

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.)
- (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.
- (6) an official fee of 3,400 yen plus 8,600 yen per class.

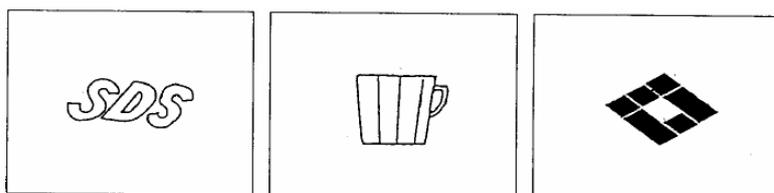
Q3. Is it possible to apply for a "standard character mark"?

A3. Yes. A word mark consisting only of letters of the English alphabet, Arabic numerals, and Japanese characters designated as standard characters by the Japan Patent Office can be designated a "standard character mark".

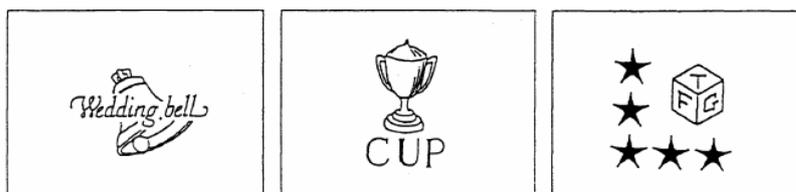
Q4. Does the Japan Patent Office recognize three-dimensional marks?

A4. An applicant can apply for a trademark consisting of a three-dimensional shape by stating so in the application. The application must adequately describe the three dimensional shape in the application. For example, the following trademarks are not recognized as three dimensional marks:

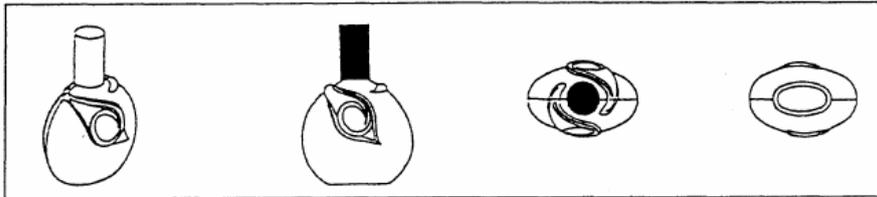
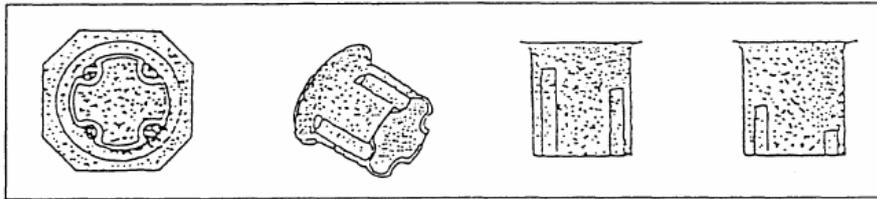
(1) Marks not described as three-dimensional:



(2) Marks containing both two and three dimensional nodes:



(3) The drawings do not match such that they cannot be combined into a single three-dimensional view.



Q5. What goods and services may be designated in Japan?

A5. The JPO does not accept all Class Headings of the Nice Agreement, but does allow certain designations unique to Japan as listed in the JPO's Examination Guideline.

Q6. How does the application proceed?

A6. 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.

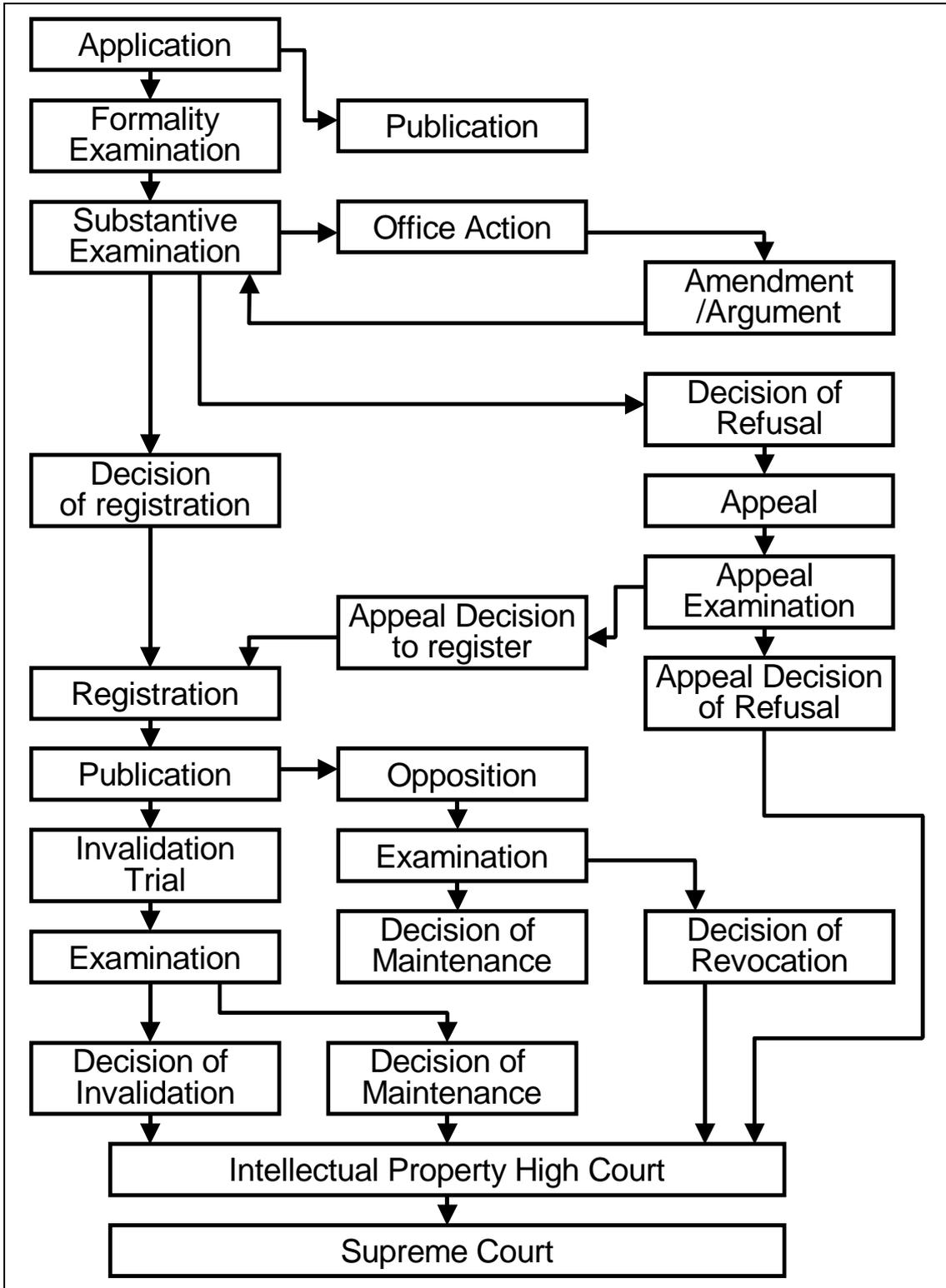


Fig. 3-A

illustrates the procedures for obtaining a trademark right.

II. Examinatin

Q7. What are typical reasons for refusal?

A7. Some typical cited grounds for rejection are:

- (1) Overly broad range of goods or services in one class;
- (2) Lack of distinctiveness;
- (3) A trademark which is liable to contravene public order or morality;
- (4) A trademark which contains a portrait or name of a person other than the applicant;
- (5) A trademark which is identical with, or similar to, another party's trademark which is well known among consumers;
- (6) A trademark which is identical or similar to prior registered trademark;
- (7) A trademark which is likely to cause confusion in connection with the goods or services pertaining to a business of another person;
- (8) trademark which is likely to mislead as to the quality of the goods or services; and
- (9) Vagueness of the designated goods or service.

Q8. How does the Japan Trademark Law define distinctiveness?

A8. Trademark Law Article 3(1) provides that the following marks are unregistable:

- (1) A trademark solely consisting of a mark indicating the common name of the goods or services in an ordinary manner (Trademark Law Art. 3(1)(i));
- (2) A trademark customarily used with respect to the particular goods or services (Trademark Law Art.

3(1)(ii));

- (3) A trademark solely consisting of a mark merely indicating, in a common way, a quality of the goods or services (Trademark Law Art. 3(1)(iii));
- (4) A trademark solely consisting of a mark indicating, in a common way, a common surname or business name (Trademark Law Art. 3(1)(iv));
- (5) A trademark solely consisting of a very simple constituent element (Trademark Law Art. 3(1)(v)); and
- (6) A trademark from which consumers cannot recognize the goods or services as those pertaining to a business of a particular person (Trademark Law Art. 3(1)(vi)).

Q9. How is the similarity of trademarks judged?

A9. 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.

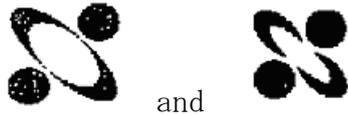
On examination, Examiner judges the similarity relatively mechanically or uniformly according to the Examination Guidelines provided by the JPO. However, on appeal/litigation, appeal Examiners/courts take actual business circumstances, such as trade conditions, into consideration. Therefore, the judgment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

Q10. How are similarity in appearance, sound, or concept judged?

A10.

Similarity in Appearance

If the components of two marks are confusingly similar each other, they may be determined to be similar in appearance. For example, the following marks would like be considered similar in appearance:



Similarity in Sound

When the pronunciations of two marks as read by Japanese native speakers are close to each other, they may be determined to be similar in sound. For example, the following marks would be considered similar in sound:

"VANCOCIN" and "BUNCOMIN"
"Atomin" and "ATAMIN"
"HETORON" and "PETRON"

Similarity in Concept

When the meaning of two marks is similar, the marks may be determined to be similar in concept. Marks in languages other than Japanese are frequently rejected based on prior Japanese registrations having a corresponding meaning. For example, the following marks would be considered similar in concept:

"りんご" and "apple"

("りんご" is the Japanese word for "apple".)

Q11. How are the judgments on the similarity of goods/services made?

A11. 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.

Q12. How can an applicant respond to a rejection on the grounds that an overly broad range of goods or services in one class?

A12. There are three measures:

- (1) The applicant can establish that they are carrying out the business connected with the designated goods or services using material evidence and arguments.
- (2) The applicant can delete some goods or services, and argue that they have a bona fide intent to use the mark in connection with the remaining goods and services. As a general rule of thumb, JPO Examiners generally appear willing to basically allow marks designating no more than seven less similarity codes (not items) per class.
- (3) The applicant can submit documentary evidence establishing that they have bona fide plans to use the mark in connection with all of the designated goods and services.

Q13. How can an applicant respond to a rejection for lack of distinctiveness?

A13. The applicant can argue against the specific grounds cited by the Examiner. For example, if the rejection states that the trademark merely indicates a "quality" of the designated goods or services, the applicant could attempt to argue that such an interpretation is not direct, or is not viewed in that manner in the particular trade in which use of the mark is intended, or to argue that the mark is not indicated in a common manner, especially if the trademark has a unique composition.

Q14. Is it possible to register an inherently indistinctive mark that has acquired distinctiveness through use?

A14. Although a trademark that has acquired a secondary meaning through long and extensive use in Japan may be registered, the standards are extremely high.

Q15. If a trademark applicant receives an Office Action citing a registered trademark, what measures can the applicant take?

A15. 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.)

Q16. 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?

A16. 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.

Q17. 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?

A17. 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.

Q18. How can an applicant respond to a final Decision of Rejection?

A18. The applicant may file an Appeal within three months of receiving such a decision.

III. Post Registration

Q19. How long does a trademark right last?

A19. The trademark right lasts 10 years from the date of registration. Registration renewal can be made every 10 years.

Q20. What rights accompany a trademark registration?

A20. The owner of a registered trademark has both a positive right to use the registered mark in connection with the designated goods and services, and a negative right to prevent unauthorized use of the mark or a similar mark on identical or similar goods or services.

Q21. Are there limits to the rights of a trademark registration?

A21. Yes. The rights to a registered trademark cannot be used to prevent another party from using their own name in a common manner or from using common names or generic terms in a common way, for example.

Q22. What acts constitute infringement of trademark rights?

A22. Commercial use of a registered trademark in connection with the designated goods or services; commercial use of a similar

trademark in connection with similar goods or services, commercial use of registered or a similar trademark in connection with similar goods or services; or acts in preparation of such use may constitute infringement.

However, use for explanation or design only is considered fair use.

Acts other than use which damage the registration or impair the owner's ability to use the registered trademark may be considered infringement.

Q23. Is there any demerit or penalty if a registered trademark is not used?

A23. Yes, the registered trademark can be cancelled by a non-use cancellation trial(Trademark Law Art. 50). See Q&A32.

Q24. Is use of an indication such as "registered trademark" required?

A24. It is recommended that a designation such as "registered trademark" be used when a registered trademark is used in connection with designated goods or services, but usage is not mandatory.

• Issuing stage and Renewal stage

Q25. When is the registration fee due?

A25. The initial registration fee is due within 30 days from the receipt of a Notice of Allowance. The fee ¥37,600 per class if paid in a single installment covering the full ten year duration of the mark, or ¥21,900 if paid in two five year installments.

Q26. Is evidence of use required to register a trademark?

A26. No evidence of use is required to register a trademark, but evidence of use within the most recent three years may be required to prevent cancellation of a mark whose registration is challenged.

Q27. How can a registered trademark be renewed?

A27. A request for renewal of a trademark right can be filed within the six months prior to the expiration date. The renewal fee may be paid in a single installment of ¥48,500 covering the full ten year term, in two five year installments of ¥28,300 per class.

Q28. Can an expired registration be revived?

A28. A request for renewal can still be filed up to six months after a registration has expired, but double the normal renewal fee must be paid.

IV. Cancellation and Invalidation

Q29. Is there an opposition system in Japan?

A29. Yes. Any person can file an opposition within two months from the date of publication of the registration.

Q30. Other than oppositions, are there any other means for a third system to request cancellation of a trademark

registration?

A30. Yes. The Japan Trademark Law provides for both Invalidation Trials and Requests for Cancellation. The grounds for filling a Request for Cancellation are:

- non-use for the most recent three years
- unfair use of the registered trademark
- likelihood of confusion
- unauthorized registration

- Invalidation Appeal

Q31. Can an Invalidation Trial be requested at any time?

A31. Other than fraudulent registration, an Invalidation Trial may only be requested within five years after the initial registration of a trademark.

- **Non-Use Cancellation**

Q32. What are the criteria for having a trademark registration cancelled due to non-use?

A32. The registered trademark will be cancelled, if the owner or licensee are unable to provide evidence of use of the registered mark in Japan , for a period of 3 consecutive years (calculating back from the date of filing of the cancellation trial) (Trademark Law Art. 50).

Q33. On whom is the burden of proof when cancellation based on non-use is requested?

A33. The owner of the registration has the burden of proving

that the registered mark was used in Japan.

Q34. Must the trademark have been used exactly as registered?

A34. Use of a trademark in a form very similar to that registered may be used to establish use. Among the commonly accepted variations are:

- use of different fonts;
- a mark registered in all caps may be used in a combination of capital and lower-case letters;
- use of alternative character sets such as Japanese *hiragana* and *katakana* characters or alphabetic characters which are recognized as identical in terms of pronunciation and connotation; or
- use of figures that are considered identical in terms of appearance as those of the registered trademark;

Examples of acceptable variations:

<i>Bluebird</i>	Bluebird
HI-KE	Hi-ke
チャンピオン "チャンピオン" is the Japanese word for "Champion".	Champion
	

Q35. Will a registered trademark not used in commerce always be cancelled?

A35. The JPO has the authority to allow the registration if the trademark owner can demonstrate good cause that the mark was not used commercially.

Q36. Will a registered trademark that has turned into a common name be cancelled?

A36. No. Evolution of a mark into a common name after its registration is not grounds for cancellation.

V. Special Trademarks

Q37. Can Collective Trademarks be registered in Japan?

A37. Yes. Recognized collective associations may obtain protection for marks used by its members.

Q38. Can regional collective trademarks be registered in Japan?

A38. Yes. Recognized regional collective associations may obtain protection for trademark consisting of a place name and a type of goods, if the goods are well known among consumers.

Q39. Is additional protection available for famous trademarks?

A39. Yes. The owner of a famous trademark may obtain a defensive registration of a trademark identical to the registered trademark in connection with goods or services not similar to the designated goods or services of their business, if there is a likelihood of confusion concerning the source of the goods or services. A defensive mark cannot be cancelled based on

non-use.

Q40. What is "Reclassification"?

A40. All trademark registrations filed prior to March 31, 1992 under the former Japanese classification system must be reclassified according to the International Classification System which is now employed in Japan.

A Request for Reclassification may be filed up to six months before or one year after the renewal deadline of a trademark registration. If reclassification is not requested, the registration may not be renewed again. No official fee is required.

Q41. Is it possible to request accelerated examination of a trademark application?

A41. Yes. Accelerated examination can be requested for applications when the applicant or a licensee is using or has plans to shortly begin use of the mark, and either:

- (1) the applicant or licensee can demonstrate an urgent need for a decision, or
- (2) the only goods or services designated in the trademark application are the actual goods and services for which use has begun or prepared for.

If a request for accelerated examination is accepted, a first office action is issued within about two months in most cases. No official fee is required.

Q42. Are there ways to comment on a pending trademark application filed by another party?

A42. Yes. Any party may file evidence or a statement concerning the registerability of any pending application. Such a disclosure may be filed anonymously, using the name of any individual. No official fee is required.

Q43. What are the current JPO official fees?

Filing Application	¥3,400 + ¥8,600 per class
Appeal	¥15,000 + ¥40,000 per class
Initial Registration	
Full ten years	¥37,600 per class
Five years only	¥21,900 per class
Renewal of Registration	
Full ten years	¥48,500 per class
Five years only	¥28,300 per class

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

Q44. Is it possible to request a territorial extension to designate Japan under the Madrid Protocol?

A44. Yes.

Q45. When the Notification of Provisional Refusal is issued, what information should be provided to an attorney in Japan?

A45. 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.

Q46. 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?

A46. 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.

**QUESTIONS AND ANSWERS
REGARDING JAPANESE TRADEMARK PRACTICE**

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