality merchandise by the national government, local governments or other public organizations

8. A trademark which is used by a person other than its applicant and member

If there exists a person other than a trademark's applicant and member who uses the trademark, and if it cannot be judged that the trademark as applied is well known among consumers due to its use only by the applicant or member, it cannot be judged that the trademark is well known among consumers as indicating goods or services pertaining to the applicant's or member's business.

9. If none of the items of Article 7-2(1) is applicable to a trademark because a name of a region constituting a part of the trademark as applied does not fall under the "name of the region" provided for in Article 7-2(2), the trademark is not registered pursuant to the provisions of the main paragraph of this Article.

Chapter 2: Article 7-2(1)(i),(ii) and(iii) (Registerable trademark)

- (i) A trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members;
- (ii) A trademark consisting solely of characters indicating, in a common manner, the name of the region and the name customarily used as a name indicating the goods or services pertaining to the business of the applicant or its members; or
- (iii) A trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members or the name customarily used as a name indicating thereof, and characters customarily added in indicating, in a common manner, the place of origin of the goods or the location of provision of the services.

1. Regarding "the name of the region"

Refer to Part VII, Chapter 3, Items 1 to 4 of the Guidelines (Article 7-2(2), (3) and (4)) for "the name of the region"

"The name of the region" includes not only geographical names for units of area under current administration, but also the geographical names such as former geographical names, former country names, names of rivers, names of mountains, names of sea areas, etc..

2. Part I, Chapter 3, Item 1 (Article 3(1)(i)) of the Guidelines apply mutatis mutandis to judgment as to the "common name" of goods or services.

3. Regarding "the name customarily used as a name indicating the goods or services"

(1) For example, the following falls under such name.

- (i) Name "織" (woven) or "紬" (spun) in respect of goods "silk fabric" or "kimono sashes"
- (ii) Name "焼" (pottery) in respect of goods "rice bowls" or "teacups"
- (iii) Name "塗" (lacquered) in respect of goods "chopsticks"
- (iv) Name "彫" (carved) in respect of goods "trays"
- (v) Name "細工" (craft work) in respect of goods "baskets" or "trunks"
- (vi) Name "豚" (pig) or "ポーク" in respect of goods "pork"
- (vii) Name "温泉" (hot spring) in respect of services "providing of hot spring facility" or "providing of temporary accommodation having hot spring facilities"

(viii) Name "中華街" (China town) in respect of services "providing Chinese cuisine"

(2) A name which comprises characters indicating the quality of goods or services and common names

When it is found that the trademark is recognized among consumers as indicating particular goods or services, such trademark is judged to fall under "the name customarily used as a name indicating the goods or services."

(Example)

"天然あゆ" (Natural sweetfish)

"完熟トマト" (Ripe tomatoes)

4. "Characters customarily added in indicating the place of origin of the goods or the location of provision of the services"

(1) For example, the following characters are determined to fall under the abovementioned characters.

(Example) Characters added in indicating the place of origin

"特産" (indigenous product), "名産" (local specialty), "名物" (specialty)

(Example) Characters added in indicating the locations of provision

"本場" (original place)

(2) Characters which are not recognized as those to be added in indicating the place of origin of the goods or the location of provision of the services are judged not fall under this item, even if they are customarily used in regard to goods or services, such as those below.

(Example)

"特選" (choice quality), "元祖" (original), "本家" (originator),  
"特級" (high quality), "高級" (high-class)

5. Marks "indicating in a common manner"

(1) Marks of which font used for indication or total composition is unique beyond the scope which is customarily used by traders are not deemed as those "indicating in a common manner" by giving due consideration to the actual state of transaction of the goods or services.

(Example 1) Marks judged as "indicating in a common manner"

Marks indicated in a font or composition commonly used by traders

(Example 2) Marks judged not as "indicating in a common manner"

Marks indicated by applying special lettering beyond the scope which is customarily

used by traders or in unique composition

(2) Methods of indicating characters

(a) The common names of goods or services indicated in Roman characters or kana characters are judged as "indicating in a common manner."

(b) The common names of goods or services indicated in Chinese characters (phonetic equivalent) which are not commonly used by traders are not judged as "indicating in a common manner."

6. Example of trademarks which are not recognized as regional collective marks

The following trademarks will not fall under the provisions of items (i) to (iii) and thus they are determined not to fall under trademarks that can be registered as regional collective marks.

(1) A trademark comprising only "the name of the region" or those not including "the name of the region"

(2) A trademark comprising only "the common name of the goods or services" or those comprising "the name customarily used as a name indicating the goods or services"

(3) A trademark including neither "the common name of the goods or services" nor "the name customarily used as a name indicating the goods or services"

(4) A trademark including characters other than those provided for in items (i) to (iii) (e.g. those falling under Item 4(2) above), signs or figures

(5) A trademark comprising characters that are designed to the extent capable of distinctiveness

Chapter 3: Article 7-2(2), (3) and (4) (Name of region)

(2) The term "name of the region" as used in the preceding paragraph means, even prior to the filing of the said application, the name of the place of origin of the goods, the location of provision of services, or the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent, for which the trademark pertaining to the said application has been used by the applicant or its members, or abbreviation thereof.

(3) For the purpose of the application of Article 3(1) (limited to the part pertaining to items (i) and (ii)) in the case of paragraph (1), the term "applicant" in that paragraph is deemed to be replaced with "applicant or its members."

(4) Any person who desires to register a regional collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is an Association, etc. and documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in paragraph (2).

1. The name of a region found to have a close relationship with the goods or services

For example, judgment will be made as follows by giving consideration to individual situations, such as the kinds of goods or services, main consumers, and actual state of transaction in addition to the use of the trademark for which the registration is sought by examining the "documents necessary to prove that the trademark for which the registration is sought contain the name of a region as provided in paragraph (2) " as prescribed in Article 7-2(4).

2. Regarding "the place of origin of the goods"

For example, the place of origin of the goods using the trademark for which registration is sought by the applicant or its member is the following regions.

(1) For agricultural products, regions where the good were produced

(2) For marine products, a region where the goods were landed or caught

(3) For craft products, a region where the main production process for the goods was carried out.

3. Regarding "the location of provision of the services"

For example, the following region is a place of provision of service using the trademark for which registration is sought by the applicant or its member.

(1) For providing hot spring facilities, a region where they have hot springs

4. Regarding "the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent"

For example, the following cases described in (1) and (2) below fall under regions that have a close relationship with the goods or services for which the applicant or its member uses the trademark subject to the application.

(1) Case of processed goods where the origin of the raw materials plays important role

A region in which the main raw materials of such processed goods were produced will fall under this case.

(Example)

(i) An origin of the raw materials "buckwheat" for "buckwheat noodles"

(ii) An origin of the raw materials "stones" for "ink stones"

(2) Case of craft products where the origin of the production method plays important role

A region in which the production method for the goods originated will fall under this case

(Example)

(i) A region in which the traditional production method originated in regard to "fabrics"

5. The facts mentioned in 2. to 4. above need to be proved by, for example, the following documents.

(1) Articles in newspapers, magazines, books, etc.

(2) A certificate issued by public organizations

(3) Leaflets, catalogs, and internal rules

(4) Business forms such as delivery slips, order forms, etc.

## Part VIII: Article 8 (Prior application)

Article 8 (1) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on different dates, only the applicant who filed the application for trademark registration on the earlier date shall be entitled to register the trademark in question. However, if the applicant who filed the application for trademark registration on the later date (hereinafter referred to as the "subsequent applicant" in this paragraph) has obtained the consent of the applicant who filed the application for trademark registration on the earlier date to register the trademark (if there is more than one applicant for trademark registration, the multiple applicants for trademark registration, hereinafter referred to as the "prior applicant" in this paragraph and paragraph (6)), and there is no likelihood of confusion between the goods and services for which the subsequent applicant uses the trademark and those for which the prior applicant uses the trademark (in case of registered trademark, the goods and services pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the application for registration), the subsequent applicant shall also be entitled to register the trademark in question.

(2) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on the same date, only one applicant who is to be determined by consultations among the applicants who filed such applications shall be entitled to register the trademark in question. However, if all applicants mutually have consented to register the trademark, and there is no likelihood of confusion between the goods and services for which the respective trademarks are used, all applicants shall be entitled to register the respective trademarks in question.

(3) Where an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial decision on an application for trademark registration becomes final and binding, such application shall, for the purposes of the application of the preceding two paragraphs, be deemed never to have been filed.

(4) In the case of the main clause of paragraph (2), the Commissioner of the Patent Office shall require the applicants for trademark registration to arrange consultations among the applicants as set forth in the main clause of the said paragraph and to report the result thereof, designating a reasonable time limit for such purpose.

(5) Where no agreement is reached in the consultations held pursuant to the main clause of



paragraph (2) or no report is submitted within the designated time limit set forth in the preceding paragraph (except in the cases specified in the proviso to paragraph (2)), only the applicant who is first in the order selected by a lottery in a fair and just manner conducted by the Commissioner of the Patent Office, shall be entitled to register the trademark in question. However, if the applicant who is subsequent in the order selected by the lottery (hereinafter referred to as the "subsequent order applicant" in this paragraph) has obtained the consent of the applicant who is prior in the order to register the trademark (if there is more than one applicant for trademark registration, the multiple applicants for trademark registration, hereinafter referred to as the "prior order applicant" in this paragraph and the next paragraph), and there is no likelihood of confusion between the goods and services for which the subsequent order applicant uses the trademark and those for which the prior order applicant uses the trademark (in case of registered trademark, the goods and services pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the registered trademark), the subsequent order applicant shall also be entitled to register the trademark in question.

(6) In the cases of the proviso to paragraph (1) or the proviso to the preceding paragraph, if the trademark of the prior applicant or the prior order applicant has been registered and the trademark right pertaining to the registered trademark has been transferred, these provisions shall apply by deeming the holder of the trademark right pertaining to the registered trademark to be the prior applicant or the prior order applicant.

1. Regarding "identical or similar trademarks which are to be used in connection with identical or similar goods or services"

Part III, Chapter 10 (Article 4(1)(xi)) of the Guidelines applies *mutatis mutandis* to the judgment on similarity under this item.

2. Consultation order under Article 8(4) (hereinafter referred to as the "consultation order") and the notice of reasons for refusal under Article 8(2) and (5)

Where more than one application for trademark registration is filed on the same date for a mutually identical or similar trademark, the consultation order and notice of the reasons of refusal provided in Article 8(2) and (5) will be given simultaneously.

However, when a written statement indicating whether an agreement has been reached or not under consultation provided for in Article 8(2) has already been submitted prior to the

abovementioned consultation order and notice of reasons for refusal being given, the following measures will be taken.

(1) When a written statement indicating that an agreement has been reached under consultation, a notice of reasons for refusal under Article 8(2) is given with respect to the application for trademark registration other than the application belonging to the single applicant specified by the consultation.

(2) When a written statement indicating that an agreement has not been reached under consultation, a notice of reasons for refusal under Article 8(5) is given to all of the applications for trademark registration.

3. Case of a written statement indicating that an agreement has been reached under consultation

When a written statement indicating that an agreement has been reached through consultation has been submitted from the applicant within the designated time ordered by the Commissioner of the Patent Office, a decision of refusal will be made under Article 8(2) with respect to other applications after the trademark is registered for the single applicant specified by the consultation.

4. Case where a written statement indicating that the consultation has failed or where either written statement indicating that an agreement has been reached or not through consultation has not been submitted.

When the applicant submits a written statement indicating that the consultation has failed or a written statement indicating that an agreement has been reached or not through such consultation within the designated time ordered by the Commissioner of the Patent Office, a lottery in a fair and just manner conducted by the Commissioner of the Patent Office as prescribed in Article 8(5) will be carried out, and after the trademark is registered for the single applicant specified by the lottery, a decision of refusal will be made under Article 8(5) with respect to other applications.

5. Case where the decision of refusal of application of "one applicant" becomes final and binding

When a decision of refusal rendered for an application of "one applicant specified by the consultation of applicants" or "one applicant specified by the lottery in a fair and just manner conducted by the Commissioner of the Patent " becomes final and binding or is withdrawn or abandoned, the application of another applicant will be entitled to receive a trademark registration.

6. Regarding the proviso to Article 8 (1), (2) and (5)

In determining whether or not there is "consent" and "no likelihood of confusion," Part III, Chapter 19 (Article 4(4)) 2. and 4. of this guideline shall apply *mutatis mutandis*.

## Part IX: Article 9 (Special provisions at the time of filing of application)

Article 9 (1) Where an application for trademark registration is filed in connection with a trademark used for goods or services exhibited at an exhibition held by the Government, etc., an exhibition held by those who are not the Government, etc. that conforms to the standards specified by the Commissioner of the Patent Office, an international exhibition held by the Government, etc. of a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or by those authorized thereby to hold such an exhibition in its territory, or an international exhibition held by the Government, etc. of a country which is not a country of the Union of the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or by those authorized thereby to hold such exhibition in its territory that conforms to the standards specified by the Commissioner of the Patent Office, by the exhibitor of such goods or services bearing the trademark within six months from the date of exhibition of such goods or services, the said application shall be deemed to have been filed at the time of exhibition of such goods or services.

(2) Any person who desires to apply the preceding paragraph in connection with a trademark relating to an application for trademark registration shall submit to the Commissioner of the Patent Office a document stating thereof at the time of filing of the application for trademark registration, and documents proving the fact that the trademark pertaining to an application for trademark registration and its designated goods or designated services fall under the trademark and goods or services provided in the said paragraph (referred to as a "certificate" in the following paragraph and paragraph (4)), within thirty days from the filing date of an application for the trademark registration.

(3) Where a person submitting a certificate is unable to submit the certificate within the time limit under the preceding paragraph, the said person may, in accordance with Ordinance of the Ministry of Economy, Trade and Industry, submit the said certificate to the Commissioner of the Patent Office only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry, even after the expiration of the time limit.

(4) Where, due to reasons beyond the control of the person, the person submitting a certificate is unable to submit the certificate within the time limit for submission of the certificate pursuant to the preceding paragraph, notwithstanding the said paragraph, submit the certificate to the Commissioner of the Patent Office within 14 days (two months for resident abroad) from the date on which the reasons for not submitting ceased to be applicable, but not later than six

months after the expiration of the said time limit.
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1. Part III, Chapter 8, Item 1 (Article 4(1)(ix)) of the Guidelines applies *mutatis mutandis* to "exhibitions."

2. Regarding the expression "that conforms to the standards specified by the Commissioner of the Patent Office"

The "standards specified by the Commissioner of the Patent Office" are shown in Notification No. 6 of JPO in 2012 (see below) and judgment will be made based on whether or not these standards are conformed to.

Part III, Chapter 8, Item 2 (Article 4(1)(ix)) of the Guidelines applies *mutatis mutandis* to the judgments described in (i) and (ii) below of said Notification.

Notification No. 6 of JPO of 2012 (extract of the requirements)

"(i) The events are held for the purpose of contributing to the development of industry wherein articles, etc. related to the industry are disclosed and displayed regardless of the name of the event such as "exhibition" or "trade fairs."

(ii) The venue and time of the event, qualifications of exhibitors and visitors, number of exhibitors as well as the kind and quantity of the articles on exhibition are deemed appropriate in light of the purpose of that item (note).

(iii) An exhibition held in Japan is one co-sponsored or aided by the government, etc., or equivalent thereto."

(Note) The term "that paragraph" refers to Article 9(1) of the Trademark Act.

### 3. Certificate

In alleging the application of the special provisions at the time of filing based on Article 9(1), the fact of exhibition or display may, for example, be made based on the following methods of evidence.

(1) Applicant's certificate of exhibition issued by the organizer of the exhibition

(2) Brochure indicating the fact of exhibition

(Note) The contents of the notification stated are as of the time when these Examination Guidelines were prepared.

## Part X: Article 10 (Division of application for trademark registration)

Article 10 (1) An applicant for trademark registration may file one or more new applications with regard to part of an application which designates two or more goods or services as its designated goods or designated services, provided that the application for trademark registration is pending in examination, trial examination or retrial examination, or that a suit against a trial decision to refuse the application is pending in court, and that the applicant has paid the fees payable under Article 76(2) for the application for trademark registration.

(2) In the case of the preceding paragraph, the new application for trademark registration shall be deemed to have been filed at the time of filing of the original application for trademark registration; provided, however, that this shall not apply for the purpose of Article 9 (2) of this Act and Article 43 (1) and 43(2) of the Patent Act (Act No.121 of 1959) as applied mutatis mutandis pursuant to Article 13 (1) of this Act (including cases where they are applied mutatis mutandis pursuant to Article 43-3 (3) of the Patent Act as applied mutatis mutandis pursuant to Article 13 (1) of this Act).

## Regulation for Enforcement of the Trademark Act

Article 22(2) The provisions of Article 26, paragraphs (3) to (6), Article 27, paragraphs (1) to (3), Article 27-4, paragraphs (1), (3) and (4), Article 28 and Article 30 (Trust, statement of shares, etc., procedures for claiming priority, etc. under the Paris Convention, notice of the number of the patent application and amendment in the case of division of patent application) of the Regulation for Enforcement of the Trademark Act shall apply mutatis mutandis to the application for trademark registration or the application for registration of defensive marks. In this case, the term "Article 195, paragraph (5) of the Patent Act" in Article 27, paragraph (3) of the Regulation for Enforcement of the Patent Act shall be deemed to be replaced with "Article 76, paragraph (4) of the Trademark Act" and the phrase "however, when the Commissioner of the Patent Office finds that the certifying document does not need to be submitted, it may be omitted" shall be deemed to be replaced with "in this case, for a person who has already submitted the certifying document to the Patent Office, the submission of the certifying document may be omitted if the particulars have not been changed," and the phrase "the description, scope of claims or drawing(s) attached to the application" in Article 30 of the Regulation for Enforcement of the Patent Act shall be deemed to be replaced with "application."

## Regulation for Enforcement of the Patent Act

Article 30 In the case where the applicant intends to file a new patent application pursuant to the provisions of Article 44, paragraph (1), item (i) of the Patent Act, if it is necessary to amend the description, scope of claims or drawing(s) attached to the original patent application, the applicant must amend the description, scope of claims or drawing(s) attached to the original patent application simultaneously with the filing of a new patent application.

1. Regarding the expression "two or more goods or services"

An application indicating its designated goods or designated services in a comprehensive manner of indication as provided in the Examination Guidelines for Similar Goods and Services can be divided into applications each goods or services among the goods or services included in the comprehensive manner of indication.

2. International application for trademark registration

According to the provisions of Article 68-12, the provisions of this Article do not apply to the international application for trademark registration.

Part XI: Article 15-2 and 15-3 (Notice of reasons for refusal)

Article 15-2 Where the examiner intends to render a decision to the effect that an application is to be refused, the examiner shall notify the applicant for trademark registration of the reasons for refusal and provide the applicant an opportunity to submit a written opinion, designating a reasonable time limit for such purpose.

Article 15-3 (1) Where a trademark pertaining to an application for trademark registration is identical with, or similar to, another person's trademark pertaining to an application for trademark registration filed prior to the filing date of the said application, if the said trademark is used for goods or services identical with, or similar to, the designated goods or designated services pertaining to such other person's trademark, the examiner may notify the applicant for trademark registration of the fact that the said application for trademark registration will fall under Article 15 (i) when the said other person's trademark is registered, and provide the applicant with an opportunity to submit a written opinion, designating a reasonable time limit for such purpose.

(2) Where the notification set forth in the preceding paragraph has already been served and the said other person's trademark is registered, the examiner shall not be required to serve the notification set forth in the preceding Article.

1. Notice of reasons for refusal

(1) When more than one reason for refusal is found

When more than one reason for refusal is found, in principle, all the reasons for refusal will be notified simultaneously

(2) When a different reason for refusal is found

When a different reason for refusal is found within the period specified by Cabinet Order as referred to in Article 16, such different reason for refusal may be notified.

2. An examiner's decision of refusal based on the reasons notified pursuant to Article 15-3(1) is to be made only after a trademark in a prior trademark application cited in the notification of a reason for refusal is registered.



3. In case where the designated goods or designated services of a prior trademark application cited in a notice of reasons for refusal are amended, it is not necessary to serve another notice of reasons for refusal.

Part XII: Article 16 (Examiner's decision of trademark registration)

Article 16 Where no reasons for refusal are found in connection with an application for trademark registration within the time limit provided by Cabinet Order, the examiner shall render a decision to the effect that the trademark is to be registered.

Order for Enforcement of the Trademark Act

Article 3 (1) The time limit provided in Article 16 of the Trademark Act (including the case where applied mutatis mutandis pursuant to Article 55-2(2) of that Act (including the case where applied mutatis mutandis pursuant to Article 60-2(2) of that Act (including the case where applied mutatis mutandis pursuant to Article 68(5) of that Act) and Article 68(4) of that Act) and Article 68(2) of that Act; the same applies in the following paragraph) is 18 months from the application date approved under the provisions of Article 5-2(1) or (4) of that Act (including the case where these provisions are applied mutatis mutandis pursuant to Article 68(1) of that Act) for registration of trademarks (when the examiner notifies the reasons for refusal of the application for registration of trademarks for falling under Article 15(3) of that Act, and when the application no longer falls under that item through amendments, the date of submission of the procedural amendment form, and when

the following paragraphs are applied to the application for trademark registration, the application date for the registration of trademarks on the occasion that those paragraphs are not applied).

(i) The provisions of Article 9(1), Article 10(2) (including the case where applied mutatis mutandis pursuant to Article 11(6), Article 12(3), Article 65(3) and Article 68(1) of the Trademark Act) or Article 68-32(2) (including the case where applied mutatis mutandis by replacing certain terms pursuant to Article 68-33, paragraph (2) of that Act) of that Act.

(ii) The provisions of Article 17-3, paragraph (1) of the Design Act as applied mutatis mutandis pursuant to Article 17-2, paragraph (1) of the Trademark Act (including the case where applied mutatis mutandis pursuant to Article 68, paragraph (2) of that Act) and Article 55-2, paragraph (3) of that Act (including the case where applied mutatis mutandis pursuant to Article 60-2, paragraph (2) of that Act (including the case where applied mutatis mutandis pursuant to Article 68(5) of that Act) and Article 68, paragraph (4) of that Act)

(2) Notwithstanding the provisions of the preceding paragraph, the period specified by Cabinet Order as referred to in Article 16 of the Trademark Act related to the territorial extension which has been regarded as an application for trademark registration pursuant to the provisions of Article 68-9, paragraph (1) of that Act shall be 18 months from the date on which the territorial extension prescribed in Article 3ter of the Protocol adopted at Madrid on June 27, 1989 in relation to the Madrid Agreement Concerning the International Registration of Marks (when the notification of the correction of the matters registered in the international register provided in Article 68-9, paragraph (1) of the Trademark Act that is specified by the Order of the Ministry of Economy, Trade and Industry is given by the international bureau provided in Article 68-3, paragraph (1) of that Act and the examiner notifies the reasons for refusal for the matters subject to the notification of correction, the date on which such correction was notified) has been made.

1. Reasons for refusal notified within the "period specified by Cabinet Order"

(1) Whether or not the reason for refusal was found during the "period specified by the Cabinet Order" will be determined by the date on which the notice of reason for refusal for the application was forwarded.

(2) Even when the notice of reason for refusal returns to the Patent Office undelivered to the applicant and is forwarded for the second time, the "period specified by the Cabinet Order" will be counted based on the date when the notice was forwarded for the first time.

(3) Please note that the date of forwarding will be the date on which the applicant required that forwarding in the case of online forwarding.

Part XIII: Article 16-2 and 17-2 (Dismissal of amendment)

Article 16-2 (1) Where an amendment made to the designated goods or designated services, or to the trademark for which registration is sought as stated in the application, is considered to cause any change of the gist thereof, the examiner shall dismiss the amendment by a ruling.

(2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state reasons therefor.

(3) Where a ruling dismissing an amendment under paragraph (1) is rendered, the examiner shall not render any decision on the said application for trademark registration before the expiration of a three month period from the date of service of a transcript of the ruling.

(4) Where an applicant for trademark registration files a request for a trial under Article 45 (1) against the ruling dismissing an amendment under paragraph (1), the examiner shall suspend the examination of the application for trademark registration until the trial decision becomes final and binding.

Article 17-2 (1) The provision of Article 17-3 (New Application for Designs as Amended) of the Design Act (Act No. 125 of 1959) shall apply mutatis mutandis to the case where an amendment is dismissed by a ruling pursuant to Article 16-2 (1) of this Act.

(2) The provision of Article 17-4 of the Design Act shall apply mutatis mutandis to the case of an extension of the time limit provided in Article 17-3 (1) of the Design Act as applied mutatis mutandis to the preceding paragraph or Article 55-2 (3) (including its mutatis mutandis application under Article 60-2 (2)) of this Act.

Design Act Article 17-3 (1) Where an applicant for design registration files, within three months from the date on which a certified copy of the ruling dismissing an amendment under paragraph 1 of the preceding Article has been served, a new application for design registration for the amended design, the new application shall be deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted.

(2) Where a new application for design registration is filed under the preceding paragraph, the original application for design registration shall be deemed to have been withdrawn.

(3) The preceding two paragraphs shall apply only when the applicant for design registration has submitted to the Commissioner of the Patent Office, at the time of the filing of a new application, a document stating a request for the application of paragraph (1) to the new application for design registration under paragraph (1).

1. A judgment on a change in the gist of an application will be made based on the following criteria.

(1) Designated goods or designated services provided for in Article 5(1)(iii) (hereinafter referred to as the "designated goods or designated services")

(a) A modification or broadening of the scope of designated goods or designated services is a change in the gist of an application not only in a case where a modification or a broadening is made to cover dissimilar goods or services but in a case where a modification or a broadening is made to cover other similar goods or services.

(Example 1) Case of change in the gist

(i) Modification of scope

Amendment from Class 32 "beer" to Class 33 "western liquors"

(ii) Broadening of scope

Amendment from Class 12 "trucks" to Class 12 "automobiles"

However, for example, when the designated goods or designated services are indicated in a comprehensive manner as shown below, changing each designated good or designated service contained in such indication made in a comprehensive manner is not a change in the gist.

(Example 2) Case which is not a change of gist

Designated goods: Amendment from "tableware" to "drinking cups, Japanese rice bowls (chawan)" in Class 21

Designated service: Amendment from "providing amusement facilities" to "providing kara-oke facilities, providing other amusement facilities" in Class 41

(b) A restriction of the scope of designated goods or designated services, correction of errors, and changes in order to clarify unclear descriptions are not deemed as a change in the gist of an application.

(c) Amendments in respect of retail services will be handled as follows.

(i) Amendments where "retail services or wholesale services for a variety of goods in each of the fields of clothing, foods and beverages, and livingware, and taking all goods together" (hereinafter referred to as "general retail services") are changed to other retail services (hereinafter referred to as "specific retail services") are deemed as a change in the gist of an application. The same will apply in the reverse case where specific retail services are changed to general retail services.

(ii) While a restriction of the scope of goods connected with specific retail services is not deemed

as a change in the gist of an application, a modification or broadening of the scope is deemed as such.

(iii) Amendments where retail services are changed to goods are deemed as a change in the gist of an application. The same will apply in the reverse case.

(2) Statements in the column in which the trademark for which registration is sought under Article 5(1)(ii) is to be stated (hereinafter referred to as the "trademark stated in the application")

(a) Amendment of the trademark stated in the application is, in principle, a change in the gist.

(Example)

(i) To alter or delete the characters, figures, symbols or three-dimensional shapes of a trademark;

(ii) To add characters, figures, symbols or three-dimensional shapes to a trademark; and

(iii) To change the color of a trademark.

(b) A deletion of any characters used in a trademark merely in an appendant portion (for example, the trademark has other parts that function to distinguish its own goods or services from those of others and the relevant part is not united in composition with such part having the function to distinguish its own goods from those of others), such as "JIS," "JAS," "特許" (patent), "実用新案" (utility model registration), "意匠" (design registration), etc. or characters indicating the place of production and sale of goods or the provision of services is not a change in the gist of an application, in principle.

(c) Amendment to add or delete a statement that the trademark as applied is a "three-dimensional trademark" as prescribed in Article 5(2) after the filing of an application for trademark registration is, in principle, a change in the gist.

However, an amendment to add a statement that the trademark as applied is a three-dimensional trademark in the case where the trademark stated in the application can only be recognized as a three-dimensional trademark or an amendment to delete a statement that the trademark as applied is a three-dimensional trademark in the case where the trademark stated in the application can only be recognized to be a plane trademark is not a change in the gist.

(d) An amendment to add or delete a statement that a trademark is composed of "standard characters" as prescribed in Article 5(3) after the filing of the application for trademark registration is deemed to be a change in the gist of an application, in principle.

However, an amendment to add a statement that a trademark is composed of standard characters in the case where the trademark stated in the application is found identical with that

indicated by being replaced with standard characters is not a change in the gist.

(e) Filing an application to receive the application of colors under the provisions of the proviso to Article 5(6) after the filing of an application for trademark registration is a change in the gist.

2. In accordance with Article 68-18, the provisions of Article 17-3 of the Design Act (New Application for Amended design) as applied *mutatis mutandis* pursuant to Article 17-2(1) of the Trademark Act do not apply to the international applications for trademark registration.

3. Motion, hologram, color, sound and position marks

(1) Amendments to descriptions stating as motion, hologram, color, sound and position marks

(a) Principle

Amendments to add or delete descriptions stating as motion, hologram, color, sound and position marks provided for in Article 5(2) are changes in the gist, in principle.

(b) Exception

However, if a trademark can only be recognized as either a motion, hologram, color, sound or position mark based on a description provided in its application, and a detailed description of the trademark (hereinafter referred to as the "detailed description of the trademark") or an material to be provided for by an Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as the "article") provided for in Article 5(4), and if an amendment is done to add a description that it is such a trademark or to delete a description that it is such a trademark, the amendment is not regarded as a change in the gist.

(2) Amendment to trademark described in application

(a) Principle

An amendment to a trademark described in an application is a change in the gist, in principle.

(b) Exception

However, in the case of sound marks, if the trademark stated in the application contains a description of an element other than linguistic elements or sounds that constitute the sound mark such as the music name or composer's name, the amendment to delete them is not regarded as a change in the gist.

(3) Amendment to detailed description of trademark or article

If a trademark for which registration is sought is not specified, in order to decide whether an

amendment to a detailed description of the trademark or a material is a change in the gist, it is examined whether the detailed description of the trademark or the material as amended falls under the scope of composition and manner of the trademark stated in the application.

If a trademark for which registration is sought is specified, in order to decide whether an amendment to a detailed description of the trademark or a material is a change in the gist, it is examined whether the detailed description of the trademark or the material as amended falls under the scope of composition and manner of the trademark stated in the application. For example, for a sound mark, because the detailed description of the trademark (limited to a case when it is required to identify a trademark described in an application) and the material can be used to identify an item which is not described in a trademark stated in an application (such as the sound tones of an instrument played or the range of voice, but excluding lyrics and other linguistic elements), it is decided based on whether the detailed description of the trademark (limited to a case when it is required to identify a trademark described in an application) and the material as amended are contained within the scope.

(a) Motion marks

For example, cases which are not changes in the gist are as follows.

[a] When a mark is described in a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the mark to the detailed description of the trademark.

[b] When the change of a mark with respect to time is described in a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the change of the mark with respect to time to the detailed description of the trademark.

(b) Hologram marks

For example, cases which are not changes in the gist are as follows.

[a] When a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the mark to the detailed description of the trademark.

[b] For a hologram mark which has a visual effect to let it display different display surfaces depending on different viewing angles, when an explanation about a display surface is described in a trademark stated in an application but is not described in a detailed description of the trademark, an amendment is made to add the explanation of the display surface to the detailed description of the trademark.

(c) Color marks



For example, cases which are not changes in the gist are as follows.

[a] When the color of a trademark stated in an application is red while that of the trademark described in a detailed description of the trademark is blue, an amendment is made to change the color of the trademark described in the detailed description of the trademark to red.

[b] When a trademark stated in an application consists of 3 colors while the trademark described in a detailed description of the trademark consists of 4 colors, an amendment is made to change the trademark described in the detailed description of the trademark into one consisting of 3 colors.

[c] When a trademark described in an application consists of 4 colors which are arranged from the bottom to the top with their ratios of 25% each while the trademark described in a detailed description of the trademark consists of 4 colors which are arranged from the bottom to the top with their ratios of 30%, 30%, 20% and 20%, an amendment is made to change the trademark described in the detailed description of the trademark into one consisting of 4 colors with their ratios of 25% each.

(d) Sound marks

(i) For example, cases which are not changes in the gist are as follows.

[a] When a trademark stated in an application is a staff notation with a piano as an instrument played while its material is a sound file which is recognized as recording sounds generated by a guitar, an amendment is made to change the material into a sound file which is recognized as recording sounds generated by a piano.

(ii) For example, cases which are changes in the gist are as follows.

[a] When a trademark stated in an application is a staff notation which describes no lyrics while its material is a sound file which records no voices singing a lyric, an amendment is made to change the material into a sound file which records voices singing a lyric.

[b] When a trademark stated in an application is a staff notation which describes no instrument played while its article is a sound file which is recognized as recording sounds generated by a guitar, an amendment is made to change the material into a sound file which is recognized as recording sounds generated by a piano.

(e) Position marks

(i) For example, cases which are not changes of gist are as follows.

[a] When a trademark described in an application is a pair of eyeglasses which have a mark attached to their temple while its detailed description of the trademark describes that a mark is attached to the lens frames of a pair of eyeglasses, an amendment is made to change the detailed

description of the trademark into a statement which describes that a mark is attached to a temple of a pair of eyeglasses.

4. Item 3(1) and (2) above do not apply to an international application for trademark registration.

## Part XIV: Article 64 (Requirements for defensive mark registration)

Article 64 (1) Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.

(2) Where a registered trademark pertaining to services is well known among consumers as that indicating the designated services in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with services other than the designated services pertaining to the registered trademark or services similar thereto or in connection with goods other than those similar to the designated services is likely to cause confusion between the said other person's services or goods and the designated services pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the services or goods for which the likelihood of confusion exists.

(3) For the purpose of the application of the preceding two paragraphs in relation to defensive mark registrations pertaining to a trademark right pertaining to a regionally collective trademark, the term "his/her own" in the said paragraphs shall be deemed to be replaced with "its own or its members' ."

## 1. Regarding the expression "well known among consumers"

(1) The expression "well-known among consumers" means that the trademark is recognized by the consumers of the goods or services across the country as the indication of source of the applicant (holder of the original registered trademark).

(2) The determination on whether or not a trademark is "well known among consumers" is determined in a comprehensive manner by taking into consideration the matters set out in (a) to (d) below.

(a) The start and duration of use of a registered trademark relating to an application for the

registration of a defensive mark (hereinafter referred to the "original registered trademark"), areas of its use, goods or services connected with its use, etc.;

(b) the degree or dissemination of an advertisement, publication, etc. of the original registered trademark;

(c) the scale of business of the holder of the original registered trademark, with consideration given to the relationship of the designated goods or designated services its business scale, business activities (state of production or sale, etc.); and

(d) the recognition of the original registered trademark's being famous by the Patent Office such as the fact of such famousness being found in trial decisions or judgments.

2. Marks contained in the application for registration of defensive marks must be identical with the original registered mark (including those different in size).

3. Determination on the identity of the original registered trademark and trademark as used

Part II, Item 1(1) (Article 3(2)) of the Guidelines applies *mutatis mutandis* to the judgment on identity.

4. Regarding the case when it "is likely to cause confusion" as to the source of goods or services

(1) The abovementioned case not only refers to the case where the consumers of the relevant goods or services (hereinafter referred to as "goods, etc.") are likely to be misled that such goods, etc. are those pertaining to the business of the holder of the original registered trademark and to be confused as to the source of the goods, etc. but also to the case where the consumers are likely to be misled that the goods, etc. are those pertaining to the business of a person who has an economic, organizational or any other relationship with the holder of the original registered trademark and to be confused as to the source of the goods, etc.

(2) Matters to be taken into consideration

The judgment on whether it "is likely to cause confusion" is made, for example, by taking into consideration, in a comprehensive manner, the following facts.

(i) How much the original registered trademark is well known

- (ii) Whether the original registered trademark consists of a coined word or has a distinctive feature in its composition
- (iii) Whether the original registered trademark is a house mark
- (iv) Whether there is any possibility of multiple management in the company
- (v) Whether there is any relationship between goods, services, or goods and services
- (vi) Whether there is any commonality between the consumers of goods, etc. and other actual state of transactions

In determining the state of being well-known as prescribed in (i) above, Part II, Item 2(2) and (3) (Article 3(2)) of the Guidelines applies *mutatis mutandis*.

5. Misleading as to the source of goods or services for which registration of a defensive mark is sought

A trademark including the common name of a good or service with an application for its registration covering goods or services other than the said goods or services is granted a registration as a defensive mark if it satisfies other requirements regardless of whether or not it will cause misleading as to the quality of the goods or services.

Part XV: Article 65-2, 3, and 4 (Duration of right based on defensive mark registration)

Article 65-2 (1) The duration of a right based on defensive mark registration shall expire after ten years from the date of registration of the establishment of such right.

(2) The duration of a right based on defensive mark registration may be renewed by filing an application for registration of renewal; provided, however, that this shall not apply to the case where the registered defensive mark becomes unregistrable as a defensive mark pursuant to Article 64.

Article 65-3 (1) A person filing an application for registration of renewal of the duration of a right based on defensive mark registration shall submit to the Commissioner of the Patent Office an application stating the following matters:

- (i) the name and the domicile or residence of the applicant;
- (ii) the registration number of the defensive mark registration; and
- (iii) in addition to those listed in the preceding two items, the matters provided by Ordinance of the Ministry of Economy, Trade and Industry.

(2) An application for registration of renewal shall be filed during the period from six months prior to the expiration of the duration of the right based on defensive mark registration to the date of expiration thereof.

(3) Where a person who files an application for registration of renewal of the duration of a right based on defensive mark registration has been unable to file the application for registration of renewal within the time limit for such application pursuant to the preceding paragraph, the person may file such application only within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply to cases where the person has intentionally failed to file the application for registration of renewal within the time limit for such application pursuant to the preceding paragraph.

(4) Where an application for registration of renewal of the duration of a right based on defensive mark registration is filed, the duration shall be deemed to have been renewed upon expiration of the duration (where an application is filed under the preceding paragraph, upon filing of the application); provided, however, that this shall not apply to the case where the examiner's decision or appeal/trial decision to the effect that the application is to be refused becomes final and binding or the renewal of the duration of a right based on defensive mark registration is registered.

Article 65-4 (1) Where an application for registration of renewal of the duration of a right based on defensive mark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused:

- (i) the registered defensive mark pertaining to application is filed becomes unregistrable as a defensive mark pursuant to Article 64; and
- (ii) the applicant is not a person who has the right based on the defensive mark registration.

(2) Where no reasons for refusal are found in connection with an application for registration of renewal of the duration of a right based on defensive mark registration, the examiner shall render a decision to the effect that the renewal is to be registered.

### 1. Identity of the applicant and the right holder

In case where the name and the domicile or residence of an applicant for the registration of a renewal of a right based on a registered defensive mark are different from those of its right holder registered in the Trademark Register, the right holder and the applicant are deemed not to be the same person (for example, in a case where one indication is "○○○株式会社" [KABUSHIKI KAISHA] and the other indication is "○○○カンパニー" [COMPANY]).

### 2. Description in the application for the registration of a renewal of a right based on a registered defensive mark

A mark or designated goods or designated services mistakenly described in the application for the registration of a renewal of a right based on a registered defensive mark are deemed not to have been described.

### 3. Criteria for judgment

A judgment on whether a defensive mark for with respect to which an application for the registration of a renewal of a right based on a registered defensive mark is filed has become not registrable under Article 64 is subject to the application mutatis mutandis of Part XIV, Items 1, 3 and 4 (Article 64) of the Guidelines. In such a case, full consideration needs to be given to the state of the use of a original registered trademark.

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 provided in Article 68-2, paragraph (5) of the Trademark Act."

(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) Any amendment to the designated goods or designated services stated in the international application for trademark registration may be made only within the time limit designated in 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))).

(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.

Part XVII: Articles 2, 3, 4, 6, 11, 12 and 24 of Supplementary Provisions

Part XVII: Articles 2, 3, 4, 6, 11, 12 and 24 of Supplementary Provisions (Reclassification)

Deleted.

Part XVIII: Others

1. When "the trial decision [...] has become final and conclusive" in Article 11(4) and Article 12 (2) (Change to the application)

The time when "the trial decision [...] has become final and conclusive" is the time when the copy of the registration decision is served.

2. When the same person files an application for the same trademark or mark designating the same goods or services

(1) When the same person makes a duplicating application for the same trademark (including those different in size) designating the same goods or services, except for cases corresponding to the provisions of Article 68-10, in principle, after the trademark in respect of the prior application is registered, the later application will be refused under the reasons that it is "against the purpose of Article 3 of the Trademark Act".

(2) This is also true when the holder of the trademark right applies for a trademark registration for the same trademark (including those different in size) designating the same goods and services.

(3) When the holder of the trademark right is found to have filed an application for registration of a defensive mark for which all of the designated goods or service are the same based on the same registered trademark, the later application will be refused for reasons that it is "against the purpose of Article 64(1) and (2) of the Trademark Act," in principle.

(4) The same applies when the person who holds rights based on a defensive trademark registration has filed an application for registration of renewal of a defensive mark for which all of the designated goods or services are the same with respect to the same registered defensive mark during the period when the application of the renewal registration of the defensive trademark can be made.

3. Application for trademark registration with priority claim under the Paris Convention

- (1) Priority claim

When the requirements set forth in (a) to (c) below are satisfied, the priority claim is judged to be appropriate.

(a) the applicant of the application for trademark registration with a priority claim is the same person or the successor of the applicant indicated in the certificate, etc. submitted pursuant to Article 43(2) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of the Trademark Act (hereinafter referred to as "priority certificate, etc.") (Article 4A(1) of the Paris Convention);

(b) the trademark stated in the application for trademark registration with a priority claim is the

same as that stated in the priority certificate, etc;

(c) all or part of the designated goods or designated services of the application for trademark registration with a priority claim is included in the designated goods or designated services presented in the priority certificate, etc.

(2) Effect of the application for trademark registration with a priority claim

When the priority claim is found to be appropriate, the relevant application for trademark registration is handled as being filed at the time of the first foreign application (hereinafter the date of this first foreign application is referred to as the "priority date") with respect to the application of the following provisions

(a) Article 4(1)(xi) (another person's registered trademark of an earlier application)

(b) Article 8 (earlier application)

In addition, "the time of the application for trademark registration" as referred to in Article 4(3) is judged based on the priority date.

(a) Article 4(1)(viii) (name of others)

(b) Article 4(1)(x) (another person's well-known trademark)

(c) Article 4(1)(xv) (confusion as to the source of goods or services)

(d) Article 4(1)(xvii) (indication of the place of production of wines or spirits)

(e) Article 4(1)(xix) (trademark identical with or similar to another person's well-known trademarks that is used for unfair purposes)