

# Information on Procedures before the Office of the designated Contracting party for Madrid Protocol Applicants

December 2015

		JAPAN (JPO)
1. When filing an application: Points to be noted when filling an MM2 format		
1.1 Applicant (Item 2 of MM2)		
1.1.1	Points to be noted when writing information about an applicant (Item 2(a), (b) and (f) of MM2 or of any equivalent form or equivalent electronic form)	
1.2 Claim of priority (Item 6 of MM2)		
1.2.1	Is partial priority allowed, which is a claim of priority based on part of a basic application? (Yes/No)	YES
1.2.2	Are multiple priorities allowed, which is a claim of priority based on multiple basic applications? (Yes/No)	YES
1.3 Mark (Item 7 to 9 of MM2)		
1.3.1	Category of marks which can be registered (e.g. collective mark, certification mark guarantee mark)	Collective trademarks (collective and regional collective trademarks) Certificate trademarks (any of normal, collective or regional collective trademarks may be relevant certificate trademarks for international registration).
1.3.2	Are there certificates required according to category specified in Item 1.3.1? (Yes/No) If a required certificate exists, time and method of submission	YES (a certificate provided for in Article 7(3) of the Japanese Trademark Act (which is a document certifying that an applicant in question is a juridical person that falls under Article 7(1) of the Japanese Trademark Act) and a certificate provided for in Article 7-2(4) of the Japanese Trademark Act must be submitted). Submission period: The certificate mentioned above can be submitted after a request for territorial extension related to the application is made. If the certificate is not submitted, it constitutes a reason for refusal of the territorial extension. If the certificate is not submitted within a period prescribed in a notification of provisional refusal of the territorial extension, the refusal shall become

		<p>final and binding.</p> <p>Submission scheme: The certificate must be submitted directly to the JPO.</p>
1.3.3	Types of non-traditional trademarks that are eligible for registration (three-dimensional, sound, single color, position, trade dress, etc) and their requirements.	Three-dimensional, sound, color, position, motion and hologram marks
1.3.4	Is description of a mark required? (Yes/No) If yes, examples of such a description	<p>Descriptions are required for motion, hologram and position marks. For color marks, “COLOR CLAIMED” or “description” sections must be provided.</p> <p>If an application requests territorial extension covering Japan and if the application is filed for a motion, hologram, color or position mark, what should be described in a “description” section of the International Register shall be regarded as what is described in a “detailed description of the trademark” section which is necessary to understand the meaning of a trademark described in the application’s trademark description section.</p> <p>To see examples of such descriptions, refer to Article 5 (Applications for trademark registration) in Chapter IV of the Examination Guidelines for Trademarks.</p>
1.3.5	What an applicant should do if he/she is required to provide a description of his/her mark in question, but such a description cannot be specified in a MM2 format?	An amendment can be made (whose written amendment must be directly submitted to the JPO) to add or correct what was described in an application (Article 68-40 of the Japanese Trademark Act).
1.3.6	Is there a standard character system? (Yes/No) If yes, what characters belong to the system? (Item 7(c) of MM2)	NO ( <a href="https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/19-71.pdf">https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/19-71.pdf</a> )
1.3.7	Points to be noted for Item 8 of MM2 (COLOR CLAIMED)	<p>For a color mark, a “COLOR CLAIMED” or “description” section must be provided.</p> <p>If an application requests territorial extension covering Japan and if the application is filed for a color trademark, what should be described in a “COLOR CLAIMED” or “description” section of the International Register shall be regarded as what is described in a “detailed description of the trademark” section which is necessary to understand the meaning of a trademark described in the application’s trademark description section.</p> <p>To see examples of such descriptions, refer to Article 5 (Applications for trademark registration) in Chapter IV of the Examination Guidelines for Trademarks.</p>
1.3.8	Points to be noted for Item 9 of MM2	

	(MISCELLANEOUS INDICATIONS)	
1.4 Description of goods and services (Item 10 of MM2)		
1.4.1	Points to be noted for describing designated goods and services	<p><u>Nice Classification</u></p> <p>The Office does not accept the following terms of the Class Headings for the following classes:</p> <p>1: Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry;</p> <p>6: Ironmongery, small items of metal hardware; goods of common metal not included in other classes;</p> <p>7: Machines and machine tools;</p> <p>9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments;</p> <p>12: Vehicles; apparatus for locomotion by land, air or water;</p> <p>14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes;</p> <p>16: Paper, cardboard and goods made from these materials, not included in other classes;</p> <p>17: Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; packing, stopping and insulating materials;</p> <p>18: Leather and imitations of leather, and goods made of these materials and not included in other classes;</p> <p>20: Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics;</p> <p>24: Textiles and textile goods, not included in other classes;</p> <p>31: Grains and agricultural, horticultural and forestry products not included in other classes;</p> <p>36: Financial affairs; monetary affairs;</p> <p>37: Repair;</p> <p>40: Treatment of materials;</p>

		<p>41: Sporting and cultural activities;</p> <p>42: Scientific and technological services and research and design relating thereto;</p> <p>45: Personal and social services rendered by others to meet the needs of individuals.</p> <p>The JPO provides the Nice Alphabetical List with Japanese translation and Similar Group Codes. The Similar Group Codes group goods/services that are in principle presumed to be similar to each other in terms of trademark examination at the JPO. These groupings are available in the Examination Guidelines for Similar Goods and Services. The guidelines are made based on comprehensive criteria such as production sector, sales sector, materials, intended purpose, targeted consumers and other factors associated with the respective goods/services. This uniform standard not only enables examiners to conduct efficient searches and consistent examination, but also enhances predictability of determination on the similarity of goods/services for the applicants.</p> <p>For details, please refer to the following two URLs.          Alphabetical List in Japanese Translation with Similar Group Code          Examination Guidelines for Similar Goods and Services (corresponding to the 10-2013th edition of the international classification)</p>
1.4.2	A link to a website to verify whether indications of goods and services are acceptable to an Office	<p>J-PlatPat          (<a href="https://www2.j-platpat.inpit.go.jp/SH1/sh1e_search.cgi?TYPE=000&amp;sTime=1440122953598">https://www2.j-platpat.inpit.go.jp/SH1/sh1e_search.cgi?TYPE=000&amp;sTime=1440122953598</a>)</p>
<b>1.5 Declaration of intention to use marks</b>		
1.5.1	Is a declaration of intention to use a mark in question required? (Yes/No) If required, how to submit such a declaration	No
<b>1.6 Additional features</b>		
1.6.1	(If any [ex. Seniority])	<p>The JPO does not request a declaration of intention to use a trademark to be submitted when the trademark's application is filed. However, if it has a "reasonable doubt" about whether the trademark will be actually used or intended to be used for designated goods or services described in the application, it applies the main paragraph of Article 3(1) of the Japanese Trademark Act to the application (refer to "Principal Paragraph of Article 3(1)" in Part 2 of the Examination Guidelines for Trademarks, and "Approach for Analyzing an Application for Confirming the Applicant's Use or Intention of Use of a Trademark" in Trademark Examination Manual 41.100.03).</p>
<b>2. Procedures after a notification of the territorial extension is received at an Office of a Contracting Party</b>		
<b>2.1 Gazettes published by an Office</b>		

2.1.1	Are gazettes published by an Office? (Yes/No)	Yes
2.1.2	If yes, what are included in gazettes?	<p><u>Publication of Unexamined Trademark Application (Article 12-2(2))</u></p> <ul style="list-style-type: none"> <li>• The name and the domicile or residence of the applicant for trademark registration</li> <li>• The number and date of the application for the trademark registration</li> <li>• The trademark stated in the application</li> <li>• The designated goods or designated services</li> <li>• Other necessary matters</li> </ul> <p><u>Publication of Registered Trademark (Article 18(3))</u></p> <ul style="list-style-type: none"> <li>• The name and the domicile or residence of the holder of trademark right</li> <li>• The number and date of the application for trademark registration</li> <li>• The trademark stated in the application</li> <li>• The designated goods or designated services</li> <li>• The registration number and the date of registration of establishment</li> <li>• Other necessary matters</li> </ul> <p><u>Others (Article 75)</u></p> <ul style="list-style-type: none"> <li>• Information on amendments made to designated goods or services stated in a request, etc. after laying open of the application</li> <li>• Information on the extinguishments of trademark rights</li> </ul>
2.1.3	If yes, is there a link to a website?	Official Publication Website ( <a href="https://www.publication.jpo.go.jp/ik_pub/changeLocale.action;jsessionid=FFB0100CAC9D719B37490DAE7450B713.jvm1">https://www.publication.jpo.go.jp/ik_pub/changeLocale.action;jsessionid=FFB0100CAC9D719B37490DAE7450B713.jvm1</a> )
<b>2.2 Substantive examination</b>		
2.2.1	Does an Office conduct substantive examination? (Yes/No)	Yes.
2.2.2	If substantive examination is conducted, will there be an <i>ex officio</i> examination under i) absolute and ii) relative	A JPO trademark examiner makes examination ex officio with regard to both absolute and relative reasons for refusal.

	grounds for refusal be examined by <i>ex officio</i> ?	
2.2.3	Does an Office issue partial refusals?	No. Even if a reason for refusal of an application is applicable to only parts of designated goods or services stated in the application, the whole application shall be refused.
2.2.4	Information on examination standards (a link to a website)	Examination Guidelines for Trademarks <a href="https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-002.htm">https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-002.htm</a>
<b>2.3 Opposition</b>		
2.3.1	i) A starting date and ii) a period to file an opposition	i) The date when a Publication of Registered Trademark containing the trademark is published ii) Within 2 months after the date mentioned above
2.3.2	Who can raise an opposition?	Anyone can oppose the grant of a trademark registration.
2.3.3	Can an opposition be filed before or after a statement of grant of protection is sent? Such a statement is based on Rule 18ter of the Common Regulations.	An opportunity to oppose the grant of a trademark registration is provided after a statement of grant of protection is sent.
<b>2.4 Third party observations/ Information submission system</b>		
2.4.1	Is there third party observations/ information submission system?	A scheme is provided for third parties to provide information.
2.4.2	If yes, i) A starting date and ii) a period to submit observations/ Information?	i) The date when an application to register a trademark is filed for which information provision is sought ii) While the application to register the trademark is pending before the JPO
2.4.3	If yes, Person who can submit observations/information?	Anyone can provide information.
<b>2.5 Notification of provisional refusal</b>		
2.5.1	Languages used to notify a provisional refusal	English.
2.5.2	A period between a day when a notification of territorial extension was sent to an Office and a day when a notification of	18 months.

	a provisional refusal is sent (12/18 months)	
2.5.3	Is there a declaration made in accordance with Article 5(2)(c) of the Madrid Protocol? (Yes/No) Note: Notification of that such a provisional refusal may be notified based on opposition after the lapse of period of 18-month	No
2.5.4	An average processing time between a day when territorial extension is notified and a day when a First Office Action is made	All applications: 4.1 months Madrid protocol applications: 6.28 months
2.5.5	i) A starting date, ii) a period and iii) an ending day of a time limit to respond to a notification of a provisional refusal. Note: Examples of “i) a day on which the computation begins” are a day when an Office sent a notification of a provisional refusal; a day when the International Bureau sent a notification of a provisional refusal; and a day when a holder received a notification of a provisional refusal. Note: Examples of “iii) an ending day” are a day when a holder sent his/her response; and a day when an Office received a	i)The day following the date when the JPO sent reasons for refusal  ii)Within 3 months after the reasons for refusal were sent  iii)The day when a response to the reasons for refusal is sent If it is sent via mail or correspondence (the day when the JPO is open again following the last date to respond to the reasons for refusal if the last date is Saturday, Sunday or a national holiday)

	response.	
2.5.6	Is it possible to extend a time limit to respond to a notification of a provisional refusal? (Yes/No) If yes, how long such a time limit can be extended, and how can such an extension be requested?	Yes A period to respond to reasons for refusal can be extended by a month only once if such extension is requested beforehand.
2.5.7	Is it always necessary to arrange a local representative when responding to a notification of a provisional refusal? (Yes/No)	Yes In principle, a local representative is necessary to respond to reasons for refusal. However, no local representative is necessary if the domicile or residence of an applicant who must respond to the reasons for refusal is in Japan.
2.5.8	Can a holder directly submit his/her response to an Office when responding to a notification of a provisional refusal? (Yes/No)	No In principle, an applicant cannot directly submit a response to reasons for refusal to the JPO. However, the applicant can directly submit the response to the JPO if the domicile or residence of the applicant is in Japan.
2.5.9	Can submitting a MM6 form to request a limitation be regarded as a domestic procedure for amendment? (Yes/No)	Yes
2.5.10	If a MM6 submission is regarded as a response to a provisional refusal, are there any points to be noted such as a time limit for submission? (For example, such points may include that a MM6 form must be filled and submitted to the IB within a time limit to respond to	Notwithstanding the period described in Section 2.5.5 above, a MM6 form can be sent to WIPO's International Bureau to amend designated goods and services stated in an application if the application is still pending before the JPO. In such a case, because a JPO examiner in charge of the application does not know the fact that the amendment was sent to WIPO's International Bureau, the examiner may decide to refuse the application based on the ground that a response to reasons for refusal of the application was not submitted within a prescribed, if WIPO's International Bureau did not notify the JPO of the amendment in time. To avoid such decision, the applicant must send a FAX message to the examiner stating that such a MM6 form was submitted to WIPO's International Bureau if the form was submitted to WIPO's International Bureau.  Reference Following JPO HP in English: <a href="http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm">http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm</a>



	a notification of a provisional refusal, or that a notification of a limitation must be sent from the IB to an Office within a time limit of response.	Item Number 5.(ii)
<b>2.6 Trial/Appeal against examiner's decision of refusal</b>		
2.6.1	When can demand for an appeal against examiner's decision of refusal be made?	Within 3 months after a decision of refusal was sent
2.6.2	What is the competent authority for such appeal?	Trial and Appeal Department, JPO
2.6.3	Information on appeal against examiner's decision of refusal (a link to a website)	(JPO Website in Japanese) <a href="https://www.jpo.go.jp/seido/tokkyo/tetuzuki/shinpan/kyozetu/index.html">https://www.jpo.go.jp/seido/tokkyo/tetuzuki/shinpan/kyozetu/index.html</a>
<b>3. Procedures after confirmation of grant of protection in designated contracting parties</b>		
<b>3.1 Registration</b>		
3.1.1	Other than a statement of grant of protection which is a notification based on Rule 18ter of the Common Regulations, is any notification of a decision of registration sent based on domestic laws? (Yes/No) If yes, to whom (a holder/an IB representative) will it be sent?	Yes A statement of grant of protection will be sent to an applicant in question (or his or her representative in Japan).
3.1.2	i) Is a registration certificate automatically issued? (Yes/No) If yes, to whom (a holder/ an IB representative) will it be sent? ii) If a certificate is not issued automatically, is it	Yes A registration certification will be sent to an applicant in question (or his or her representative in Japan).

	possible to make a request so that a certificate will be issued? (Yes/No) If yes, how will it be requested?	
3.1.3	Points to be noted for registration (For example, payment of fee)	The JPO adopts a two-step system for fee payment. Therefore, an applicant must pay to the International Bureau a first step individual fee when a mark's application for international registration and subsequent designation are made, as well as a second step individual fee after the protection of the mark is granted based on examinations done by the respective Offices of designated Contracting Parties.
3.1.4	Points to be noted for the purpose of maintaining the registration such as submitting a affidavits of continued use in commerce	
<b>3.2 Replacement</b>		
3.2.1	Does an Office require a request to operate procedure for 'taking note' of an international registration?	<p>The JPO records an "overlap" in the JPO's register ex officio, and the JPO does not request any application to be submitted for an overlap.</p> <p>On the other hand, to record a replacement in the International Register, an application for the replacement must be submitted to the JPO.</p> <p>Recording of overlap in the National Register takes place ex officio under Article 68decies of the Japanese Trademark Law.</p> <p>Recording of replacement in the international register takes place upon written request filed with the Office. No fees are required.</p>
3.2.2	Timing when a request to operate procedure for 'taking note' of an international registration is allowed (while an application being processed, post-registration, etc.)	An application can be submitted any time.
3.2.3	Does it cost to "take note"?	No cost may be incurred.
3.2.4	When will it be decided to replace a registration in question?	A JPO trademark examiner makes a judgment on a replacement when he or she conducts a substantive examination.
3.2.5	Can a replaced national registration and an international registration coexist?	They coexist.

4. Others		
4.1 Trial/Appeal for invalidation		
4.1.1	Time period for filing an invalidation	A trial can be demanded any time. However, for specific grounds for invalidation, no trial can be demanded 5 years after the date when a registration to establish a trademark right in question was made, or later.
4.1.2	Person who can demand a trial/appeal for invalidation	Interested parties
4.1.3	What is the competent authority for such trial/appeal?	Trial and Appeal Department, JPO
4.1.4	Procedure relating to a trial/appeal for invalidation (a link to a website)	(JPO Website in Japanese) ( <a href="https://www.jpo.go.jp/seido/tokkyo/tetuzuki/shinpan/mukou/index.html">https://www.jpo.go.jp/seido/tokkyo/tetuzuki/shinpan/mukou/index.html</a> )
4.2 Trial/Appeal for cancellation of registered trademark not in use		
4.2.1	Time period for filing a non-use cancellation	A trial can be demanded any time.
4.2.2	Person who can demand a trial/appeal for cancellation of registered trademark not in use	Anyone can demand a trial.
4.2.3	What is the competent authority for such trial/appeal?	Trial and Appeal Department, JPO
4.2.4	Procedure relating to a trial/appeal for cancellation of registered trademark not in use (a link to a website)	(JPO Website in Japanese) ( <a href="http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/guideline_for_grounds.htm">http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/guideline_for_grounds.htm</a> )
4.3 Trial/Appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee		
4.3.1	Time period for filing an unfair use cancellation	A trial can be demanded any time.
4.3.2	Person who can demand a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	Anyone can demand a trial.
4.3.3	What is the competent	Trial and Appeal Department, JPO

	authority for such trial/appeal?	
4.3.4	Procedure relating to a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	(JPO Website in Japanese) <a href="http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/guideline_for_grounds.htm">http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/guideline_for_grounds.htm</a>
4.4 Other information relating to a trial/appeal		
4.4.1	Other information relating to a trial/appeal	
4.5 Invalidation of the effects of an international registration in part or in whole		
4.5.1	Where the effects of an international registration in a designated Contracting Party are cancelled in part or in whole because of a trial/appeal for invalidation etc, the timing when a notification of invalidation per Rule 19 of the Common Regulations will be sent to the International Bureau	The JPO notifies the International Bureau of invalidation about one month after a trial decision of the invalidation was made.
4.6 Transformation of an international registration into national or regional applications under Article 9quinquies of Madrid Protocol		
4.6.1	Points to be noted for transformation (If any) An amount of a fee if such a fee needs to be paid	<p>If the international mark has not been granted protection in Japan on or before the date of cancellation, the Office examines the application resulting from transformation as to absolute and relative grounds and the following fees are to be paid to the JPO:</p> <p>a) Filing fee: 3,400 JPY plus 8,600 JPY per class. b) Registration fee: 37,600 JPY per class payable at the time of registration.</p> <p>If the international mark has been granted protection in Japan on or before the date of cancellation, the Office examines whether other requirements are met, and then the following fees are to be paid: Filing fee: 3,400 JPY + 8,600 JPY per class.</p>
4.7 Additional features		
4.7.1	(If any [ex. Conversion])	
5. Madrid Protocol declarations		

5.1	Article 5(2)(b) of the Protocol (extension to 18 months of the refusal period) (Yes/No)	Yes
5.2	Article 5(2)(c) of the Protocol (possible notification of refusals based on an opposition after the 18-month time limit) (Yes/No)	No
5.3	Article 8(7)(a) of the Protocol (individual fees) (Yes/No)	Yes
5.4	Article 9 <sup>quater</sup> of the Agreement and that of the Protocol (Common Office of several Contracting States) (Yes/No)	No
5.5	Article 14(2)(d) of the Agreement (in respect of international registrations effected under the Agreement prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	No
5.6	Article 14(5) of the Protocol (in respect of international registrations effected under the Protocol prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	No
5.7	Rule 7(2) of the Common Regulations (declaration of intention to use the mark) (Yes/No)	No

5.8	Rule 17(5)(d) of the Common Regulations (notwithstanding the fact that all procedures before the Office may not have been completed, notification to the International Bureau by the Office of decisions concerning refusals) (Yes/No)	No
5.9	Rule 17(5)(e) of the Common Regulations ( <i>ex officio</i> provisional refusals not open to review before the Office) (Yes/No)	No
5.10	Rule 20 <i>bis</i> (6)(a) of the Common Regulations (recording of licenses not provided for in the domestic law, so that the recording of licenses in the International Register has no effect) (Yes/No)	No
5.11	Rule 20 <i>bis</i> (6)(b) of the Common Regulations (recording of licenses provided for in the domestic law, but the recording of licenses in the International Register has no effect) (Yes/No)	Yes
5.12	Rule 34(2)(b) of the Common Regulations (the Office accepts to collect and forward fees to the International Bureau) (Yes/No)	No
5.13	Rule 34(3)(a) of the	Yes

	Common Regulations (individual fee payable in two parts) (Yes/No)	
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