

4-1. International Trademark Application

Japan is also a contracting state of the Madrid Protocol ("Protocol"); thus a request for territorial extension to designate Japan shall be deemed to be a trademark application filed on the date of international registration provided in Article 3(4) of the Protocol. However, in the case of subsequent designation, such request shall be deemed to be a trademark application filed on the date on which the subsequent designation is recorded in the International Register of the International Bureau provided in Article 2(1) of the Protocol (Article 68-9 of the Japanese Trademark Law).

It should be noted, however, that in the case of a trademark application based on the Protocol, there are many exceptions, such as:

- A divisional trademark application is not allowed (Article 68-12 of the Trademark Law);
- Conversion of the trademark application into a defensive, collective or regional collective trademark application is not allowed (Article 68-13 of the Japanese Trademark Law); and
- The period to allow an applicant to file an amendment of designated goods or services with the Japan Patent Office via a Japanese patent attorney is limited. After this period expires, a voluntary amendment of goods or services cannot be filed at the JPO directly; thus a MM6 form must be filed at the WIPO by an attorney recorded at the International Register.

Please be advised that, unlike many other countries, individual fees provided in Article 8(7)(a) of the Protocol shall be paid not only where a trademark application based on the Protocol is filed, but also where a final decision to the effect that the trademark application is to be registered, i.e., "a decision to grant a trademark registration," is rendered (Article 68-30 of the Japanese Trademark Law).

In order for a Japanese patent attorney to respond to a provisional refusal against a trademark application based on the Protocol on behalf of a foreign applicant, a signed power of attorney is necessary. No notarization or legalization is required, but the original document is needed.

4-2. Flow Chart

(See the attached "4-2. Flow Chart.ppt.")

4-3. Examination

Japan has adopted the examination system. All applications, including trademark applications based on the Protocol, are placed under substantive examination after formalities are checked. In the substantive examination, the presence or non-presence of both absolute grounds and relative grounds are examined.

➤ Absolute grounds

Whether the subject trademark possess sufficient distinctiveness is examined. The following marks cannot be registered as trademarks:

- (1) Common terms for designated goods or services;
- (2) Customary terms for designated goods or services;
- (3) Descriptive terms in relation to designated goods or services;
- (4) Commonplace surnames and appellations;
- (5) Extremely simple and common indications alone; or
- (6) Other marks incapable of indicating whose business they are related to.

➤ Relative grounds

Whether there already exist prior registrations held by others is examined. The following trademarks cannot be registered:

- (1) Trademarks identical or similar to already registered trademarks which are intended to be used for identical or similar goods or services;
- (2) Trademarks which are likely to cause confusion with well-known or famous trademarks of others; or
- (3) Trademarks which are likely to cause misconception about quality of goods or services.

In addition, the examination also covers whether the designated goods or services are properly described and whether classification of goods or services is inappropriately broad. A provisional refusal will be issued if any inappropriateness is found in the examination.

The applicant can respond to a provisional refusal within a three-month period by submission of an argument and/or an amendment. This three-month period is extendible for only one month by making such written request.

4-4. Amendment (Limitation) of Goods and Services

(1) Time Limit for Amendment (Limitation) filed with the JPO

If an applicant wishes to file with the JPO an amendment (including a limitation of goods and services) of the Japanese part of its international application in response to a provisional refusal issued by the JPO, such amendment must be filed by a Japanese patent attorney and only within a certain period under Article 68-28 of the Japanese Trademark Law. Under the present Japanese trademark practice, the certain period given is three months after the issue date of the JPO's provisional refusal.

(2) Amendment (Limitation) filed with the International Bureau

The applicant of an international registration may file any limitation at any time, in respect of all or some of the Contracting Parties, or of goods and services listed in the international registration under Article 9bis (iii) of the Protocol.

If an applicant fails to file an amendment (limitation) with the JPO within the period set forth in the above (1), it may file such amendment with the International Bureau of the WIPO. If such amendment overcoming the provisional refusal is to be filed with the International Bureau of the WIPO when the application for the Japanese part is still pending before the JPO, the application for the Japanese part of the international registration will be allowed by the JPO.

4-5. Arguments

If the applicant does not believe that the Examiner's reasoning is correct, the applicant may make an argument, e.g., that the applicant's mark is not similar to the other party's prior registered mark(s). It should be noted, however, that if the argument fails, a final decision for refusal is generally issued without giving a second chance to the applicant. In this case, the applicant must file an appeal at the JPO's Board of Appeal.

4-6. Individual Fee

Japan adopts and sets up its own “individual fee” system in place of the supplementary and complementary fee system under Article 8(7) of the Protocol. Therefore, if Japan is designated in the international registration, only the individual fee, instead of the supplementary and complementary fee, is payable.

In this regard, the applicant should be careful about the following three points.

- The individual fee for Japan must be paid in two parts (at two stages).

First Part (at the time of filing):	99 CHF for one class
	75 CHF for each additional class
Second Part (at the time of registration):	328 CHF for each class

* CHF (in Swiss francs – Status on July 12, 2014)

- The Second Part of the individual fee must be paid within three months from the date of allowance under the present practice. It should be noted, however, that this three-month period can be extended to five months if a request for extension of time is made at WIPO with payment of a prescribed fee within two months after the three-month period.

- Failure to pay the Second Part of the individual fee would lead to the lapse of the Japanese part of the international application.

Generally, an applicant tends to fail to pay the Second Part of the individual fee. Therefore, it is recommended for an applicant to retain a Japanese patent attorney to monitor the status of the application.