

### 41.100.03

#### **Regarding the Operation for the Examination for Confirming the Applicant's Use or Intention of Use of a Trademark**

When examiners have "reasonable doubts" about the applicant's use or intention of use a trademark for the designated goods or designated services described in the application, the examiner determines that the relevant trademark does not satisfy the requirements prescribed in the main paragraph of Article 3(1) of the Trademark Act (see Part I, Chapter 2, Item 2(3) of the Examination Guidelines for Trademarks).

However, the description of the applications is an insufficient source to correctly determine the goods or services for which the respective trademarks will be used. Therefore, specific use or intention to use the trademarks is confirmed in the process of analyzing the applicant's business connected to the designated goods or designated services, which is a premise for using a trademark (see Part I, Chapter 2, Item 3(2) of the Examination Guidelines for Trademarks).

#### 1. Application of the main paragraph of Article 3(1) of the Trademark Act

When the designated goods or designated services described in the application are included in 1) or 2) below, examiners, in principle, send a notification of reasons for refusal to the applicant describing the reason that the filed trademark cannot be registered as a trademark according to the main paragraph of Article 3(1) of the Trademark Act because they have reasonable doubts about the applicant's use or intention of use of the trademark and then confirm such applicant's use or intention of use of the trademark through the applicant's business .

However, this does not apply to cases where the applicant has submitted documents, etc. certifying his/her use or intention of use of the trademark at the time of filing an application.

#### (1) Retail services

Part I, Chapter 2, Item 2(3) of the Examination Guidelines for Trademarks

(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 as a general merchandise business for a variety of goods in the fields of clothing, foods and beverages, and livingware" (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 an ex-officio investigation as to whether or not the trademark will be "used in connection with goods or services pertaining to the business of an applicant" cannot find that the applicant is conducting general retail services.

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

[Handling]

Similar group codes for goods dealt in retail services shall not be taken into consideration. For example, in the case of "retail services or wholesale services for automobiles 35K04 (12A05)," the number of similar group codes are two but since 12A05 is a similar group code assigned to the goods dealt in the service, the number of similar group codes will be counted as one

(Explanations)

Items (i) and (ii) above mention general retail services involving services provided by department stores, hypermarkets, offices of general trading companies, or the like and generally, it is hardly considered that these are the services which an individual (natural person) deals in as a business which is a premise of using the trademark. In addition, general retail services include a wide variety of goods for food, clothing and housing, which is a different characteristic from retail services that are not general retail services (hereinafter referred to as "specific retail services"), and thus, there is a concern that every applicant would want to file an application by designating such general retail services. To prevent this, when an applicant files an application by designating general retail services and it is covered by items (i) or (ii), the examiners shall confirm the business of the applicant connected to the designated services based on reasonable doubts about the applicant's use or intention of use of the trademark.

Furthermore, item (iii) above mainly involves specific retail services. The Examination Guidelines for Similar Goods and Services stipulates the scope of similar retail services based on the Standard Industrial Classification of Japan, which provides classifications of business operators according to the types of their businesses, and it is not considered to be a common practice that a single business operator deals in a variety of retail services covered by multiple similar group codes. Therefore, when an applicant who is a single business operator designates retail services covered by multiple similar group codes, examiners shall confirm the business of the applicant connected to the designated services based on reasonable doubts about the applicant's use or intention of use of the trademark. Examiners make a decision as to whether or not the designated retail services are covered by various similar group codes (35K01-35K99) for retail services exemplified in the Examination Standards for Similar Goods and Services.

## (2) Goods or services in general

Part I, Chapter 2, Item 2(3) of the Examination Guidelines for Trademarks

(b) Regarding overall goods and services other than those mentioned in (a)

Where the designation of goods or services ranges widely in one classification.

[Handling]

In principle, when an applicant has designated goods or services covered by 23 or more similar group codes (hereinafter referred to as "similar groups") in one classification, since the designation of goods or services are ranging widely, the examiner confirms the applicant's use or intention of use of the trademark based on doubts about the applicant's use or intention of use of the trademark for the designated goods or designated services.

However, when the applicant has designated the goods or services to which 23 or more similar group codes are assigned among the goods or services listed in the Examination Guidelines for Similar Goods and Services, the abovementioned handling will not apply if the applicant has designated the goods or services within the number of similar group codes assigned in the classification to which the relevant goods or services belong.<sup>1</sup>

(Reference)

With respect to the submission of documents certifying the use or intention of use of the trademark, when they are submitted simultaneously with the application for trademark registration, they are often submitted in documents, and thus, basically, the procedures will be taken using written supplements.

(Example) (Abstract of the form of a written supplement)

[List of submitted materials]

[Name of the material] Documents certifying the use or intention of use of the trademark: 1

(3) How to count the number of similar group codes [Example: International Classification No. 11- 2018 edition]

(a) Retail services

<sup>1</sup> The goods or services published on the Table of International Classification of Goods and Services will be handled in the same manner. As of April 2018, the maximum number of similar group codes assigned to one goods or services is 22 (Class 11: "Drying apparatus [for chemical processing]) and thus there are no goods or services that are subject to the provisions of the "proviso." However, if any goods or services are assigned 23 or more similar group codes as a result of the revision of the Examination Guidelines for Similar Goods and Services in the future, this provision will be applied.

(i) When there are two or more designated services covered by the similar group codes for retail services (35K01~35K99).

In this example, since multiple retail services that are not similar to each other are designated, the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied (the similar group codes assigned to the goods dealt in the retail services will not be counted)

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	35K04 (12A05)	35	Retail services or wholesale services for automobiles
2	35K05 (12A06)	35	Retail services or wholesale services for two-wheeled motor vehicles
2 in total (2 for retail services)			

(ii) When there are two or more designated services covered by the similar group codes for retail services (35K01~35K99) and the similar group codes are overlapping.

The same similar group codes will not be counted redundantly (see (iv) below for exceptions). In this case, the number of similar group codes will be counted as one in total and thus the examiner will determine that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are satisfied.

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	<u>35K03</u> (30A01)	35	Retail services or wholesale services for confectionery, bread and buns
-	<u>35K03</u> (29C01)	35	Retail services or wholesale services for carbonated drinks (refreshing beverages) and non-alcoholic fruit juice beverages
1 in total (1 for			

retail services)			
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(iii) When there are two or more designated services covered by the similar group codes for "other retail services" (35K99), and they are similar to each other

When there are two or more designated services covered by the similar group codes for "other retail services" (35K99), they will not be counted redundantly if they are similar to each other. In the following example, since the "retail services or wholesale services for therapeutic apparatus and instruments" and "retail services or wholesale services for surgical apparatus and instruments" are similar to each other, the number of similar group codes will be counted as one in total and the examiner will determine that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are satisfied.

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	35K99 (10D01)	35	Retail services or wholesale services for therapeutic apparatus and instruments
-	35K99 (10D01)	35	Retail services or wholesale services for surgical apparatus and instruments
1 in total (1 for retail services)			

(iv) When there are two or more services covered by the similar group codes for "other retail services" (35K99), and they are not similar to each other.

For "other retail services" that are not similar to each other, the number of similar group codes is counted redundantly. In the following example, since the "retail services or wholesale services for yachts" and "retail services or wholesale services for gliders" are not similar to each other, the number of similar group codes will be counted as two in total and the examiner will determine that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied.

Number of counts	Similar group	Classification	Designated goods (designated services)

1	35K99 (12A01)	35	Retail services or wholesale services for yachts
2	35K99 (12A02)	35	Retail services or wholesale services for gliders
2 in total (2 for retail services)			

(v) When a service is covered by multiple similar group codes for retail services (35K01~35K99)

Even when a service is covered by multiple similar group codes for retail services (35K01~35K99), if the goods dealt in the retail services cannot be indicated in any other appropriate manner, the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are satisfied.

	Similar group codes	Classification	Designated goods (designated services)
1	35K02 35K20 21A02 21B01 21D01	35	Retail services or wholesale services for jewelries
1 in total (1 for retail services)			

(b) Retail services and other services in Class 35

(vi) When a service covered by the similar group code for retail services (35K01~35K99) and other services in Class 35 are designated with respect to Class 35

(Example No. 1)

Even when one similar group code for retail services is included, it will be counted in the same manner as that for other similar group codes. However, the similar group codes for the goods dealt in the retail service (21C01 in this case) will not be counted.

In the following example, the number of similar group codes is 23 in total, and thus the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied.

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	35K02 (21C01)	35	Retail services or wholesale services for bags and pouches
2	35A01	35	Advertising
3	35A02	35	Promoting the goods and services of others through the issuance of trading stamps
4	35J01	35	Business management analysis or business consulting
5	35J02	35	Retail services for vending machines
21	42G02	35	Providing employment information
22	35E01	35	Auctioneering
23	35F01	35	Import/export agencies
23 in total			

(Example No. 2)

Even when the number of similar group codes in Class 35 is not more than 22, if there are two or more retail services that are not similar to each other, the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied (However, this determination will only be made with respect to retail services).

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	35K13 (26A01)	35	Retail services or wholesale services for printed matter
2	35K15 (24E01) (24E02)	35	Retail services or wholesale services for musical instruments and records
-	35A01	35	Advertising
-	35B01	35	Marketing research
4 in total			

(2 for retail services)			
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(Example No. 3)

When there are two or more retail services that are not similar to each other and they are covered by 23 or more similar group codes in Class 35, the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied.

Number of counts	Similar group codes	Classification	Designated goods (Designated services)
1	35K13 (26A01)	35	Retail services or wholesale services for printed matter
2	35K15 (24E01) (24E02)	35	Retail services or wholesale services for musical instruments and records
3	35J01	35	Advertising
4	35J01	35	Advertising
	35J01		Public relations
	35J01		Public relations
20	35J02	35	Rental of copying machines
21	42G02	35	Providing employment information
22	42G04	35	Providing information on newspaper articles
23	42X07	35	Rental of vending machines
23 in total (2 for retail services)			

(C) Goods and services in general

(vii) When there are not less than 23 designated goods (designated services) that are covered by one similar group code under one class and the similar group codes are overlapping

The same similar group code will not be counted redundantly (see item (ix) for exceptions). In the following example, the number of similar group codes is 22 in total



and the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are satisfied.

Number of counts	Similar group codes	Classification	Designated goods (designated services)
1	06A01	06	Irons and steels
2	06A02	06	Nonferrous metals and their alloys
3	06B01	06	石Ores of metals
4	07A01	06	Metal materials for building or construction
5		06	fabricated assembly kits
20	09G60	06	Liquefied gas storage tanks of metal
-	09G60	06	Gas storage tanks of metal
21	12A01	06	Anchors
22	12A74	06	Containers of metal for transport
22 in total			

(viii) When there are two or more goods or services covered by the same "Other similar group codes" (40H99 or the like) under one class and they are similar to each other

When there are two or more goods (services) that are covered by the same "other similar group codes," they will not be counted redundantly if they are similar to each other. In the following example, "cutting work of keys" and "reproduction work of keys" are services that are similar to each other and thus the number of similar group codes is 22 in total and the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are satisfied.

Number of counts	Similar groups	Classification	Designated goods (Designated services)
1	40C01	40	Metal work
2	40C02	40	Processing of rubber
3	40C03	40	Ceramic processing
4	40C04	40	Food-working
	40C05	40	Printing and working
21	40C06	40	Stone-working

22	<u>40H99</u>	40	<u>Cutting work of keys</u>
-	<u>40H99</u>	40	<u>Reproduction work of keys</u>
22 in total			

(ix) When there are multiple services covered by the same "other similar group code" (40H99 or the like) under one class and they are not similar to each other

If the "other similar group codes" are not similar to each other, they will be counted redundantly. In this example, "key work" and "glass work" are not similar to each other and thus the number of similar group codes is 23 in total and the examiner determines that the requirements stipulated in the main paragraph of Article 3(1) of the Trademark Act are not satisfied.

Number of counts	Similar group	Classification	Designated goods (designated services)
1	37G06	40	Removal of radiation rays
2	40A01	40	Fire-proofing for cloth, clothing or fur
3	40B01	40	Tailoring or dressmaking
4	40C01	40	Metalwork
20	40C02	40	Plastic and rubber
20	40C05	40	Paper treating and working
21	40C06	40	Stone-working
22	<u>40H99</u>	40	<u>Key work</u>
23	<u>40H99</u>	40	<u>Glass work</u>
23 in total			

## 2. Documents for confirming the applicant's use or intention of use of the trademark

### 1) firming the applicant's use or intention of use of the trademark

When an applicant receives a notification of reasons for refusal from examiners according to item 1 above, the applicant is required to submit documents certifying his/her use or intention of use of the trademark in the form of a written opinion.

When the applicant submits documents certifying the actual use of the trademark or "use in connection with goods or services pertaining to the business of the applicant," he/she has to explicitly indicate that he/she conducts or plans to conduct the business connected to the designated goods or designated services for at least each similar group code he/she designates. (When the applicant files for retail services, he/she has to indicate that he/she conducts or plans to conduct the business connected

to the designated services for at least each similar group code.)

In addition, when the examiners still have doubts over the designated goods or designated services relating to the applicant's use or intention to use the trademark even after a written opinion as well as documents certifying the use of the trademark have been submitted, they notify the applicant of the designated goods or designated services over which they have doubts and require the applicant to submit additional certifying documents.

## 2) Documents for confirming the use of the trademark

An applicant's use of the trademark is certified by the following documents:

(Part I, Chapter 2, Item 3 of the Examination Guidelines for Trademarks)

### (3) Ascertaining whether the applicant is conducting business

(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 as a general merchandiser.

(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/her

(iii) Business documents showing the goods handled by the applicant, etc. (order forms, delivery statements, invoices, receipts, etc.)

(iv) Articles in newspapers, magazines, on 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)

Items (a) and (b) above extracted from the Examination Guidelines for Trademarks show the procedure by which the applicant is able to certify that he/she conducts the business connected to the designated goods or designated services, as a premise of using the trademark, and both of them are examples.

The applicant is able to comprehensively certify that he/she conducts the business connected to general retail services by clearly stating the facts described in (3)(a)(i) to (iii), through the steps described in (b)(i) to (vii).

The applicant is able to comprehensively certify that he/she conducts the business connected to specific retail services through the steps described in (b)(i) to (vii).

In addition, documents certifying "that the sales of each field ... account for around from 10% to 70% of the total sales" for general retail services in (a)(iii) are flexibly considered to be certified even without submitting the exact documents, taking into account that the examination according to the main paragraph of Article 3(1) of the Trademark Act is conducted to confirm the probability of using the trademark by the applicant, if other documents certify that the applicant deals in various goods, such as clothing, beverages, and commodities, and thereby the applicant is clearly a business operator of department stores, hypermarkets, or the like. However, if other documents show a substantial difference in the handling of the various goods relating to clothing, beverages, and commodities compared to the former documents, it should be noted that the weight placed on the respective documents is an important factor to judge the application.

Note: The range "around from 10% to 70%" is a result of consulting the definition of department stores or hypermarkets based on the business types according to the Census of Commerce conducted by the Ministry of Economy, Trade and Industry. The Census of Commerce requires department stores or hypermarkets to be "businesses retailing various goods across clothing, foods and housing, wherein the sales of each field account for around from 10% to 70% of the total sales."

3) Documents to confirm the applicant's intention to use the trademark  
(Part I, Chapter 2, Item 3 of the Examination Guidelines for Trademarks)

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

(a) Where an applicant, etc. shows his/her 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), the applicant is judged to be planning to start business connected with the designated goods or designated services.

(b) In order to confirm that an applicant, etc. is planning to start business connected with the designated goods or designated services, the examiner requires the applicant to submit documents specifying his/her intention of use of the trademark and documents stating his/her preparation status.

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

Appendices 1 and 2 show examples of the documents clearly showing the applicant's intention to use the trademark while Appendix 3 shows an example of the

documents stating this preparation status. These documents will be submitted in the form of written supplement of procedures or written submission of materials.

In addition, when the applicant does not clearly show his/her intention to use the trademark or examiners have doubts over the business plan, the examiner shall request, as needed, the applicant to submit any documents to support the implementation of the business and business plan. However, the applicant is allowed to conceal the desired sections of these documents which are unnecessary to support such information as far as his/her preparation status is supported since these sections are to be disclosed to the public according to the provisions of Article 72(1) of the Trademark Act.

4) Skipping the submission of "documents certifying the applicant's use or intention of use of the trademark" by the same applicant

i. Skipping the submission of certifying documents, and the criteria for determining the skipping

If the applicant already submitted "documents certifying the applicant's use or intention of use of the trademark" when he/she filed the other application before filing the application in question, and if he/she describes the application number of the application he/she filed before and the name of the certifying documents he/she submitted before in the written opinion, the applicant is allowed to skip submitting documents that certify he/she conducts the business connected to the designated goods or designated services, documents clearly showing the his/her use or intention of use of the trademark or documents stating his/her preparation status concerning the business (business plan).

In addition, when the document certifies that the applicant is conducting the business connected to the same designated goods or designated services as well as other designated goods or designated services covered by the same similar group code, the applicant may skip submitting documents that certify the applicant's use or intention of use of the trademark by stating the application number to be cited and the name of the document in the written opinion.

In this case, examiners shall confirm whether the applicant is conducting or is planning to conduct the business connected to the designated goods or designated services by analyzing the documents which were filed by the applicant when he/she previously filed another application. It should be noted, however, that examiners shall reconfirm the documents when they have reasonable doubts as to whether the applicant is conducting the business connected to the designated goods or designated services or the applicant will use the trademark within three or four years after he/she files the application (the time equivalent to the period of three years after the registration). Furthermore, when the applicant files another application later and claims that he/she once submitted the documents at the time of filing the former application, the applicant is allowed to skip submitting the documents, according to the form of the application

exemplified below:

(Example) Example of a description form of the application

The applicant should provide a section titled [Other information] in the application and describe the expressions "documents certifying the applicant's use or intention of use of the trademark," the "application number" of the former application and "names of the documents and the submission date" in the section.

[Other information] Documents certifying the applicant's use or intention of use of the trademark JPT2007-123456  
Written opinion (submitted on MM DD, 2007)

ii. Skipping the submission of certifying documents for some of the designated goods or designated services

When the applicant designates goods or services covered by 23 or more similar group codes under one class and the applicant has already proved the business connected to some of the designated goods or designated services by submitting the certifying documents when he/she filed a former application, the applicant is allowed to skip submitting another certifying document. However, when the applicant has other designated goods or designated services for which he/she has not yet proved the business connected to the goods or services, he/she has to prove the business for each similar group code even if these goods or services are covered by 22 or less similar group codes.

This approach is also applied to the case where the applicant designates multiple retail services which have no similarity, and the applicant has to certify the business connected to the retail services for each similar group code for which he/she has not proved the business yet.

(5) Determination of whether or not the business conducted by persons other than the applicant is found as the "business of the applicant"

See Item 41.100.05 of the Trademark Examination Manual, "Handling of an Application for Trademark Registration of Which Designated Goods or Designated Services are Those Pertaining to the Business of a Person Who is Substantially Recognized to Be under Control of the Applicant"

3. Procedures in lieu of submission of documents to confirm the applicant's use or intention of use of the trademark

When the application no longer falls under the "case where there are reasonable doubts" as a result of amending the application by deleting some of the designated goods or designated services for which the examiner found doubts about the use of the trademark in lieu of submitting documents certifying the applicant's use or intention of

use of the trademark, the application shall be handled as satisfying the requirements set forth in the main paragraph of Article 3(1) of the Trademark Act (see the following example).

<Example No. 1>

When an applicant receives a notification of reasons for refusal on the grounds that the application does not satisfy the requirements set forth in the main paragraph of Article 3(1) of the Trademark Act since the applicant designated goods or services covered by not less than 23 similar group codes under one class, and thus reduces the total number of similar groups for the designated goods or designated services to not more than 22 by submitting a written amendment deleting some of the goods or services.

<Example No. 2>

When an applicant receives a notification of reasons for refusal on the grounds that the application does not satisfy the requirements set forth in the main paragraph of Article 3(1) of the Trademark Act since the applicant designated multiple specific retail services in Class 35, and thus reduces the number of specific retail services to one by submitting a written amendment deleting some of the services.

Case clearly stating the applicant's intention to start using the trademark for some of the designated goods (designated services)

(Appendix 1)

Declaration of Intention to Start Using the Trademark	
<p>Currently, our company does not conduct the business connected to the designated goods or designated services, but we have a business plan to manufacture the designated goods "XX" or transfer the right to manufacture the designated goods "XX" including selling them, or a business plan to provide the designated services therefor, and we plan to start using the trademark around MM in YY.</p>	
<p>The above statement is true and correct.</p>	
	Date: day/month/year
<p>Applicant:</p>	
<p>    Address:</p>	
<p>    Name of Company:</p>	
<p>    Name of Representative: (Seal)</p>	

Case clearly stating the applicant's intention to start using the trademark for all of the designated goods (designated services) or all of the goods or services in one classification

(Appendix 2)

Declaration of Intention to Start Using the Trademark	
<p>Currently, our company does not conduct the business connected to the designated goods or designated services, but we have a business plan to manufacture the designated goods "XX" or transfer the right to manufacture the designated goods "XX," including selling them, or a business plan to provide the designated services therefor, and we plan to start using the trademark around MM in YY.</p>	
<p>The above statement is true and correct.</p>	
	Date: day/month/year
<p>Applicant:</p>	
<p>    Address:</p>	
<p>    Name of Company:</p>	
<p>    Name of Representative: (Seal)</p>	



(Appendix 3)

Business Plan	
Outline of the Plan	
MM, YY Plan to start construction of or borrow a plant or store	
MM, YY Plan to start manufacturing or selling goods	
	Date: day/month/year
Applicant:	
Address:	
Name of Company:	
Name of Representative:	

**4. When the examiner has reasonable doubts as to whether the applicant uses or has the intention to use the trademark due to the number of applications filed by the applicant in the past**

Even when the relevant application does not fall under 1.(1) or (2) above, if the following conditions set forth in (a) and (b) below are met, the examiner determines that the application is in violation of the main paragraph of Article 3(1) of the Trademark Act on the grounds that there is an extremely low probability for the applicant to use the trademark for the goods or services pertaining to his/her own business and there are reasonable doubts as to whether or not the applicant uses or has the intention to use the trademark. In addition, when the following conditions are met, even when the applicant has submitted a document certifying his/her intention to use the trademark, it is obvious that the applicant will not use the trademark for the goods or services pertaining to the applicant's business and thus, the reasonable doubts will not be resolved.

- (a) The applicant has filed an unconceivably high number of applications for a trademark to be used by a single applicant for the goods or services pertaining to his/her own business in consideration of the past number of applications filed by the applicant (not less than 1,000 applications per year).
- (b) The applicant's use or intention of use of the trademark cannot be confirmed from the applicant's website or broadcast, etc. (e.g. according to the applicant's website, the applicant is only found to be engaged in the sale or licensing of trademark, etc.).

**5. Date of commencement of application**

This handling applies from the date of publication (no transitional measures).

Attached document

## **Background to the Introduction and Revision of the Approach**

### (1) Retail services

In the process of the amendment of the Trademark Act for introducing the retail services system (2006 amendment, Act No. 55), a report, "Appropriate State of Trademark System" (published in February 2006) compiled by the Intellectual Property Policy Committee of the Industrial Structure Council showed the following concerns about unused trademarks:

"The Trademark Act requires an applicant to pay an application fee and registration fee based on one class of the goods or services connected to the application, and in the Nice Agreement stipulating international classifications of goods or services, businesses such as retail services are classified in Class 35. Therefore, according to the Agreement, an applicant is able to describe several services connected to retail services in one application for a single fee for one class (Class 35), and when an applicant designates multiple services for which the applicant does not have the intention to use the trademark, it is a concern that the application would comprehensively exclude other applicants' trademarks for goods that have the potential of being confused with such designated multiple services from being registered."

In addition, the Committee suggested that "it is considered to be proper that examiners should strictly apply the main paragraph of Article 3(1) of the Trademark Act to applications filed for registering trademarks used for services connected to retail services and that they should confirm the applicants' intention to use or the actual status of using the trademarks in question."

To achieve this purpose, the Examination Guidelines for Trademarks stipulates the application of the main paragraph of Article 3(1) of the Trademark Act to such applications and it has been applied to the applications filed on or after April 1, 2007.

### (2) Goods and services in general

An applicant who files an application for services other than goods or retail services is not able to transversely designate retail services relating to all goods at a fee for a single class (Class 35), and the amount of fee would increase proportionately to the number of goods or services the applicant designates under corresponding classes. Therefore, it is a lesser concern that an applicant may transversely designate many goods or services, which is different from applications for retail services. In addition, similar group codes for services other than goods or retail services are not provided based on the business types of business operators, which is another difference from

applications for retail services.

However, an applicant who files an application for services other than goods or retail services may designate a wide variety of goods or services under one class as far as possible since no additional fee is imposed on the applicant if he/she designates the same number of classes as those for regular goods or retail services. Therefore, examiners should consider the possibility that some applicants who filed for services other than goods or retail services may designate a wide variety of goods or services for unused trademarks as it is the case for retail services.

The report by the Intellectual Property Policy Committee of the Industrial Structure Council also suggests "It is considered to be proper that examiners should consider the appropriate procedures for applying the main paragraph of Article 3(1) of the Trademark Act to applications for trademark registration filed for registering trademarks designating services other than goods or retail services while considering the actual state of transaction or actual conditions of using the filed trademarks."

For this purpose, the Examination Guidelines for Trademarks stipulates that examiners should confirm the applicant's use or intention of use of the trademark when the applicant designates a wide variety of goods or services under one class, especially when, as a rough guideline, the applicant designates goods or services covered by eight or more similar group codes under one class from the viewpoint of securing examination consistency. This rough guideline is a result of considering the balance between the number of similar group codes covering the goods connected to retail services and the number of the applications.

However, more than 10 years have passed from the time when the examiners started using this approach in 2007 and various opinions had been raised by users such as, the method to count the number of similar group codes is complicated and difficult to understand, there is a difference in the number of similar group codes assigned to goods and services and thus is unfair, and there are cases where the applicant prefers to designate a wide range of goods or services as in the case of a house mark. Therefore, this approach had been reviewed as follows.

Similar group codes were decided to be simply counted based on the number of similar group codes assigned. For example, with respect to goods or services assigned with multiple similar group codes which had been counted as one in the past, all of the similar group codes assigned will be counted from now on.

In connection with this, as a rough guideline to determine whether goods or services are designated in a wide range within one classification, the examiner will make such determination when the applicant has designated goods or services covered by 23 or more similar group codes under one class. This rough guideline has been provided to correct the unfairness caused by the difference in the number of similar group codes assigned to goods and services and by taking into consideration the maximum number of similar group codes (22) assigned to one good (service) in the

Examination Guidelines for Similar Goods and Services, and by giving consideration so as to avoid a situation where the number of goods or services that may be designated under one class would become smaller than that in the past<sup>2</sup> due to the change in the method of counting.

In addition, with respect to documents clearly showing the applicant's intention to use the trademark, which the applicants were not allowed to skip in their submissions in the past, they can now skip them on the grounds that the probability to use the trademark can be found even when such documents have been submitted at the time of filing the earlier application by the same applicant.

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

Main paragraph of Article 3(1)

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<sup>2</sup> In the past approach, as a rough guideline to find that the applicant has designated a wide range of goods or services under one class, cases where the applicant had designated goods or services covered by eight or more similar group codes under one class were subject, in principle. However, the following steps were making the method to count the similar group codes complicated: (i) when there are no other appropriate indications for a single good or service assigned with a number of similar group codes, even if such good or service was covered by two or more similar group codes, the number of similar groups codes were counted one; and (ii) even in the case of goods or services which are indicated by general indications and assigned with two or more two similar group codes, they were treated as goods or services covered by one similar group code.