

46.01

Administration of Examinations of Unclearly Designated Goods or Services

Concept for Examination of Unclearly Designated Goods or Services

In cases where either the content or scope of the designated goods or designated services described in the written application is unclear, the examiner will order the applicant to present a written submission of materials or to make an amendment to clarify the designated goods or designated services, in the past administration. If the applicant does not then present a written submission of materials or written amendment, an order for submission of a written amendment will be sent to the applicant in the name of the Commissioner of the Patent Office. If this also met with no response, the application for trademark registration will be dismissed.

However, this method of ordering a written submission of materials wasted a considerable amount of time before the goods or services could either be properly amended or before the application could be dismissed due to the lack of amendment, given that the procedure required not only an order in the name of the examiner, but also another order to the same effect in the name of the Commissioner of the Patent Office. Thus, it was fraught with problems in terms of speeding up the examination process.

Moreover, the examination of whether or not the content or scope of designated goods or designated services described in the written application is clear requires technical knowledge, so this could essentially be regarded as a matter for substantive examination by the examiner, rather than that for a formal examination by the Commissioner of the Patent Office. (There is an appeal precedent where the application in question was handled by applying Article 6(1) of the Trademark Act before the revision, based on the same purport (Appeal No. 8314 of 1984).)

Meanwhile, the means of remedy against the dismissal by the Commissioner of the Patent Office is to file complaints under the Administrative Complaint Review Act. However, as mentioned above, technical knowledge is required to handle a dispute on the content or scope of designated goods or designated services, so such cases should be dealt with by the JPO's trial or appeal procedures rather than by procedures under the Administrative Complaint Review Act that instead apply to general administrative measures.

Therefore, cases in which the content or scope of designated goods or designated services described in the written application are unclear shall be handled, in principle, by sending a notification of reasons for refusal instead of ordering the presentation of a written submission of materials or a written amendment. The specific examination processes shall be based on the following policy.

(Reference) Flowchart of the processes for examination of unclearly designated goods or services

1. In cases where the designated goods or designated services described in the written application are unclear and the classification of the goods or services described in the written application cannot be determined to conform to the classification specified by Cabinet Order, the application for trademark registration shall not comply with the requirements provided in Article 6(1) and (2) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

Grounds for not satisfying the requirements provided in Article 6(1) and (2) of the Trademark Act

Article 6(1) of the Trademark Act provides “designate ... goods or services ... to be used,” and the paragraph requires the applicant to designate goods or services for which the trademark will be used when filing an application for trademark registration.

Also, the content and scope of this “designation” must be clear, since the goods or services described in the written application not only determine the scope of the trademark, but also the scope of the application for trademark registration or the trademark right.

Therefore, when the content or scope of the designated goods or designated services is unclear, the application for trademark registration does not comply with the requirement in this paragraph due to an insufficient “designation” of goods or services.

There are cases where, because the designated goods or designated services described in the written application are unclear, it is not possible to determine whether the designated goods or designated services fall under the classification described in the written application. The application for trademark registration does not comply with the requirements provided in Article 6(2) of the Trademark Act in such cases, because it is difficult to determine whether the designation of goods or designated services complies with the classification specified by Cabinet Order (Note).

The main paragraph of Article 3(1) of the Trademark Act provides that trademarks used for “goods or services pertaining to the business of an applicant” can be registered. Therefore, when the designated goods or designated services described in the written application are unclear, it will be deemed that the “goods or services pertaining to the business of an applicant” prescribed in that paragraph are unclear, thus, it will not be illegal to refuse the application for trademark registration for not complying with the requirements prescribed in the main paragraph of Article 3(1) of the Trademark Act. However, since the provision of this paragraph is not stipulated as directly as that of Article 6(1) of the Trademark Act, it would be more appropriate to refuse the application for not complying with the requirements prescribed in Article 6(1) of the Trademark Act.

Since Article 6(2) of the Trademark Act obligates the applicant to abide by the classification specified by Cabinet Order when designating goods or services based on the provision of paragraph (1) of that Article, the provision of Article 6(2) of the

Trademark Act should be applied in cases where the classification of goods or services described in the written application is unclear or different from the actual classification of the goods or services, and not to cases where the designated goods or designated services themselves are unclear.

(Note) Requirement on administration

In cases where the designated goods or designated services are unclear and the described classification of the goods or services cannot be found to conform to the classification specified by Cabinet Order, and where a notification of reasons for refusal is sent for not complying with the requirement prescribed in only Article 6(1) of the Trademark Act, it will be necessary for the JPO to send another notification of reasons for refusal for not complying with the requirement prescribed in Article 6(2) of the Trademark Act in cases where the classification is found to be different at a later stage.

Nevertheless, if a notification of reasons for refusal is sent for not complying with the requirements prescribed in both Article 6(1) and (2) of the Trademark Act from the very first, it is assumed that the applicant would amend both designated goods or designated services and their classification at the same time. Administering the case in this way is therefore considered desirable for realizing expeditious examination processes.

2. In cases where the designated goods or designated services described in the written application are unclear but the classification of the goods or services described in the request can be found to conform to the classification specified by Cabinet Order, the application for trademark registration shall be deemed not to comply with the requirement prescribed in Article 6(1) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

For example, when the designated goods are described as “Class 12: Automobiles and other goods belonging to this class,” the description cannot be approved as the indication of the designated goods because the content and scope of goods are unclear. In this case, the scope of designated goods is handled with the stance that the goods within the scope belonging to Class 12 are designated by the term “goods belonging to this class”, of course including the term “automobiles.”

Therefore, in such cases, a notification of reasons for refusal shall be sent to the applicant for not satisfying the requirement prescribed in only Article 6(1) of the Trademark Act.

3. In cases where the applicant submits a written opinion or written submission of materials solely consisting of the explanation of goods, etc. against the notification of reasons for refusal mentioned in 1. or 2. above, the examiner takes into account the written argument or written submission of materials, and orders the applicant to amend the designated goods or designated services by, for example, indicating a draft amendment (order for amendment under the name of the examiner).

When the applicant does not respond to such order for amendment or does not make any appropriate amendment, etc., that application for trademark registration shall be refused based on the earlier reasons for refusal.

[Explanation]

For example, when the designated goods described in the written application are new goods, etc. that have never been distributed on the market, it may often be difficult for the applicant to indicate the goods in his/her application.

In such cases, the applicant may be able to explain the use, function, materials, etc. of the goods, but it is often difficult for the applicant to actually make an immediate accurate amendment of the goods in response to the reasons for refusal. Thus, it may be too harsh to immediately refuse the application for reasons that the applicant has not made the amendment.

Therefore, when the applicant submits a written opinion or written submission of materials solely consisting of the explanation of the goods, and even if documents do not resolve the reasons for refusal, the application will not be immediately refused.

In such cases, the examiner will sufficiently take into account the explanation of the goods described in the written opinion or written submission of materials, and order, under its name, the applicant to amend the designated goods by, for example, indicating a draft amendment.

However, if the applicant does not respond in any way or does not amend the designated goods, the examiner shall refuse the application based on the earlier reasons for refusal.

The examiner shall explain the details related to the reasons for refusal or the order for amendment, or give instruction and advice on how to respond, by interviewing or phoning the applicant or the agents required, and encourage the submission of an appropriate written amendment, etc.

4. In cases where the designated goods or designated services described in the written application are clear, but the classification of goods or services designated in the written application does not conform to the classification specified by Cabinet Order, the application for trademark registration shall be deemed not to satisfy the requirement prescribed in Article 6(2) of the Trademark Act, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

When the designated goods or designated services described in the written application are clear, but there is an error in the classification of the goods or services, for example, when the classification of the goods or services does not conform to the classification specified by Cabinet Order (Article 2 of the Enforcement Order of the Trademark Act (Cabinet Order)), as in the case where the description is “Class 20: Confectionery” instead of “Class 30: Confectionery,” the application for trademark registration shall be deemed not to satisfy the requirement prescribed in Article 6(2) of the Trademark Act, as in the past, and a notification of reasons for refusal shall be sent to the applicant.

5. Applications filed before the 1996 Amendment Act entered into force shall be handled in the same manner as from 1. to 4. mentioned above, based on Article 6(1) of the Trademark Act before the revision.

[Explanation]

Article 3 of the Supplementary Provisions of the Act for Partial Revision of the Trademark Act, etc. (Act No. 68 of 1996) provides that prior laws continue to govern examinations concerning designated goods or designated services in applications filed before the 1996 Amendment Act entered into force. However, since there are no particular reasons to handle these differently from the applications filed after the Act enter into force, such applications shall be handled in the same manner as from 1. to 4. mentioned above. In cases where a written submission of materials has already been made or amendment has been ordered under the name of the examiner for an application filed before the Act entered into force, but where the application still does not satisfy the requirement prescribed in Article 6(1) of the Trademark Act before the revision, a notification of reasons for refusal shall be sent to the applicant, in principle.

6. Unclear designated goods and/or services or unclear classification of goods and/or services in an international application for trademark registration shall be handled as follows.

(i) When the designated goods and/or services are recognized to be unclear, the examiner will send a notification of reasons for refusal on the grounds that the requirement prescribed in Article 6(1) of the Trademark Act has not been satisfied and shall request that the applicant to amend the respective designated goods and/or services so that they are clearly described.

However, when the content and scope of the goods and/or services are clear from the indication of each item of designated goods and/or services, the indication is accepted as the indication of the designated goods and/or services of the respective application, in principle, even if the designated goods and/or services are overlapped.

(ii) The classification of the goods and/or services shall follow the classification described in a notification of designation. When classification is found to be apparently erroneous, the examiner confirms this with the International Bureau.

(iii) Handling described in Item 3. above applies mutatis mutandis to international applications for trademark registration.

[Explanation]

(1) In respect to the indication of the designated goods and/or services, when the content and scope of the designated goods and/or services are unclear from the indication of designated goods and/or services in an international application for trademark registration (including the name of the goods and/or services on the classification table and the alphabetical list of International Classification), the JPO shall send a notification of reasons for refusal on the grounds that the requirement prescribed in Article 6(1) of the Trademark Act has not been satisfied, and shall request that the applicant amend the designated goods and/or services to clarify the content and scope. (In this case, goods and/or services that are found to be unclear, even though published in the alphabetical list of International Classification, shall be the goods and/or services indicated with * in the remark column of the “Japanese translation of the alphabetical list of the International Classification List of Goods and Services (with group codes for similar items)” based on the Nice Classification” for the time being.)

However, since the goods and/or services designated by an international registration have already been classified and examined by the International Bureau, the international registration notified to our country and recognized as an international application for trademark registration shall be basically dealt with in deference to the indicated classification and examination. When the indication of each item of the designated goods and/or services clarifies the content and scope of the goods and/or services, it is recognized as the indication of the designated goods and/or services of the respective application in principle, even if the designated goods and/or services overlap.

(2) Since the International Bureau has already examined whether or not the designated goods or designated services are indicated according to the classification of the goods and services, there is no need to examine this in the designated Contracting Party. Even if the examiner in charge finds doubt in the designated classification, the examiner shall follow the classification specified by the International Bureau and confirm this with the International Bureau only when an obvious error is recognized.

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

Examination Guidelines for Trademarks: Article 6 (Single trademark on each application)

(Reference)

