

**Retail and Wholesale Service marks can be registered in Class 35
since April 1, 2007**

From April 1, 2007, the Japan Patent Office (JPO) has allowed an applicant to register a mark used for “retail or wholesale services” in Class 35. This makes retailers or wholesalers possible to protect their trademarks that, for example, appear on shop signboard, display cases, shopping carts or salesperson uniforms. Such service marks had not been registrable until then, because retail or wholesale services were considered to be incidental to the sale of the goods.

1. What does “retail or wholesale services” mean?

The JPO now considers that retail or wholesalers provide “a wide variety of services such as bringing together a variety of goods, providing explanations to customers, and arranging goods to enable customers to view the goods conveniently” and regards these services as a whole as “retail or wholesale services” which generate retailers’ or wholesalers’ own goodwill different from that of manufacturers. However, a mark attached to goods or packages to indicate the origin of goods themselves is not a service mark used for “retail or wholesale services”, but a trademark to be registered for goods in Classes 1 to 34.

2. Matters to be noticed for filing retailers’ or wholesalers’ service marks

(1) Designation of services

- A. If an applicant is a general retail service provider (“general retail or wholesale services”) such as a department store, the service should be described as **“Retail services or wholesale services for a variety of goods in each field of clothing, foods and beverages, and livingware, carrying all goods together.”** The following examples will not be accepted as “general retail or wholesale services”.
 - 1. “Retail services or wholesale services for all goods”
 - 2. “Retail services or wholesale services for a variety of goods in each field of clothing and foods”
- B. If an applicant is a specific retail service provider (“specific retail or wholesale services”) such as a shoe store or a liquor store, the specific goods should be described as **“Retail services or wholesale services for footwear”** or **“Retail services or wholesale services for liquor.”**
- C. The following examples of descriptions cannot be accepted because the services with such descriptions are too broad and vague since the goods are not specified.
 - 1. “Retailing”
 - 2. “Retail store services”
 - 3. “Retail services”
 - 4. “Wholesale services”
 - 5. “Department store services”
 - 6. “Sale services”
- D. It is impossible to amend the designated services from “general retail services” to “specific retail services” or vice versa. Also, it is impossible to change the category of goods subject to retail services. However, the following amendment to restrict the range of the subject goods for specific retail services will be accepted.
 - <Initial designation>
 - “Retail services or wholesale services for **foods and beverages**”
 - <Amendment>

“Retail services or wholesale services for confectionery, bread and buns”

(2) Search for prior applications or registrations

During the examination phase, the JPO conducts a search to find prior applications or registrations of marks, which are identical or similar to a trademark or service mark as filed. For applications designating retail or wholesale services in Class 35, this search is carried out not only among prior service marks designating retail or wholesale services but also among prior trademark designating goods and prior service marks designating services. Accordingly, retail or wholesale services can be treated as similar to the specified goods. For example, “Retail services or wholesale services for clothing” in Class 35 can be treated as similar to “clothing” in Class 25. Therefore, a service mark for “specific retail or wholesale services” may be rejected by a prior mark designating relevant goods. On the contrary, a service mark for “general retail or wholesale services” cannot be rejected based upon any prior trademarks designating goods unless the service mark as filed is identical or similar to well-known trademarks.

(3) Use or Intent-to-use requirements

If the designated retail or wholesale services includes more than one different categories of “specific retail or wholesale services” which may be considered dissimilar to each other, for example, “retail services of sports goods” and “retail services for musical instruments”, the JPO requires the applicant to submit documents certifying that he/she is conducting, or planning to start, business connected with each category of the designated services.

For more details, please consult your local attorney.

Trademark Committee