

Session 9

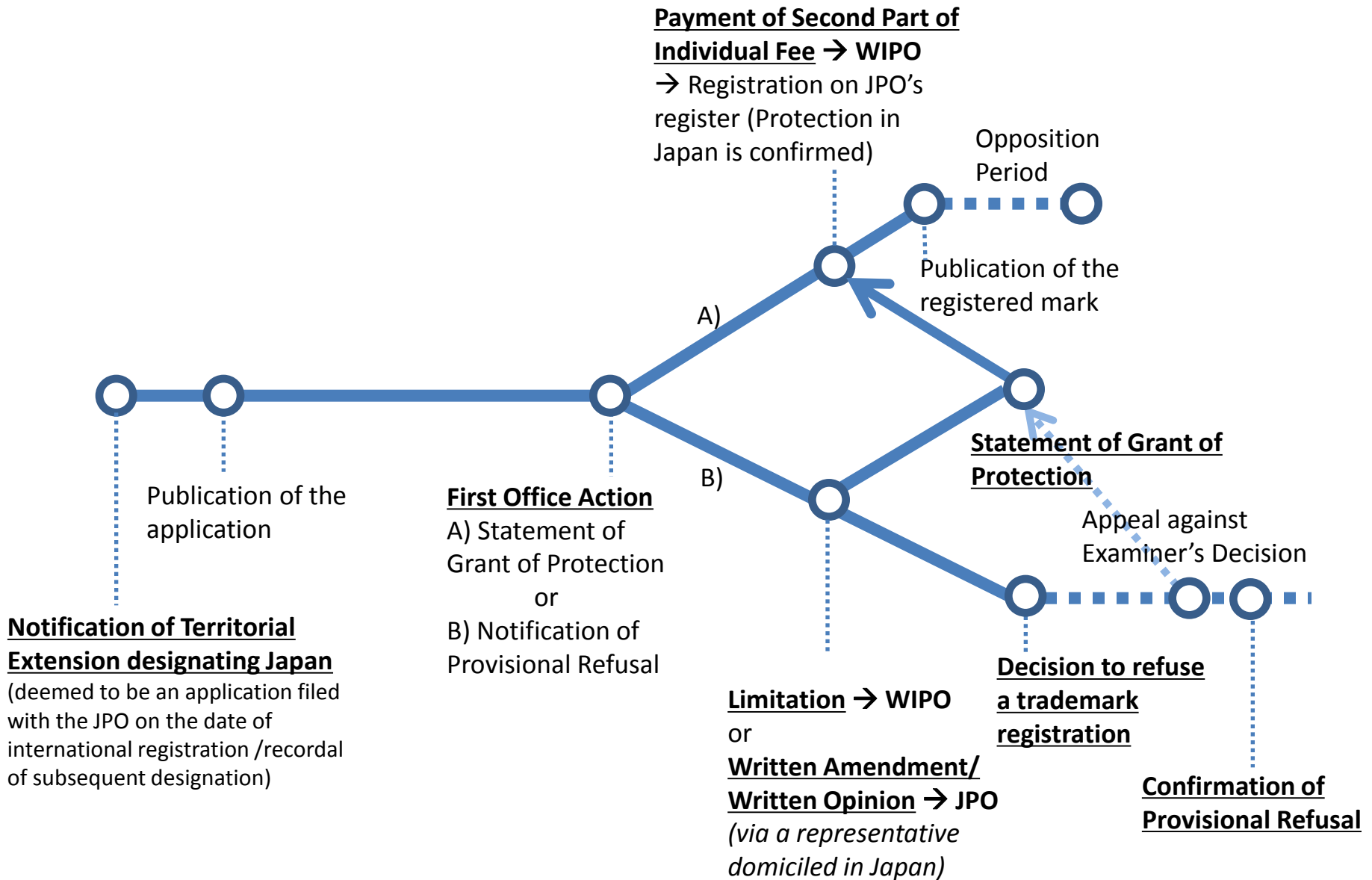
Role of the Designated Contracting Party, i.e. Substantive Examination and Opposition Procedure Before a Designated Contracting Party, Notifications by Designated Office on the Status of International Registration, Responding to Refusals, etc.



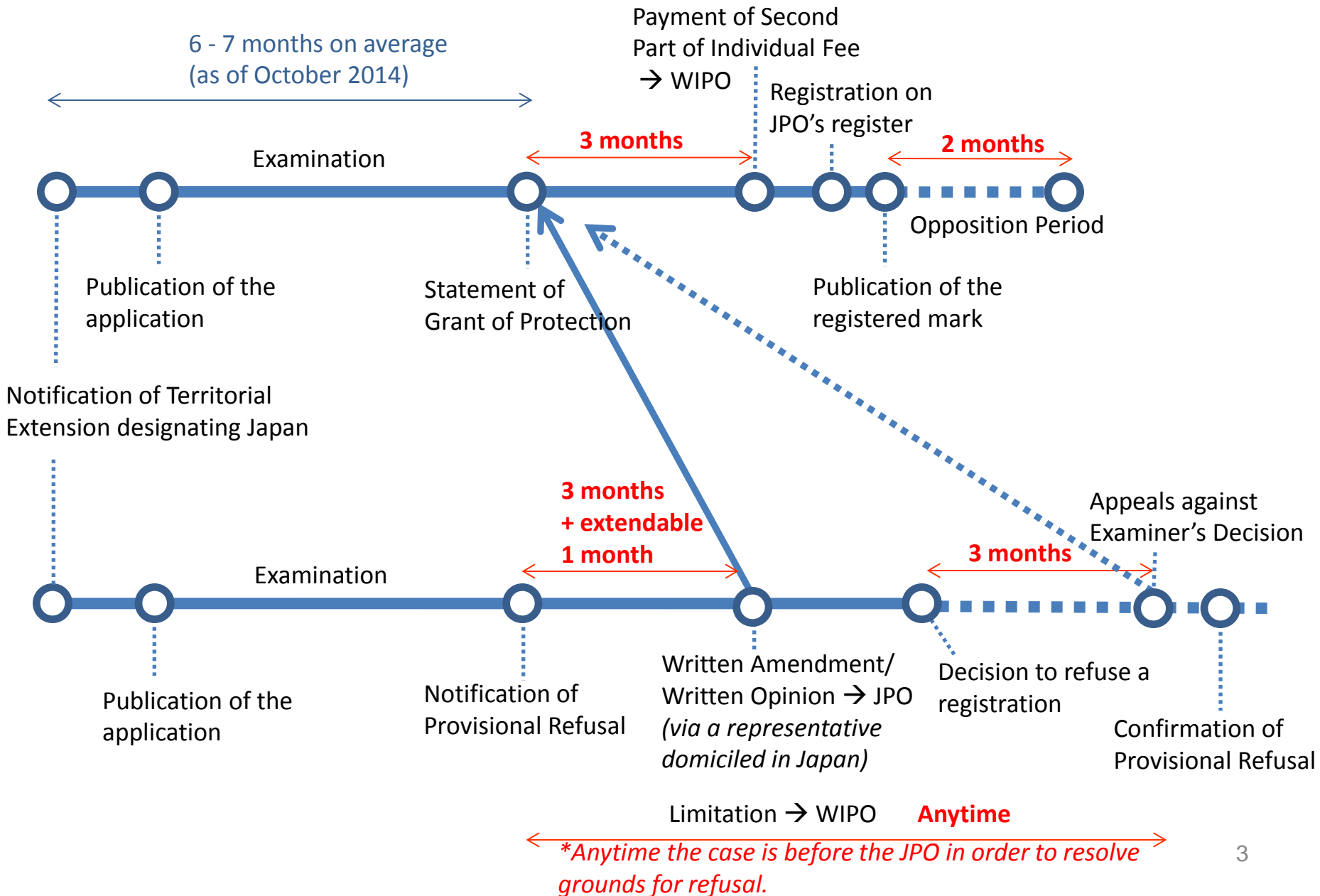
Sunao SATO
Japan Patent Office
January 21, 2016

1. Flow of Examination Procedures
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1. Flow of Examination Procedures - at a glance



1. Flow of Examination Procedures - timeline



2. Specific Requirements for Designating Japan

- The mark has to be one of the types protected under the Japanese Trademark Act *Article 2(1)*, namely **“any character(s), figure(s), sign(s), three dimensional shape(s), or any combination thereof, or any combination thereof with colors, or sounds or any others prescribed in the Cabinet Order.**

| | Revised Act |
|--------------------|-------------|
| 3-D marks | OK |
| Position marks | OK |
| Color per se marks | OK |
| Motion marks | OK |
| Hologram marks | OK |
| Sound marks | OK |
| Olfactory marks | - |
| Taste marks | - |

**Revised trademark Act has come into effect as from April 1, 2015*

2. Specific Requirements for Designating Japan

- The Japanese Trademark Act does not protect guarantee marks.
- The JPO follows the procedures below when the mark is indicated as a “**collective mark, certification mark, or guarantee mark**” in the notice of designation:
 - i) The JPO issues the notification of provisional refusal inviting an applicant to indicate which type of marks the applicant wishes to protect in Japan, and to submit necessary documents such as a proof of being the juridical person.
 - ii) If holders seek protection under “**guarantee marks**”, their applications will be refused based on the main paragraph of Article 3(1).

| Types of marks | |
|---------------------|---|
| Collective mark | Protectable as “collective marks” or “regional collective marks” |
| Certification marks | Protectable as “collective marks”, “regional collective marks”, or “ordinary marks” |
| Guarantee marks | Not-protectable |

◆ Payment of Second Part of Individual Fee (Rule 34(3))

- Second part of individual fee: 328 (CHF) for each class

*First Part: 99 (CHF) for one class plus × 75 (CHF) for each additional class

- Payment to WIPO

- Within **3 months** from the date on which the statement of grant of protection is sent. If the second part of the individual fee is not paid within the deadline, the international registration **will be cancelled with respect to Japan.**

**The new Rule 5bis “Continued Processing” will take effect on Jan. 1, 2015, whereby an applicant or holder who failed to comply with a time limit may submit a request to IB for continued processing.*

- ◆ JPO conducts examination on:
 - Clarity of goods/services
 - Absolute grounds
 - Relative grounds
 - Intention to Use

- ◆ Frequently cited Grounds for Refusal are:
 - (1) Clarity of goods/services (Article 6(1))
 - (2) Similarity to prior registered trademarks (Article 4(1)(xi))
 - (3) Intention to Use (main paragraph, Article 3(1))

[Note] JPO does not have a partial registration system, meaning that if applicants do not respond to provisional refusals, their entire applications will ultimately be refused.

(1) Clarity of goods/services (Article 6(1))

CLASS HEADINGS

- Class headings of list of classes, with explanatory notes under the NICE Agreement, do not cover all goods or services in that class.
- Some of the class headings are acceptable as indications of goods or services, provided that the indication meets the clarity requirement.
- Unacceptable class headings and examples for alternative indications are provided on the JPO's website (English page):
http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm

Unacceptable class headings [NCL(10-2014)]

- 1: Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry;
- 6: Ironmongery, small items of metal hardware; goods of common metal not included in other classes;
- 7: Machines and machine tools;
- 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments;
- 12: Vehicles; apparatus for locomotion by land, air or water;
- 14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes;
- 16: Paper, cardboard and goods made from these materials, not included in other classes;
- 17: Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; packing, stopping and insulating materials;
- 18: Leather and imitations of leather, and goods made of these materials and not included in other classes;
- 20: Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics;
- 24: Textiles and textile goods, not included in other classes;
- 31: Grains and agricultural, horticultural and forestry products not included in other classes;
- 36: Financial affairs; monetary affairs;
- 37: Repair;
- 40: Treatment of materials;
- 41: Sporting and cultural activities;
- 42: Scientific and technological services and research and design relating thereto;
- 44: Agriculture, horticulture and forestry services;
- 45: Personal and social services rendered by others to meet the needs of individuals.

4. JPO Examination Practices (1) Goods and Services

Examples:

NCL(10-2014)

| Class | Unacceptable indications | Examples of acceptable indications |
|-------|--|--|
| 6 | Goods of common metal not included in other classes; | Pipes of metal; metal materials for building or construction; metal joinery fittings; safes; hardware of metal, small; prefabricated building assembly kits of metal; reservoirs of metal; industrial packaging containers of metal; |
| 7 | Machines and machine tools; | Metalworking machines and tools; construction machines and apparatus; textile machines and apparatus; food or beverage processing machines and apparatus; printing or bookbinding machines and apparatus; agricultural machines and implements; packaging or wrapping machines and apparatus; |
| 9 | Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; | Apparatus and instruments for scientific research in laboratories; nautical, surveying, photographic, cinematographic, optical, and weighing apparatus and instruments; measuring apparatus; luminous or mechanical signals; electric monitoring apparatus; life-saving apparatus and equipment; teaching apparatus; |
| 16 | Paper, cardboard and goods made from these materials, not included in other classes | Paper, boxes of paper, table cloths of paper, table napkins of paper, cardboard and cardboard articles; |
| 42 | Scientific and technological services and research and design relating thereto; | Scientific and technological research and development; computer software design; industrial design; |

* Please refer to the JPO's website for alternative indications for other classes.

http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm

Unacceptable indications relating to retail/wholesale services (Class 35)

● “Retail services”, “Retail store services” or “Retail services or wholesale services for all goods”

→ These are considered to be too vague. Goods which are subject to retail or wholesale services must be specified. e.g. “Retail services for cosmetics”

● “The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods”

→ It is not clear whether the service described above is service to support others’ businesses; or retail services or wholesale services.

<Suggestions for amending and limiting the indication>

“The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods (other than retail or wholesale services)”

or

“Retail or wholesale services for [specified goods]”

Tools to find acceptable indications of goods/services

● List of Goods and Services at Industrial Property Digital Library (IPDL)

JPO website: https://www2.j-platpat.inpit.go.jp/SH1/sh1e_search.cgi?TYPE=000&sTime=1452059646885

The database includes:

- Indications of goods and services listed in the Japanese Ministerial Ordinance
- Indications in the Nice Alphabetical List
- Indications on the ID List
- Indications accepted in past examinations

● Madrid Goods & Services Manager (MGS)

4. JPO Examination Practices (1) Goods and Services



Help desk (9:00-21:00)
(+81)3-6666-8801
helpdesk@j-platpat.inpit.go.jp

Japanese Top page Help list Site map JPO INPIT



Patent & Utility Model Design Trademark

Number search Classification search Text search Classification

Patent & Utility Model

Patent & Utility Model Number Search

FI/F-term Search

PAJ

Patent Map Guidance(PMGs)

Design

Design Number Search

Design Classification Search

Japan

Trademark

Searching Figure Trademarks or Non-traditional Marks

Japanese Trademark Database
Searching Goods & Services
Japanese Well-known Trademark

Table of Contents

Searching Goods & Services Help

Search List

You can retrieve appropriate goods and services for Japanese trademark applications by the name of goods and services.

For similar group code or classification, please refer to the [information about designating goods and services](#).
Look at [NEWS](#) about the update. In addition, please confirm [NOTICE](#) on appointing a product, labor.

The version of the referred international classification.

- International classification; 10th edition, version 2015 (NCL(10-2015)) (Applied to the applications on or after January 1st,2015.)
- International classification; 10th edition, version 2014 (NCL(10-2014)) (Applied to the applications on or after January 1st,2014.)
- International classification; 9th edition (Applied to the applications on or after January 1st,2007.)

The data kind can be selected.

- Examination guidelines for similar goods and services
- International Classification of Goods and Services(Nice Classification)
- TMS ID List
- Goods and Services accepted at examination(Japanese or English only)
- WIPO Madrid Goods and Services Manager

Goods and Services AND

Class Similar group code OR

Search

NEWS

[News](#)

Links

[Related Web Site](#)

Database Contents

[Patent & Utility Model Number Search](#) [Design Number Search](#)

[FI/F-term Search](#) [Design Classification Search](#)

[PAJ](#) [Japanese Trademark Database](#)

[Japanese Figure Trademarks](#)

Access Total : 259,838

How to Use

[Notice on Usage](#)

Questionnaire

(2) Similarity to prior registered trademarks (Article 4(1)(xi))

Key factors for determining similarity:

□ Similarity of Marks

Visual, aural and conceptual similarities of the marks are all considered together. Other factors such as target market/consumers for the designated goods or services, state of commercial transactions for the designated goods or services, and level of consumers' awareness are taken into consideration.

□ Similarity of Goods/Services

Whether the goods/services are similar in terms of production stage, stage of sales, materials and quality, intended purpose, targeted consumers, and relationship between finished-products and parts are taken into consideration.

* JPO examiners use **Similar Group Codes** to ensure consistent & efficient examination.

What are Similar Group Codes?

Similar group codes **presume similarity of goods and services** and are used as **keys** for searching prior trademarks. They ensure **consistency** in determining similarity of goods and services during the examination process; and degree of **predictability** for applicants and holders.

24C01 Sporting Equipment

Class 6
Diving boards of metal

Class 25
Ski boots, Gymnastic shoes,
Golf shoes

Class 9
Protective helmets for sports

Class 27
Gymnastic mats

Class 19
Diving boards, not of metal

Class 28
Ski gear, Weightlifting equipment

Similar

Examination Guideline for similar goods and services

| | | | |
|---------|-----------|--|-------|
| Class 9 | 測定機械器具 | Measuring or testing machines and instruments | 10C01 |
| | 1 基本単位計量器 | 1 Standard-unit measuring machines and apparatus | |
| | 温度計 | * Temperature indicators | |
| | ガスメーター | (*) Gasometers | |
| | 寒暖計 | Thermometers | |
| | 水量メーター | Water meters | |
| | はかり | Balances | |

International Classification of Goods and Services Alphabetical List in Japanese Translation with Similar Group Code

| Class 9 | Index | Indication of Goods(English version) | Indication of Goods(Japanese translation) | Similar Group Code | Basic No. | * | Remarks |
|---------|--------|--------------------------------------|---|--------------------|-----------|---|---------|
| | 3#0001 | 3D spectacles | 3D眼鏡 | 10B01, 11B01 | 090726 | | A14 |
| | A#0001 | abacuses | 計算器 | 09D01 | 090627 | | |
| | A#0021 | accounting machines | 会計機 | 09D01 | 090135 | | D13 |
| | A#0022 | accumulator boxes | アキュムレータボックス | 09E12, 11A03 | 090009 | | |
| | A#0023 | accumulator jars | 蓄電池槽 | 11A03 | 090008 | | |
| | A#0027 | accumulators, electric | 蓄電池 | 11A03 | 090361 | | |
| | A#0028 | accumulators, electric, for vehicles | 蓄電池 (乗物用) | 11A03 | 090007 | | |
| | A#0044 | acid hydrometers | 酸用浮きばかり | 10C01 | 090387 | | |
| | A#0046 | acidimeters for batteries | アシジメーター (電池用) | 10C01 | 090010 | | |

(3) Intention to Use (main paragraph, Article 3(1))

- It is not necessary for the trademark to be in actual use when applicants file applications.
- Japanese Trademark Act is based on “registration” rather than “use”.
- However, when **it is reasonably questionable whether the holders currently use or will use the trademark for the designated goods/services**, JPO examiners send provisional refusals to confirm the holder’s use of or intent to use the trademark.

For example:

- Scope of the designated goods/services is too broad
- Natural person designating “retail and wholesale services for clothing, foods, household items dealing in all goods together”
- Designated service is limited to only those qualified to provide such services (eg. private companies designating “legal services” that only qualified lawyers can provide.)
- In order to resolve grounds for refusal, holders needs to submit **evidence of proof showing their actual use or their intent to use; or limit the scope** of the designated goods/services.

The scope of the designated goods/services is considered to be too broad in JPO's examination practice when:

✓ the holder designates goods or services covered by eight or more similar group codes within one class

e.g. → See the next slide.

✓ two or more kinds of retail/wholesale services are designated

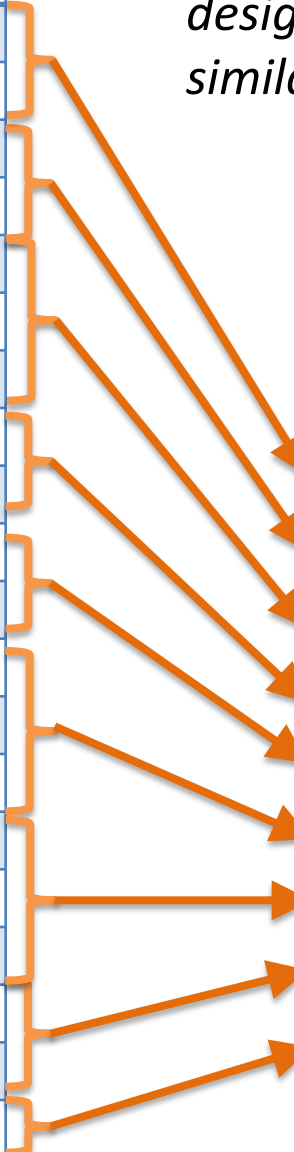
e.g.

• “Retail services for clothing”, “Retail services for footwear”, “Retail services for bags and pouches” → considered to be in the same type of retail services (35K02)

• “Retail services or wholesale services for automobiles”, “Retail services for cosmetics” → considered that two different types of retail services are designated (Similar group codes are “35K04” and “35K10” respectively.)

4. JPO Examination Practices (3) Intention to Use

An example of a case in which the holder designates goods covered by eight or more similar group codes within one class

| Class 9 | |
|--------------------------------|--|
| Fire escapes |  |
| Life jackets | |
| Laboratory centrifuges | |
| Ovens for laboratory use | |
| Cameras [photography] | |
| Microscopes | |
| Optical lenses | |
| Pressure indicators | |
| Scales | |
| Cables, electric | |
| Connections for electric lines | |
| DVD players | |
| Headphones | |
| Telephone apparatus | |
| Computers | |
| Computer software | |
| Integrated circuits | |
| Eyeglasses | |
| Sunglasses | |
| Protective helmets for sports | |

| Grouping | Similar Group Code |
|--------------------------------|--------------------|
| Life saving apparatus | 09G01 |
| Apparatus for laboratory use | 10A01 |
| Optical/Photographic apparatus | 10B01 |
| Measuring/testing apparatus | 10C01 |
| Electric wires and cables | 11A05 |
| Telecommunication apparatus | 11B01 |
| Electronic apparatus | 11C01 |
| Spectacles | 23B01 |
| Sporting equipment | 24C01 |

Holders may respond to grounds by any of the following ways:

(a) Providing documents* in order to prove that they are currently conducting business in Japan in connection with the goods/services.

*newspaper articles, catalogs, business documents etc.

(b) Providing documents showing that they are planning to conduct business in connection with the goods/services in Japan within three to four years from the date of the international registration or the subsequent designation:

(i) A Declaration of Intention to Use stating the expected date when the goods/services using the trademark will be launched in Japan; and

(ii) Documents stating the current state and schedule of their business plan; or

(c) Limiting the goods/services to a reasonable range. [Item VI of the provisional refusal can be helpful.]

JPO Reference number: 2014-351143 (1 / 2)

MD171A1

11.30

(3257)

審査長/代理: 小出 浩子 (8156)

審査官: 林田 悠子 (3257)

NOTIFICATION OF PROVISIONAL REFUSAL

This notification is issued by the Japan Patent Office (JPO) in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement and Section 15-2 and 15-3 of the Japanese Trademark Law.

I. International registration number: 1191373
Mark: GOLDSMITH
Date of international registration: 2013/12/11
Holder of the international registration:
SYNGENTA PARTICIPATIONS AG

II. This trademark application* shall be totally refused protection. The grounds for refusal are indicated under Item V. A copy of the corresponding provisions of the Japanese Trademark Law is attached to this notification.

III. This refusal is issued on August/07/2014 by

Hayashida Yuko (Ms.)
Examiner
Madrid Protocol Division
Facsimile: +81-3-3593-2398
Telephone: +81-3-3501-2392

IV. The trademark of this application can be protected subject to amendments to be made by the holder of the international registration as suggested under Item VI. The amendment must be made through the intermediary of a representative domiciled in Japan within three months from the date of pronouncement, as indicated below. If any, the holder may submit to the JPO a written opinion against this provisional refusal through the intermediary of a representative domiciled in Japan by the same date. Alternatively, the holder may request a limitation of the list of goods and/or services in accordance with Rule 25(1)(a) of the Common Regulations. This request must be presented to the International Bureau of WIPO by Official Form MM6.

See VI. Suggestions for Amendment/Limitation

* A request for territorial extension to Japan under the Protocol relating to the Madrid Agreement is deemed as a trademark application made in Japan in accordance with Section 68-9 of the Japanese Trademark Law.

The date of pronouncement: 2014/08/21

JPO Reference number: 2014-351143 (2 / 2)

Continuation sheet

V. The grounds for refusal

Ground 1

This application does not conform to the requirements provided for under Section 6(1) of the Trademark Law because some of the designated goods and services are inappropriately described in this application in a vague/broad manner(see below).

[vague/broad description]

Class 31 Agricultural, horticultural and forestry products and grains, not included in other classes.

Ground 2

The trademark of this application does not conform to the requirements as provided in the main paragraph of Section 3(1) of the Trademark Law because of the following reason:

The main paragraph of Section 3(1) requires that registerable trademarks either be currently in use or will be put into use in the near future; however, there is reasonable doubt as to whether the applicant currently uses or will use in the near future this trademark on the designated goods or services, as indicated below, because the designated goods or services come under too wide a scope within one class:

[All the designated goods or services in Class 31]

However, the above reason for refusal will be resolved if the above-mentioned doubt, as to the use of or the intent to use this trademark, is eliminated by the applicant's taking any of the following procedures (a), (b) or (c):

- (a) Proving that the applicant is conducting business connected with the above-mentioned designated goods or services in Japan by submitting some documents such as newspaper articles, catalogs, business documents etc.;
- (b) Proving that the applicant is planning to conduct business connected with the above-mentioned designated goods or services in Japan within three to four years from the date of the international registration or the subsequent designation by submitting both of the following documents:
 - (i) A written Declaration of Intention to Use stating when this trademark will begin to be used and what goods or services this trademark will be used for in Japan; and
 - (ii) Documents of Business Plan stating the current status of the applicant's business preparations; or
- (c) Limiting the above-mentioned designated goods or services to an appropriate range. [For your reference, examples of amendments/limitations can be found in Item VI.]

<Important notes for proving (a) or (b) above>

- (1) The Examination Guidelines are available on the JPO website at http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1303-061_3_6.pdf
- (2) The above-mentioned documents for proving (a) or (b) must be accompanied with a Japanese translation and submitted to the JPO through the intermediary of a representative domiciled in Japan.

VI. The trademark of this application will be protected if the goods and services are amended/limited as follows: (Examples are underlined. The underlined goods/services are the examples of amendment/limitation of the goods/services shown in V. Sometimes there are no underlined goods/services.)

31 Barley; grains (cereals); trees; fresh fruits and vegetables; seeds, seedlings, cuttings, natural plants and flowers.

Holders may respond to provisional refusals by:

Procedure for WIPO

- Filing requests to limit the indications of designated goods and services (Official Form MM6)
- Limitation can be requested at anytime, i.e., anytime while the case is before the JPO in order to resolve grounds for refusal.
- Limitations can be requested by holders or their representatives for International Registrations.

Procedure for the JPO

- Submitting amendments or opinions in writing within 3 months from the date on which the notice of provisional refusal was sent (extendable by another 1 month upon request)
- Amendments or opinions can be submitted only through representatives domiciled in Japan.

**Communication between a holder or representative for IRs and a representative in Japan is important.*

6. After receiving a Grant of Protection

A letter of “Decision to grant a registration” is sent to the holder or a representative domiciled in Japan (if any) from JPO.

JPO Reference number: 2014-353037 (1 / 1)

THE PROTOCOL RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

登録査定
DECISION TO GRANT A TRADEMARK REGISTRATION

起案日
Drafting date: 2014/09/29

I. 締約国官庁
Office of a Designated Contracting Party:
日本国特許庁 〒100-8915 東京都千代田区霞が関3-4-3
Japan Patent Office (JPO) 4-3, Kasumigaseki 3-chome Chiyoda-ku Tokyo 100-8915 JAPAN
Tel: +81-3-3501-2392 Fax: +81-3-3593-2398
日本国特許庁審査官 林田 悠子 (3257)
Examiner of the JPO Hayashida Yuko

II. 国際登録番号/International registration number:
1197292
商標/Mark:
YOS
国際登録日/Date of international registration:
2013/10/01
商品又は役務の区分の数/Number of classes of goods and services:
1

III. 商標登録出願人の氏名又は名称/Holder of the international registration:
NOVACYL

IV. この商標登録出願*については、拒絶の理由を発見しないから、この出願に係る商標は、日本国において登録すべきものと認めます。
The trademark of this application* is to be registered as a trademark registration in Japan with respect to all the goods and/or services in this application since no reason for refusal has been found.

*マドリッド協定議定書に基づき日本国を指定する領域指定は、商標法第68条の9の規定により、日本国における商標登録出願とみなされます。
*A request for territorial extension to Japan under the Protocol relating to the Madrid Agreement is deemed as a trademark application made in Japan in accordance with Section 68-9 of the Japanese Trademark Law.

注意事項 / Note:
「個別手数料の第二の部分」は、後日、国際事務局から送付される「個別手数料の第二の部分」に関する通知書に記載された期日までに、当該個別手数料を国際事務局に納付してください。納付されない場合には、我が国に関する国際登録簿の国際登録は取り消されます。
The second part of the individual fee is payable within the prescribed period indicated in the notification, which will be transmitted from the International Bureau in due course. Where the second part of the individual fee is not paid within the said period, the international registration in the International Register shall be cancelled with respect to Japan.

審査長/代理: 小出 浩子 (8156)
審査官: 林田 悠子 (3257)

発送日 2014/10/09

“Statement of grant of protection” and “Notification of second part of individual fee” are sent to the holder or a representative of international registration (if any) through IB.

JPO Reference number: 2014-353037 (1 / 1)

MADRID AGREEMENT AND PROTOCOL
FINAL DISPOSITION ON STATUS OF A MARK

STATEMENT OF GRANT OF PROTECTION

notified to the IB
 Rule 19a(1) of

I. Office sending the state
Japan Patent Office

II. International registration
Mark:
Date of international registration:

III. Holder of the international registration:
NOVACYL

IV. The protection is to be granted
with respect to all the goods and services:

JPO Reference number: 2014-353037 (1 / 1)

THE PROTOCOL RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

NOTIFICATION OF SECOND PART OF INDIVIDUAL FEE

This notification is issued pursuant to the Rule 34(3)(C) of the Common Regulations.

Drafting date: 2014/09/29

I. Office of a Designated Contracting Party:
Japan Patent Office (JPO) 4-3, Kasumigaseki 3-chome Chiyoda-ku Tokyo 100-8915 JAPAN
Fax: +81-3-3580-8033

II. International registration number: 1197292
Mark: YOS
Date of international registration: 2013/10/01

III. Holder of the international registration:
NOVACYL

IV. Number of classes of goods and services for which the mark is protected: *
1

V. Date by which a second part of individual fee must be paid:
The payment shall be paid to the International Bureau by the following date.
2015/01/09

*Note
Where the second part of the individual fee is not paid by the above-mentioned date, the International Bureau shall cancel the International registration in the International Register with respect to Japan. [Rule 34(3)(d)]

VI. Date on which the notification was pronounced: 2014/10/09

Payment due date

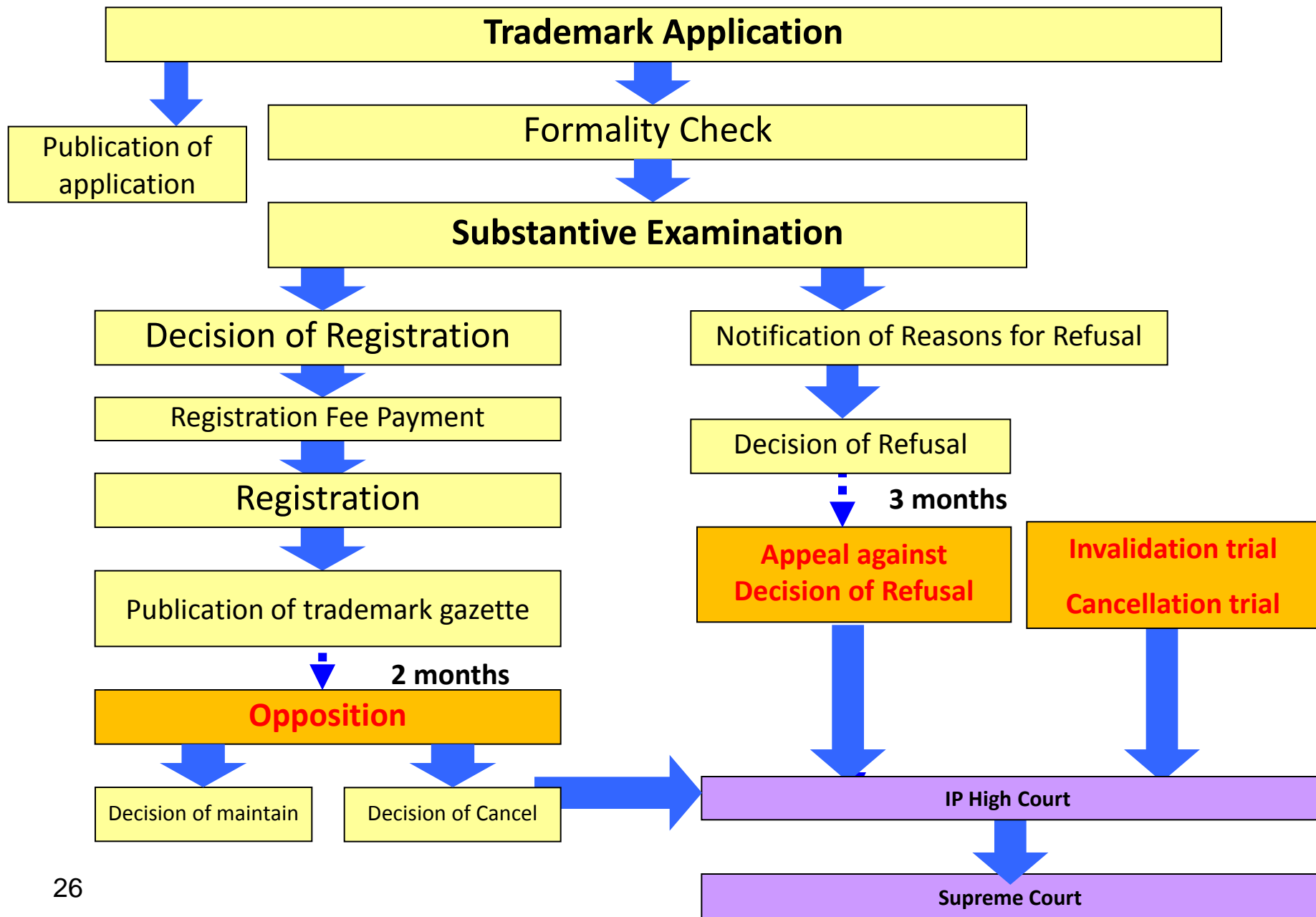
- ◆ Payment of Second Part of Individual Fee (Rule 34(3))
 - Second part of individual fee: 328 (CHF) for each class
 - *First Part: 99 (CHF) for one class plus × 75 (CHF) for each additional class
 - Payment to WIPO
 - Within **3 months** from the date on which the statement of grant of protection is sent. If the second part of individual fee is not paid within the deadline, the international registration **will be cancelled with respect to Japan.**
- *The new Rule 5bis “Continued Processing” will take effect on Jan. 1, 2015, whereby an applicant or holder who failed to comply with a time limit may submit a request to IB for continued processing.*

◆ Certificate of Trademark Registration

Certificate of trademark registration will be issued and sent directly to the holder or a representative domiciled in Japan (if any) after the trademark has been registered at JPO.



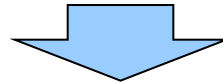
7. Opposition, Appeals and Trials



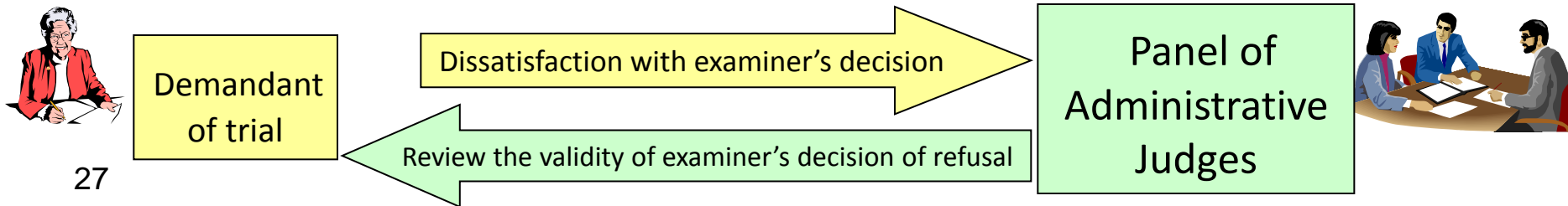
7-1. Appeals against Examiners' Decisions of Refusal

Article 44 (1) of the Trademark Act

Applicants who receive examiners' decisions stating that their applications are to be refused and who are dissatisfied with these decisions may request to have trials to reverse the examiners' decisions of refusal within 3 months from the date on which they were served the examiners' decisions.



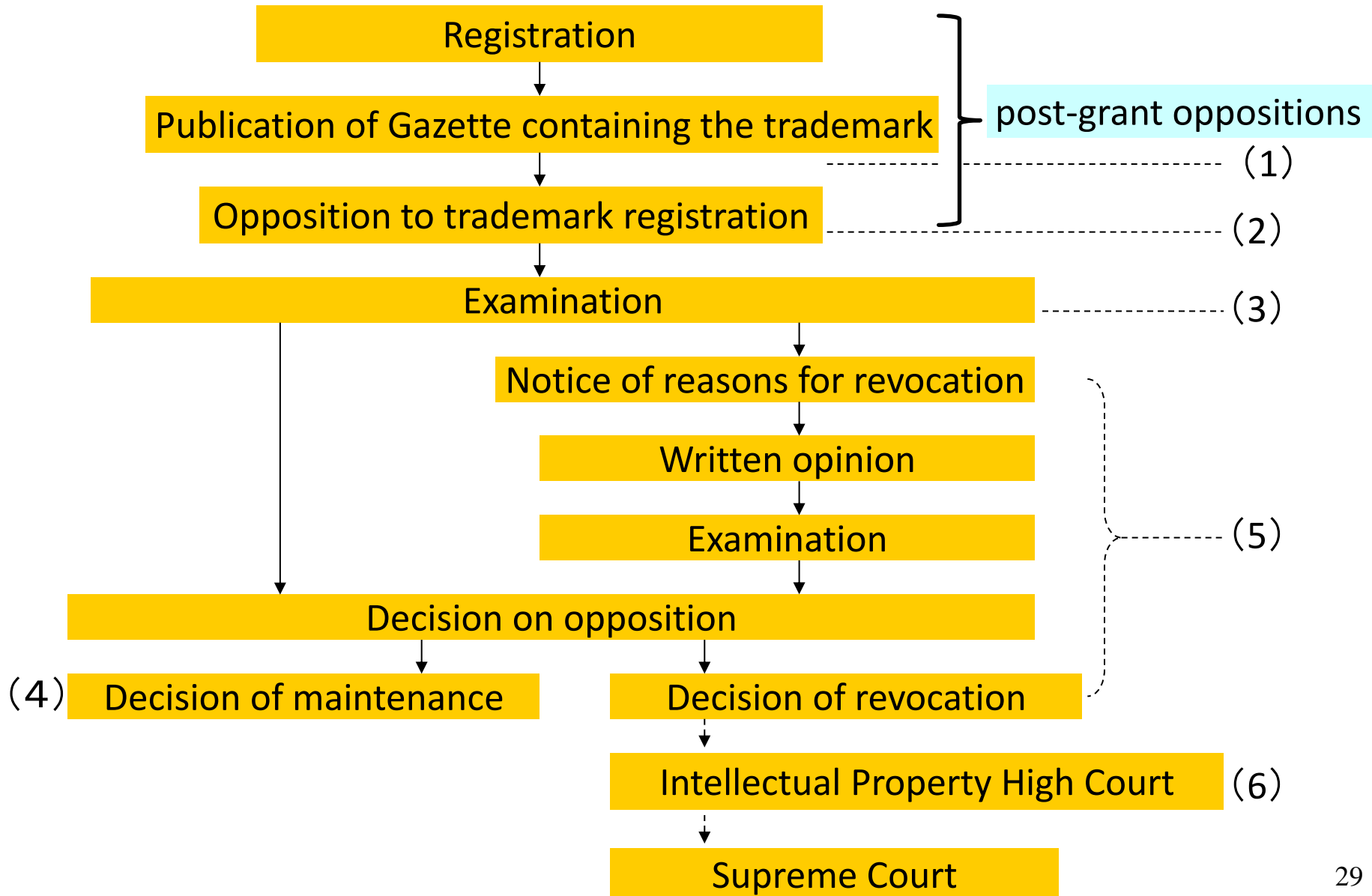
- Under the Trademark Act of Japan, the applicants who are not satisfied with examiners' decisions of refusal for their trademarks, are not allowed to immediately file lawsuits in courts. Instead, the JPO established a system of ex parte re-examination proceedings in order to review and make decisions on the validity of examinations conducted by examiners.
- A panel of Administrative Judges, after conducting ex-officio searches, will conduct trials to review and decide on the validity of examiners' decisions of refusal.



7-2. Oppositions to trademark registration

| | |
|---|---|
| Who conducts examinations? | Panel |
| Mede of examinations | Examination by documentary proceeding in principle |
| Participation | Participation for the purpose of assisting trademark right holders |
| Ex-officio examination | <ol style="list-style-type: none">1) Reasons for which an appeal is not made by the opponent may be examined2) Goods or services for which an opposition is not made may not be examined |
| Opportunity for counterargument for trademark right holders | Submission of written opinions in response to a notice of reasons for rescission |
| Decision | Decision of rescission or maintenance of registration |
| Action | <ol style="list-style-type: none">1) Trademark right holder may take an action before the Intellectual Property High Court for rescission of the decision of rescission.2) Opponent is not able to take an action against the decision of maintenance. |

7-2. Oppositions to trademark registration



Thank you for your attention!

- ❑ JPO website: <http://www.jpo.go.jp/index.htm>
- ❑ Information for Holders of International Registrations seeking Extension of Protection to Japan under the Madrid Protocol:
http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm
- ❑ [FAQs](#) > Madrid Protocol: <http://www.jpo.go.jp/english/faqs/madrid.html>