

Handling of Country Names in the Japanese Trademark System

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1. Overview

(1) Any application for trademark which consists solely of a country name shall be refused as trademarks lacking distinctiveness, because such a trademark is generally considered to indicate the place of origin or the place of sale of designated goods¹.

Relevant Article and Examination Guidelines:

- Article 3 (1) (iii) of the Trademark Act.
- Para 3 and 11 of the Examination Guidelines for the said article.

(2) Any application for trademark which consists solely or partly of a country name shall be refused, if the designated goods include goods originated from countries other than the inherent namesake country, because it is likely to be misleading as to the origin/quality of the goods².

Relevant Article and Examination Guidelines:

- Article 4 (1) (xvi) of the Trademark Act.
- Para 3 of the Examination Guidelines for the said article.

(3) Any application for trademark which partly contains a country name, such as in the case stated in (2) above, can be registered provided that the designated goods³ are originated from the inherent namesake country, and there are no other reasons for refusal.

(4) Variations of country names such as abbreviations shall be handled in the same manner as the formal and official names provided that such variations are considered to indicate those country names.

Relevant Article and Examination Guidelines:

- Article 3 (1) (iii) of the Trademark Act.
- Para 3 of the Examination Guidelines for the said article.

(5) If, in contrary to the above provision on handling country names, any trademarks that should have been refused were registered, such registrations can be cancelled or invalidated through oppositions or invalidation trials.

¹ The same applies to services.

² The same applies to services.

³ The same applies to services.

Relevant Articles:

- Article 43-2 and 46 of the Trademark Act.

2. The Legal Basis

Trademark Act

(Requirements for trademark registration)

Article 3 Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

- (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;

(Unregistrable trademarks)

Article 4 Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

- (xvi) is likely to mislead as to the quality of the goods or services;

(Examiner's decision of refusal)

Article 15 Where an application for trademark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused:

- (i) the trademark pertaining to an application for trademark registration is not registrable pursuant to the provisions of Articles 3, 4(1), 7-2(1), 8(2), 8(5), 51(2) (including the case of its mutatis mutandis application under Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under 77(3) of this Act;

(Limitations of effects of trademark right)

Article 26 A trademark right shall have no effect on any of the following trademarks (including those which constitute part of other trademarks):

- (ii) a trademark indicating, in a common manner, the common name, place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages; the same shall apply in the following item), price, the method or time of production or use of the designated goods or goods similar thereto, or the common name, location of provision, quality, articles to be used in such provision, efficacy, intended

, quantity, modes, price or method or time of provision of services similar to the designated goods;

Examination Guidelines for Trademarks

Article 3(1)(iii)

3. (1) A trademark indicating a geographical name in Japan or overseas does not necessarily require that the designated goods are produced or sold or designated services are provided practically at the place indicated by the geographical name. Where a consumer or a trader generally recognizes that the designated goods will be produced or sold or the designated services will be provided at the place indicated by the geographical name, the trademark falls under the provision of this Item as indicating origin or place of sale of the goods or location of provision of the service. The names of states, famous geographical names (including the names of administrative zones, former state names and foreign geographical names), the names of shop streets (including famous foreign busy streets), maps, etc. are considered, in principle, as the place of origin of goods or the place of their sale or the location of provision of services (including the place of trading).

[NOTE] "A geographical name in Japan and overseas" shall include a name or a map indicating a nation, a capital, a state, a prefecture, the capital of a state, a province, the capital of a province, a county, a prefectural capital (the capital of a prefecture), an old nation, an old area, a country, a city, a special city ward, an administrative area, a busy downtown street, a sightseeing area (including its location and surrounding areas), a lake, a mountain, a river, or a park, etc. (the same shall apply hereinafter).

11. A foreign state name, geographical name, etc. directly indicating a specific cooking style (such as French, Italian, Beijing, etc.) in connection with a service relating to the "providing of foods and beverages" is judged to indicate the quality of the service.

Article 4 (1)(xvi)

3. A trademark including a state name, a geographical name, etc. which is recognized to indicate the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services and used for goods produced and sold or services provided in a country or a place other than those where it is inherently produced and sold or provided falls under the provision of this paragraph on the ground that the trademark is liable to be misleading as to the quality of goods or services.

Especially, those trademarks in which the description of the composition of appearance is well united or conceptually related to the state name contained, (excluding cases where the term is a

segment of an established word etc. not being recognized as a name of a state.), in principle, fall under the provision of the paragraph as indicating the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services.

3. The Applicable Procedures

(1) Pre-registration

Any person or any legal entities can provide information on trademark applications with the Japan Patent Office (JPO). Examiners at the JPO refer to information provided in the examination and decide to grant or refuse registration. The Ordinance for Enforcement of the Trademark Act of Japan stipulates the following provisions;

The Ordinance for Enforcement of the Trademark Act

(Information that can be provided)

Article 19(1)

Where an application for trademark registration has been filed, any person may provide the Commissioner of the Patent Office with information to the effect that the application for trademark registration is unregistrable pursuant to the provisions of Art. 3, Art. 4(1)(i), (vi) through (xi), (xiii), or (xv) through (xix), Art. 7-2(1), or Art. 8(2) or (5) of the Trademark Act by submitting a publication, a copy of an application for trademark registration, or any other document with regard to said application for trademark registration. However, only those trademark applications pending before the JPO are subject to the offering of information.

(2) Post-registration

Any registration that has been made in violation of Article 3 (1) (iii) or Article 4 (1) (xvi) can be cancelled or invalidated. The Trademark Act of Japan stipulates the following provisions;

Trademark Act

(Opposition to registration)

Article 43-2 Any person may file with the Commissioner of the Patent Office an opposition to registration within two months from the date of publication of the bulletin containing the trademark, on the grounds that the trademark registration falls under any of the following items; in this case, an opposition to registration may be filed for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or

designated services:

- (i) where the trademark registration has been made in violation of Article 3, 4(1), 7-2(1), 8(1), 8(2), 8(5), 51(2) (including its mutatis mutandis application under Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under Article 77(3) of this Act; and

(Trial for invalidation of trademark registration)

Article 46 Where a trademark registration falls under any of the following items, a request for a trial for invalidation of the trademark registration may be filed; In this case, where the trademark has been registered in connection with two or more designated goods or designated services, a request may be filed for each of the designated goods or designated services:

- (i) where the trademark registration has been made in violation of Article 3, 4(1), 7-2(1), 8(1), 8(2), 8(5), 51(2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 77(3) of this Act;
- (v) where, after the trademark registration, the registered trademark has become a trademark that falls under any of Articles 4(1)(i) to 4(1)(iii), 4(1)(v), 4(1)(vii) and 4(1)(xvi); and

4. Trial Decisions

Trial decisions on trademarks consisting of or containing country names are as follows:

- Trial decision on an appeal against examiner's decision of refusal (Trial No.: 2004-474)

Applied mark: "LEBANON"

Designated goods: Class 1 Fertilizers, Plant growth regulating preparations

Summary : When the applied mark is used for the designated goods, traders and consumers would merely recognize that the designated goods were produced or sold in the Republic of Lebanon, i.e., the applied mark is considered to be an indication of the place of origin of the designated goods. Therefore, the applied mark lacks distinctiveness. In addition, if the applied mark is used for goods produced in countries other than Lebanon, it is considered to be likely to cause confusion as to the origin/quality of the goods. Accordingly, it falls under Article 3 (1) (iii) and Article 4 (1) (xvi).

- Trial decision on an appeal against examiner's decision of refusal (Trial No.: 2008-17491)

Applied mark: “tonga”

Designated goods: Class 25 Sash band for piggyback and huggy

Summary: When the applied mark is used for the designated goods, traders and consumers may invoke an image of the country named “Tonga”, and would consider that the designated goods were produced in the country of Tonga. Accordingly, such trademark falls under Article 3 (1) (iii) and Article 4 (1) (xvi).

○ Trial decision on an appeal against examiner’s decision of refusal (Trial No.: 2010-6312)

Applied mark: “JAMAICA JAXX”

Designated goods: Class 25 Clothing, Headgear for wear, Footwear, Masquerade costumes, Clothes for sports, Special footwear for sports.

Summary: The word “JAMAICA” in the applied mark would make traders and consumers recognize that the designated goods were produced in the country of Jamaica. Accordingly, if the applied mark is used for the goods produced in countries other than Jamaica, such trademark falls under Article 4 (1) (xvi), because such trademark is likely to cause confusion as to the origin/quality of the goods.