

Contribution of Japan concerning grounds for refusal of all types of marks

Japan's contribution concerning grounds for refusal of all types of marks is based on paragraph 12 of document SCT/20/4 adopted by the 20th Session of the SCT.

Section 3 of the Trademark Law mainly focuses on grounds for refusal with regard to distinctiveness of a mark; on the other hand, Section 4 of the Trademark Law covers various grounds for refusal including those related to an outrageous or obscene mark, a prior registered conflicting trademark, etc.

1. Section 3

Section 3(1) of the Trademark Law concerns the requirement of distinctiveness and does not allow registration of trademarks consisting of any of the following: (i) common names of the goods/services represented in a commonly used way, (ii) customarily used marks in relation to the designated goods/services, (iii) geographic names indicating origins or sales places or words that show quality, quantity or usage of goods/services, etc., represented in a commonly used way, (iv) commonplace surnames or names of legal entities represented in a commonly used way, (v) very simple and commonplace marks, (vi) undistinguishable marks in addition to above marks. Nevertheless, according to Section 3(2) of the Trademark Law, where, as a result of being used, consumers come to be able to recognize that the mark is connected with a certain person's business, the mark can be registered in spite of the provisions of Section 3(1)(iii), (iv), (v).

Section 3 of the Trademark Law provides as follows:

Section 3 (Requirements for trademark registration)

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

(i) consists solely of a mark indicating, in a common manner, the common name of the goods or services;

(ii) is customarily used in connection with the goods or services;

(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;

(iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person;

(v) consists solely of a very simple and common mark; or

(vi) is in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

(2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.

According to Section 3(1)(i) of the Trademark Law, a trademark which consists solely of common names of goods/services represented in a common way cannot be registered. Common names are the general names of goods/services and are recognized as such in the business community and do not include words recognized as the names of goods/services only among specific business persons or specific consumers. This section applies to such marks; *e.g.* “WATCH” for watches, “BEAUTY SALON” for beauty salons.

According to Section 3(1)(ii) of the Trademark Law, a trademark customarily used in respect of goods/services is not registrable. Customarily used trademarks are marks unable to distinguish the source as a result of being commonly used in goods/services in the market or industry.

Section 3(1)(iii) of the Trademark Law does not allow registration of a trademark which consists solely of words indicating the geographic origin, place of sales, quality,

raw materials, efficacy, usage, shapes including package shapes, price, methods or time of manufacturing or use of goods; or the location of services, quality of services, articles used for providing services, effect, usage, quantity, modes or price of services, methods or time of providing services; *e.g.* “LONDON” for clothes, “GINJO” (used to refer to the quality of Japanese sake brewed from the finest rice) for Japanese sake, “WOOL” for clothes; “SPEEDY COPY” for copiers, “¥1,000” for books, “SURGEON” for medical services, “ATM” for banks.

According to Section 3(1)(ix) of the Trademark Law, a trademark which consists solely of a commonplace surname or a name of a legal entity represented in a common way is not registrable; *e.g.* “SUZUKI” (a common place surname in Japan), “TOKYO Co., Ltd.” (mere combination of a geographical name and Co., Ltd).

According to Section 3(1)(v) of the Trademark Law, a trademark consisting solely of a very simple and commonplace mark is not registrable; *e.g.* “○” (circle), “△” (triangle), “A” (letter of the alphabet), “123” (numeral).

According to Section 3(1)(vi) of the Trademark Law, a trademark not distinguishable, and unable to be recognized among consumers as a source identifier is not registrable; *e.g.* background patterns, catch phrases, or shop names used by a great number of shops in the service.

Notwithstanding the above refusal grounds, according to Section 3(2) of the Trademark Law, where, as a result of being used, consumers come to be able to recognize that the mark is connected with a certain person’s business, the mark can be registered in spite of provisions of Section 3(1)(iii), (iv), and (v). Such acquired distinctiveness is determined by a comprehensive examination that takes into account facts, such as (a) trademarks and goods/services being actually used, (b) terms and geographic areas the trademark being used, (c) quantity of goods/services produced,

certified or sold, and the marketing scale; *e.g.* number of stores, marketed geographic areas, sales volume, (d) advertising methods, numbers and contents, (e) numbers and contents introduced by general or trade papers, magazines or websites, and (f) questionnaire surveys.

2. Section 4

Section 4 of the Trademark Law provides another threshold for trademark registration as follows:

Section 4 (Unregistrable trademarks)

(1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;

(ii) is identical with, or similar to, the coats of arms or any other State emblems (except national flags of any country of the Union to the Paris Convention, member of the World Trade Organization or Contracting Party to the Trademark Law Treaty) of a country of the Union to the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967; the same shall apply hereinafter), a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty designated by the Minister of Economy, Trade and Industry;

(iii) is identical with, or similar to, a mark indicating the United Nations or any other international organization which has been designated by the Minister of Economy, Trade and Industry;

(iv) is identical with, or similar to, the emblems or titles in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Act No.159 of 1947) or the distinctive emblem in Article 158 (1) of the Act Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Act No.112 of 2004);

(v) is comprised of a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national or a local government of Japan, a country of the Union to the Paris Convention, a member of the World Trade

Organization or a Contracting Party to the Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if such a trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used;

(vi) is identical with, or similar to, a famous mark indicating the State, a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a non-profit enterprise

undertaking a business for public interest;

(vii) is likely to cause damage to public policy or morality;

(viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);

(ix) is comprised of a mark identical with, or similar to, a prize awarded at an exhibition held by the national or a local government (hereinafter referred to as the "Government, etc.") or by those who are not the Government, etc. but designated by the Commissioner of the Patent Office, or at an international exhibition held in a foreign country by the Government, etc. of the foreign country or those authorized thereby (except those used by the recipient of such a prize as part of his/her own trademark);

(x) is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

(xi) is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (referring to goods or services designated in accordance with Article 6 (1) (including cases where it is applied mutatis mutandis pursuant to Article 68 (1)); the same shall apply hereinafter), or goods or services similar thereto;

(xii) is identical with a registered defensive mark of another person referring to a mark registered as a defensive mark; the same shall apply hereinafter, if such a trademark is used in connection with designated goods or designated services relating to the defensive mark;

(xiii) is a trademark of another person (excluding those which had not been used by the said person for a period of one year or longer from the date the trademark right became extinguished) the right to which has been extinguished for a period of shorter than one year from the date of the extinguishment of the said trademark right (or the date on which a ruling to the effect that the trademark registration is to be rescinded or a trial decision to the effect that the trademark registration is to be invalidated is rendered; the same shall apply hereinafter) or a trademark similar thereto, if such a trademark is used in connection with the designated goods or designated services in connection with the trademark right of such other person or goods or services similar thereto;

(xiv) is identical with, or similar to, the name of a variety registered in accordance with Article 18 (1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto;

(xv) is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);

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

(xvii) is comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by the said member from being used on wines or spirits not originating from the region of the said member, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of the said member;

(xviii) consists solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function; or

(xix) is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);

(2) Where the State or a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a person undertaking a non-profit activity for public interest files an application for trademark registration falling under item (vi) of the preceding paragraph, the provision of the said item shall not apply.

(3) Items (viii), (x), (xv), (xvii) and (xix) of paragraph 1 shall not apply to a trademark falling under any of the said items which does not fall under the said item at the time of filing of an application for trademark registration.

4 Where a trial decision to the effect that a registration of a trademark is to be rescinded pursuant to Article 53-2 becomes final and binding, and the demandant of the said trial files a trademark application for the trademark pertaining to the rescinded registration following the said decision, or a trademark similar thereto, item (xiii) of paragraph 1 shall not apply.

Section 4(1)(i)-(vi) of the Trademark Law does not allow registration of trademarks where the mark is identical or similar to (i) the national or foreign national flag, (ii) state coat of arms or other emblems designated by the Minister of Economy, Trade and Industry, (iii) marks indicating United Nations or any other international organizations designated by the Minister of Economy, Trade and Industry, (iv) emblems or titles related to the Red Cross, etc., (v) official seals or signs designated by the Ministry of Economy, Trade and Industry, which is used for supervision or certification by the Government or local public entities when designating goods/services identical

with or similar to the goods/services such seals or signs are used, or (vi) famous marks indicating entities or agencies of the Government of Japan or local public entities or a non-profit organization working for the public interest, etc..

According to Section 4(1)(vii) of the Trademark Law, trademarks likely to contravene public order or morality are not registrable and include outrageous or obscene marks and discriminative or unpleasant marks that are likely to conflict with the public interests of society or morality.

According to Section 4(1)(viii) of the Trademark Law, trademarks containing the portrait of another person, full name (a combination of first name and family name), famous pseudonym, or famous abbreviation are not registrable without consent from the person concerned.

Section 4(1)(ix) of the Trademark Law does not allow registration of trademarks containing marks identical with or similar to a name of a prize awarded at an exhibition held by the Government or local public entities, a prize awarded by a non governmental body but designated by the Commissioner of the Japan Patent Office, or a prize awarded at an international exhibition held in a foreign country by its government or a person authorized thereby, except where the recipient of such a prize uses the mark as part of his trademark.

According to Section 4(1)(x) of the Trademark Law, a trademark which is identical or similar to a prior well-know mark used in connection with identical or similar goods/services is not registrable. A well-known mark in this paragraph includes not only a famous mark known throughout Japan but also a well-known mark that is widely recognized in a certain area.

According to Section 4(1)(xi) of the Trademark Law, a trademark identical with or similar to a prior applied, registered trademark used in identical or similar

goods/services with the registered mark is not registrable. Similarity of marks is determined in a comprehensive examination that takes into account the appearance, sound, and meaning of marks.

According to Section 4(1)(xii) of the Trademark Law, a trademark identical with a registered defensive mark in identical goods/services of the registration is not registrable. Defensive marks in Japan are specially registered marks in good/services which are not used or intended to be used but likely to cause confusion due to the fame of the well-known mark. It should be noted that this section only applies when the marks and goods/services are identical with the defensive mark.

According to Section 4(1)(xiii) of the Trademark Law, a trademark identical with or similar to a prior, expired mark is not registrable within at least one year after the expiration. This section helps to prevent the registration of trademarks when an expired trademark is renewed within one year after the expiration upon request.

Section 4(1)(xiv) of the Trademark Law does not allow the registration of a trademark identical with or similar to a name registered as a variety under the Agricultural Seed and Seedlings Law, when used on the seed or seedlings of the variety concerned, or goods/services similar to the seedlings.

According to Section 4(1)(xv) of the Trademark Law, a trademark which is likely to cause confusion in relation to another person's business is not registrable. This section applies not only when consumers are likely to actually confuse the source, but also when consumers are likely to recognize some economical or organizational relationship with another person's business.

According to Section 4(1)(xvi) of the Trademark Law, a trademark likely to mislead consumers with regard to its quality of goods/services is not registrable; *e.g.* a trademark containing a word, "ALMOND CHOCOLATE", for chocolate not

containing almonds.

Section 4(1)(xvii) of the Trademark Law does not allow registration of a trademark containing a mark indicating an origin of wines or spirits in Japan which has been designated by the Commissioner of the Japan Patent Office or a mark indicating an origin of wines or spirits in a Member of the World Trade Organization prohibited to be used on wines or spirits not originating in the region in that member, which is used in respect of wines or spirits not originating in the region.

According to Section 4(1)(xviii) of the Trademark Law, a trademark consisting solely of the three-dimensional shape of a good or its packaging with the shape being indispensable to secure the function of the designated goods or packages is not registrable.

Section 4(1)(xix) of the Trademark Law does not allow registration of a trademark identical with or similar to well-known trademarks in Japan or abroad when applied with unfair intention; *i.e.* intention to gain an unfair profit, intention to cause damage to the well-known mark owner, or other unfair intention. This provision applies to trademarks, such as; (a) a trademark, identical with or similar to a well-known mark in a foreign country, that is registered for the purpose of selling the registered mark to the well-known mark owner at a high price since the mark is still unregistered in Japan, or for the purpose of preventing the owner's expansion of its business into Japan, or of forcing the owner to make an agent contract with the applicant; (b) a trademark, identical with or similar to a well-known mark in Japan, that is registered in order to dilute the distinctiveness of the well-known mark or to impair its image.