

## Session 3

# Initiatives of JPO's Trademark Administration; Highlights of Japan's 15 year Experience since its Accession to the Madrid Protocol

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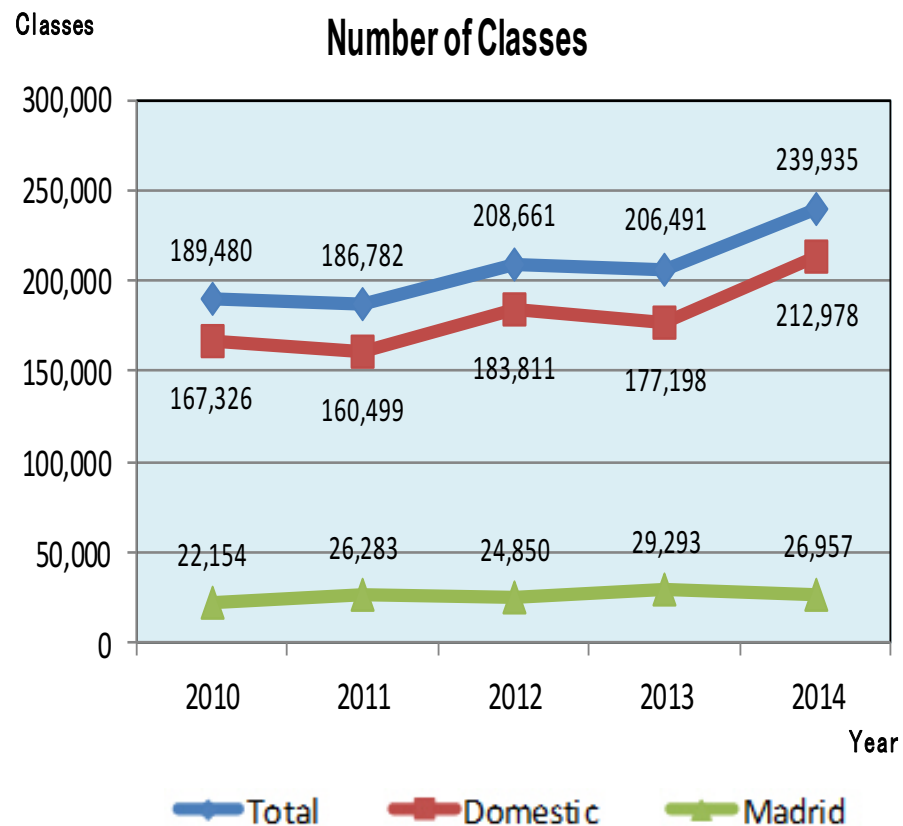
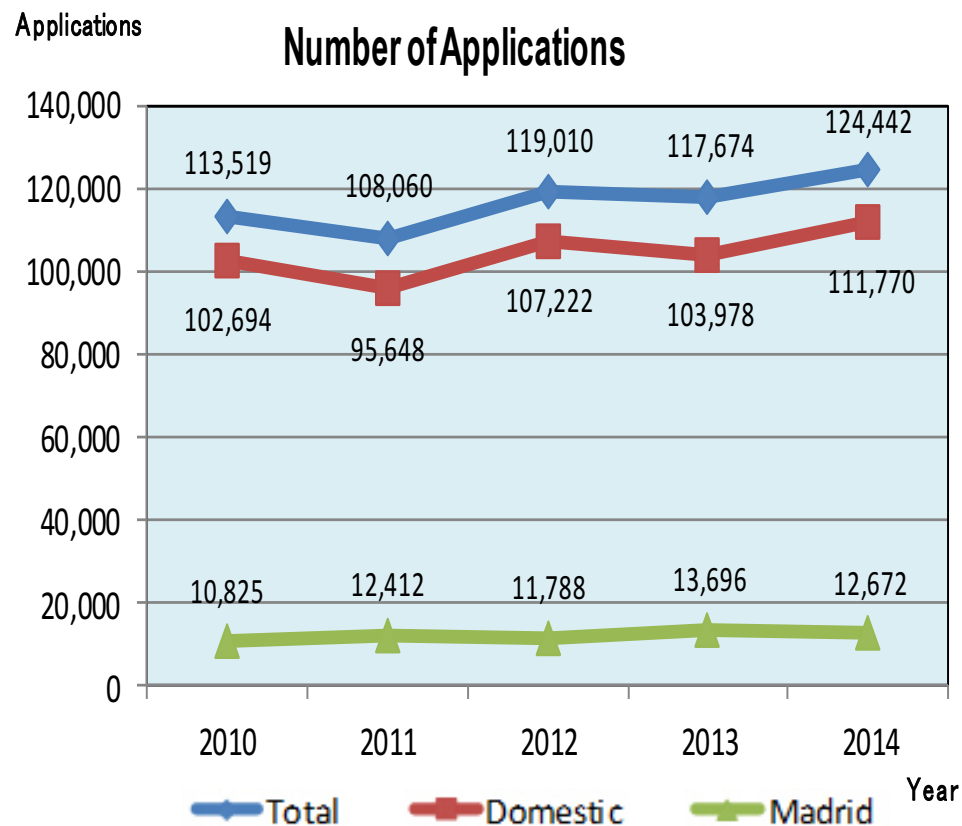


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4. Regional Collective Trademark System
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Appendix: Summary of the JPO's Presentation at Round table Discussion held on the margin of the WG of the Madrid Union on November 2015

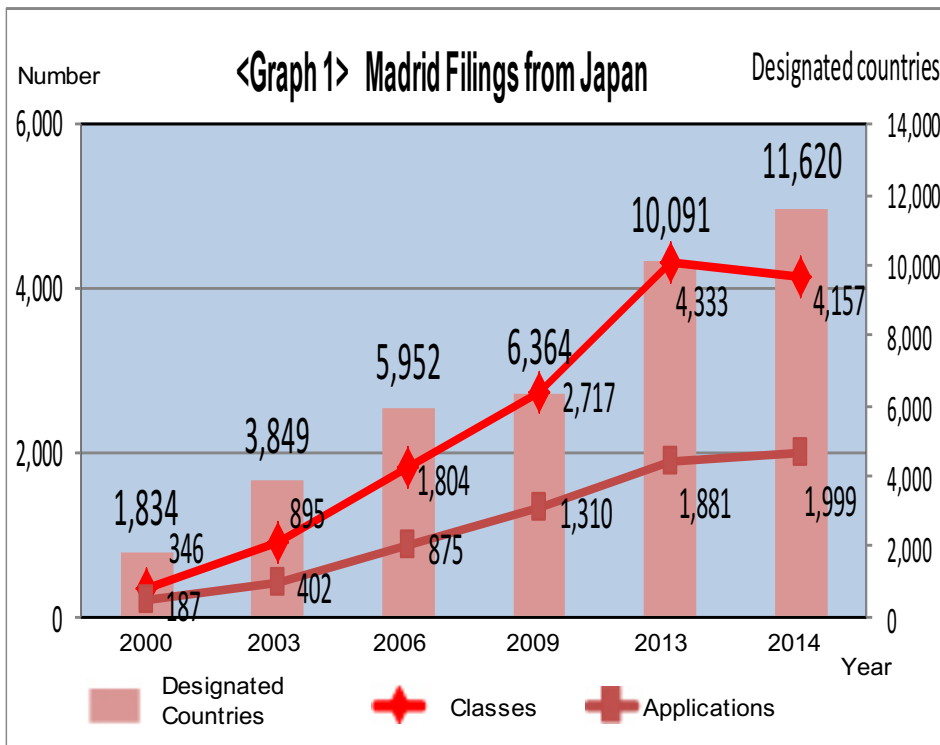
# 1. Trends in Trademark Applications at JPO (1) Last 5 years

The number of trademark applications filed at the JPO in 2014 exceeded 120,000, and is expected to increase slightly in 2015.

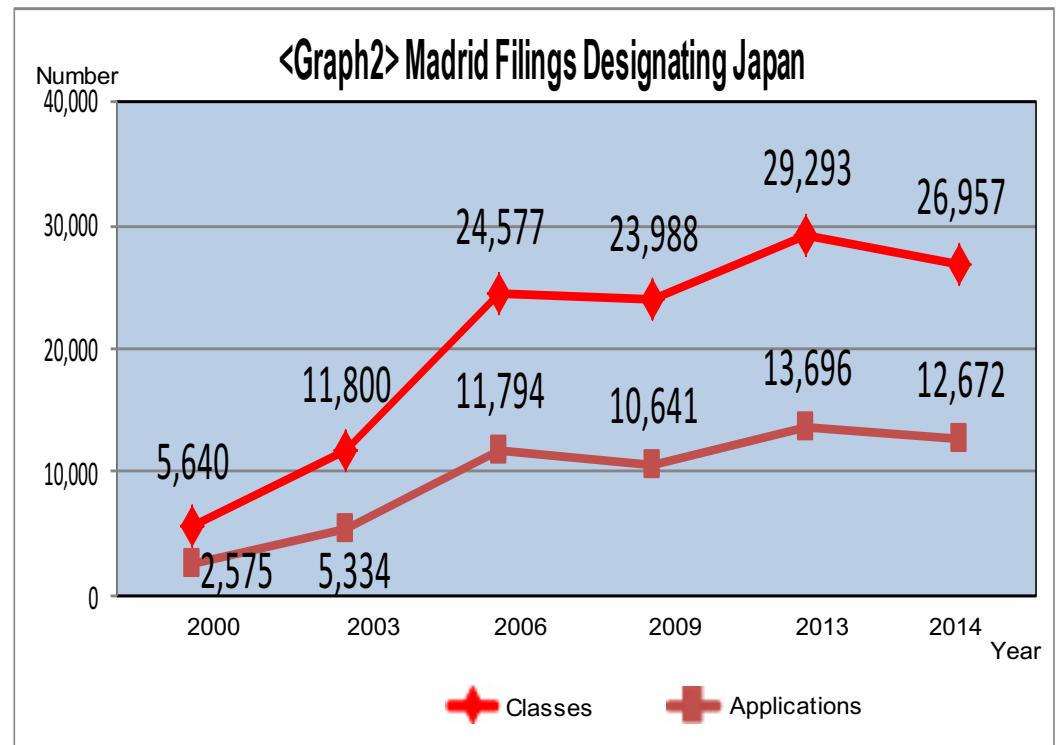


# 1. Trends in Trademark Applications at JPO (2) Madrid Protocol

Ever since Japan acceded to the Madrid Protocol in 2000, the number of international trademark applications from/to Japan using the Madrid Protocol has been increasing.



JPO started accepting applications from March 14, 2000.



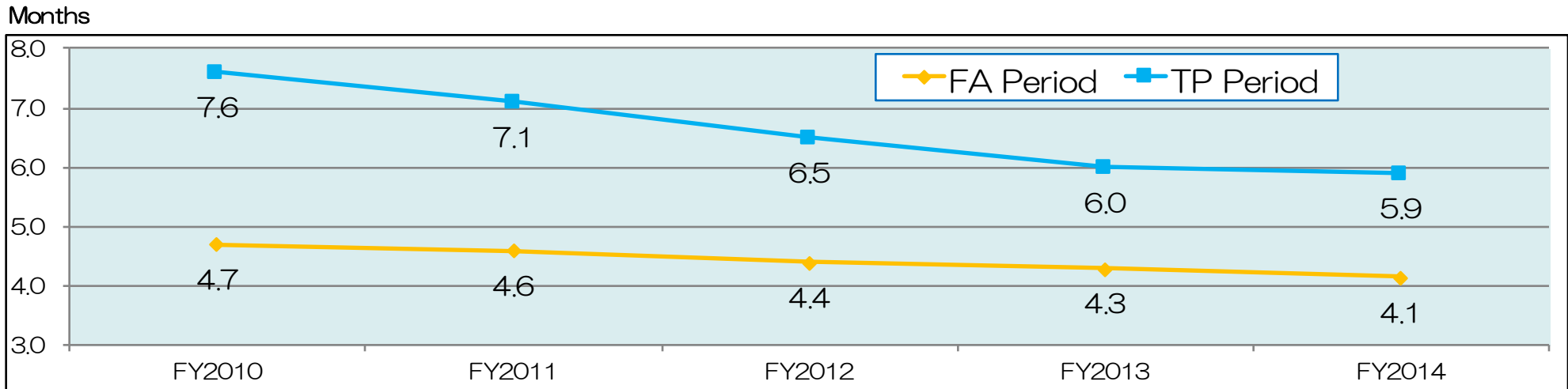
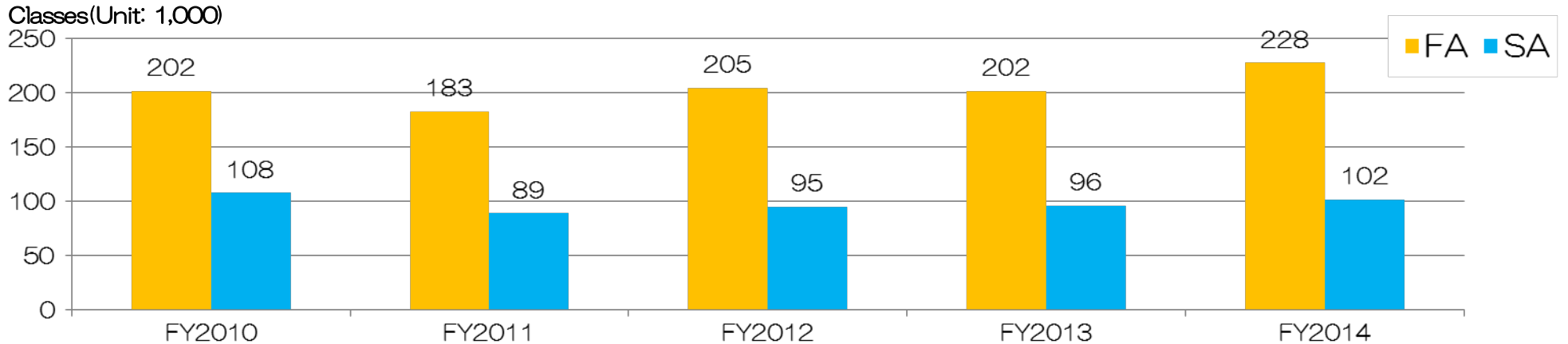
JPO started accepting applications from March 14, 2000.

## 2. Results of Trademark Examinations

JPO has steadily shortened the first action (FA) pendency and total pendency\* (TP) for trademark applications, by achieving prompt and efficient examinations.

\*Total Pendency: The period from the filing date of an application to the date a final decision are sent.

### Results of Trademark Examinations



### 3. Examination Quality Management

- The Subcommittee on Examination Quality Management was established (FY 2014)
- From the viewpoints of experts, the Subcommittee objectively evaluates the implementation system of examination quality management and its current status at JPO, and suggests improvements that need to be done on the basis of such evaluations.

Members: 11 Experts (University professors, lawyers, patent attorneys, business operators, quality management professionals, etc.)

- A variety of initiatives to assure and verify the quality of trademark examinations

#### Initiative 1: Formulating “Quality Policy” and “Quality Manual”

- **Quality Policy**; Basic principles of quality management for trademark examinations.  
[http://www.jpo.go.jp/seido\\_e/quality\\_mgt/pdf/quality\\_mgt/trademark.pdf](http://www.jpo.go.jp/seido_e/quality_mgt/pdf/quality_mgt/trademark.pdf)
- **Quality Manual**; Documenting and publishing the quality management system and its implementation, and the clarified roles and responsibilities of departments and officials in trademark examination process.  
[http://www.jpo.go.jp/seido\\_e/quality\\_mgt/trademark\\_manual.htm](http://www.jpo.go.jp/seido_e/quality_mgt/trademark_manual.htm)

#### Initiative 2: Quality Assurance

- **Approvals**; Director’s substantive and formal check of trademark examination, including the check of drafted documents of all the trademark applications.
- **Utilization of Check Sheets for Examiners**; To avoid typical careless mistakes that could be made in the examination process, and the approver can easily check the examiners’ judgement.
- **Consultations**; Knowledge Sharing and Opinion Exchange between Examiners and Directors.

#### Initiative 3: Quality Verification

- **Quality Audit**; Reviewing approved documents and Checking the appropriateness of decisions, reasoning behind notifications in trademark examinations.
- **User Satisfaction Survey and Exchange of Opinions with Users**; Clarifying points that need to be improved, by gathering user feedback.
- **Discrepancy Analysis between Examination Decisions and Trial/Appeal Decisions**; Assessing differences between results of examinations and appeal/trial decisions, with a view to develop the initiatives of improving the quality of trademark examinations.

# A tool to protect “Regional Brands” under Trademark System in Japan

**Regional Collective Trademark = “Name of Region” + “Name of Goods (Service)”**

**(e.g.) Kobe Beef = Kobe + Beef**

- In the past, registration was not allowed, in principle, for trademarks that combined a “name of region” with a “name of goods (service)”, which are typically used as “Regional Brands”. The “Regional Collective Trademark System”, which is a system for registering such trademarks, was enforced in 2006.
- Presently, 587 trademarks (As of Dec. 31, 2015) in the field of the following goods or services are registered as regional collective trademarks.

### Breakdown of Regional Collective Trademarks by Product (As of Dec. 31, 2015)

Vegetables	Rice	Fruits	Meat, beef and chicken
56	7	44	58
Fish and seafood products	Processed food	Milk and dairy products	Seasoning
45	52	5	16
Confections	Noodles and grains	Tea	Liquors
11	11	16	13
Soft drinks	Plants	Fabric, clothing and fabric goods	Crafts, bags, bowls and sundries
1	3	56	80
Pottery and tiles	Toys and dolls	Buddhist shrines, Buddhist objects, funeral objects and furniture	Articles of precious metals, blades and tools
28	15	37	9
Lumber, stones and coal	Hot springs	Services (excluding hot springs)	
14	42	15	

Note: When one registration designates several goods, it is accounted for under each good.

## 4. Regional Collective Trademark System (2) Dissemination Activities

- In order to broadly disseminate the Regional Collective Trademark System, JPO conducts explanatory meetings on the outline of the System and its examinations/practices throughout Japan, upon requests.
- JPO also distributes a brochure that provides an easy to understand explanation about the Regional Collective Trademark System to promote the dissemination and use of the System to users.
- A booklet titled “Case Examples of Regional Collective Trademarks” that introduces the details of the goods and services that were registered as regional collective trademarks is published each year. The booklet is distributed to prefectures, municipalities, Commerce and Industry Associations, Chambers of Commerce and Industry, tourist associations, and right holders, as well as distributed at explanatory meetings to broadly disseminate the system to the public.

Brochure



Case Examples of Regional Collective Trademarks



Distributed to



- Prefectures,
- Municipalities,
- Commerce and Industry Associations,
- Chambers of Commerce and Industry,
- Tourist Associations,
- Right Holders, etc.



## 4. Regional Collective Trademark System (3) Expansion of Requirement for Eligible Entities (Revision of Article 7-2, Trademark Act)

- In the past, the eligible entities for registration were limited to associations such as business cooperative associations, agricultural cooperatives, and fisheries cooperatives. The eligible entities for registration were expanded to Commerce and Industry Associations, Chambers of Commerce and Industry, and specified non-profit organizations (NPOs) that are playing a key role in disseminating the regional brands in recent years. (The revision became effective on August 1, 2014.)
- It became possible to provide protection at an early date through the System to regional brands that are being disseminated by the Commerce and Industry Associations and other entities.

### Examples of registered regional collective trademarks in the past

- Trademark: 青森の黒にんにく (Aomori No Kuro Ninniku)  
Aomori Black Garlic
- Right Holder: 協同組合青森県黒にんにく協会  
Aomori Black Garlic Association
- Trademark: 天草ぶり (Amakusa Buri)  
Amakusa Yellowtail
- Right Holder: 熊本県海水養殖漁業協同組合  
Kumamoto Seawater Culture Fisheries Cooperative Association
- Trademark: 鴨川温泉 (Kamogawa Onsen)  
Kamogawa Spa
- Right Holder: 鴨川温泉旅館業協同組合  
Kamogawa Onsen Hotels Cooperative Association



### Example of the first registered trademark by a new eligible entity under new system

- “小豆島オリーブオイル (Shodoshima Olive Oil)” of Shodoshima, Kagawa Prefecture  
(NPO Corporation: 小豆島オリーブ協会 (Shodoshima Olive Association))



Photo Credit: Shodoshima Town

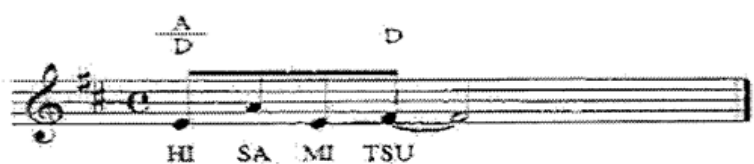
## 5. Recent Development on Non-traditional Trademarks in Japan (1)

- The Trademark Act was amended in May 2014 to include the protection of non-traditional trademarks and provide support for corporate brand strategies (Effective from April 1, 2015)
- JPO has revised its trademark examination guidelines in order to examine Non-traditional Trademarks appropriately.

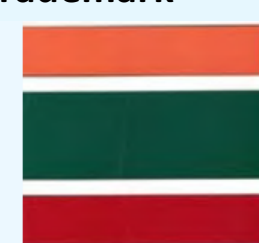
### Examples of “Non-Traditional Trademarks” Registered Abroad

#### Sound Trademark

Registered in  
Europe  
Hisamitsu Pharmaceutical Co., Inc.



#### Color Trademark



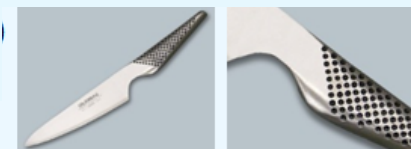
Registered in Australia  
7- Eleven, Inc.

#### Position Trademark



Registered in the US  
Yoshida Metal Industry Co., Ltd.

Example  
of usage:



#### Motion Trademark



Registered in  
Europe

Toray Industries, Inc.

#### Hologram Trademark



Registered in Germany  
Nikon Corporation

## 5. Recent Development on Non-traditional Trademarks in Japan (2)

- JPO started accepting applications for non-traditional trademarks on April 1, 2015
- We accepted more than 1,100 applications by the end of December 2015 and 40 applications have been registered so far.

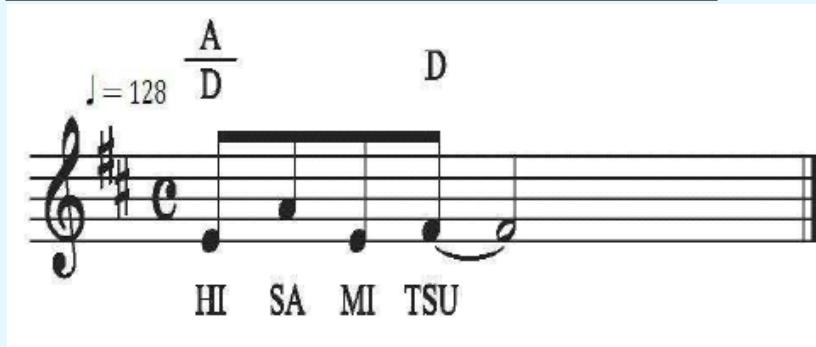
### Break down of Applications and Registrations of “Non-Traditional Trademarks”

	Total	Break down				
		Color	Sound	Position	Motion	Hologram
Applications on Apr/1/2015	481	192	151	103	32	3
Applications (from Apr 1 <sup>st</sup> to Dec. 31 <sup>st</sup> 2015)	1,150	448	365	243	80	14
Registrations (as of Dec. 31 <sup>st</sup> 2015)	40	0	21	5	13	1

## 5. Recent Development on Non-traditional Trademarks in Japan (3)

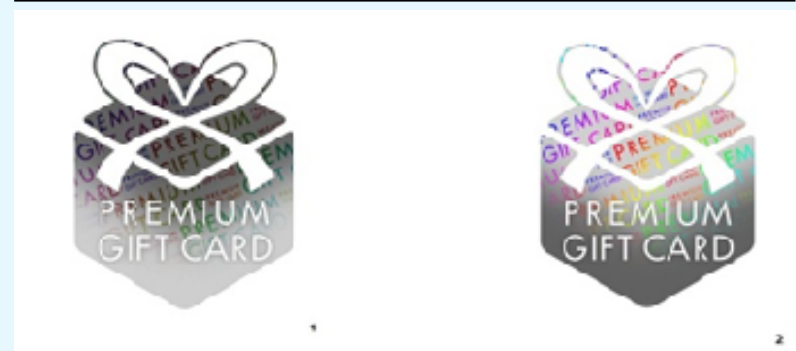
### Examples of “Non-Traditional Trademarks” which is registered in Japan

#### Sound Trademark(Reg.No.5804299)



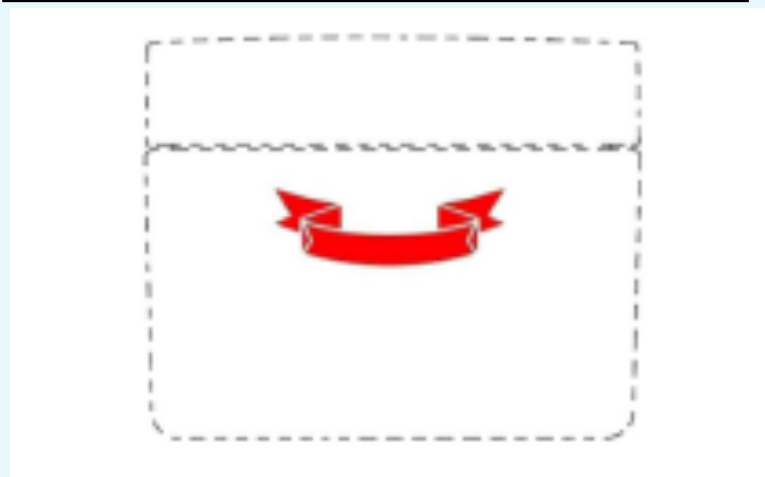
Hisamitsu Pharmaceutical Co., Inc.

#### Hologram Trademark(Reg.No.5804315)



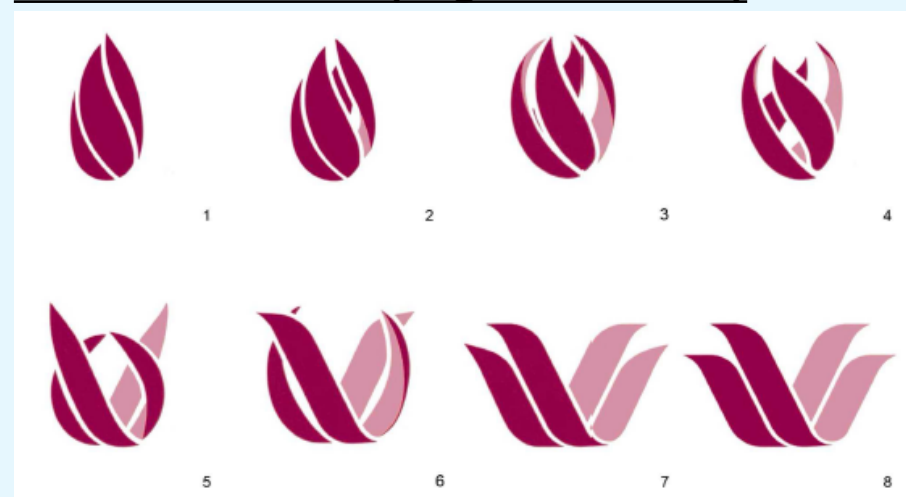
Sumitomo Mitsui Card Co., Ltd.

#### Position Trademark(Reg.No.5804314)



Dr.Ci:Labo Co., Ltd.

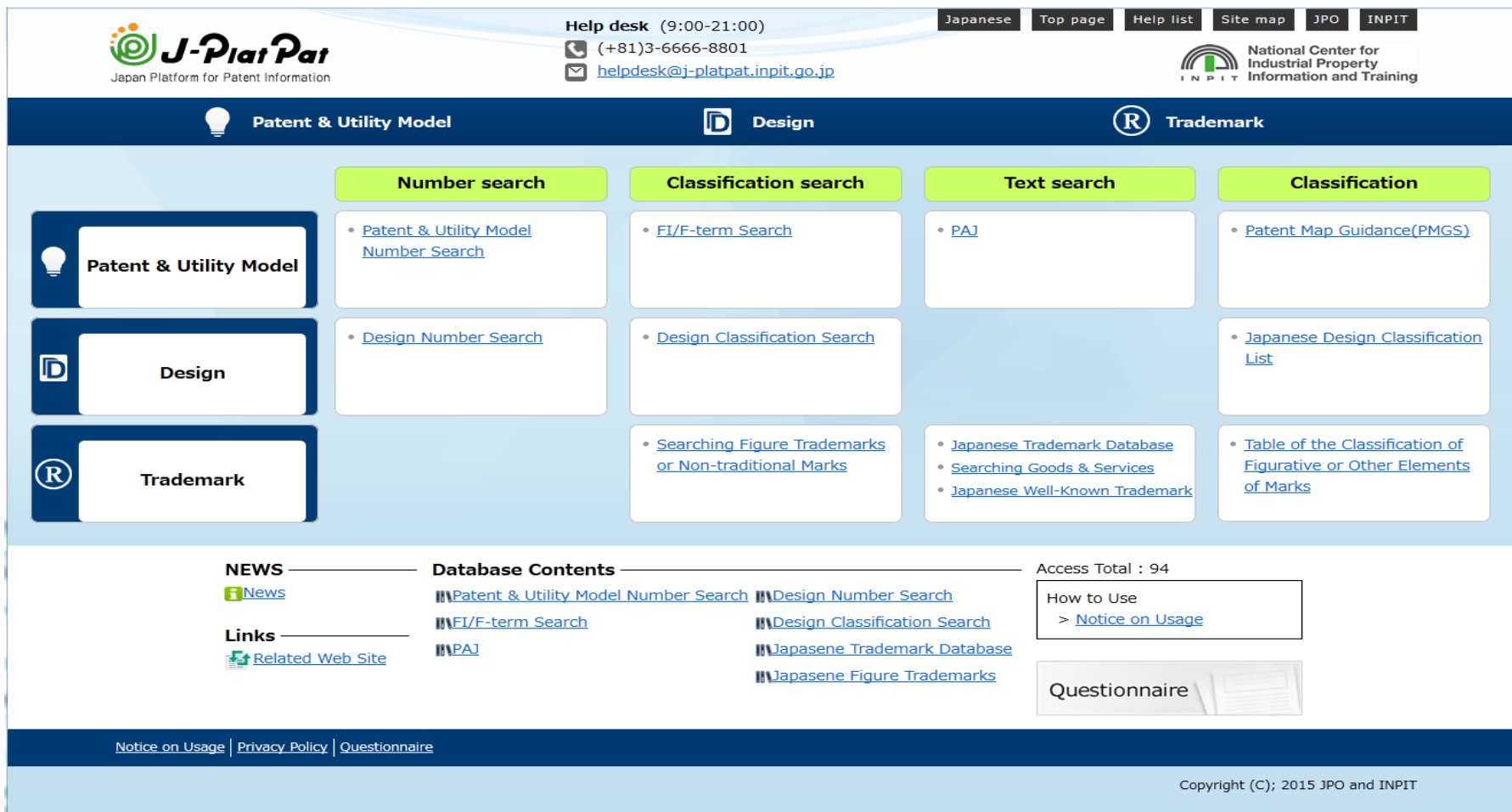
#### Motion Trademark(Reg.No.5804316)



Wacoal Co., Ltd.

## 5. Recent Development on Non-traditional Trademarks in Japan (4)

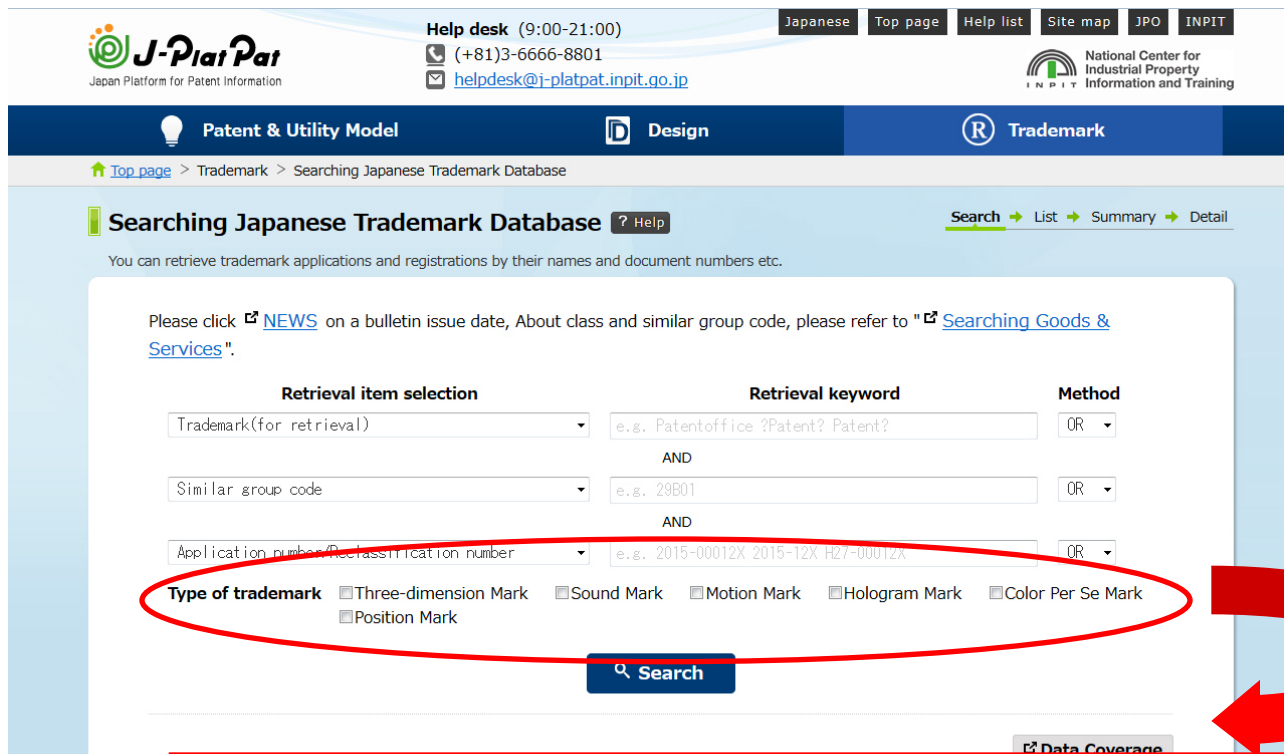
- JPO completely reformed the “Industrial Property Digital Library (IPDL)” in response to the user needs which are getting more sophisticated and diversified, and newly launched an information providing service named “J-PlatPat” from March, 2015.



The screenshot displays the J-PlatPat website interface. At the top, there is a navigation bar with the J-PlatPat logo, contact information for the help desk, and utility links like 'Japanese', 'Top page', 'Help list', 'Site map', 'JPO', and 'INPIT'. Below this is a dark blue header with three main categories: Patent & Utility Model, Design, and Trademark. The main content area is divided into four columns: Number search, Classification search, Text search, and Classification. Each column contains search options and links. For example, the 'Number search' column includes links for 'Patent & Utility Model Number Search' and 'Design Number Search'. The 'Classification search' column includes links for 'FI/F-term Search', 'Design Classification Search', and 'Searching Figure Trademarks or Non-traditional Marks'. The 'Text search' column includes a link for 'PAJ'. The 'Classification' column includes links for 'Patent Map Guidance(PMGS)', 'Japanese Design Classification List', and 'Table of the Classification of Figurative or Other Elements of Marks'. At the bottom, there are sections for 'NEWS', 'Database Contents', 'Access Total', 'How to Use', and 'Questionnaire'. The footer contains links for 'Notice on Usage', 'Privacy Policy', and 'Questionnaire', along with the copyright notice: 'Copyright (C); 2015 JPO and INPIT'.

## 5. Recent Development on Non-traditional Trademarks in Japan (5)

- In using the “J-PlatPat”, it is possible to search non-traditional trademarks by type of trademark. \* Information stated on the application is used to determine the type of trademark.



The screenshot shows the J-PlatPat search interface. At the top, there is a navigation bar with 'Patent & Utility Model', 'Design', and 'Trademark' tabs. The 'Trademark' tab is selected. Below the navigation bar, there is a search bar and a 'Search' button. The search results page displays a table with columns for 'Retrieval item selection', 'Retrieval keyword', and 'Method'. The 'Retrieval item selection' column has three rows: 'Trademark(for retrieval)', 'Similar group code', and 'Application number/Reclassification number'. The 'Retrieval keyword' column has three rows: 'e.s. Patentoffice ?Patent? Patent?', 'e.s. 29B01', and 'e.s. 2015-00012X 2015-12X H27-00012X'. The 'Method' column has three rows, each with a dropdown menu set to 'OR'. Below the table, there is a section for 'Type of trademark' with several checkboxes: 'Three-dimension Mark', 'Sound Mark', 'Motion Mark', 'Hologram Mark', 'Color Per Se Mark', and 'Position Mark'. A red oval highlights the 'Type of trademark' section, and a red arrow points from it to a larger red box below the screenshot.

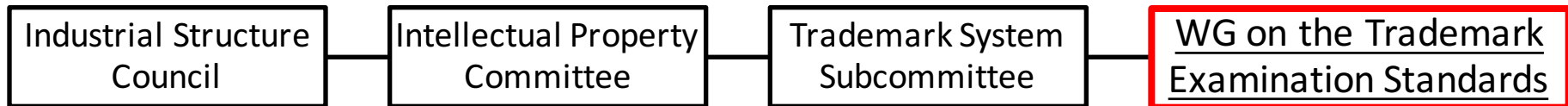
Three-dimension Mark    Sound Mark    Motion Mark    Hologram Mark    Color Per Se Mark  
 Position Mark

Please mark the type of trademark you want to search!



## 6. Revision of Trademark Examination Guidelines

- The Working Group on the Trademark Examination Standards was established in 2012 in order to discuss the amendment and formulation of the “Trademark Examination Guidelines”.
- In Fiscal Year 2014, the Working Group discussed the Guidelines of non-traditional trademarks. From Fiscal Year 2015 to 2016, from the perspective of further enhancing the appropriateness and the predictability of trademark examinations, the Working Group is under discussion the overall revision of the Guidelines.



### Schedule of individual discussion topics

#### <FY2015>

Mainly discussing the Distinctiveness of the trademarks which is defined in the Article 3 of the Trademark Act dealing with Requirements for trademark registration

(examples)

- Corporate slogans and the other similar phrases (3-1-6)
- Common names of goods or services (3-1-1)
- Marks which indicating the Quality of goods or services (3-1-3)
- Acquired Distinctiveness Through Use(3-2), etc.

#### <FY2016>

Mainly will be discussed the Unregistrable trademarks such as similar trademarks with the another persons registered trademarks which is defined Article 4 of the Trademark Act

(examples)

- Judging the similarity of trademarks (including non-traditional trademarks)(4-1-11)
- Contravention of Public order or morality(4-1-7)
- Names of another person(4-1-8)
- Well-known trademarks of another person (4-1-10,15)
- Misleading as to the quality of the goods and services,(4-1-16) etc.

## 7. The Singapore Treaty on the Law of Trademarks

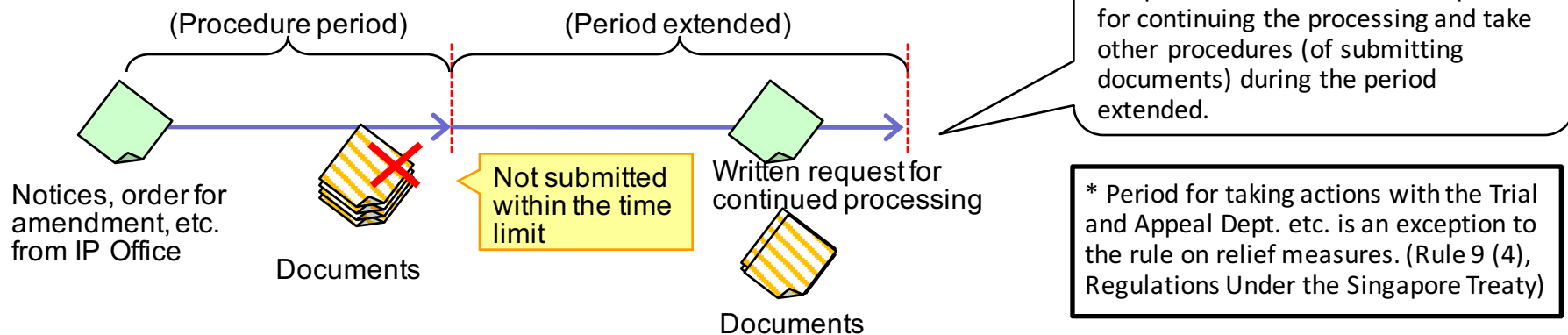
### Outline of The Singapore Treaty

- The Singapore Treaty was adopted in March 2006 and came into force in March 2009.
- Number of Member Countries: 42 (As of December 2015)
- The Treaty incorporated the content of the Trademark Law Treaty (TLT) which has been in force since 1996 and has the objective of standardizing and simplifying the procedures for trademark registration applications that are different in each country, to improve user-friendliness, and reduce the burden on applicants.

### Adapting Japan's Trademark Act

- Japan acceded to the TLT in 1997 and the provisions of the Singapore Treaty except for the provision on the Relief Measures in Case of Failure to Comply with Time Limits (Article 14 (2), Singapore Treaty) are already provided for under the Trademark Act.
- In order to accede to the Singapore Treaty, we revised the Trademark Act in July 2015 for implementing the Treaty, by creating a new provision on relief measures in case of failure to comply with time limits regardless of the legal term or designated time limit (in view of Article 14 (2) (ii), Singapore Treaty) in the Trademark Act.
- The revised Trademark Act is scheduled to come into force around spring of 2016.

### Conceptual Diagram of Relief Measures



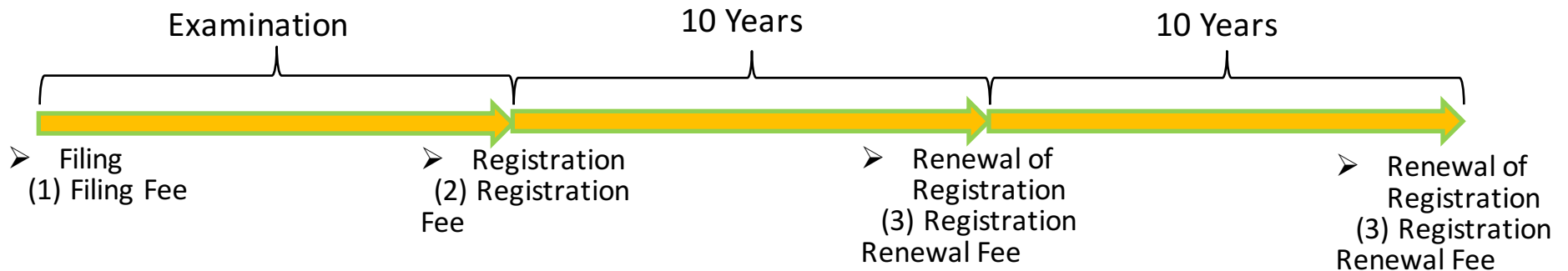


## 8. Revision of the Registration Fee and the Registration Renewal Fee

- JPO considered revising the fees for the purpose of reducing the burden on users, strengthening the corporate competitiveness and promoting economic revitalization through further use of trademarks.
- We reduced the registration fee by approximately 25% and the renewal registration fee by approximately 20%.
- The revision was promulgated in July 2015. The enforcement date will be specified by a Cabinet Order within a period not exceeding one year from the date of promulgation.

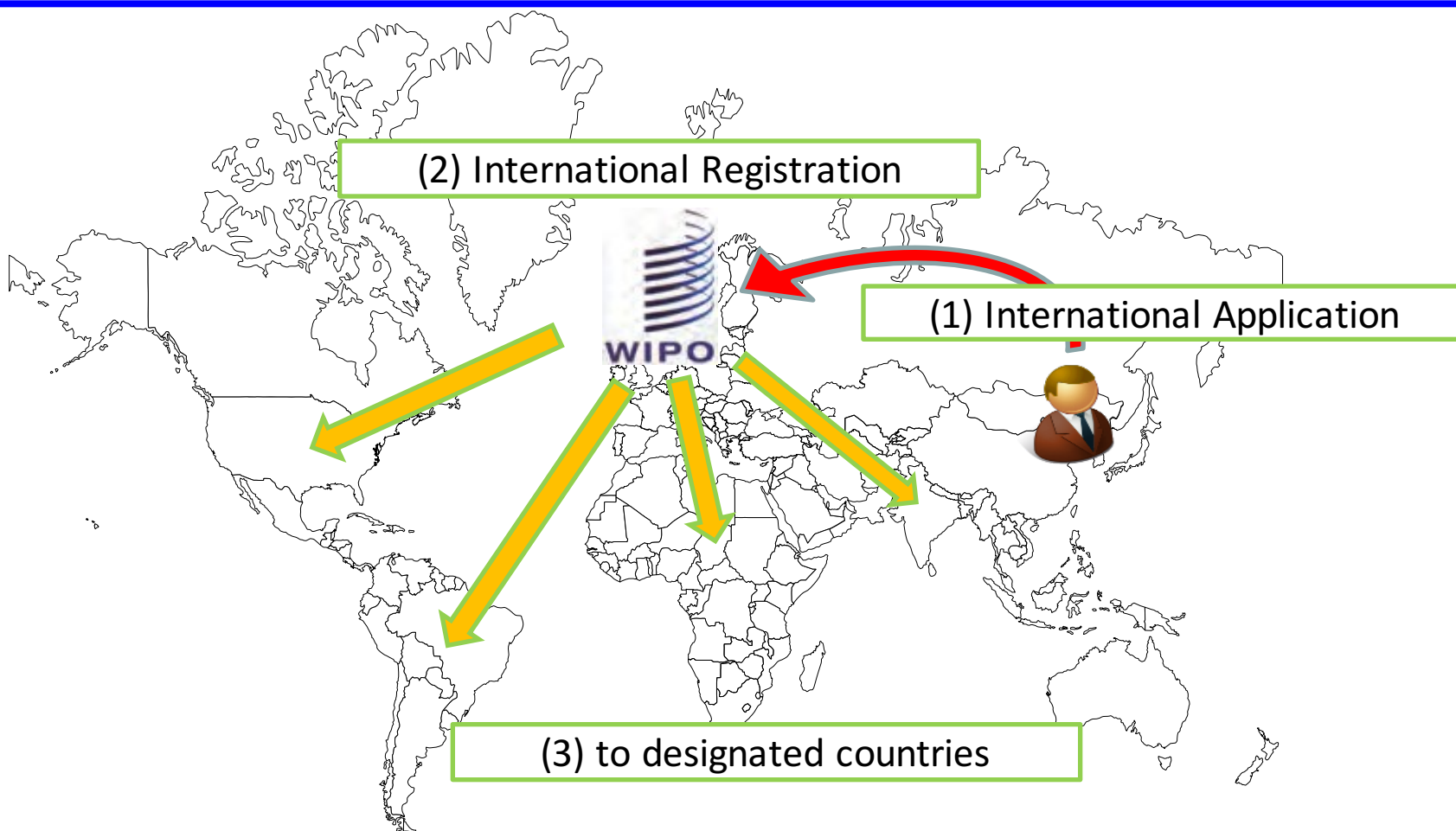
	Current Fee	New Fee	Provision (Japanese Trademark Act)
Registration Fee (For 10 years)	JPY37,600 X No. of Classes	<b>JPY28,200</b> X No. of Classes	Article 40 (1) Article 68-30 (1) (ii)
Registration Renewal Fee (For 10 years)	JPY48,500 X No. of Classes	<b>JPY38,800</b> X No. of Classes	Article 40 (2) Article 68-30 (5)

### Procedures and Fees for Obtaining/Maintaining Trademarks



## 9. Outline of the Madrid Protocol

- The Madrid Protocol is a treaty for filing international applications to the WIPO via various country's IP Offices and securing protection of trademarks in the designated countries after undergoing examinations based on laws of countries designated for protection.
- The Madrid Protocol was adopted in 1989. There are 97 Contracting Parties as of December 2015.



## 10. Japan's Accession to the Madrid Protocol

- In view of the user needs for simple, prompt and low-priced method of obtaining and protecting trademark rights not only in Japan but also abroad, under the circumstances in which international competition between companies was increasing, Japan acceded to the Madrid Protocol in December 1999. The Protocol came into force in March 2000.

### Conducting of User Needs Survey (July 1998)

Q1. Do you think Japan's accession to the Protocol would benefit your company?

Yes 94% (861 companies)

No 2% ( 14 companies)

Q2. If Japan joined the Protocol, would your company consider making use of the Protocol for filing abroad?

Yes 95% (741 companies)

No 5% ( 36 companies)

## 11. Preparations for Acceding to the Madrid Protocol

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### **Step 1: 1997～1998 Feasibility Study**

- Conducted User-needs Survey
- Researched Madrid application procedures conducted in other countries and at WIPO.

### **Step 2: 1998～1999 Trademark Law Amended**

- Revised Trademark Act
- Deposited an instrument of accession to the Madrid Protocol.

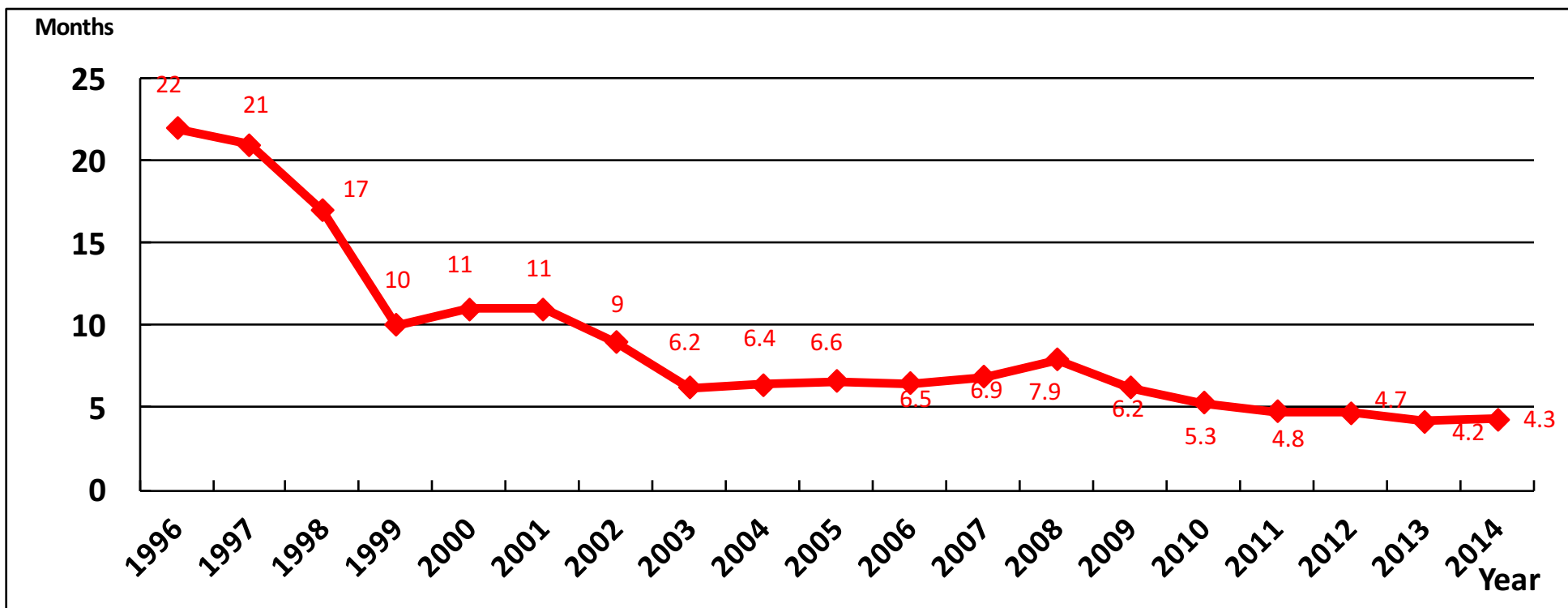
### **Step 3: 1999～2000 Final Preparations**

- Established the International Trademark Application Office (to function as the Office of Origin and the contacts with WIPO)
- Established the Substantive Examination Office for Madrid Applications(to function as the Designated Office)
- Conducted promotional activities to users(seminars & consultations)

**The Madrid Protocol became effective on March 14, 2000.**

## 12. Major Challenge for acceding to the Madrid Protocol

- In order to enter the Madrid Protocol, JPO has challenged to shorten Examination Period from FA 22 months to FA11 month, and has continued its effort after the accession.
- Measures taken:
  - support examination process through outsourcing
  - improve examination system (developed and introduced computer system)
  - hired new trademark examiners and assistant researchers and rehired former trademark examiners



# 13. Mechanism of Japanese Trademark System in Addressing the Madrid Protocol (1)

- Any requests for territorial extension designating Japan are deemed to be an application for trademark registration filed to Japan on the date of international registration. (Article 68-9, Trademark Act)  
(Subsequent designations are deemed to be an application for trademark registration filed to Japan on the day they were recorded on the international register.)
  - **This made it possible to apply existing procedures, examination practices, and registration procedures under the Japanese Trademark Act.**
  
- There are cases for which existing procedures under the Japanese Trademark Act cannot be applied, due to integrated management of the international register.
  - **Therefore provisions on exemption of procedures under the Japanese Trademark Act were established.**  
**Ex.: Restriction on division of Madrid Protocol route applications/registrations; restrictions on making changes to applications; restrictions on amendment period; renewal procedures through international registrations; duration of trademark rights based on international registrations; etc.**

## 13. Mechanism of Japanese Trademark System in Addressing the Madrid Protocol (2)

■ Characteristic rules of the Madrid Protocol were provided for by the Trademark Act:

(1) *Examination within 18 months*

→ In principle, to notify reasons for refusal within 18 months from filing.

(2) *New protection from filing to registration*

→ Right to monetary claim was introduced.

(3) *International register and national register*

→ To state items stated on the international register (trademark, right holder, designated goods/services, etc.) on the national register without any changes.

(4) *Publications*

→ To publish “publication of application” and “publication of trademark registration” in trademark gazettes together with reference translations of goods and services.

(5) *Replacement*

→ Both existing domestic trademark rights and trademark rights for Madrid Protocol route when they meet certain requirements.

(6) *Other matters*

→ Japan adopted the system of individual fee payable in two parts, etc.

Keeping communication channels open with WIPO to review and solve operational issues with the Madrid System:

- Dispatching JPO Staff member to Team 3 of WIPO, assisting examination on international applications to be done at WIPO
- Enabling JPO and Team 3 at WIPO to communicate when procedures and operations need to be clarified and revised
- Consulting with WIPO about legal interpretations and the best solutions for filling gaps between Madrid common regulations and practical operations
- Holding regular meetings at WIPO to exchange views and opinions about operational issues with the Madrid System



## 15. International Cooperation (1)

- In rapidly growing developing countries and regions such as the ASEAN Region, urgent and collective actions are needed to create a framework in which trademarks of Japanese companies can be adequately protected.
- Based on the ASEAN IPOs-JPO IPR Action Plan 2015-2016 that was concluded in May 2015 at the 5th ASEAN-JAPAN Heads of Intellectual Property (IP) Offices Meeting, JPO has been conducting support activities on human resources development, enhancing IT infrastructures, and **helping ASEAN countries to accede the Madrid Protocol.**

### ◆ Cooperative initiatives on trademarks implemented thus far:

- For ASEAN countries, training on examination practices for trademark examiners and holding workshops for senior officials of IP offices to support ASEAN countries' accession to the Madrid Protocol, etc.
  - Myanmar : Training Course on Trademark for Myanmar (in Tokyo on September, 2015)
  - Vietnam : JPO Trademark mission 2015 for NOIP examiners (in Tokyo on October, 2015 )  
Vietnam-Japan IP-Seminar (in Hanoi, Vietnam on January, 2015 )
  - Indonesia : Indonesia-Japan IP-Seminar (in Tangerang, Indonesia on August, 2014)
  - Brunei Darussalam : Classification Seminar (in Brunei Darussalam, on October, 2014 )

### ◆ Future cooperation on trademarks:

- **In supporting ASEAN countries' accession to the Madrid Protocol, JPO is supporting the enhancement of organizational structures for trademark examination based on each country's needs, by inviting trainees to Tokyo or sending experts to IPOs in receiving countries.**
- JPO is considering an exchange of information with Asian countries on examination for determining similarity/dissimilarity of trademarks/goods and services, in order to raise the level of efficiency and predictability in terms of their trademark examinations.

## 15. International Cooperation (2)

- The “TM5” is a framework established for the purpose of promoting international cooperation among the five Trademark Offices of Japan, the U.S., Europe, China and Korea; and supporting global business activities of entities by developing an international framework that provides appropriate protection for, and ensures the strategic use of, their trademarks in countries around the world.
- Currently, 13 projects are being implemented.
- The 4<sup>th</sup> TM5 Annual Meeting was held in Alexandria, the US from December 1 to 2, 2016.

### Current Projects

1. TM5 Website (KIPO)
2. Comparative Analysis on Examination Results (KIPO)
3. Common Statistical Indicators (OHIM)
4. TMView (OHIM)
5. TM Class and Taxonomy (OHIM)
6. ID List (USPTO)
7. Common Statistical Indicators (USPTO)
8. Indexing of Non-Traditional Trademarks (USPTO)
9. Bad Faith Trademark Filings (JPO)
10. Image Search of Figure Trademarks (JPO)
11. Improving User-Friendliness of International Trademark Applications (JPO)
12. User Involvement (JPO and OHIM)
13. Providing Information on How TM5 Members Describe Goods and Services (KIPO)



# 16. Project of Improving User-Friendliness of International Trademark Applications(1)

## Outline

- When using the Madrid system, there are some cases where the applicants find difficult to get necessary information relating to domestic procedures and requirements of Designated Offices, due to deferent procedures and languages.
- This project aims to provide users with “easy-to-use information guide” regarding the domestic procedures and requirements of TM5 partners in the standardized format, thereby ensuring that users of the Madrid system file international applications, and respond to notifications of provisional refusal to the Office of Designated parties.

## Main Activities in the Past

- At the 4th TM5 Annual Meeting held at the USPTO headquarters in December 2015, TM5 Partners agreed on “the Easy-to-use Information Guide of TM5 partners”, which was compiled by the JPO.

## Next Step

- JPO will publish this guide on the TM5 website shortly in cooperation with the KIPO.
- JPO will consider enhancing the information (content) provided in the guide, in cooperation with WIPO.

# 16. Project of Improving User-Friendliness of International Trademark Applications(2)

## Structure of the Guide

1. When filing an application: Points to be noted when filling the MM2 format
2. Procedures after notices of the territorial extension are received at the Designated Offices
3. Procedures after receiving confirmation of grant of protection by Designated Office
4. Others
5. Declarations relating to Madrid Protocol

## Image of the Guide

Information on Procedures before the Office of the designated Contracting party for Madrid Protocol Applicants<sup>4)</sup>

December 2015<sup>4)</sup>

		JAPAN <sup>4)</sup> (JPO) <sup>4)</sup>
1. When filing an application: Points to be noted when filling an MM2 format		
1.1 Applicant (Item 2 of MM2) <sup>4)</sup>		
1.1.1 <sup>4)</sup>	Points to be noted when writing information about an applicant (Item 2(a), (b) and (f) of MM2 or of any equivalent form or equivalent electronic form) <sup>4)</sup>	
1.2 Claim of priority (Item 6 of MM2) <sup>4)</sup>		
1.2.1 <sup>4)</sup>	Is partial priority allowed, which is a claim of priority based on part of a basic application? (Yes/No) <sup>4)</sup>	YES <sup>4)</sup>
1.2.2 <sup>4)</sup>	Are multiple priorities allowed, which is a claim of priority based on multiple basic applications? (Yes/No) <sup>4)</sup>	YES <sup>4)</sup>
1.3 Mark (Item 7 to 9 of MM2) <sup>4)</sup>		
1.3.1 <sup>4)</sup>	Category of marks which can be registered (e.g. collective mark, certification mark guarantee mark) <sup>4)</sup>	Collective trademarks (collective and regional collective trademarks) <sup>4)</sup> Certificate trademarks (any of normal, collective or regional collective trademarks may be relevant certificate trademarks for international registration). <sup>4)</sup>
1.3.2 <sup>4)</sup>	Are there certificates required according to category specified in Item 1.3.1? (Yes/No) If a required certificate exists, time and method of submission <sup>4)</sup>	YES (a certificate provided for in Article 7(3) of the Japanese Trademark Act (which is a document certifying that an applicant in question is a juridical person that falls under Article 7(1) of the Japanese Trademark Act) and a certificate provided for in Article 7-2(4) of the Japanese Trademark Act must be submitted). <sup>4)</sup> Submission period: The certificate mentioned above can be submitted after a request for territorial extension related to the application is made. If the certificate is not submitted, it constitutes a reason for refusal of the territorial extension. If the certificate is not submitted within a period prescribed in a notification of provisional refusal of the territorial extension, the refusal shall become

## 17. Classification of Goods and Services (1)

JPO has engaged in (i) improving the Nice Classification in the Asian context and (ii) standardizing practices on indications of Goods/Services aimed at reducing the procedural burden on trademark applicants and reducing the examination burden on the IP Offices in each country, etc.

### Relation with users for filing applications abroad directly and via the Madrid system

- JPO reflected the needs of Japanese user associations (25 associations) in Japan's proposals for the "Revision of the Nice Classification" and the "Expansion of the ID List".

(Examples of entries accepted in the Nice Classification: Randsels (Class 18), Yakitori (Class 29) and Ramen (Class 30))

### Cooperation to the WIPO/MGS for filing applications via the Madrid system

- JPO provides data on Japanese translation of indications of Goods/Services, acceptance/rejection of indications, and Similar Group Codes to the WIPO as data for the MGS (database for searching Goods/Services).
- Schedule for Similar Group Code data to become available on the MGS: TBD

### Use of Similar Group Codes

- The Similar Group Code is a code for groups of Goods/Services that are presumed to be similar to each other.
- Using the Similar Group Codes will improve the predictability of examination results relating to prior trademarks.
- It is possible to use the Similar Group Code as the search key for the trademark search database in the J-PlatPat.

( URL : [https://www3.j-platpat.inpit.go.jp/cgi-bin/ET/TM\\_AREA\\_E.cgi?1447029573681](https://www3.j-platpat.inpit.go.jp/cgi-bin/ET/TM_AREA_E.cgi?1447029573681) )

- A concordance list between the Similar Group Codes in Japan and Korea was developed and published.  
( URL : [http://www.jpo.go.jp/sesaku\\_e/j-k\\_codes2015.htm](http://www.jpo.go.jp/sesaku_e/j-k_codes2015.htm) )
- JPO will introduce the Similar Group Codes to developing countries/emerging countries and provide support.

### What is a Similarity Group Code?

Similarity group codes presume similarity of G/Ss and are used as keys for searching trademarks. They ensure consistency in determining similarity of G/Ss in examination and predictability for applicants.

#### 24C01 Sporting Equipment

Class 6

Diving boards of metal

Class 25

Ski boots, Gymnastic shoes, Golf shoes

Class 9

Protective helmets for sports

Similar

Class 27

Gymnastic mats

Class 19

Diving boards, not of metal

Class 28

Ski gear, Weightlifting equipment



## 17. Classification of Goods and Services (3)

**JPO cooperates with WIPO in harmonizing Practices on Classification of Goods and Services with aim of promoting use of the Madrid system by Japanese users.**

- JPO is promoting the use of Madrid System, and the total number of using Madrid System have been increasing yearly.
- However, some Japanese users hesitated to use Madrid System because the rate of irregularity notice against classification and indication of designated goods/services was high (approx. 30%- 40% of the total number of international applications from Japan).
- JPO has taken measures against irregularities in cooperation with WIPO in harmonizing practices on classification of Goods and Services since 2012.
- So JPO has continued to revise its Guide of Goods and Services to be used by Japanese users for applying international application from Japan, and the rate of irregularity notice has been drastically decreased.

Number of Irregularity Notices during the Recent 6 Years

Year	2010	2011	2012	2013	2014	2015
No. of International Applications	1,567	1,547	2,127	1,881	1,999	1,962
No. of Irregularity Notices	478	645	778	550	495	360
Irregularities/Applications	30.5%	41.7%	36.6%	29.2%	24.8%	18.3%
						(Jan-Nov)

## 18. Working Group on the Legal Development of the Madrid System

### Outline

- The Working Group on the Legal Development of the Madrid System for the International Registration of Marks was established in 2005, in order to make the Madrid System more user-friendly under the Madrid Union.
- The Working Group, which were held each year and attended by representatives of the Contracting Parties including Japan, had a series of discussions on agenda items such as the drafts of common regulations, and the outcomes of which were approved by the Assembly of the Madrid Union where necessary.
- At the 13<sup>th</sup> WG meeting held in November 2015, discussions were made on agenda items such as a proposal for the introduction of the recordal of division or merger concerning an international registration, etc., which will continue to discuss.

### Roundtable discussion

- In addition, the WG holds informal discussions at the roundtable to be held in the margin of the WG meetings in order to share among themselves practical issues and information relating to the Madrid system, which are to presented by WIPO and representatives of the Contracting Parties for possible future agenda items.
- At the round table held in November 2015, in addition to WIPO and the UK, JPO presented new issues relating to Japanese users when using the Madrid system caused by Japanese language, and its on-going research project about certification of identification of basic trademarks and trademarks in international applications.
- Survey result will be compiled in March 2016, and JPO will share the results with those concerned.



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**Summary of the JPO's Presentation at Roundtable Discussion  
held on the margin of the WG of the Madrid Union on  
November 2015:**

**The survey relating to improving the certification practices by  
the Office of Origin on identification between trademarks of  
basic applications/registrations and trademarks of  
international applications**

# 1. Characteristics of the Japanese Language

■ Japanese is not based on the Roman alphabet. It has three writing systems (Kanji characters; and Hiragana and Katakana that are somewhat like an alphabet). In addition to them, a variety of writing systems and styles such as Roman letters are used on a daily basis to express ideas and designs.

## Japanese writing systems

Kanji Characters

For example : 佐藤

Katakana

For example : サトウ

Hiragana

For example : さとう

Roman Letters

For example : SATO

Japanese

## Examples of registered trademarks in Japan

➤ An example of “Kanji”

Right holder : Nintendo Co., Ltd.

Registration number : 2255284

任天堂

➤ An example of “Katakana”

Right holder : Yamaha Corporation

Registration number : 4929181

ヤマハ

➤ An example of “Hiragana”

Right holder : KONICA MINOLTA, INC.

Registration number : 201722

ミニolta

➤ An example of two lined parallel entries of “Roman letters” and “Katakana”

Right holder : Kracie Holdings, Ltd.

Registration number : 5098170

K r a c i e

クラシエ

# 1. Characteristics of the Japanese Language

## An actual example in use (from Nintendo's website)

The screenshot shows the Japanese Nintendo website for the game *Zelda: The Legend of Zelda: Skyward Sword*. The page layout includes a top navigation bar with the Nintendo logo, user links, and search options. A left sidebar contains a menu with categories like '本体・周辺機器' (Hardware) and 'ソフトウェア' (Software). The main content area features a large, colorful banner for the game, with the title 'ゼルダの伝説 ZELDA トライフォース3銃士' and the subtitle 'さんじゅうし'. The banner depicts Link and other characters in a dynamic scene. A right sidebar shows a 'Nintendo 3DS' console and a 'Nintendo 3DS SOFTWARE' section. The footer is a red bar with the text 'NINTENDO 3DS SOFTWARE' and a list of links for software categories.

**Navigation Menu (Left Sidebar):**

- 本体・周辺機器 (HARDWARE)
- ソフトウェア (SOFTWARE)
- CM・紹介映像 (CM/MOVIE)
- トピックス (TOPICS)
- サポート (SUPPORT)

**Game Banner (Center):**

ゼルダの伝説  
**ZELDA**  
トライフォース3銃士  
さんじゅうし

**Footer (Red Bar):**

NINTENDO 3DS SOFTWARE

**Footer Links (Right):**

- 任天堂ソフト一覧
- ソフトウェア一覧
- ニンテンドー3DSソフトについて

# 1. Characteristics of the Japanese Language

## Actual examples in use (from company websites)



Asahi Soft drinks Co., LTD.

Soft drink



Yakult Honsha Co., Ltd.

Yoghurt drink



NISSIN FOODS HOLDINGS CO., LTD.

Instant noodles



## 2. Issues for Japanese users when using the Madrid System

### Issue1

- There are not many registered trademarks in Japan, which consist of only Roman letters because Japanese is based on kanji, hiragana and katakana . On the other hand, companies that intend to develop their brands overseas tend to prefer to use trademarks consisting of Roman letters which have greater versatility.
- Accordingly there are many cases in which Japanese users file national applications only to have basis for international applications, when they file for international applications under the Madrid system.
- So there is a burden in terms of time and money for users to file trademarks which are not intended to use in Japan, and furthermore, there is a risk of revocation of trademarks (central attack) due to non-use of trademark within three years.

### Case1 : Imuraya Group Co., Ltd.

- Trademark filed for international registration

Registration number : 1003781

International registration date : April 2, 2009

imuraya

- National Trademark

Registration Number : 4951092

Date of application : June 20, 2005



井村屋 / imuraya

- Basic Trademark

Registration Number : 5269747

Date of application : March 17, 2009

imuraya

- National Trademark

Registration Number : 1444107

Date of application : January 10, 1974

井村屋

### Case2 : ICHIBANYA CO., LTD.

- Trademark filed for international registration

Registration Number : 1104160

International registration date : December 1, 2011



- Basic Trademark

Registration Number : 5472209

Date of application : August 24, 2011



- National Trademark

Registration Number : 4890856

Date of application : December 6, 2004



## 2. Issues for Japanese users when using the Madrid System

### Issue2

- There is the possibility to register trademarks in other countries in spite of the fact that the trademarks will not be able to be registered in Japan.
- However, international filings under the Madrid System must have basic trademarks in each Contracting Country (basic requirements). Moreover, even after international registration, if basic trademarks are revoked within five years from the date of international registration, the international registrations are also revoked, as they are within the scope of being revoked as basic trademarks. (Dependency)
- Therefore there are cases in which applications must be filed to every country individually because trademarks that are difficult to be registered in Japan cannot be basic applications for international applications. As a result, users do not use the Madrid system.

### Case1 : Hino Motors, Ltd.

- Corporate name “Hino” is considered to be a geographical name from the city of “Hino” in Japan, and it is not registered in terms of distinction.
- On the other hand, “Hino” as a character is not going to matter as much in terms of distinction in other countries.
- In the case of acquiring rights in other countries, an application must be filed for the other countries directly.

### Case2 : Hamamatsu Photonics K.K.

- Corporate brand “HAMAMATSU” is considered to be a geographical name from the city of “Hamamatsu” in Japan and it is not registered in terms of distinction. The goods which are able to be registered are merely extremely limited specific goods (photomultiplier tubes).
- As a corporate brand, it is difficult to file for international applications under Madrid System on the basis of trademarks in Japan.

### 3. Certification of identification of basic trademarks and trademarks in international applications at the JPO as an Office of origin

#### The JPO's Practice

■ In dealing with the interpretation of “identification” when it comes to certifying the identification of basic trademarks and trademarks of international applications in an office of origin in accordance with Article 3 (1) of the Protocol and Rule 9 (5) (d) of the common regulations, the JPO strictly interprets that both trademarks are identical in terms of their compositions and forms (including similar figures).

#### An example recognized to be identical

➤ Basic Trademark

➤ A trademark of international application

WIPO

VS

WIPO



VS



#### An example not recognized to be identical

➤ Basic Trademark

➤ A trademark of international application

SANUPS

VS

SANUPS

 **KOBE**

VS

 **KOBE**

## 4. Surveys concerning certification of identification of basic trademarks and trademarks in international applications

### Outline

- When it comes to certifying the identification of basic trademarks and trademarks in international applications, users are requesting that more flexible operations be implemented in regard to applications filed to the JPO as an office of origin.
- The JPO is now conducting surveys on practices relating to certification works by an office of origin for Contracting Parties, in order to enable users to avail themselves of the benefits of the Madrid System thereby promoting the use of the Madrid System.
- Survey results will be compiled in March 2016 and the JPO would like to share the survey results.

### Survey Content

#### 1. Comparative survey on identification

The JPO will conduct a survey comparing 70,000 basic trademarks and trademarks of international applications that had been registered internationally between 2013 and 2014 , in regard to their similarity/identify by using ROMARIN and other means.

#### 2. Survey by questionnaire and interviews

The JPO will conduct a questionnaire survey of 50 member countries and of top 50 companies' users in Japan and abroad to collect information about the actual cases in certifying identification of basic trademarks and trademarks in international applications. Interview surveys with Japanese companies will be also conducted based on the results of the questionnaire survey.



**THANK YOU FOR YOUR ATTENTION!**