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Trademark Registration in Japan

# Common Grounds for Refusal and How to Overcome Them

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# Why Filing a Trademark in Japan Matters

## World's 5th Largest Economy:

Japan is a high-purchasing-power market and a key player in global business.

## Strong Consumer Brand Preference:

Japanese consumers are passionate about brands.

They view brand ownership as a status symbol and a form of self-expression.

## Brand Protection in the Japanese Market:

Japanese consumers value authenticity, sincerity, cleanliness, and the spirit of hospitality, making brand integrity essential.

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## 2. Overcoming Article 3(1)( )–(v)

- Pocky Case Article3(2)
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## 3. Overcoming Article 4(1)(**xi**)

- Consent System Article4(4)



# 1. Grounds for Refusal

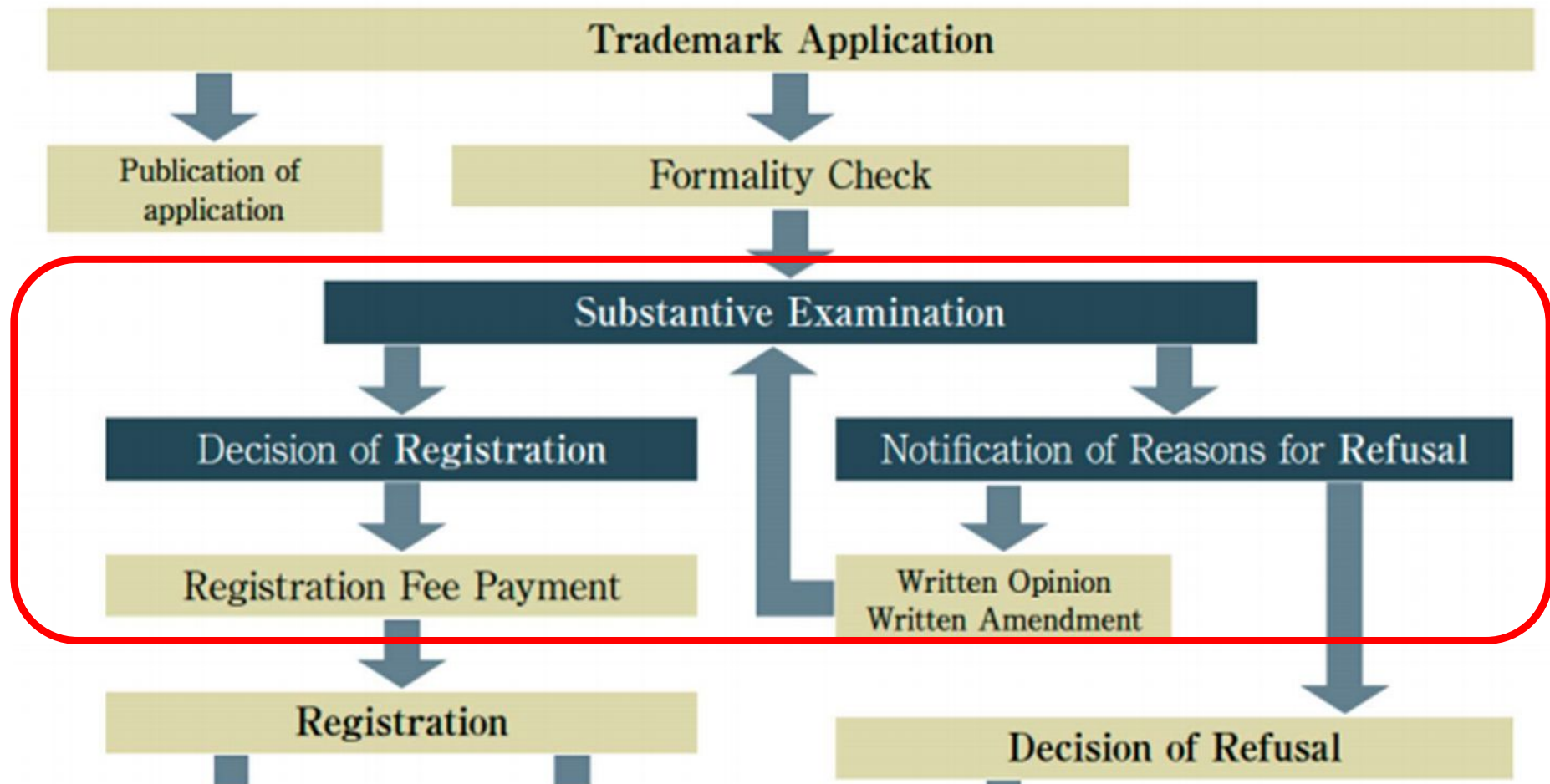
Flowchart

Main Grounds for Refusal

- Article 3(1)( )-(v) (Lack of Distinctiveness)
- Article 4(1)(xi) (Prior registered mark)

# 1. Grounds for Refusal

## Flowchart



# 1. Grounds for Refusal

## Article 3(1)(iii)-(v) (Lack of Distinctiveness)

Trademark Law	
Article 3(1)(i)	Generic terms
Article 3(1)(ii)	Customary Marks
Article 3(1)(iii)	Descriptive Marks
Article 3(1)( iv )	Common Personal Names or Business Names
Article 3(1)( v )	Simple and Commonplace Marks
Article 3(1)( vi )	Lack of Distinctiveness
Article 3(2)	Exception for Acquired Distinctiveness

# 1. Grounds for Refusal

Trademark Law	
Article 4(1)(i)	National Flags, Emblems, and Decorations
Article 4(1)(ii)	National Emblems of Treaty Members
Article 4(1)(iii)	Marks of International Organizations
Article 4(1)( iv )	Red Cross or Special Symbols
Article 4(1)( v )	Government Certification Marks
Article 4(1)( vi )	Public or Non-Profit Organizations
Article 4(1)(vii)	Public Order and Morality
Article 4(1)(viii)	Portraits, Names, or Famous Pseudonyms
Article 4(1)( ix )	Exhibition Awards
Article 4(1)( x )	Well-Known Trademarks in Japan



# 1. Grounds for Refusal

## Article 4(1)(xi) (Prior registered mark)

Trademark Law	
Article 4(1)( xi )	Prior registered mark
Article 4(1)(xii)	Registered Defensive Marks
Article 4(1)(13)	(Deleted)
Article 4(1)(14)	Plant Variety Names
Article 4(1)(15)	Likelihood of Confusion
Article 4(1)(16)	Misleading Quality
Article 4(1)(17)	Indication of Wine or Spirits Origin
Article 4(1)(18)	Essential Functional Features
Article 4(1)(19)	Famous Foreign Trademarks with Bad Faith



## 2. Overcoming Article 3(1)(v)

### 1) Solution: Article 3(2)

Acquired distinctiveness through use.

### 2) Example: Pocky Case

The examiner acknowledged the 3D trademark's distinctiveness based on prolonged use under Article 3(2).

### 3) Example: Godzilla Case

The court recognized the distinctiveness of the "Shin Godzilla" 3D trademark under Article 3(2).

## 2. Overcoming Article 3(1)( )–(v)

### 1) Solution: Article 3(2)

Acquired distinctiveness through use.

Trademarks under 3(1)(iii)-(v)  
can be registered if consumer use  
links them to a specific business.

## 2. Overcoming Article 3(1)( )–(v)

### 1) Solution: Article 3(2)

How to prove Acquired Distinctiveness

- (i) Photos or videos of trademark use
- (ii) Business documents
- (iii) Advertisements and related records
- (iv) Media articles presenting the trademark
- (v) Consumer questionnaire results

## 2. Overcoming Article 3(1)( )–(v)

### 2) Example: Pocky Case (Registration No.:6951539)

The examiner acknowledged the 3D trademark's distinctiveness based on prolonged use under Article 3(2).



Registration No.:6951539

Class:30

Goods: Chocolate confectionery

Mark: Three-dimensional Mark

Grounds for refusal: Represents the goods' shape or quality in a customary manner, falling under Article 3(1)(3) of the Trademark Act.

Applicant:

EZAKI GLICO CO.,LTD.

## 2. Overcoming Article 3(1)( )–(v)

### 2) Example: Pocky Case (Registration No.:6951539)

#### Reasons for the decision

A survey of 1,036 Japanese men and women (aged 16–79) showed that **over 90% immediately recognized the applicant** and their popular product from the applied trademark.

Along with the survey results, the applicant submitted evidence of **trademark use, market share, and advertising activities.**

The designated goods were **amended** from "confectionery" to **"chocolate confectionery."**

Based on these factors, the examiner recognized the distinctiveness of the three-dimensional trademark.

## 2. Overcoming Article 3(1)( )–(v)

### 2) Example: Pocky Case

The examiner acknowledged the 3D trademark's distinctiveness based on prolonged use under Article 3(2).

"Pocky" (3D)



"Pocky"





## 2. Overcoming Article 3(1)( )–(v)

### 3) Example: Godzilla Case (Appeal No.:2021-11555)

The court recognized the "Shin Godzilla" 3D trademark's distinctiveness under Article 3(2).



Applicant:  
TOHO CO., LTD.

Application No.:2019-131821

Class:9,16,25,28,41

Divisional Application No.:2020-120003

Divisional Class:28

("stuffed toys, action figures, dolls, and other toys")

Mark: Three-dimensional Mark

Grounds for refusal: Represents the goods' shape or quality in a customary manner, falling under Article 3(1)(3) of the Trademark Act.

## 2. Overcoming Article 3(1)( )–(v)

### 3) Example: Godzilla Case

Case No.: Reiwa 6 (Gyo-ke) No. 10047

#### CASE OVERVIEW

Issues:

A: Applicability under Article 3(1)(3) (Ground for Cancellation 1)

B: Applicability under Article 3(2) (Ground for Cancellation 2)

Conclusion:

**The JPO's decision that the trademark did not meet the conditions under Article 3(2) was determined to be incorrect.**

## 2. Overcoming Article 3(1)( )–(v)

### 3) Example: Godzilla Case

Case No.: Reiwa 6 (Gyo-ke) No. 10047

#### Reasons for the decision

The applied trademark, resembling dinosaurs or monsters, is commonly seen in similar products and is not recognized as an indicator of a specific source, making its classification under Article 3(1)(3) of the Trademark Act appropriate.

However, the Godzilla character, widely recognized since 1954 and further popularized by "Shin Godzilla," has become associated with the plaintiff's products, leading consumers to recognize the applied trademark as an indicator of a specific source.

## 2. Overcoming Article 3(1)( )–(v)

### 3) Example: Godzilla Case

Case No.: Reiwa 6 (Gyo-ke) No. 10047

The court recognized the "Shin Godzilla" 3D trademark's distinctiveness under Article 3(2).

"Shin Godzilla"  
( New Version )



"Godzilla"  
( First Version )



### 3. Overcoming Article 4(1)(xi)

#### 1) Registration possibility under Trademark Act 4(1)(**xi**)

Background

#### 2) Implementation of Consent System

Examination Procedures Using Consent Agreement (CA)

#### 3) Types of consent systems

#### 4) The first trademark registration in Japan using the "Consent System"

### 3. Overcoming Article 4(1)(xi)

#### 1) Registration possibility under Trademark Act 4(1)(xi)

No trademark shall be registered if the trademark is:  
Identical, **or similar to**, another person's prior trademark  
registration

Trademark applied for	Prior registered trademark			
	Trademark	Goods/Services		
		Identical	Similar	Dissimilar
	Identical	No	No	Yes
	Similar	No	No	Yes
	Dissimilar	Yes	Yes	Yes



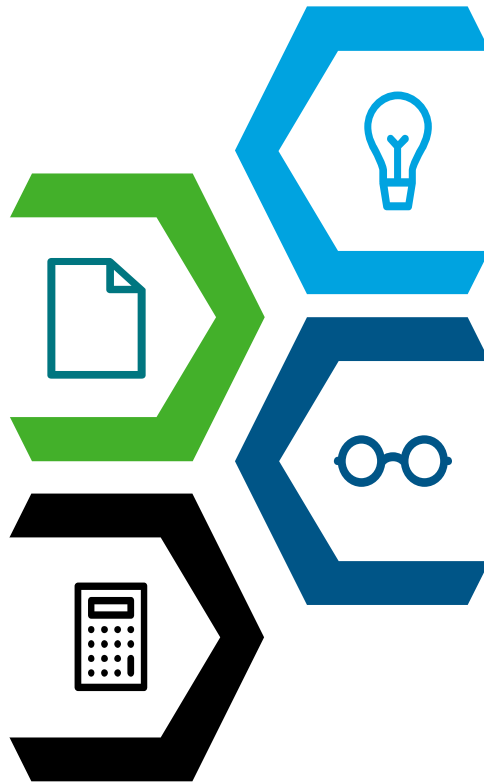
### 3. Overcoming Article 4(1)(xi)

## Background

Response to refusal

Procedural  
amendment

Argument



Negotiating transfer  
or Assign-Back

Trial for cancellation  
of a registered  
trademark not in use  
(non-use )

# 3. Overcoming Article 4(1)(xi)

## 2) Implementation of Consent System

### Amendment intent

Responding to a notice of refusal requires a certain amount of financial and time costs for preparing documents and transferring rights.

On the other hand, users are calling for the introduction of a "consent system," which they believe would be a simpler and less expensive option.

### 3. Overcoming Article 4(1)(xi)

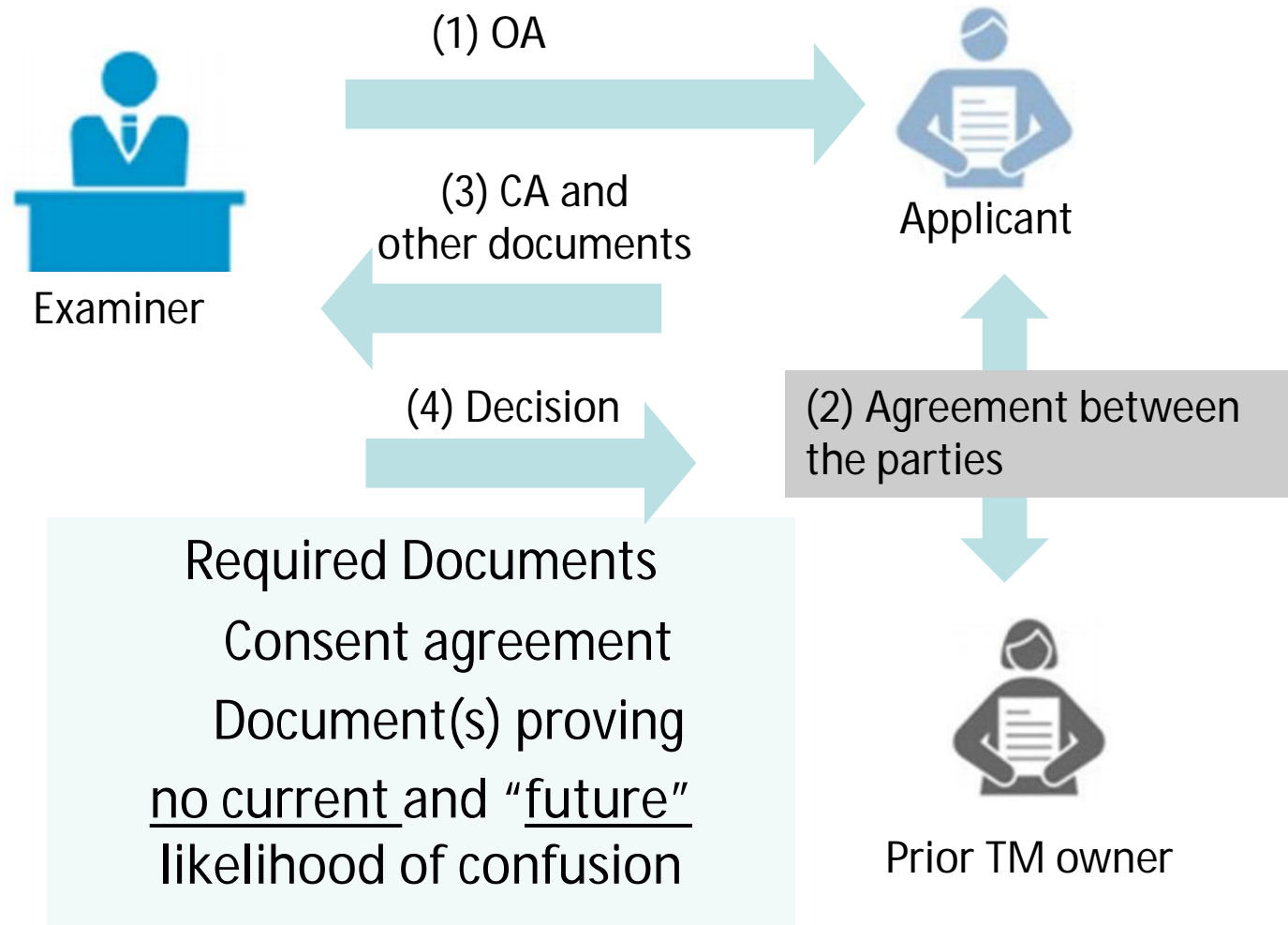
#### 2) Implementation of Consent System

##### Article 4 (4)

If the applicant obtains consent from the relevant party under Article 4(1)(xi), and there is no likelihood of confusion with the goods or services of the other party, the provisions of that item do not apply.

### 3. Overcoming Article 4(1)(xi)

#### Examination Procedures Using Consent Agreement (CA)



# 3. Overcoming Article 4(1)(xi)

## 3) Types of consent systems

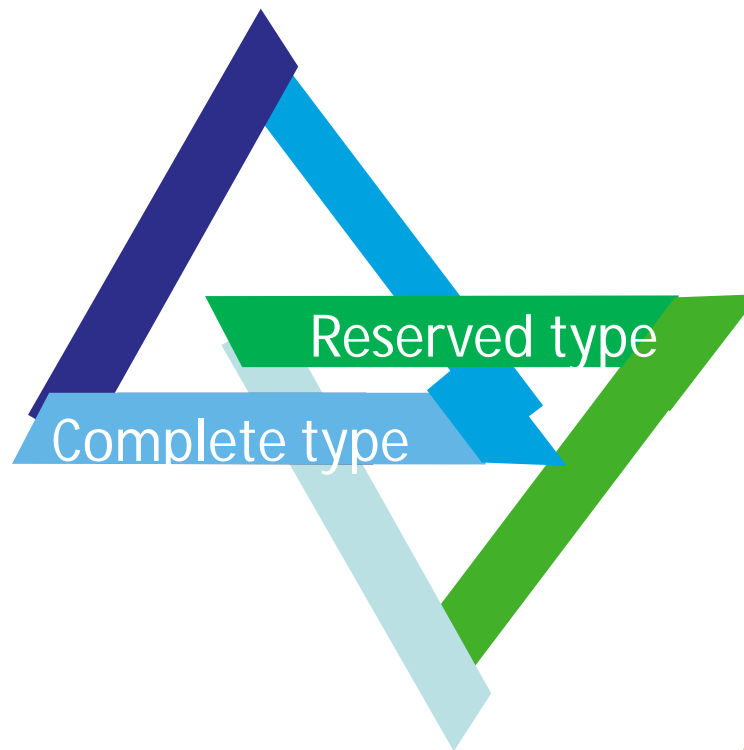
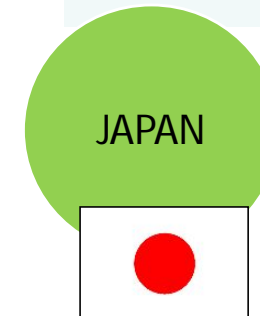
### Complete type

A similar trademark can be registered with the trademark owner's consent, without further examination.



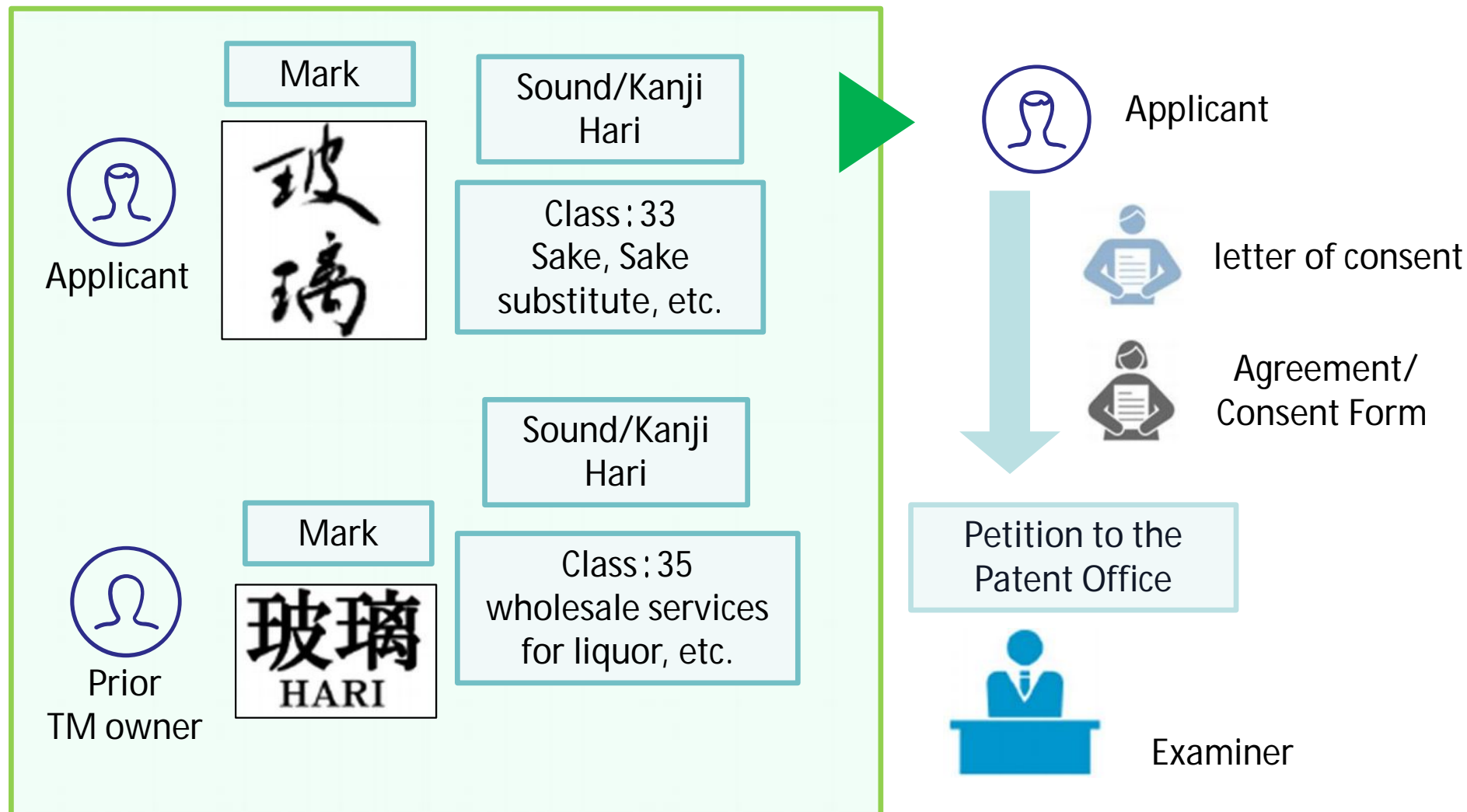
### Reserved type

Consent does not allow registration if there is a risk of confusion about the origin, a practice adopted in many regions, including the U.S.



### 3. Overcoming Article 4(1)(xi)

#### 4) The first trademark registration in Japan using the "Consent System"





# Key Takeaways

## 1) High Brand Recognition:

Japan is a market with strong brand awareness and great potential.

## 2) Distinctiveness Through Use:

Long-standing use can make seemingly non-distinctive trademarks (e.g., 3D marks) eligible for registration.

## 3) New Consent System:

Registration is possible with the rights holder's consent, but the process is complex and requires skilled representation.

As of today, traditional assign-back practices are still commonly employed.

# Disclaimer

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Q&A

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