

**QUESTIONS AND ANSWERS
REGARDING JAPANESE TRADEMARK PRACTICE
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by the International Activities Center of
the Japan Patent Attorneys Association¹

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¹ The members of the International Activities Center on this project are Kanji FUJIYOSHI, Fujihiko KANDA, Shuhei KATAYAMA, Yoshihiko KIDO, Hiroshi KOBAYASHI, Tomoya KUROKAWA, Nobuyuki NISHIKAWA, Takeshi NONAKA, Toshiharu OGAWA, Makoto ONDA, Yoko SAKUMA and Yasumitsu SUZUKI.

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I. Application

Q1. What kinds of marks are registerable as trademarks in Japan?

A1. Registerable marks include any characters, figures, signs or three-dimensional shapes, or any combination thereof, or any combination thereof with colors. Color itself (including a combination of colors without being combined with characters, figures or the like), sound and smell cannot be registered as trademarks.

Q2. What is required to file a trademark application in Japan?

A2. The information required for a trademark application includes the following:

- (1) the mark for which registration is sought;
- (2) the designated goods or services and the International Class to which said goods or services belong; (Note: A multi-class application is possible. It should also be noted that the Class Heading of the Nice Agreement may not be acceptable as designated goods/services by the JPO. In the case of a designating broad range of goods/services in one class, proof of use of the trademark or intent to use may be required during the examination.)
- (3) the name and the domicile or residence of the applicant for trademark registration;
- (4) a power of attorney is not required at the time of filing, but is necessary when you abandon/withdraw the application or file an appeal or the like.
- (5) when claiming priority from the filing date of a first trademark application, the filing date, the country name and the filing number are required. A priority document has to be filed within 3 months from the filing date.

Q3. How does the application proceed?

A3. As the application is filed, both a formality examination and a substantive examination are held.

At the substantive examination, the existence of either absolute or relative grounds for refusal is determined.

It takes about 6 or 7 months until the first Office Action is issued.

If there is no reason for refusal in the application, a decision of registration is issued, and registration of the trademark right comes into force after payment of the registration fee. All together, it should take 8 or 9 months from the filing date until registration of the trademark right, at the earliest.

If there is a reason for refusal in the application, the Examiner issues an Office Action. In other words, a notification of reasons for refusal is sent. Against the Office Action, the applicant may file an argument and/or an amendment to overcome the reasons for refusal within the response term allowed by the Office Action. The response term for an Office Action for a resident abroad is 3 months. A one-month extension is obtainable by paying the official fee.

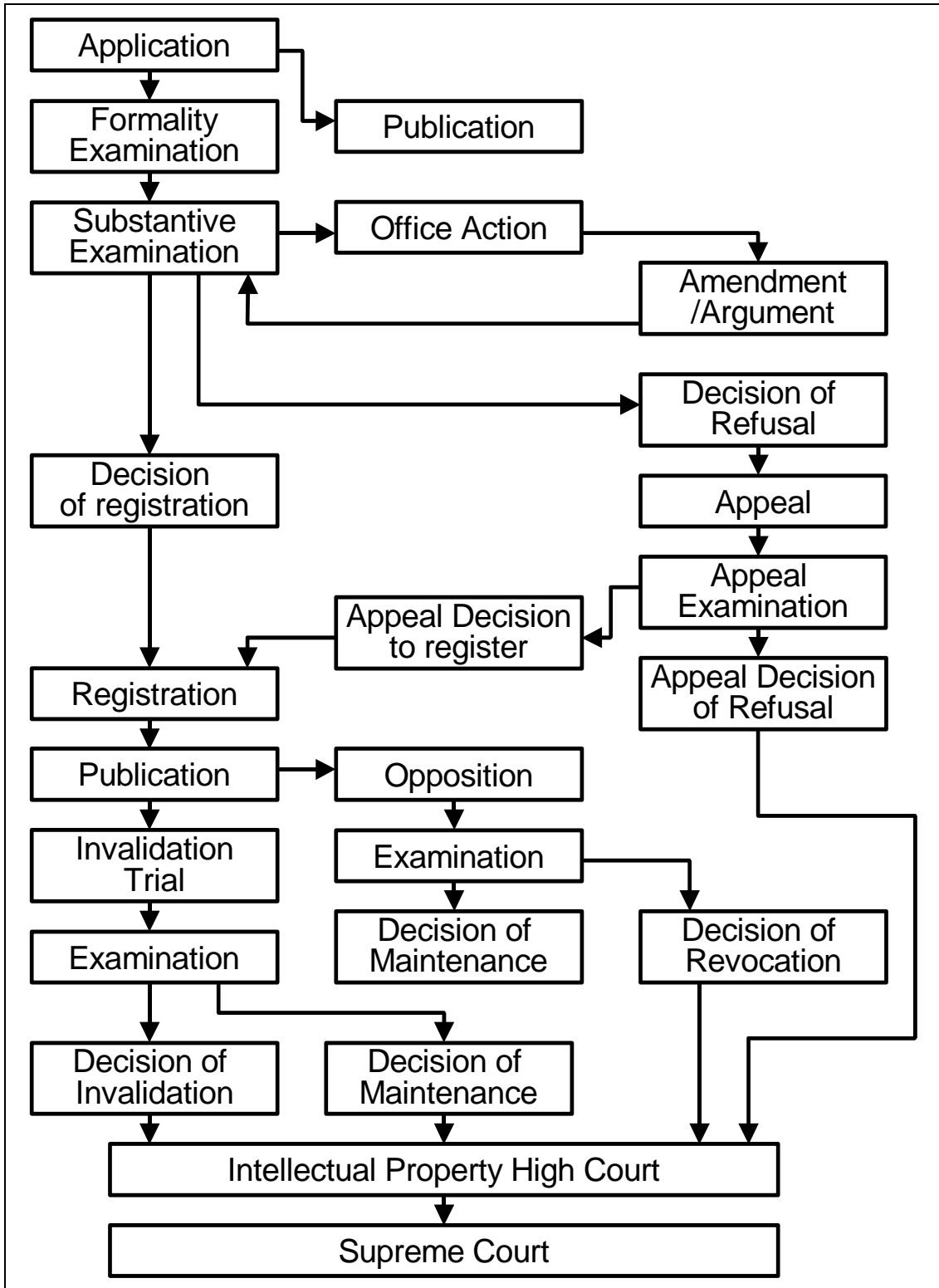


Fig. 3-A

illustrates the procedures for obtaining a trademark right.

II. Examination

Q4. What are the typical reasons for refusal?

A4. There are various requirements for registrability, however, (a) Lack of distinctiveness of the trademark (Trademark Law Art. 3(1)), (b) Existence of a prior registered trademark (Trademark Law Art. 4(1)(xi)), and (c) Vagueness of the designated goods or service (Trademark Law Art. 6(1) and (2)) are the most typical reasons for refusal.

Q5. How is the similarity of trademarks judged?

A5. In judging the similarity of trademarks, appearance, sound and concept (connotation) are comprehensively taken into consideration. Generally, the most important factor in the judgment is the sound of trademarks.

The judgment of similarity may vary in examination, appeal, and litigation.

On examination, Examiner judges the similarity relatively mechanically or uniformly according to the Examination Guidelines provided by the JPO. However, on appeal/litigation, appeal Examiners/courts take actual business circumstances, such as trade conditions, into consideration. Therefore, the judgment concerning trademarks on appeal/litigation is more flexible or comprehensive than on examination.

Q6. How are the judgments on the similarity of goods/services made?

A6. Although Japan has adopted the Nice International Classification, goods or services are categorized into some

groups unique to Japan and independent of the International Classification. Each group has a certain code. Specifically, goods or services bearing the same code, that is, goods or services categorized into the same group, are presumed to be similar. If the goods or services for an application have the same codes as the cited prior trademark, the goods or services are deemed to be similar to one another and it is generally difficult to argue that they are dissimilar.

Q7. If a trademark applicant receives an Office Action citing a registered trademark, what measures can the applicant take?

A7. There are four measures:

- (1) Filing an argument stating that the applicant's trademark is not similar to the cited trademark and/or the designated goods or services are not similar to those of the cited trademark.
- (2) Filing an amendment to delete the goods or services in conflict with those of the cited trademark.
- (3) Filing a non-use cancellation trial against the cited registered trademark. (Please note that the cited registered trademark will be cancelled unless the owner of the cited registered trademark proves that the cited registered trademark has been used in connection with at least one of the designated goods in Japan within a period of three years prior to the filing of the cancellation trial.)
- (4) Negotiating with the owner of the cited registered trademark to have the cited trademark assigned. (It should be noted that the Office Action cannot be overcome by merely filing a Letter of Consent executed by the owner of the cited trademark. To overcome the refusal, the assignment has to be registered with the Patent Office.)

Q8. If a trademark applicant receives an Office Action pointing out that some of the designated goods or services are vague, what measures can the applicant take?

A8. There are two possible measures:

- (1) Filing an amendment to delete the goods or services refused by the Examiner or to amend the description of such goods or services in a form acceptable to the Japanese trademark practice.
- (2) Filing an argument explaining what the goods or services refused by the Examiner are like.

Q9. If a trademark application designates goods or services in multi-class and the Examiner issues an Office Action finding a reason for refusal in one of the classes, is such an application unregistrable concerning the other classes which were not refused?

A9. Unregistrable. Unless the reasons for refusal are completely overcome, the application will be refused as a whole. If the applicant intends to register the application on the other classes which were not refused as soon as possible, it is advisable to divide the application into two independent applications. However, in the case of an international application under the Madrid Protocol, such division is not allowed.

III. Post Registration

Q10. How long does a trademark right last?

A10. The trademark right lasts 10 years from the date of

registration. Registration renewal can be made every 10 years.

Q11. Is there an opposition system to the registration of a trademark right?

A11. Yes. Any person can file an opposition within 2 months from the date of publication of the registration.

Q12. Is there any demerit or penalty if a registered trademark is not used?

A12. Yes, the registered trademark can be cancelled by a non-use cancellation trial. Non-use is defined as: if none of the owner or a licensee uses the registered trademark (including a trademark regarded to be generally accepted as identical with the registered trademark), for a period of 3 consecutive years (calculating back from the date of filing of the cancellation trial) (Trademark Law Art. 50).

IV. Trademark Application Based on Request for Territorial Extension under the Madrid Protocol

Q13. Is it possible to request a territorial extension to designate Japan under the Madrid Protocol?

A13. Yes.

Q14. When the Notification of Provisional Refusal is issued, what information should be provided to an attorney in Japan?

A14. The Examiner's remarks set forth in the Notification of Provisional Refusal and a power of attorney should be provided. It should be noted that the power of attorney is indispensable although it can be submitted to the JPO later.

Q15. Is there any difference between a case where Japan is designated in an international application under the Madrid Protocol and another case where a domestic application for trademark registration is filed with the JPO?

A15. A request for territorial extension to designate Japan under the Madrid Protocol shall be deemed to be a domestic application for a trademark registration filed on the international registration date or the date of subsequent designation. Thus, the international application is examined in a manner similar to that of the domestic trademark application. However, there are some exceptions. For example:

- (1) Filing a divisional application derived from the international application is not allowed (Trademark Law Art. 68-12).
- (2) Any amendment to the designated goods or services in the international application may be made only during a specifically designated time frame (Trademark Law Art. 68-28), i.e., 3 months from the date of pronouncement indicated in the Notification of Provisional Refusal;
- (3) The designated goods or services in the international application cannot be transferred to another class by an amendment; and
- (4) The individual fee should be paid to the WIPO after decision to grant in order to obtain protection in Japan.