

# Trademark Act

(Act No. 127 of April 13, 1959)

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## CHAPTER I GENERAL PROVISIONS

(Purpose)

Article 1 The purpose of this Act is, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and to protect the interests of consumers.

(Definitions, etc.)

Article 2 (1) "Trademark" in this Act means any character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors (hereinafter referred to as a "mark") which is:

- (i) used in connection with the goods of a person who produces, certifies or assigns the goods as a business; or

- (ii) used in connection with the services of a person who provides or certifies the services as a business (except those provided for in the preceding item).
- (2) "Services" set forth in item (ii) of the preceding paragraph shall include retail services and wholesale services, namely, the provision of benefits for customers conducted in the course of retail and wholesale business.
- (3) "Use" with respect to a mark as used in this Act means any of the following acts:
  - (i) to affix a mark to goods or packages of goods;
  - (ii) to assign, deliver, display for the purpose of assignment or delivery, export, import or provide through an electric telecommunication line, goods or packages of goods to which a mark is affixed;
  - (iii) in the course of the provision of services, to affix a mark to articles to be used by a person who receives the said services (including articles to be assigned or loaned; the same shall apply hereinafter);
  - (iv) in the course of the provision of services, to provide the said services by using articles to which a mark is affixed and which are to be used by a person who receives the said services;
  - (v) for the purpose of providing services, to display articles to be used for the provision of the services (including articles to be used by a person who receives the services in the course of the provision of services; the same shall apply hereinafter) to which a mark is affixed;
  - (vi) in the course of the provision of services, to affix a mark to articles pertaining to the provision of the said services belonging to a person who receives the services;
  - (vii) in the course of the provision of services through an image viewer, by using an electromagnetic device (an electromagnetic device shall refer to any electronic, magnetic or other method that is not recognizable by human perception; the same shall apply in the following item), to provide the said services by displaying a mark on the image viewer; or
  - (viii) to display or distribute advertisement materials, price lists or transaction documents relating to goods or services to which a mark is affixed, or to provide information on such content, to which a mark is affixed by an electromagnetic device.
- (4) To affix a mark to goods or other articles provided for in the preceding paragraph shall include to form in the shape of the mark goods, packages of goods, articles to be used for the provision of services, or advertisement materials relating to goods or services.
- (5) "Registered trademark" in this Act means a trademark that has been registered as a trademark.
- (6) In this Act, the scope of those similar to goods may include services, and the scope of those similar to services may include goods.

## **CHAPTER II TRADEMARK REGISTRATION AND APPLICATION FOR TRADEMARK REGISTRATION**

(Requirements for trademark registration)

Article 3 (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.

(Unregistrable trademarks)

Article 4 (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;
- (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.

(Application for trademark registration)

Article 5 (1) Any person who desires to register a trademark shall submit an application to the Commissioner of the Patent Office accompanied by the required documents. The application shall state the following matters:

- (i) the name and the domicile or residence of the applicant for trademark registration;
- (ii) the trademark for which registration is sought; and

- (iii) the designated goods or designated services and the class of goods or services provided by Cabinet Order as provided for in Article 6(2).
- (2) Where a person desires to register a trademark consisting of a three-dimensional shape (including those combined with character(s), figure(s), sign(s) or color(s) or any combination thereof) (hereinafter referred to as a "three-dimensional trademark"), the application shall contain a statement indicating thereof.
- (3) Where a person desires to register a trademark consisting solely of characters designated by the Commissioner of the Patent Office (hereinafter referred to as "standard characters"), the application shall contain a statement indicating thereof.
- (4) Where a portion of the trademark for which a registration is sought is in the same color as that of the column in which a trademark for which a registration is sought is required to be stated, the said portion of the trademark shall be deemed not to be a part of the trademark; provided, however, that this shall not apply to an area specified and identified as an area to be colored in the same color as that of the column.

(Accordinging of filing date, etc.)

Article 5-2 (1) The Commissioner of the Patent Office shall accord as the filing date of an application for trademark registration the date of submission of the application relating thereto, unless the application for trademark registration falls under any of the following items:

- (i) the statement of intent to register a trademark is unclear;
  - (ii) the name of the applicant for trademark registration is not stated or the statement thereof is not sufficient to identify the applicant;
  - (iii) the trademark for which a registration is sought is not stated in the application; and
  - (iv) the designated goods or designated services are not stated.
- (2) Where an application for trademark registration falls under any of the items of the preceding paragraph, the Commissioner of the Patent Office shall require the person who desires to register the trademark registration to supplement the application, designating a reasonable time limit for such purpose.
  - (3) Supplement of an application for trademark registration shall be made by submitting a document with respect to the supplement (hereinafter referred to as a "Written Supplement").
  - (4) Where an applicant who was required to supplement an application for trademark registration under paragraph (2) supplements the said application within the designated time limit as provided in the said paragraph, the Commissioner of the Patent Office shall accord the date of submission of the Written Supplement as the filing date of the application for trademark registration.
  - (5) Where an applicant who has been required to supplement an application for trademark registration under paragraph (2) fails to supplement the said application within the designated time limit as provided in the said paragraph, the Commissioner of the Patent Office may dismiss the said application for trademark registration.

(Single trademark on each application)

- Article 6 (1) An application for trademark registration shall be filed for each trademark and designate one or more goods or services in connection with which the trademark is to be used.
- (2) The designation provided for in the preceding paragraph shall be made in accordance with the class of goods and services provided by Cabinet Order.
- (3) The class of goods and services provided for in the preceding paragraph shall not be perceived as prescribing the scope of similarities of goods or services.

(Collective trademarks)

- Article 7 (1) Any incorporated association established pursuant to Article 34 of the Civil Code (Act No. 89 of 1896) or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto shall be entitled to obtain a collective trademark registration with respect to a trademark to be used by their members.
- (2) For the purpose of the application of Article 3(1), in the case of the preceding paragraph, "applicant" in the said paragraph shall read "applicant or its members."
- (3) Any person who desires to register a collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1).

(Regional collective trademarks)

- Article 7-2 (1) Any association established by a special Act, including a business cooperative (those which do not have juridical personality are excluded, and limited to those which are established by a special Act providing, without a just cause, that the association shall not refuse the enrollment of any person who is eligible to become a member or that the association shall not impose on any of its prospective members any condition that is heavier than those imposed on its existing members) or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regional collective trademark registration with respect of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):
- (i) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members;
- (ii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the name customarily used as a name indicating the goods or services pertaining to the business of the applicant or its members; or
- (iii) a trademark consisting solely of characters indicating, in a common manner, the name of

the region and the common name of the goods or services pertaining to the business of the applicant or its members or the name customarily used as a name indicating thereof, and characters customarily added in indicating, in a common manner, the place of origin of the goods or the location of provision of the services.

- (2) The term "name of the region" as used in the preceding paragraph means, even prior to the filing of the said application, the name of the place of origin of the goods, the location of provision of services, or the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent, for which the trademark pertaining to the said application has been used by the applicant or its members, or abbreviation thereof.
- (3) For the purpose of the application of Article 3(1)(limited to the part pertaining to items (i) and (ii)) in the case of paragraph (1), "applicant" in the said paragraph shall read "applicant or its members."
- (4) Any person who desires to register a regional collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is an Association, etc. and documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in paragraph (2).

(Prior application)

- Article 8 (1) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on different dates, only the applicant who filed the application for trademark registration on the earlier date shall be entitled to register the trademark in question.
- (2) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on the same date, only one applicant who is to be determined by consultations among the applicants who filed such applications shall be entitled to register the trademark in question.
  - (3) Where an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial decision on an application for trademark registration becomes final and binding, such application shall, for the purposes of the application of the preceding two paragraphs, be deemed never to have been filed.
  - (4) In the case of paragraph (2), the Commissioner of the Patent Office shall require the applicants for trademark registration to arrange consultations among the applicants as set forth in the said paragraph and to report the result thereof, designating a reasonable time limit for such purpose.
  - (5) Where no agreement is reached in the consultations held pursuant to paragraph (2) or no report is submitted within the designated time limit set forth in the preceding paragraph, only



one applicant, selected by a lottery in a fair and just manner conducted by the Commissioner of the Patent Office, shall be entitled to register the trademark in question.

(Special provisions concerning time of filing of application)

Article 9 (1) Where an application for trademark registration is filed in connection with a trademark used for goods or services exhibited at an exhibition held by the Government, etc., an exhibition held by those who are not the Government, etc. but are designated by the Commissioner of the Patent Office, an international exhibition held by the Government, etc. of 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 or by those authorized thereby to hold such an exhibition in its territory, or an international exhibition held by the Government, etc. of a country which is not a country of the Union of the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or by those authorized thereby to hold such exhibition in its territory and designated by the Commissioner of the Patent Office, by the exhibitor of such goods or services bearing the trademark within six months from the date of exhibition of such goods or services, the said application shall be deemed to have been filed at the time of exhibition of such goods or services.

(2) Any person who desires to apply the preceding paragraph in connection with a trademark relating to an application for trademark registration shall submit to the Commissioner of the Patent Office a document stating thereof at the time of filing of the application for trademark registration, and documents proving the fact that the trademark pertaining to an application for trademark registration and its designated goods or designated services fall under the trademark and goods or services provided in the said paragraph, within thirty days from the filing date of an application for the trademark registration.

(Priority claim governed by the Paris Convention)

Article 9-2 A right of priority based on an application for registration of a trademark filed in a country of the Union to the Paris Convention (limited to a trademark equivalent to a trademark provided in Article 2(1)(ii)) may be claimed as governed by the same rules as Article 4 of the Paris Convention in connection with a right of priority based on an application for registration of a trademark equivalent to the trademark provided in Article 2(1)(i).

Article 9-3 A right of priority based on an application filed by a person stated in the left column of the following table in a country stated in the right column of the same table may be claimed in connection with an application for trademark registration as governed by Article 4 of the Paris Convention.

Japanese nationals or nationals of a country of the Union to the Paris Convention (including those who are deemed to be nationals of a country of the Union as provided by Article 3	A member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty
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of the Paris Convention)	
Nationals of a member of the World Trade Organization (refers to nationals of a member provided in paragraph 3 of Article 1 of Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization) or nationals of a Contracting Party to the Trademark Law Treaty	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

(Amendment of designated goods, etc. or trademark for which registration is sought and change of gist thereof)

Article 9-4 Where, after the registration of establishment of a trademark right, any amendment made to the designated goods or designated services, or trademark for which registration is sought stated in the application, is found to cause any change of the gist thereof, the application for trademark registration shall be deemed to have been filed at the time of submission of the written amendment relating thereto.

(Division of application for trademark registration)

Article 10 (1) An applicant for trademark registration may file one or more new applications with regard to part of an application which designates two or more goods or services as its designated goods or designated services, provided that the application for trademark registration is pending in examination, trial examination or retrial examination, or that a suit against a trial decision to refuse the application is pending in court.

(2) In the case of the preceding paragraph, the new application for trademark registration shall be deemed to have been filed at the time of filing of the original application for trademark registration; provided, however, that this shall not apply for the purpose of Article 9(2) of this Act and Article 43(1) and 43(2) of the Patent Act (Act No.121 of 1959) as applied mutatis mutandis pursuant to Article 13(1) of this Act (including cases where it is applied mutatis mutandis pursuant to Article 43-2(3) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of this Act).

(3) Where a new application for trademark registration is filed as provided in paragraph (1), statements or documents submitted in connection with the original application for trademark registration which are required to be submitted in connection with the new application for trademark registration pursuant to Article 9(2) of this Act or Article 43(1) and 43(2) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of this Act (including its mutatis mutandis application pursuant to Article 43-2(3) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of this Act) shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of filing the new application for trademark registration.

(Conversion of application)

- Article 11 (1) An applicant for trademark registration may convert an application for trademark registration of a collective trademark into a regular application for trademark registration (referring to an application for trademark registration other than those of collective trademarks and regional collective trademarks; the same shall apply hereinafter) or an application for trademark registration of a regional collective trademark.
- (2) An applicant for trademark registration may convert an application for trademark registration of a regionally based collective trademark into a regular application for trademark registration or an application for trademark registration of a collective trademark.
- (3) An applicant for trademark registration may convert a regular application for trademark registration into an application for trademark registration of a collective trademark or an application for trademark registration of a regionally based collective trademark.
- (4) The conversion of an application for trademark registration pursuant to the provisions of the preceding three paragraphs may not be made after an examiner's decision or a trial decision on the application for trademark registration becomes final and binding.
- (5) Where the conversion of an application for trademark registration is made pursuant to paragraphs (1) to (3), the original application for trademark registration shall be deemed to have been withdrawn.
- (6) The provisions of Articles 10(2) and 10(3) shall apply mutatis mutandis to the conversion of an application for trademark registration pursuant to paragraphs (1) to (3).

Article 12 (1) An applicant for a defensive mark registration may convert such an application into an application for trademark registration.

- (2) The conversion of an application pursuant to the preceding paragraph may not be made after an examiner's decision or a trial decision on the application for a defensive mark registration becomes final and binding.
- (3) The provisions of Articles 10(2), 10(3) and 11(5) shall apply mutatis mutandis to the conversion of an application pursuant to paragraph (1).

(Laying open of application)

Article 12-2 (1) Where an application for trademark registration is filed, the Commissioner of the Patent Office shall lay open the trademark application.

- (2) The laying open of a trademark application shall be effected by stating the following matters in the Trademark Gazette; provided, however, that this shall not apply to the matters listed in items (iii) and (iv), where the Commissioner of the Patent Office finds that publishing the said matters in the trademark bulletin is likely to cause damage to public policy.
- (i) the name and the domicile or residence of the applicant for the trademark registration;
- (ii) the number and date of the application for trademark registration;
- (iii) the trademark stated in the application (in the case provided in Article 5(3), the trademark represented in standard characters; the same shall apply in Articles 18(3)(iii) and 27(1));
- (iv) the designated goods or designated services; and

(v) other necessary matters in addition to those matters listed in the preceding items.

(Mutatis mutandis application of the Patent Act)

- Article 13 (1) The provisions of Paragraphs (1) to (4) of Article 43, 43-2(2) and (3) of the Patent Act shall apply mutatis mutandis to an application for trademark registration. In this case, the term "one year and four months from the earliest of the following dates" in Article 43(2) of the Patent Act shall be deemed to be replaced with "three months from the filing date of an application for trademark registration"; "or members of the World Trade Organization" in Article 43-2(2) of the said Act shall be deemed to be replaced with "members of the World Trade Organization or Contracting Parties to the Trademark Law Treaty"; "or nationals of members of the World Trade Organization" in the same paragraph shall be deemed to be replaced with "nationals of members of the World Trade Organization or nationals of Contracting Parties to the Trademark Law Treaty"; and "preceding two paragraphs" in paragraph (3) of the said Article shall be deemed to be replaced with "preceding paragraph."
- (2) The provisions of Articles 33 and paragraphs (4) to (7) of Article 34 (Right to obtain a patent) of the Patent Act shall apply mutatis mutandis to the rights deriving from an application for trademark registration.

(Right to monetary claim, etc. prior to registration of establishment of trademark right)

- Article 13-2 (1) Where an applicant for trademark registration issues a warning after filing an application for trademark registration by presenting a document stating a description of the application, the applicant may claim against any person who uses the trademark pertaining to the application, for the designated goods or designated services in the application during the period from the warning to the registration of establishment of the trademark right, the payment of money in the amount equivalent to the loss incurred in the course of business due to such use.
- (2) The right to claim under the preceding paragraph may not be exercised prior to the registration of establishment of the trademark right.
- (3) The exercise of the right to claim under paragraph (1) shall not preclude the exercise of the trademark right.
- (4) The right to claim under paragraph (1) shall be deemed never to have arisen in any of the following cases: where an application for trademark registration is abandoned, withdrawn or dismissed; where an examiner's decision or a trial decision to the effect that an application for trademark registration is to be refused becomes final and binding; where a ruling to rescind a trademark under Article 43-3(2) becomes final and binding; or where, excluding the cases falling under the proviso to Article 46-2(1), a trial decision to the effect that a trademark registration is to be invalidated becomes final and binding.
- (5) The provisions of Articles 27 and 37 of this Act, Articles 104-3 to 105-2, 105-4 to 105-6 and 106 of the Patent Act as applied mutatis mutandis under Article 39 of this Act, and Articles paragraphs (3) to (6) of Article 168 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act and Articles 719 and 724(Tort) of the Civil Code shall apply mutatis

mutandis to the exercise of the right to claim under paragraph (1). In this case, where prior to the registration of the establishment of the trademark right, the person having the right to claim becomes aware of the fact that the trademark in connection with the application for trademark registration is used, and the identity of the person using the trademark, the term "the time when the injured party or his/her legal representative becomes aware of such damage, and of the person responsible therefor" in Article 724 of the said Code shall be deemed to be replaced with "the date of the registration of the establishment of the trademark right."

### **CHAPTER III EXAMINATION**

(Examination by an examiner)

Article 14 The Commissioner of the Patent Office shall direct the examination of applications for trademark registration by an examiner.

(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;
- (ii) the trademark pertaining to an application for trademark registration is not registrable pursuant to the provisions of a relevant treaty; or
- (iii) the application for trademark registration does not comply with the requirements provided in Article 6(1) or 6(2).

(Notification of reasons for refusal)

Article 15-2 Where the examiner intends to render a decision to the effect that an application is to be refused, the examiner shall notify the applicant for trademark registration of the reasons for refusal and provide the applicant an opportunity to submit a written opinion, designating a reasonable time limit for such purpose.

Article 15-3 (1) Where a trademark pertaining to an application for trademark registration is identical with, or similar to, another person's trademark pertaining to an application for trademark registration filed prior to the filing date of the said application, if the said trademark is used for goods or services identical with, or similar to, the designated goods or designated services pertaining to such other person's trademark, the examiner may notify the applicant for trademark registration of the fact that the said application for trademark registration will fall under Article 15(i) when the said other person's trademark is registered, and provide the applicant with an opportunity to submit a written opinion, designating a

reasonable time limit for such purpose.

- (2) Where the notification set forth in the preceding paragraph has already been served and the said other person's trademark is registered, the examiner shall not be required to serve the notification set forth in the preceding Article.

(Examiner's decision of trademark registration)

Article 16 Where no reasons for refusal are found in connection with an application for trademark registration within the time limit provided by Cabinet Order, the examiner shall render a decision to the effect that the trademark is to be registered.

(Dismissal of amendment)

Article 16-2 (1) Where an amendment made to the designated goods or designated services, or to the trademark for which registration is sought as stated in the application, is considered to cause any change of the gist thereof, the examiner shall dismiss the amendment by a ruling.

- (2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state reasons therefor.

- (3) Where a ruling dismissing an amendment under paragraph (1) is rendered, the examiner shall not render any decision on the said application for trademark registration before the expiration of a thirty-day period from the date of service of a transcript of the ruling.

- (4) Where an applicant for trademark registration files a request for a trial under Article 45(1) against the ruling dismissing an amendment under paragraph (1), the examiner shall suspend the examination of the application for trademark registration until the trial decision becomes final and binding.

(Mutatis mutandis application of the Patent Act)

Article 17 The provisions of Articles 47(2) (Qualification of Examiners), 48 (Exclusion of Examiners), 52 (Formal Requirements for Examination) and 54 (Relationship with Litigation) of the Patent Act shall apply mutatis mutandis to the examination of applications for trademark registration. In this case, the term "a trial decision" in Article 54(1) of the Patent Act shall be deemed to be replaced with "a ruling on an opposition to registration or a trial decision."

(Mutatis mutandis application of the Design Act)

Article 17-2 (1) The provision of Article 17-3 (New Application for Designs as Amended) of the Design Act (Act No. 125 of 1959) shall apply mutatis mutandis to the case where an amendment is dismissed by a ruling pursuant to Article 16-2(1) of this Act.

- (2) The provision of Article 17-4 of the Design Act shall apply mutatis mutandis to the case of an extension of the time limit provided in Article 17-3(1) of the Design Act as applied mutatis mutandis to the preceding paragraph or Article 55-2(3) (including its mutatis mutandis application under Article 60-2(2)) of this Act.

## CHAPTER IV TRADEMARK RIGHT

### Section 1 Trademark Right

(Registration of establishment of trademark right)

Article 18 (1) A trademark right shall arise upon registration of establishment of such right.

(2) Where the registration fee under Article 40(1) or the registration fee due and payable within thirty days from the date of service of a transcript of an examiner's decision or a trial decision to the effect that a trademark is to be registered pursuant to Article 41-2(1) is paid, the establishment of the trademark right shall be registered.

(3) Upon registration set forth in the preceding paragraph, the following matters shall be published in the trademark bulletin:

(i) the name and the domicile or residence of the holder of trademark right;

(ii) the number and date of the application for trademark registration;

(iii) the trademark stated in the application;

(iv) the designated goods or designated services;

(v) the registration number and the date of registration of establishment; and

(vi) other necessary matters in addition to those listed in the preceding items.

(4) The Commissioner of the Patent Office shall make application documents and their annexed articles available for public inspection at the Patent Office for two months from the date of issuance of the trademark bulletin containing matters listed in each item of the preceding paragraph (hereinafter referred to as "bulletin containing the trademark") pursuant to the provisions of the preceding paragraph; provided, however, that this shall not apply to documents or articles that are likely to damage the reputation or disturb the peaceful existence of an individual or to cause damage to public policy, and the Commissioner of the Patent Office finds necessary to be kept confidential.

(5) Where the Commissioner of the Patent Office intends to make available for public inspection documents or articles which are likely to damage the reputation or disturb the peaceful existence of an individual and are other than those the Commissioner of the Patent Office finds necessary to be kept confidential pursuant to the proviso set forth in the preceding paragraph, the Commissioner of the Patent Office shall notify the person who submitted the documents or the articles thereof and the reasons therefor.

(Duration)

Article 19 (1) The duration of a trademark right shall expire after ten years from the date of registration of establishment of such right.

(2) The duration of a trademark right may be renewed by the holder of trademark right by filing an application for registration of renewal.

(3) Where the renewal of the duration of the trademark right is registered, the duration shall have been renewed at the time of expiration of the duration.

(Application for registration of renewal of duration)

Article 20 (1) A person filing a request for registration of renewal of the duration of a trademark right shall submit to the Commissioner of the Patent Office an application stating the following matters:

- (i) the name and the domicile or residence of the applicant;
  - (ii) the registration number of the trademark registration; and
  - (iii) in addition to those listed in the preceding two items, the matters provided by Ordinance of the Ministry of Economy, Trade and Industry.
- (2) An application for registration of renewal shall be filed during the period from six months prior to the expiration of the duration of a trademark right to the date of expiration thereof.
- (3) Where the holder of trademark right is unable to file an application for registration of renewal within the time limit provided in the preceding paragraph, the holder of trademark right may file the said application within six months even after the expiration of the said time limit.
- (4) Where the holder of trademark right fails to file an application for registration of renewal within the time limit for such request pursuant to the provision of the preceding paragraph, the trademark right shall be deemed to have been extinguished retroactively from the time of the expiration of its duration.

(Restoration of trademark right)

Article 21 (1) Where the original holder of trademark right of a trademark right which is deemed to have been extinguished pursuant to Article 20(4) is unable to file an application for registration of renewal within the time limit for such application pursuant to Article 20(3) due to reasons beyond the control of the said holder of trademark right, the holder of trademark right may file the said application within fourteen days (two months for residents abroad) from the date when the reason ceased to exist but not later than six months after the expiration of the said time limit.

- (2) Where an application for registration of renewal is filed under the preceding paragraph, the duration shall be deemed to have been renewed retroactively at the time of expiration of the duration.

(Limitations of effects of restored trademark right)

Article 22 The effects of a trademark right restored pursuant to Article 21(2) may not extend to the following acts committed after the expiration of the time limit for the filing of the application for registration of renewal provided in Article 20(3) and before the registration of renewal of the duration of the trademark right by the application under Article 21(1):

- (i) the use of the registered trademark in connection with the designated goods or designated services; and
- (ii) the acts provided for in each item of Article 37.

(Registration of renewal of duration)

Article 23 (1) Where the registration fee under Article 40(2) or the registration fee due and



payable at the time of filing of the application for registration of renewal pursuant to Article 41-2(2) is paid, the renewal of the duration of the trademark right shall be registered.

(2) Notwithstanding the preceding paragraph, where an application for registration of renewal is filed pursuant to Article 20(3) or 21(1), the renewal of the duration of the trademark right shall be registered at the time of payment of the registration fee under Article 40(2) and the registration surcharge under Article 43(1), or the registration fee due and payable at the time of filing of the application for registration of renewal under Article 41-2(2) and the registration surcharge under Article 43(2).

(3) Upon registration as set forth under the preceding two paragraphs, the following matters shall be published in the trademark bulletin:

- (i) the name and the domicile or residence of the holder of trademark right;
- (ii) the registration number and the date of registration of renewal; and
- (iii) other necessary matters in addition to those listed in the preceding two items.

(Division of trademark right)

Article 24 (1) Where there are two or more designated goods or designated services for which a trademark right shall apply, the trademark right may be divided for each of the designated goods or designated services.

(2) Where a request for a trial is filed under Article 46(2), the division provided for in the preceding paragraph may be made even after the extinguishment of the trademark right, provided that a trial, retrial or court proceeding in connection with the case is pending.

(Transfer of trademark right)

Article 24-2 (1) Where there are two or more designated goods or designated services, the trademark right may be divided into each of the designated goods or services in transferring such right.

(2) A trademark right in connection with an application for trademark registration which falls under Article 4(2) filed by the State, a local government, an agency thereof, or a non-profit organization undertaking a business for public interest may not be assigned.

(3) A trademark right in connection with an application for trademark registration that falls under Article 4(2) filed by a non-profit enterprise undertaking a business for public interest, may not be transferred unless the business is transferred together with such right.

(4) A trademark right in connection with a regionally based collective trademark may not be assigned.

(Transfer of collective trademark right)

Article 24-3 (1) Upon transfer, the trademark right to a collective trademark shall be deemed to have been converted to a regular trademark right, except in the case as provided in the following paragraph.

(2) Where the right holder of a collective trademark desires to transfer the collective trademark right, the said right holder shall submit an application for registration of transfer accompanied

by a document stating thereof, and the documents provided in Article 7(3), to the Commissioner of the Patent Office.

(Request for indication to prevent confusion arising from transfer of trademark right)

Article 24-4 Where, as a result of transfer of a trademark right, the trademark right to a similar registered trademark to be used in connection with identical goods or services, or the trademark right to an identical or similar registered trademark to be used in connection with similar goods or services becomes owned by a different holder of trademark right, if the use of one of such registered trademarks for its designated goods or designated services by its holder of trademark right, exclusive right to use or non-exclusive right to use is likely to damage business interests (limited to those pertaining to the designated goods or designated services using the said other registered trademark) of the other holder of trademark right or of exclusive right to use, the other holder of trademark right or of exclusive right to use may request the holder of trademark right, exclusive right to use or non-exclusive right to use to affix an indication that may sufficiently prevent any confusion between the goods or services pertaining to the business of the other party and those of its own.

(Effects of trademark right)

Article 25 The holder of trademark right shall have an exclusive right to use the registered trademark in connection with the designated goods or designated services; provided, however, that where an exclusive right to use the trademark is established in connection with the trademark right, this provision shall not apply to the extent that the holder of exclusive right to use has an exclusive right to use the registered trademark.

(Limitations of effects of trademark right)

Article 26 (1) A trademark right shall have no effect on any of the following trademarks (including those which constitute part of other trademarks):

- (i) a trademark indicating, in a common manner, one's own portrait, name, famous pseudonym, professional name, pen name or famous abbreviation thereof;
- (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 purpose, quantity, modes, price or method or time of provision of services similar to the designated goods;
- (iii) a trademark indicating, in a common manner, the common name, location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision of the designated services or services similar thereto, or the common name, place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape, price, the method or time of production or use of goods

- similar to the designated services;
- (iv) a trademark customarily used for the designated goods or designated services or goods or services similar thereto; or
  - (v) a trademark consisting solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function.
- (2) Item (i) of the preceding paragraph shall not apply where, after the registration of establishment of the trademark right, one's own portrait, name, famous pseudonym, professional name, pen name or famous abbreviation thereof is used for the purpose of unfair competition.

(Scope of registered trademark, etc.)

Article 27 (1) The scope of a registered trademark shall be determined based on the trademark stated in the application.

- (2) The scope of the designated goods or designated services shall be determined based on the statement in the application.

Article 28 (1) A request for an advisory opinion on the effects of a trademark right may be filed to the Patent Office.

- (2) Upon receipt of the request under the preceding paragraph, the Commissioner of the Patent Office shall designate three trial examiners and have them make an advisory opinion.
- (3) Articles 71(3) and 71(4) of the Patent Act shall apply *mutatis mutandis* to the advisory opinion provided for in paragraph (1).

Article 28-2 (1) Where the Commissioner of the Patent Office is commissioned by a court to provide an expert opinion on the effects of a trademark right, the Commissioner shall designate three trial examiners and have them provide such expert opinion.

- (2) Articles 71-2(2) of the Patent Act shall apply *mutatis mutandis* to the commissioned provision of the expert opinion provided for in paragraph (1).

(Relationship with another person's patent right, etc.)

Article 29 Where the use of a registered trademark in a particular manner in connection with its designated goods or designated services conflicts with another person's right to a patent, utility model or design for which an application has been filed prior to the filing date of an application of the said registered trademark or upon another person's copyright arising prior to the filing date of the same, the holder of trademark right, exclusive right to use or non-exclusive right to use may not use the registered trademark in the same manner on the conflicting part of the designated goods or designated services.

(Exclusive right to use)

Article 30 (1) The holder of trademark right may establish an exclusive right to use to the trademark to which he/she holds the right; provided, however, that this provision shall not

apply to the trademark right pertaining to an application for trademark registration provided in Article 4(2) or a regionally based collective trademark.

- (2) The holder of exclusive right to use shall have an exclusive right to use a registered trademark in connection with the designated goods or designated services to the extent provided by the agreement under which such right is granted.
- (3) The exclusive right to use may be transferred only where the consent of the holder of trademark right is obtained or where the transfer falls under general succession including inheritance.
- (4) Articles 77(4) and 77(5) (establishment of pledge, etc.), 97(2) (waiver), and 98(1)(ii) and 98(2) (effects of registration) of the Patent Act shall apply mutatis mutandis to an exclusive right to use.

(Non-exclusive right to use)

Article 31 (1) The holder of trademark right may grant to another person a non-exclusive right to use to the trademark to which he/she holds the right; provided, however, that this provision shall not apply to the trademark right pertaining to an application for trademark registration provided in Article 4(2).

- (2) The holder of non-exclusive right to use shall have the right to use the registered trademark for the designated goods or designated services to the extent provided by the agreement under which such right is granted.
- (3) A non-exclusive right to use may be transferred only where the consent of the holder of trademark right (the holders of trademark right and of exclusive right to use in the case of a non-exclusive right to use granted in connection with an exclusive right to use) is obtained or where the transfer falls under general succession including inheritance.
- (4) Articles 73(1) (co-ownership), 94(2) (establishment of pledge), 97(3) (waiver), and 99(1) and 99(3) (effects of registration) of the Patent Act shall apply mutatis mutandis to a non-exclusive right to use.

(Right of members of corporation or association)

Article 31-2 (1) Members of a juridical person provided in Article 7(1) holding a trademark right to a collective trademark (hereinafter referred to as "collective members") or members of an association, etc. holding a trademark right to a regionally based collective trademark (hereinafter referred to as "regional collective members") shall have the right to use a registered trademark relating to collective trademark or regionally based collective trademark for the designated goods or designated services as provided by the said juridical person or association, etc.; provided, however, that in the case and only to the extent that an exclusive right to use the registered trademark (limited to the trademark right pertaining to a collective trademark) has been established.

- (2) The right provided for in the main clause of the preceding paragraph may not be transferred.
- (3) For the purpose of application of Articles 24-4, 29, 50, 52-2, 53 and 73, collective members or regional collective members shall be deemed to be holders of non-exclusive right to use.

(4) For the purpose of the application of Article 33(1)(iii) in relation to registered trademarks in connection with collective trademarks and regionally based collective trademarks, "or a person who has the non-exclusive right to use which is effective regarding the trademark right or the exclusive right to use under Article 99(1) of the Patent Act as applied mutatis mutandis under Article 31(4) of this Act. " in the said item shall read, "or the holder of non-exclusive right to use having effects provided for in Article 99(1) of the Patent Act as applied mutatis mutandis under Article 31(4) of this Act in relation to the trademark right or the exclusive right to use, or collective members or regional collective members holding the right to use the said trademark."

(Right to use trademark arising from prior use)

Article 32 (1) Where a trademark identical with, or similar to, the trademark for which the application is filed by another person has been used in Japan in connection with the designated goods or designated services of the trademark for which the application is filed, or in connection with goods or services similar thereto, without any intention to be engaged in unfair competition, from the time prior to the filing of such other person's application for the said trademark registration, and as a result, at the time of filing of the application for trademark registration (at the time of filing of the original application for trademark registration or the submission of a written amendment, if the application for trademark registration is deemed to have been filed at the time of submission of a written amendment under Article 9-4 of this Act or Article 17-3(1) of the Design Act as applied mutatis mutandis under Article 17-2(1) or 55-2(3) of this Act (including its mutatis mutandis application under Article 60-2(2))), such trademark has become well known among consumers as that indicating goods or services pertaining to the business of the person, the person shall have the right to use the trademark in connection with such goods or services as far as the said person continuously uses the trademark for the goods or services. The same shall apply to those by whom such business is succeeded.

(2) The holder of trademark right or of exclusive right to use may request the person who has the right to use the trademark pursuant to the preceding paragraph to affix an indication that may sufficiently prevent any confusion between the goods or services pertaining to the business of the said person and those of its own.

Article 32-2 (1) Any person who has been using in Japan a trademark identical with, or similar to, a regionally based collective trademark for which an application for registration is filed by another person in connection with the designated goods or designated services for which the application for trademark registration is filed, or in connection with goods or services similar thereto, without any intention to be engaged in unfair competition, prior to the filing of such other person's application for trademark registration of the said regionally based collective trademark, shall have the right to use the trademark in connection with such goods or services as far as the said person continuously uses the trademark in connection with such goods or services. The same shall apply to those by whom such business is succeeded.

(2) The holder of trademark right may request the person who has the right to use the trademark pursuant to the preceding paragraph to affix an indication that may sufficiently prevent any confusion between the goods or services pertaining to the business of the said person and those of its own or its members.

(Right to use trademark arising from use prior to registration of request for invalidation trial)

Article 33 (1) Where, prior to the registration of a request for a trial provided for in Article 46(1), a person falling under any of the following items has been using in Japan a registered trademark or a trademark similar thereto in connection with the designated goods or designated services or goods or services similar thereto without the knowledge that the said trademark registration falls under one of the items of the said paragraph, and the said trademark has become well known among consumers as that indicating goods or services pertaining to its business, the person shall have the right to use the trademark in connection with such goods or services as far as the said person continuously uses the trademark for such goods or services; the same shall apply to those by whom such business is succeeded:

(i) the original holder of trademark right, where one of two or more trademark registrations for identical or similar trademarks to be used in connection with identical or similar designated goods or designated services has been invalidated;

(ii) the original holder of trademark right, where the trademark registration has been invalidated and a trademark identical with, or similar to, such trademark to be used in connection with identical or similar designated goods or designated services is registered for the person who is entitled to such a trademark; or

(iii) in the case of the preceding two items, a person who, at the time of registration of the request for a trial under Article 46(1), has the exclusive right to use of the trademark right of the trademark registration which has been invalidated or a person who has the non-exclusive right to use which is effective regarding the trademark right or the exclusive right to use under Article 99(1) of the Patent Act as applied mutatis mutandis under Article 31(4) of this Act.

(2) The said holder of trademark right or of exclusive right to use shall be entitled to receive reasonable compensation from the person who has the right to use the trademark pursuant to the preceding paragraph.

(3) Article 32(2) shall apply mutatis mutandis to paragraph (1).

(Right to use trademark after expiration of duration of patent right, etc.)

Article 33-2 (1) Where a patent right of an application that has been filed prior to or on the same date as the filing date of an application for trademark registration conflicts with the trademark right of the application for trademark registration, upon expiration of the duration of the said patent right, the original patent right holder shall have the right to use the registered trademark or a trademark similar thereto in connection with the designated goods or designated services specified in the application, or goods or services similar thereto, within the limits of the original patent right; provided, however, that such trademark is not used for the purpose of

unfair competition.

(2) Article 32(2) shall apply mutatis mutandis to the preceding paragraph.

(3) The preceding two paragraphs shall apply mutatis mutandis, where a utility model or design right of an application that has been filed prior to or on the same date as the filing date of an application for trademark registration conflicts with the trademark right of the application for trademark registration, upon expiration of the duration of such utility model right or design right.

Article 33-3 (1) Where a patent right of an application that has been filed prior to or on the same date as the filing date of an application for trademark registration conflicts with the trademark right of the application for trademark registration, upon expiration of the duration of the said patent right, the person who, at the time of expiration of the duration of the patent right, has the exclusive registered right to work the patent right, or a non-exclusive registered right to work which is effective on the patent right or on the exclusive registered right to work under Article 99(1) of the Patent Act, shall have the right to use the registered trademark or a trademark similar thereto, within the limits of the original patent right, in connection with the designated goods or designated services specified in the application for trademark registration, or goods or services similar thereto; provided, however, that such trademark is not used for the purpose of unfair competition.

(2) Articles 32(2) and 33(2) shall apply mutatis mutandis to the preceding paragraph.

(3) The preceding two paragraphs shall apply mutatis mutandis, where a utility model or a design right of an application which has been filed prior to or on the same date as the filing date of an application for trademark registration conflicts with the trademark right of the application for trademark registration, upon expiration of the duration of such utility model right or design right.

(Pledges)

Article 34 (1) Where a pledge is established on a trademark right, exclusive right to use or non-exclusive right to use, unless otherwise provided for by contract, the pledgee may not use the registered trademark in connection with the designated goods or designated services.

(2) Article 96 (subrogation) of the Patent Act shall apply mutatis mutandis to pledges on a trademark right, exclusive right to use or non-exclusive right to use.

(3) Articles 98(1)(iii) and 98(2) (effects of registration) of the Patent Act shall apply mutatis mutandis to pledges on a trademark right or an exclusive right to use.

(4) Article 99(3) (effects of registration) of the Patent Act shall apply mutatis mutandis to pledges on a non-exclusive right to use.

(Mutatis mutandis application of the Patent Act)

Article 35 Article 73 (co-ownership), 76 (Lapse of patent rights in absence of heir), 97(1) (waiver), and 98(1)(i) and 98(2) (Effect of registration) of the Patent Act shall apply mutatis mutandis to trademark rights. In this case, the term "transfer (excluding those by general

succession including inheritance)" in Article 98(1)(i) of the Patent Act shall be deemed to be replaced with "division and transfer (excluding those by general succession including inheritance)."

## **Section 2 Infringement of Rights**

(Right to demand injunction)

Article 36 (1) The holder of trademark right or of exclusive right to use may demand a person who is infringing or is likely to infringe the trademark right or the exclusive right to use to stop or prevent such infringement.

(2) In making such a demand under the preceding paragraph, the holder of trademark right or of exclusive right to use may demand the person to take measures necessary for the prevention of such infringement, including the destruction of articles which constitute the act of infringement and the removal of equipment used for or contributing to the act of infringement.

(Acts deemed to constitute infringement)

Article 37 The following acts shall be deemed to constitute infringement of a trademark right or an exclusive right to use:

- (i) the use of a trademark similar to the registered trademark in connection with the designated goods or designated services, or the use of the registered trademark or a trademark similar thereto in connection with goods or services similar to the designated goods or designated services;
- (ii) the possession for the purpose of assignment, delivery or export of the designated goods, or goods similar to the designated goods or designated services, affixed with the registered trademark or a trademark similar thereto on the goods or their packages;
- (iii) the possession or importation of articles affixed with the registered trademark or a trademark similar thereto, that are used in the course of the provision of designated services or services similar to the designated services or the designated goods by a person who receives the said services, for the purpose of the provision of the said services through use of the said articles;
- (iv) the assignment, delivery, or possession or importation for the purpose of assignment or delivery of articles affixed with a registered trademark or a trademark similar thereto, that are used in the course of the provision of designated services or services similar to the designated services or the designated goods by a person who receives the said services, for the purpose of causing the provision of the said services through use of the said products;
- (v) the possession of products indicating the registered trademark or a trademark similar thereto, for the purpose of using the registered trademark or a trademark similar thereto in connection with the designated goods or designated services, or goods or services similar thereto;
- (vi) the assignment, delivery, or possession for the purpose of assignment or delivery, of articles indicating the registered trademark or a trademark similar thereto, for the purpose



- of causing the registered trademark or a trademark similar thereto to be used in connection with the designated goods or designated services, or goods or services similar thereto;
- (vii) the manufacture or importation of products indicating the registered trademark or a trademark similar thereto, for the purpose of using or causing to be used the registered trademark or a trademark similar thereto in connection with the designated goods or designated services or goods or services similar thereto; and
- (viii) the manufacture, assignment, delivery or importation, as a business, of products to be used exclusively for the manufacturing of products indicating the registered trademark or a trademark similar thereto.

(Presumption of amount of damage, etc.)

- Article 38 (1) Where a holder of trademark right or of exclusive right to use claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, and the infringer assigned the goods that composed the act of infringement, the amount of damage sustained by the holder of trademark right or of exclusive right to use may be presumed to be the amount of profit per unit of goods which would have been sold by the holder of trademark right or of exclusive right to use if there had been no such act of infringement, multiplied by the quantity of goods assigned by the infringer (hereinafter referred to as the "Assigned Quantity"), the maximum of which shall be the amount attainable by the holder of trademark right or of exclusive right to use in light of the capability of the holder of trademark right or of exclusive right to use to use such goods; provided, however, that if any circumstances exist under which the holder of trademark right or of exclusive right to use would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of goods not able to be sold due to such circumstances shall be deducted.
- (2) Where the holder of trademark right or of exclusive right to use claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer shall be presumed to be the amount of damage sustained by the holder of trademark right or of exclusive right to use.
- (3) The holder of trademark right or of exclusive right to use may claim against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, by regarding the amount the holder of trademark right or of exclusive right to use would have been entitled to receive for the use of the registered trademark as the amount of damage sustained.
- (4) The preceding paragraph shall not prevent any relevant party from claiming compensation for damage in an amount exceeding the amount provided therein. In this case, where the infringer committed the infringement of the trademark right or the exclusive right to use without intent or gross negligence, the court may take these circumstances into consideration in determining the amount of damages to be awarded.

(Mutatis mutandis application of the Patent Act)

Article 39 Articles 103 (Presumption of negligence), 104-2 to 105-6 (Obligation to clarify acts in concrete manner; Restriction on exercise of rights of patentee, etc.; Submission of documents, etc.; Expert opinion for calculation of damages; Determination of reasonable damages; Order to keep confidentiality; Rescission of confidentiality Order; Notification of petition requesting inspection of trial record, etc.) and 106 (Measures to restore credibility) of the Patent Act shall apply mutatis mutandis to the infringement of a trademark right and an exclusive right to use.

### **Section 3 Registration Fees**

(Registration fees)

Article 40 (1) A person obtaining the registration of establishment of a trademark right shall pay as a registration fee for each trademark registration the amount of 66,000 yen multiplied by the number of classes (referring to classes of goods and services provided by Cabinet Order provided for in Article 6(2), to which the designated goods or designated services belong; the same shall apply hereinafter).

(2) A person filing a request for the registration of renewal of the duration of a trademark right shall pay as a registration fee for each trademark registration the amount of 151,000 yen multiplied by the number of classes.

(3) The preceding two paragraphs shall not apply to trademark rights belonging to the State.

(4) Where a trademark right is jointly owned by the State and a person or persons other than the State, and the portion of their respective shares of the said trademark right has been agreed, notwithstanding paragraphs (1) and (2), the registration fee provided for in the said paragraphs shall be the amount of the registration fee provided in the said paragraphs multiplied by the total ratio of the share of each person other than the State, which shall be paid by the person or persons other than the State.

(5) Any fractional figures of the registration fee calculated in accordance with the preceding paragraph smaller than 10 yen, if any, shall be discarded.

(6) The registration fee provided for in paragraphs (1) and (2) shall be paid by patent revenue stamps as provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that the payment may be made in cash if permitted under the Ordinance of the Ministry of Economy, Trade and Industry.

(Time limit for payment of registration fees)

Article 41 (1) The registration fee under Article 40(1) shall be paid within 30 days from the service of a transcript of an examiner's decision or a trial decision to the effect that a trademark is to be registered.

(2) Upon the request of a person required to pay the registration fee, the Commissioner of the Patent Office may extend the period of time provided in the preceding paragraph by a maximum of 30 days.

- (3) The registration fee under Article 40(2) shall be paid at the time of filing of a request for renewal of registration.

(Payment of registration fee by installments)

- Article 41-2 (1) Notwithstanding Article 40(1), a person obtaining a registration of establishment of a trademark right may pay the prescribed registration fee by installments. In this case, 44,000 yen multiplied by the number of classes shall be paid for each trademark registration within 30 days from the service of a transcript of an examiner's decision or a trial decision to the effect that a trademark is to be registered, and an additional 44,000 yen multiplied by the number of classes shall be paid for each trademark registration no later than five years prior to the expiration of the duration of the trademark right.
- (2) Notwithstanding Article 40(2), a person filing a request for the registration of renewal of the duration of a trademark right may pay the prescribed registration fee by installments. In this case, the said applicant shall pay 101,000 yen multiplied by the number of classes for each trademark registration at the time of filing of the request for the registration of renewal, and an additional 101,000 yen multiplied by the number of classes for each trademark registration no later than five years prior to the expiration of the duration of the trademark right.
- (3) Where the holder of trademark right is unable to pay the prescribed registration fee no later than five years prior to the expiration of the duration of the trademark right in accordance with paragraph (1) or (2), the holder of trademark right may make a delayed payment for such fee within six months even after the expiration of the said time limit.
- (4) Where the holder of trademark right fails to pay the prescribed registration fee due and payable no later than five years prior to the expiration of the duration of the trademark in accordance with paragraph (1) or (2) and the surcharge for late registration provided for in Article 43(3) within the time limit permitted to make a delayed payment for the registration fee in accordance with the preceding paragraph, the trademark right is deemed to have been extinguished retroactively as of the last day five years prior to the expiration of the duration.
- (5) The provisions of paragraphs (3) to (5) of Article 40 shall apply mutatis mutandis to paragraphs (1) and (2).
- (6) Article 41(2) shall apply mutatis mutandis to the payment of the prescribed registration fee due and payable within 30 days from the service of a transcript of an examiner's decision or a trial decision to the effect that a trademark is to be registered under paragraph (1).

(Payment of registration fee by interested person)

- Article 41-3 (1) Any interested person may make payment of the registration fee (excluding the registration fee due and payable at the time of filing of a request for renewal of registration) even against the intention of the person by whom the said fee is to be paid.
- (2) An interested person who makes payment of the registration fee in accordance with the preceding paragraph may demand payment to reimburse the expense thereof from the person by whom the said fee was to have been paid, to the extent that the said person receives actual benefits therefrom.

(Refund of registration fee already paid)

Article 42 (1) Only the following registration fees are refundable upon request by a payee:

- (i) a registration fee paid in excess, or in error; or
- (ii) a registration fee due and payable no later than five years prior to the expiration of the duration of the trademark right under Article 41-2(1) or 41-2(2) (limited to the case where a rescission decision under Article 43-3(2) or a trial decision to the effect that a trademark registration is to be invalidated becomes final and binding no later than five years prior to the expiration of the duration of the trademark right).

(2) No refund of any registration fee under the preceding paragraph may be requested after the lapse of one year from the day on which the registration fee is paid in the case of registration fees provided for in item (i) of the preceding paragraph and six months from the day on which a rescission decision under Article 43-3(2) or a trial decision becomes final and binding in the case of registration fees provided for in item (ii) of the preceding paragraph.

(Registration surcharge)

Article 43 (1) A person filing a request for renewal of registration under Article 20(3) or 21(1) shall pay, in addition to the registration fee due and payable under Article 40(2), a surcharge in an amount equivalent to the registration fee.

- (2) Where Article 41-2(2) is applicable, a person filing a request provided in the preceding paragraph shall pay, in addition to the registration fee due and payable at the time of filing of the request for registration of renewal under Article 41-2(2), a surcharge in an amount equivalent to the registration fee.
- (3) Where Article 41-2(3) is applicable, the holder of trademark right shall pay, in addition to the registration fee due and payable no later than five years prior to the expiration of the duration of the trademark right under Article 41-2(1) or (2), a surcharge in an amount equivalent to the registration fee.
- (4) The surcharges under the preceding three paragraphs shall be paid by patent revenue stamps as provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that the payment may be made in cash, if permitted by Ordinance of the Ministry of Economy, Trade and Industry.

## **CHAPTER IV-2 OPPOSITION TO REGISTRATION**

(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
- (ii) where the trademark registration has been made in violation of a treaty.

(Decision)

Article 43-3 (1) An examination and decision on an opposition to registration shall be conducted by a panel consisting of three or five trial examiners.

- (2) Where the trial examiners find the trademark registration pertaining to an opposition to registration falls under any of the items of Article 43-2, the trial examiners shall render a decision to the effect that the trademark registration is to be rescinded (hereinafter referred to as "rescission decision").
- (3) Where the rescission decision becomes final and binding, the relevant trademark right shall be deemed never to have existed.
- (4) Where the trial examiners find the trademark registration pertaining to an opposition to registration does not fall under any of the items of Article 43-2, the trial examiners shall render a decision to the effect that the trademark registration is to be maintained.
- (5) The decision under the preceding paragraph shall not be subject to appeal.

(Formal requirements for filing an opposition, etc.)

Article 43-4 (1) A person filing an opposition to registration of a trademark shall submit to the Commissioner of the Patent Office a written opposition stating the following matters:

- (i) the name and the domicile or residence of the opponent to the registration and a representative(s) thereof;
  - (ii) the indication of the trademark registration pertaining to the opposition to registration; and
  - (iii) the grounds of the opposition to registration and the indication of supporting evidence.
- (2) An amendment of the written opposition to registration submitted under the preceding paragraph shall not change the gist thereof. Notwithstanding, this provision shall not apply to any amendment with respect to the matters provided for in item (iii) of the preceding paragraph; provided that such amendment is made no later than thirty days from the lapse of the term provided in Article 43-2.
  - (3) The Commissioner of the Patent Office may, upon request or ex officio, extend the period provided in the preceding paragraph for a person in a remote area or an area with transportation difficulties.
  - (4) The chief trial examiner shall transmit a copy of the written opposition to the holder of trademark right.
  - (5) Article 46(3) shall apply mutatis mutandis to the case where an opposition to registration is filed.

(Designation of trial examiners, etc.)

Article 43-5 Articles 136(2) and 137 to 144 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to the panel under Article 43-3(1) and the trial examiners constituting thereof.

-2 (Trial Clerk)

Article 43-5 (1) The Commissioner of the Patent Office shall designate a trial clerk for each case of opposition to registration.

(2) The provisions of paragraphs (3) to (5) of Article 144-2 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to the trial clerk provided for in the preceding paragraph.

(Proceedings of examination, etc.)

Article 43-6 (1) The examination of the opposition to registration shall be conducted by documentary examination; provided, however, that where a petition is filed by the holder of trademark right, the opponent, an intervenor or ex officio, the chief trial examiner may decide to conduct the proceedings by oral examination.

(2) Paragraphs (3) to (5) of Articles 145, 146 and 147 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to a trial by oral examination provided for in the proviso to the preceding paragraph.

(3) Where any ground for suspension or termination of procedures is applicable to one of the joint holders of trademark right for an examination and decision on an opposition to registration, the said suspension or termination shall have effect on all such joint holders of trademark right.

(Intervention)

Article 43-7 (1) In an examination to render a decision on an opposition to registration, any person who has a right relating to the trademark right or any other person who has an interest in the trademark right may intervene in the examination in order to assist the holder of trademark right until the decision on the opposition to registration is rendered.

(2) Articles 148(4), 148(5) and 149 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to the intervenor provided for in the preceding paragraph.

(Examination and preservation of evidence)

Article 43-8 Articles 150 and 151 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to the examination and preservation of evidence in the examination of the opposition to registration.

(Ex officio examination)

Article 43-9 (1) In an examination of an opposition to registration, any grounds not pleaded by the holder of trademark right, the opponent or the intervenor may be examined.

(2) In an examination of an opposition to registration, no examination shall be conducted on any designated goods or designated services for which the opposition to registration is not raised.

(Joint or separate conduct of oppositions)

Article 43-10 (1) Where two or more oppositions to registration are filed in relation to the same trademark right, unless special circumstances exist, the examinations thereof shall be conducted jointly.

(2) An examination conducted jointly in accordance with the preceding paragraph may later be divided.

(Withdrawal of opposition)

Article 43-11 (1) An opposition to registration, once filed, may not be withdrawn after the notification under Article 43-12 is served.

(2) Article 155(3) of the Patent Act as applied mutatis mutandis under Article 56(2) of this Act shall apply mutatis mutandis to the withdrawal of an opposition to registration.

(Notification of reasons for rescission)

Article 43-12 Where the chief trial examiner intends to render a rescission decision, the chief trial examiner shall notify the holder of trademark right and the intervenor of the reasons for rescission of the trademark registration and give the said parties an opportunity to submit a written opinion, designating a reasonable time limit.

(Formal requirements of decision)

Article 43-13 (1) The decision with regard to an opposition to registration shall be rendered in writing stating the following matters:

- (i) the case number of the opposition to registration;
- (ii) the name and the domicile or residence of the holder of trademark right, the opponent, the intervenor and their representative(s);
- (iii) an indication of the trademark registration on which the decision was rendered;
- (iv) the conclusions of and reasons for the decision; and
- (v) the date of the decision.

(2) Where a decision has been rendered, the Commissioner of the Patent Office shall serve a transcript of the decision to the holder of trademark right, the opponent, the intervenor and persons whose request for intervention in the examination on the opposition to registration has been refused.

(Mutatis mutandis application of provisions concerning trial)

Article 43-14 (1) Articles 133, 133-2, 134(4), 135, 152, 168, paragraphs (3) to (6) of Article 169, and 170 of the Patent Act as applied mutatis mutandis under Article 56(1) of this Act shall apply mutatis mutandis to an examination and a decision on an opposition to registration.

(2) Article 43-3(5) of this Act shall apply mutatis mutandis to a decision under Article 135 of the

Patent Act as applied mutatis mutandis under the preceding paragraph.

## CHAPTER 5 TRIAL

(Trial against examiner's decision of refusal)

Article 44 (1) A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for a trial against the examiner's decision of refusal within 30 days from the date the transcript of the examiner's decision has been served.

(2) Where, due to reasons beyond the control of the person, the person filing a request for a trial pursuant to the preceding paragraph is unable to file the request within the time limit as provided in the preceding paragraph, the said person may, notwithstanding the said paragraph, file the request within 14 days (two months for resident abroad) from the date on which the reasons for not filing ceased to be applicable, but not later than six months after the expiration of the said time limit.

(Trial against examiner's decision of dismissal of amendment)

Article 45 (1) Any person who has received a decision of dismissal of amendments under Article 16-2(1) and is dissatisfied may file a request for a trial against the decision within 30 days from the date the transcript of the decision has been served; provided, however, that this provision shall not apply where a new application for trademark registration provided in Article 17-3(1) of the Design Act as applied mutatis mutandis pursuant to Article 17-2(1) of this Act is filed.

(2) Article 44(2) shall apply mutatis mutandis to a request for a trial under the preceding paragraph.

(Trial for invalidation of trademark registration)

Article 46 (1) 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;
- (ii) where the trademark registration has been made in violation of a treaty;
- (iii) where the trademark registration has been made on an application for trademark registration filed by a person who has not succeeded the rights deriving from the application for trademark registration;
- (iv) where, after the trademark registration, the holder of trademark right has become unable to enjoy the trademark right pursuant to Article 25 of the Patent Act as applied mutatis



mutandis pursuant to Article 77(3) of this Act, or the trademark registration has become in violation of a treaty;

(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

(vi) where, after the trademark registration of a regionally based collective trademark, the holder of trademark right has ceased to be an Association, etc., or the registered trademark has ceased to be a trademark well known among consumers as that indicating goods or services in connection with the business of the holder of trademark right or its members, or ceases to fall under any of the items of Article 7-2(1).

(2) A request for a trial under the preceding paragraph may be filed even after the extinguishment of the trademark right.

(3) Where a request for a trial is filed under paragraph (1), the chief trial examiner shall notify the holder of exclusive right to use in connection with the trademark right, and other persons who have any registered rights relating to the trademark registration.

Article 46-2 (1) Where a trial decision to the effect that the trademark registration is to be invalidated becomes final and binding, the trademark right shall be deemed never to have existed; provided, however, that where the trademark registration falls under any of items (iv) to (vi) of paragraph (1) of Article 46, and a trial decision to the effect that the trademark registration is to be invalidated becomes final and binding, the trademark right shall be deemed not to have existed from the time any of items (iv) to (vi) of the said paragraph first became applicable to the trademark registration.

(2) In the case of the proviso to the preceding paragraph, where the time at which any of items (iv) to (vi) of Article 46(1) first became applicable to the trademark registration cannot be specified, the trademark right shall be deemed not to have existed from the date of registration of the request for a trial for invalidation of the said trademark registration.

Article 47 (1) Where a trademark registration has been made in violation of Article 3, 4(1)(viii), 4(1)(xi) to 4(1)(xiv), 8(1), 8(2) or 8(5), where a trademark registration has been made in violation of Article 4(1)(x) or 4(1)(xvii) (excluding the case where a trademark has been registered for the purpose of unfair competition), where a trademark has been registered in violation of Article 4(1)(xv) (excluding the case where a trademark has been registered for unfair purposes), or where a trademark registration falls under Article 46(1)(iii), a request for a trial relating to the trademark registration under Article 46(1) may not be filed after a lapse of five years from the date of registration of the establishment of the trademark right.

(2) Where a trademark registration has been made in violation of Article 7-2(1) (limited to the case where the trademark was not well known, as a result of the use of the trademark, among consumers as that indicating goods or services in connection with the business of the applicant for the trademark registration or its members) and five years have lapsed from the date of registration of the establishment of the trademark right, and further the registered trademark is well known among consumers as that indicating goods and services in connection with the

business of the holder of trademark right or its members, a request for a trial pertaining to the trademark registration under Article 46(1) may not be filed.

#### Article 48 and Article 49 Deleted

(Trial for rescission of trademark registration)

Article 50 (1) Where a registered trademark (including a trademark deemed identical from common sense perspective with the registered trademark, including a trademark consisting of characters identical with the registered trademark but in different fonts, a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and concept, and a trademark consisting of figures that are considered identical in terms of appearance as those of the registered trademark; hereinafter the same shall apply in this article) has not been used in Japan in connection with any of the designated goods and designated services for three consecutive years or longer by the holder of trademark right, the exclusive right to use or non-exclusive right to use, any person may file a request for a trial for rescission of such trademark registration in connection with the relevant designated goods or designated services.

(2) Where a request for a trial under the preceding paragraph is filed, unless the demandee proves that any of the holder of trademark right, exclusive right to use or non-exclusive right to use has used the registered trademark in Japan in connection with any of the designated goods or designated services pertaining to the request within three years prior to the registration of the request for the trial, the holder of trademark right may not prevent the rescission of the trademark registration in connection with the relevant designated goods or designated services; provided, however, that this shall not apply where the demandee shows just causes for non-use of the registered trademark in connection with the relevant designated goods or designated services.

(3) Where the registered trademark in connection with the designated goods or designated services pertaining to the request under paragraph (1) has been used in Japan by any of the holders of trademark right, exclusive right to use or non-exclusive right to use, during the period from three months prior to the filing of the request for a trial under paragraph (1) to the date of the registration of the filing of the request, and where the demandant proves that the registered trademark has been used after the user became aware of the fact that the said request for a trial would be filed, the use of the registered trademark shall not fall under the use of the registered trademark provided in paragraph (1); provided, however, that this shall not apply to the case where the demandee shows just causes for the use of the registered trademark.

Article 51 (1) Where a holder of trademark right intentionally uses, either a trademark similar to a registered trademark in connection with the designated goods or designated services, or a registered trademark in connection with goods or services similar to the designated goods or

designated services or a trademark similar thereto, in a manner that misleads as to the quality of the goods or services or causes confusion in connection with the goods or services pertaining to a business of another person, any person may file a request for a trial for rescission of the trademark registration.

- (2) The previous holder of trademark right may not be granted a registration of the same trademark or of a trademark similar thereto in connection with the designated goods or designated services for which the trademark registration has been rescinded, or in connection with goods or services similar thereto, until after a lapse of five years from the date the trial decision to the effect that the trademark registration is to be rescinded under the preceding paragraph becomes final and binding.

Article 52 A request for a trial under Article 51(1) may not be filed after the lapse of five years from the date on which the holder of trademark right ceased to use the trademark in the manner provided in the said paragraph.

Article 52-2 (1) Where a trademark right to a similar registered trademark to be used in connection with identical goods or services, or a trademark right to an identical or similar registered trademark to be used in connection with similar goods or services becomes owned by a different holder of trademark right as a result of transfer of the trademark right, if the holder of trademark right of one of the registered trademarks uses, for the purpose of unfair competition, the registered trademark for its designated goods or designated services in a manner that causes confusion in connection with the goods or services pertaining to the business of the holder of trademark right, exclusive right to use or non-exclusive right to use of the other registered trademark, any person may file a request for a trial for rescission of the trademark registration.

- (2) Articles 51(2) and 52 shall apply mutatis mutandis to a trial under the preceding paragraph.

Article 53 (1) Where a holder of exclusive right to use or non-exclusive right to use uses a registered trademark in connection with the designated goods or designated services or in connection with goods or services similar thereto, or a trademark similar thereto, in a manner that misleads as to the quality of the goods or services or causes confusion in connection with the goods or services pertaining to the business of another person, any person may file a request for a trial for rescission of the trademark registration; provided, however, that this shall not apply to the case where the holder of trademark right was not aware of the fact and using due care.

- (2) The previous holder of trademark right, exclusive right to use or non-exclusive right to use who used the trademark in a manner provided in the preceding paragraph may not be granted a registration of the same trademark or of a trademark similar thereto in connection with the designated goods or designated services for which the trademark registration has been rescinded, or in connection with goods or services similar thereto, until after the lapse of five years from the date the trial decision to the effect that the trademark registration is to be

rescinded under the preceding paragraph becomes final and binding.

(3) Article 52 shall apply mutatis mutandis to a trial under paragraph (1).

Article 53-2 Where a registered trademark is a trademark pertaining to a right to a trademark (limited to a right equivalent to a trademark right) held by a person in 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 or a trademark similar thereto, and the designated goods or designated services thereof are goods or services pertaining to the said right or goods or services similar thereto, and further, the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by his/her agent or representative or by his/her former agent or representative within one year prior to the filing date of the trademark registration, the person who has the right pertaining to the trademark may file a request for a trial for rescission of the trademark registration.

Article 53-3 A request for a trial under Article 53-2 may not be filed after the lapse of five years from the date on which the establishment of the trademark right has been registered.

Article 54 (1) Where a trial decision to the effect that the trademark registration is to be rescinded becomes final and binding, the trademark right shall become extinguished thereafter.

(2) Notwithstanding the preceding paragraph, where a trial decision to the effect that the trademark registration is to be rescinded becomes final and binding by a trial under Article 50(1), the trademark right shall be deemed to have become extinguished on the date of registration of the request for a trial under the said paragraph.

Article 55 The provision of Article 46(3) shall apply mutatis mutandis to the case where a request for a trial is filed under Article 50(1), 51(1), 52-2(1), 53(1) or 53-2.

(Special provisions on trials against examiner's decision of refusal)

Article 55-2 (1) The provisions of Articles 15-2 and 15-3 shall apply mutatis mutandis to the case where reasons for refusal that are different from those contained in the examiner's decision are found in the trial under Article 44(1).

(2) The provision of Article 16 shall apply mutatis mutandis where a request for a trial under Article 44(1) is found to have reasonable grounds; provided, however, that this provision shall not apply where a trial decision to the effect that a further examination is to be carried out under Article 160(1) of the Patent Act as applied mutatis mutandis pursuant to Article 56(1) of this Act is rendered.

(3) The provisions of Article 16-2 of this Act and Article 17-3 of the Design Act shall apply mutatis mutandis to a trial under Article 44(1) of this Act. In this case, the term "files a request for a trial under Article 45(1)" in Article 16-2(4) shall be deemed to be replaced with

"institutes an action under Article 63(1)."

(Mutatis mutandis application of the Patent Act)

Article 56 (1) The provisions of Articles 131(1), 131-2(1), 132 to 133-2, 134(1), 134(3), 134(4), 135 to 154, 155(1), 155(2), 156 to 158, 160(1), 160(2), 161, and 167 to 170 (effect of trial decision, request for trial, trial examiner, trial procedures in relation to litigation, and costs of trial) of the Patent Act shall apply mutatis mutandis to a trial. In this case, the term "is made with respect to the grounds for the request as provided in item (iii) of paragraph (1) of the preceding Article in the course of filing a request for a trial other than a trial for Patent invalidation, or in the event that approval is granted by the chief trial examiner under the following paragraph" in Article 131-2(1) of the Patent Act shall be deemed to be replaced with "is made with respect to the grounds for the request as provided in Article 131(1)(iii) of the Patent Act as applied mutatis mutandis pursuant to Article 56(1) of this Act in the course of filing a request for a trial other than a trial under Article 46(1) of the Trademark Act," the term "a trial for Patent invalidation and a trial for invalidation of the registration of extension of term" in Articles 132(1) and 167 of the Patent Act and the term "a trial for Patent invalidation or a trial for invalidation of the registration of extension of term" in Articles 145(1) and 169(1) of the Patent Act shall be deemed to be replaced with "a trial under Article 46(1), 50(1), 51(1), 52-2(1), 53(1) or 53-2 of the Trademark Act," the term "a party in the case or an intervener in the case" in Article 139(i), (ii) and (v) of the Patent Act shall be deemed to be replaced with "a party in the case, an intervener in the case or an opponent to the registration in the case", the term "a party in the case or an intervener in the case" in Article 139(iii) of the Patent Act shall be deemed to be replaced with "a party in the case, an intervener in the case or an opponent to the registration in the case," the term "a trial against the examiner's decision of refusal" in Article 161 of the Patent Act and "a trial against an examiner's decision of refusal and a trial for correction" in Article 169(3) of the Patent Act shall be deemed to be replaced with "a trial under Article 44(1) or 45(1) of the Trademark Act," and the term "the decision in another trial" in Article 168(1) of the Patent Act shall be deemed to be replaced with "a decision on the opposition to registration or a trial decision in another trial."

(2) The provisions of Article 155(3) (Withdrawal of request for trial) of the Patent Act shall apply mutatis mutandis to a trial under Article 46(1) of this Act.

(Mutatis mutandis application of the Design Act)

Article 56-2 The provision of Article 51 of the Design Act shall apply mutatis mutandis to a trial under Article 45(1) of this Act.

## **CHAPTER 6 RETRIAL AND LITIGATION**

(Request for retrial)

Article 57 (1) A party or intervener in the case may file a request for a retrial against a final and

binding rescission decision or a final and binding trial decision.

- (2) The provisions of Articles 338(1), 338(2) and 339 (grounds for retrial) of the Code of Civil Procedure (Act No. 109 of 1996) shall apply mutatis mutandis to a request for a trial under the preceding paragraph.

Article 58 (1) Where the demandant of a trial in conspiracy with the demandee has caused a trial decision to be rendered for the purpose of harming the right or interest of a third party, the third party may file a request for a retrial against the final and binding trial decision.

- (2) A request for a retrial under the preceding paragraph shall be filed against the demandant and the demandee in the trial as joint demandees.

(Limitations of effects of trademark right restored by a retrial)

Article 59 Where a trademark right pertaining to a rescinded or invalidated trademark registration has been restored by a retrial, the trademark right shall have no effect on any of the following acts:

- (i) the use of the registered trademark in good faith in connection with the designated goods or designated services after the rescission decision or trial decision became final and binding but before the registration of the request for a retrial; and
- (ii) the acts listed in each of the items in Article 37 committed in good faith after the rescission decision or trial decision became final and binding but before the registration of the request for a retrial.

Article 60 (1) Where a trademark right pertaining to a rescinded or invalidated trademark registration has been restored by a retrial or, where the establishment of a trademark right with respect to an application for trademark registration refused by a trial decision has been registered through a retrial, and where a person, after the rescission decision or trial decision becomes final and binding but before the registration of a request for a retrial, uses the registered trademark or a trademark similar thereto in Japan in good faith in connection with the designated goods or designated services or in connection with goods or services similar thereto, and as a result, such trademark has become well known among consumers as that indicating goods or services pertaining to the business of the person at the time of registration of the filing of a request for a retrial, the person shall have the right to use the trademark in connection with such goods or services as far as the said person continuously uses the trademark for such goods or services. The same shall apply to those by whom such business is succeeded.

- (2) The provision of Article 32(2) shall apply mutatis mutandis to the preceding paragraph.

(Mutatis mutandis application of provisions concerning trial)

Article 60-2 (1) The provisions of Articles 43-3, 43-5 to 43-9 and 43-12 to 43-14 of this Act, Article 131(1), the main clause of Article 131-2(1), 132(3), 154, 155(1) and 156 of the Patent Act as applied mutatis mutandis pursuant to Article 56(1) of this Act, and Article 155(3) of

the Patent Act as applied mutatis mutandis pursuant to Articles 56(2) of this Act shall apply mutatis mutandis to a retrial against a final and binding rescission decision.

- (2) The provision of Article 55-2 shall apply mutatis mutandis to a retrial against a final and binding trial decision on a trial under Article 44(1).
- (3) The provision of Article 56-2 shall apply mutatis mutandis to a retrial against a final and binding trial decision on a trial under Article 45(1).

(Mutatis mutandis application of the Patent Act)

Article 61 The provisions of Article 173 (Time limit for request for retrial) and Articles 174(2) and 174(4) (Application mutatis mutandis of provisions regarding appeal/trial, etc.) of the Patent Act shall apply mutatis mutandis to a request for a retrial. In this case, the term "trial decision" in paragraphs (1) and (3) to (5) of Article 173 of the Patent Act shall be deemed to be replaced with "rescission decision or trial decision," the term "a trial for patent invalidation or a trial for invalidation of the registration of extension of the term" in Article 174(2) of the Patent Act shall be deemed to be replaced with "a trial under Article 46(1), 50(1), 51(1), 52-2(1), 53(1) or 53-2 of the Trademark Act."

(Mutatis mutandis application of the Design Act)

- Article 62 (1) The provision of Article 58(2) (Mutatis mutandis application of provisions regarding appeal/trial) of the Design Act shall apply mutatis mutandis to a retrial against a final and binding trial decision on a trial under Article 44(1) of this Act.
- (2) The provision of Article 58(3) of the Design Act shall apply mutatis mutandis to a retrial against a final and binding trial decision on a trial under Article 45(1) of this Act.

(Actions against trial decisions, etc.)

- Article 63 (1) The Tokyo High Court shall have exclusive jurisdiction over any action against a rescission decision or a trial decision, an action against a ruling to dismiss an amendment under Article 16-2(1) as applied mutatis mutandis pursuant to Article 55-2(3) (including cases where it is applied mutatis mutandis pursuant to Article 60-2(2)) and an action against a ruling to dismiss a written opposition or a written request for trial or retrial.
- (2) The provisions of paragraphs (2) to (6) of Article 178 (time limit for institution of action, etc.), 179 to 180-2 (appropriate party as defendant, notification of institution of action, opinion of the Commissioner of the Patent Office in litigations annulling a trial decision), 181(1) and 181(5) (rescission of trial decision or ruling) and 182 (delivery of original copy of judgment) of the Patent Act shall apply mutatis mutandis to the actions under the preceding paragraph. In this case, the term "the trial" in Article 178(2) of the Patent Act shall be deemed to be replaced with "the examination or trial of the opposition to registration in the trial," the term "a trial for patent invalidation or a trial for invalidation of the registration of extension of the term" in Article 179 of the Patent Act shall be deemed to be replaced with "a trial under Article 46(1), 50(1), 51(1), 52-2(1), 53(1) or 53-2 of the Trademark Act."

(Relationship between objection and litigation)

Article 63-2 The provision of Article 184-2 (Relationship between (administrative) objection and litigation) of the Patent Act shall apply mutatis mutandis to an action demanding the rescission of measures (excluding measures provided in Article 77(7)) imposed by this Act or an order thereunder.

## **CHAPTER 7 DEFENSIVE MARK**

(Requirements for defensive mark registration)

Article 64 (1) Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.

(2) Where a registered trademark pertaining to services is well known among consumers as that indicating the designated services in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with services other than the designated services pertaining to the registered trademark or services similar thereto or in connection with goods other than those similar to the designated services is likely to cause confusion between the said other person's services or goods and the designated services pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the services or goods for which the likelihood of confusion exists.

(3) For the purpose of the application of the preceding two paragraphs in relation to defensive mark registrations pertaining to a trademark right pertaining to a regionally based collective trademark, the term "his/her own" in the said paragraphs shall be deemed to be replaced with "its own or its members' ."

(Conversion of application)

Article 65 (1) An applicant for trademark registration (1) may convert an application for trademark registration into an application for defensive mark registration.

(2) The conversion of an application under the preceding paragraph may not be made after the examiner's decision or the trial decision on the application for trademark registration becomes final and binding.

(3) The provisions of Articles 10(2), 10(3) and 11(5) shall apply mutatis mutandis to the conversion of an application under paragraph (1).



(Duration of right based on defensive mark registration)

Article 65-2 (1) The duration of a right based on defensive mark registration shall expire after ten years from the date of registration of the establishment of such right.

(2) The duration of a right based on defensive mark registration may be renewed by filing an application for registration of renewal; provided, however, that this shall not apply to the case where the registered defensive mark becomes unregistrable as a defensive mark pursuant to Article 64.

(Registration of renewal of duration of right based on defensive mark registration)

Article 65-3 (1) A person filing an application for registration of renewal of the duration of a right based on defensive mark registration shall submit to the Commissioner of the Patent Office an application stating the following matters:

- (i) the name and the domicile or residence of the applicant;
- (ii) the registration number of the defensive mark registration; and
- (iii) in addition to those listed in the preceding two items, matters provided by Ordinance of the Ministry of Economy, Trade and Industry.

(2) An application for registration of renewal shall be filed during the period from six months prior to the expiration of the duration of the right based on defensive mark registration to the date of expiration thereof.

(3) Where a person filing an application for registration of renewal of the duration of a right based on defensive mark registration is, due to reasons beyond his/her control, unable to file the application during the time an application for registration of renewal is permitted to be filed under the preceding paragraph, the applicant may file such an application within fourteen days (two months for residents abroad) from the date when the reason ceased to exist but not later than six months after the expiration of the said time limit.

(4) Where an application for registration of renewal of the duration of a right based on defensive mark registration is filed, the duration shall be deemed to have been renewed upon expiration of the duration (where an application is filed under the preceding paragraph, upon filing of the application); provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the application is to be refused becomes final and binding or the renewal of the duration of a right based on defensive mark registration is registered.

Article 65-4 (1) Where an application for registration of renewal of the duration of a right based on defensive mark 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 registered defensive mark pertaining to application is filed becomes unregistrable as a defensive mark pursuant to Article 64; and
- (ii) the applicant is not a person who has the right based on the defensive mark registration.

(2) Where no reasons for refusal are found in connection with an application for registration of

renewal of the duration of a right based on defensive mark registration, the examiner shall render a decision to the effect that the renewal is to be registered.

Article 65-5 The provisions of Articles 14 and 15-2 of this Act and Articles 48 (Exclusion of examiners) and 52 (Formal requirements for examination) of the Patent Act shall apply mutatis mutandis to an examination of an application for registration of renewal of the duration of a right based on defensive mark registration.

(Registration of renewal of duration of right based on defensive mark registration)

Article 65-6 (1) Where a registration fee under Article 65-7(2) is paid, the renewal of the duration of the right based on defensive mark registration shall be registered.

(2) Upon registration under the preceding paragraph, the following matters shall be published in the trademark bulletin:

- (i) the name and the domicile or residence of the person who has the right based on defensive mark registration;
- (ii) the registration number and the date of registration of renewal; and
- (iii) other necessary matters in addition to those listed in the preceding two items.

(Registration fees)

Article 65-7 (1) A person obtaining a registration of establishment of a right based on defensive mark registration shall pay as a registration fee for each defensive mark registration the amount of 66,000 yen multiplied by the number of classes.

(2) A person obtaining a registration of renewal of the duration of a right based on defensive mark registration shall pay as a registration fee for each defensive mark registration the amount of 130,000 yen multiplied by the number of classes.

(3) The provisions of paragraphs (3) to (5) of Article 40 shall apply mutatis mutandis to the preceding two paragraphs.

(Time limit for payment of registration fee)

Article 65-8 (1) A registration fee under Article 65-7(1) shall be paid within 30 days from the service of a transcript of the examiner's decision or the trial decision to the effect that a defensive mark is to be registered.

(2) A registration fee under Article 65-7(2) shall be paid within 30 days from the service of a transcript of the examiner's decision or the trial decision to the effect that the renewal of the duration of the right based on defensive mark registration is to be registered (where the service is made prior to the expiration of the duration of the right based on defensive mark registration, the date of expiration of the duration).

(3) The Commissioner of the Patent Office may extend the period of time provided in the preceding two paragraphs by a maximum of 30 days upon the request of a person who is required to pay the registration fee.

(Payment of registration fees by interested persons)

Article 65-9 (1) Any interested person may make the payment of the registration fee under Article 65-7(1) or 65-7(2) even against the intention of the person by whom the said fee is to be paid.

(2) The interested person who makes the payment of the registration fee under the preceding paragraph may request the person by whom the said payment was to be paid to reimburse the expense thereof to the extent that the said person receives actual benefits therefrom.

(Refund of registration fee paid in excess or in error)

Article 65-10 (1) A registration fee under Article 65-7(1) or 65-7(2) paid in excess or in error shall be refunded upon the request of the person that paid them.

(2) No refund of a registration fee may be requested under the preceding paragraph after the lapse of one year from the date of payment.

(Incidental nature of right based on defensive mark registration)

Article 66 (1) The right based on defensive mark registration shall become extinguished when the trademark right relating thereto is divided.

(2) When a trademark right is transferred, the right based on defensive mark registration shall be transferred with the trademark right relating thereto.

(3) When a trademark right becomes extinguished, the right based on defensive mark registration relating thereto shall become extinguished.

(4) Where a trademark right is deemed to have become extinguished under Article 20(4), the effects of the right based on defensive mark registration pertaining to the trademark right restored under Article 21(2) may not extend to the acts provided in each of the items of Article 67 committed during the period after the expiration of the time limit for the filing of an application for registration of renewal provided in Article 20(3) but before the registration of renewal of the duration of the trademark right by an application under Article 21(1).

(Acts deemed to constitute infringement)

Article 67 The following acts shall be deemed to constitute infringement of a trademark right or an exclusive right to use:

(i) the use of the registered defensive mark in connection with the designated goods or designated services;

(ii) the possession for the purpose of assignment, delivery or export of the designated goods affixed with the registered defensive mark on the goods or their packages;

(iii) the possession or importation of articles affixed with a registered defensive mark, that are used in the course of the provision of designated services by a person who receives the said services, for the purpose of the provision of the said services through use of the said articles;

(iv) the assignment, delivery, or possession or importation for the purpose of assignment or delivery of articles affixed with a registered defensive mark, that are used in the course of

- the provision of designated services by a person who receives the said services, for the purpose of causing the provision of the said services through use of the said articles;
- (v) the possession of articles indicating a registered defensive mark, for the purpose of using the registered defensive mark in connection with the designated goods or designated services;
- (vi) the assignment, delivery, or possession for the purpose of assignment or delivery, of articles indicating a registered defensive mark, for the purpose of causing the registered defensive mark to be used in connection with the designated goods or designated services;
- and
- (vii) the manufacture or importation of articles indicating a registered defensive mark, for the purpose of using the registered defensive mark or causing the registered defensive mark to be used in connection with the designated goods or designated services.

(Mutatis mutandis application of provisions concerning trademarks)

- Article 68 (1) The provisions of Articles 5, 5-2, 6(1), 6(2), 9-2 to 10, 12-2, 13(1), and 13-2 shall apply mutatis mutandis to an application for defensive mark registration. In this case, the term "(iii) the designated goods or designated services and the class of the goods or services provided by Cabinet Order as provided for in Article 6(2)" in Article 5(1) shall be deemed to be replaced with "(iii) the designated goods or designated services and the class of the goods or services provided by Cabinet Order as provided for in Article 6(2), (iv) the registration number of the trademark registration pertaining to the application for defensive mark registration," the term "(iv) the designated goods or designated services are not stated" in Article 5-2(1) shall be deemed to be replaced with "(iv) the designated goods or designated services are not stated, (v) the registration number of the trademark registration pertaining to the application for defensive mark registration is not stated" and the term "Article 37" in Article 13-2(5) shall be deemed to be replaced with "Article 67 (except the part pertaining to item (i))."
- (2) The provisions of Articles 14 to 15-2 and 16 to 17-2 shall apply mutatis mutandis to the examination of an application for defensive mark registration. In this case, the term "Articles 3, 4(1), 7-2(1), 8(2), 8(5), 51(2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2(2)), 53(2)" in Article 15(i) shall be deemed to be replaced with "Article 64."
- (3) The provisions of Article 18, 26 to 28-2, 32 to 33-3, 35 and 69 of this Act and Article 104-3 of the Patent Act as applied mutatis mutandis pursuant to Article 39 of this Act shall apply to a right based on defensive mark registration. In this case, the term "the registration fee under Article 40(1) or the registration fee due and payable within thirty days from the date of service of a transcript of the examiner's decision or a trial decision to the effect that the trademark is to be registered under Article 41-2(1)" in Article 18(2) shall be deemed to be replaced with "the registration fee under Article 65-7(1)."
- (4) The provisions of Articles 43-2 to 45, 46 (except paragraph (1)(vi)), 46-2, 53-2, 53-3, 54(1) and 55-2 to 56-2 shall apply mutatis mutandis to an opposition to registration and a trial pertaining to defensive mark registration. In this case, the term "Articles 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)" in Articles 43-2(i) and 46(1)(i) shall be deemed to be replaced with "Article 64" and the term "where ... 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)" in Article 46(1)(v) shall be deemed to be replaced with "where ... the trademark registration becomes in violation of Article 64."

- (5) The provisions of Articles 57 to 63-2 shall apply to a retrial and litigation pertaining to defensive mark registration. In this case, the term "each of the items in Article 37" in Article 59(ii) shall be deemed to be replaced with "items (ii) to (vii) of Article 67," the term "a trademark right pertaining to ... trademark registration" in Article 60 shall be deemed to be replaced with "a right based on defensive mark registration in connection with ... defensive mark registration," the term "an application for trademark registration" in the same article shall be deemed to be replaced with "an application for the registration of a defensive mark or an application for the registration of a defensive mark or an application for registration of renewal of the duration of a right based on defensive mark registration," the term "the establishment of a trademark right ... has been registered" in the same article shall be deemed to be replaced with "the establishment of a right based on defensive mark registration or the renewal of the duration of a right based on defensive mark registration ... has been registered" and the term "the registered trademark or a trademark similar thereto ... in connection with the designated goods or designated services or in connection with goods or services similar thereto" in the same article shall be deemed to be replaced with "a trademark identical with the registered defensive mark."

## **CHAPTER 7-2 SPECIAL PROVISIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT**

### **Section 1 Application for international registration**

(Application for international registration)

Article 68-2 (1) A Japanese national or a foreign national domiciled or resident (or, in the case of a juridical person, with a place of business) in Japan who desires to obtain an international registration (hereinafter referred to as an "application for international registration") provided in Article 2(1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on June 27, 1989 (hereinafter referred to as the "Protocol") shall file with the Commissioner of the Patent Office an application (hereinafter referred to as an "application for international registration") pursuant to Article 2(2) of the Protocol based on any of the following items; in this case, where requirements provided by Ordinance of the Ministry of Economy, Trade and Industry are applicable, two or more persons may jointly file the application for international registration:

- (i) the application for trademark registration or application for defensive mark registration of the applicant that is pending before the Patent Office (hereinafter referred to as the "application for trademark registration, etc."); or

- (ii) the trademark registration or defensive mark registration of the applicant (hereinafter referred to as the "trademark registration, etc.").
- (2) Any person who desires to file an application for international registration shall submit the prescribed application and required documents in foreign language pursuant to Ordinance of the Ministry of Economy, Trade and Industry.
- (3) The application shall state the following matters:
  - (i) the name(s) of the Contracting Party to the Protocol in which the protection of the trademark pertaining to the application for international registration is sought; and
  - (ii) the goods or services in connection with which the protection of the trademark pertaining to the application for international registration is sought and the class of the goods and services provided by Cabinet Order in Article 6(2).
- (4) Any person who desires to apply Article 3(3) of the Protocol in connection with a trademark or a mark pertaining to the application for international registration shall state in the application a statement indicating thereof and the color or the combination of colors claimed and append to the application copies of the trademark or mark pertaining to the application for trademark registration, etc., in color, or of the registered trademark or registered defensive mark in color.

Article 68-3 (1) The Commissioner of the Patent Office shall send the application for international registration and the required documents to the International Bureau provided in Article 2(1) of the Protocol (hereinafter referred to as the "International Bureau").

- (2) In the case of the preceding paragraph, where the matters stated in the application correspond to the matters stated in the basic application for trademark registration, etc. or in the basic trademark registration, etc., the Commissioner of the Patent Office shall state in the application the fact thereof and the date of receipt of the application for international registration.
- (3) In the case of paragraph (1), the Commissioner of the Patent Office shall send to the applicant of the application for international registration a copy of the application for international registration sent to the International Bureau.

(Subsequent designation)

Article 68-4 The registered holder of international registration may present to the Commissioner of the Patent Office, pursuant to Ordinance of the Ministry of Economy, Trade and Industry, a request for territorial extension provided in Article 3ter of the Protocol (hereinafter referred to as "territorial extension") subsequent to the international registration (hereinafter referred to as the "subsequent designation.")

(Application for renewal of the duration of international registration)

Article 68-5 The registered holder of international registration may file with the Commissioner of the Patent Office, pursuant to Ordinance of the Ministry of Economy, Trade and Industry, an application for renewal of the duration of international registration provided in Article 7(1)

of the Protocol (hereinafter referred to as "renewal of the duration of international registration").

(Request for recording of change in the ownership of international registration)

Article 68-6 (1) The registered holder or transferee of international registration may, pursuant to Ordinance of the Ministry of Economy, Trade and Industry, present to the Commissioner of the Patent Office a request for the recording of a change in the ownership of an international registration, as provided in Article 9 of the Protocol (hereinafter referred to as "change in the ownership of international registration").

(2) The request provided in the preceding paragraph may be made for each of the goods or services listed in the international registration or for each of the Contracting Parties in which the international registration has effect.

(Mutatis mutandis application of provisions concerning application for trademark registration)

Article 68-7 Article 17(3) (limited to the part pertaining to item (iii)) and Article 18(1) of the Patent Act as applied mutatis mutandis pursuant to Article 77(2) of this Act, shall apply mutatis mutandis to the application for international registration, subsequent designation, an application for the renewal of the duration of international registration and a request for the recording of a change in the ownership of international registration.

(Delegation to Ordinance of the Ministry of Economy, Trade and Industry)

Article 68-8 In addition to the provisions of Articles 68-2 to 68-7, details of matters relating to the application for international registration, subsequent designation, an application for renewal of the duration of international registration and a request for the recording of a change in the ownership of international registration required for the implementation of the Protocol and the regulations thereunder shall be provided by Ordinance of the Ministry of Economy, Trade and Industry.

## **Section 2 Special Provisions pertaining to International Application for Trademark Registration**

(Application for trademark registration based on request for territorial extension)

Article 68-9 (1) Any request for territorial extension to designate Japan shall be deemed to be an application for trademark registration filed on the date of international registration provided in Article 3(4) of the Protocol (hereinafter referred to as the "date of international registration"); provided, however, that in the case of subsequent designation, such request shall be deemed to be an application for trademark registration filed on the date on which the subsequent designation pertaining to the international registration pursuant to Article 3ter(2) of the Protocol (hereinafter referred to as the "date of subsequent designation") is recorded in the International Register of the International Bureau provided in Article 2(1) (hereinafter referred to as the "International Register").

(2) Matters stated in the left column of the following table contained in the International Register pertaining to the international registration designating Japan shall be deemed to be the matters stated in the right column of the said table contained in the application submitted pursuant to Article 5(1).

The name and the domicile or residence of the registered holder of international registration	The name and the domicile or residence of the applicant for trademark registration
The trademark subject to international registration	The trademark for which registration is sought
The goods or services listed in the international registration and the class of the goods or services	The designated goods or designated services and the class of the goods or services provided by Cabinet Order as provided for in Article 6(2);

(Special provisions concerning time of filing of international application for trademark registration)

Article 68-10 (1) Where a registered trademark (hereinafter in this article referred to as a "registered trademark based on international registration") pertaining to the request for territorial extension which is deemed to have been an application for trademark registration pursuant to Article 68-9(1) (hereinafter in this chapter referred to as an "international application for trademark registration") is identical with the registered trademark prior to the trademark registration (except registered trademarks based on international registration, hereinafter referred to in this article as a "registered trademark based on national registration") and the designated goods or designated services pertaining to the registered trademark based on international registration overlap with the designated goods or designated services based on national registration, and further the holder of trademark right of the registered trademark based on international registration is identical with the holder of trademark right of the registered trademark based on national registration, the international application for trademark registration shall be deemed to have been filed on the date of filing of the application for trademark registration pertaining to the registered trademark based on national registration to the extent of the scope which is overlapping.

(2) The provisions of paragraphs (3) and (4) of Article 68-32 shall apply mutatis mutandis to the international application for trademark registration under the preceding paragraph.

(Special provisions concerning time of filing of application)

Article 68-11 For the purpose of application of Article 9(2) to an international application for trademark registration, the term "at the time of filing of the application for trademark registration" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

(Special provisions concerning division of application)



Article 68-12 Article 10 shall not apply to an international application for trademark registration.

(Special provisions concerning conversion of application)

Article 68-13 Articles 11 and 65 shall not apply to an international application for trademark registration.

(Special provisions concerning matters to be contained in the trademark bulletin pertaining to laying open of application)

Article 68-14 For the purpose of application of Article 12-2(2) to the international application for trademark registration, the term "the number and date of the application for trademark registration" in item (ii) of the said paragraph shall be replaced with "the number and the date of the international registration (in the case of the international application for trademark registration pertaining to the subsequent designation, the date of subsequent designation)."

(Special provisions concerning proceedings for priority claim governed by the Paris Convention, etc.)

Article 68-15 (1) The provisions of paragraphs (1) to (4) of Article 43 of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13(1) of this Act shall not apply to an international application for trademark registration.

(2) For the purpose of application of Article 43(1) of the Patent Act as applied mutatis mutandis pursuant to Article 43-2(3) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13(1) of this Act to the international application for trademark registration, the portion "at the time of filing of the patent application" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

(Special provisions concerning the right deriving from application for trademark registration)

Article 68-16 (1) For the purpose of application of Article 34(4) of the Patent Act as applied mutatis mutandis pursuant to Article 13(2) of this Act to the international application for trademark registration, the portion ", except in the case of general succession including inheritance, without the Commissioner of the Patent Office." in the said paragraph shall be replaced with "without notification to the International Bureau."

(2) The provisions of paragraphs (5) to (7) of Article 34 of the Patent Act as applied mutatis mutandis pursuant to Article 13(2) of this Act shall not apply to an international application for trademark registration.

(Treatment of international application for trademark registration in the case of change in the ownership of international registration)

Article 68-17 Where all or some of the goods or services listed in the international registration

are divided and transferred as a result of a change in the ownership of international registration, the international application for trademark registration shall be deemed to have become applications for trademark registration with respect to each of the registered holders after the change.

(Special provisions concerning new application for trademark as amended)

Article 68-18 (1) Article 17-3 of the Design Act as applied mutatis mutandis pursuant to Article 17-2(1) or 55-2(3) (including cases where it is applied mutatis mutandis pursuant to Article 60-2(2)) of this Act shall not apply to an international application for trademark registration.  
(2) Article 17-4 of the Design Act as applied mutatis mutandis pursuant to Article 17-2(2) of this Act shall not apply to an international application for trademark registration.

(Special provisions concerning registration of establishment of trademark right)

Article 68-19 (1) For the purpose of application of Article 18(2) to the international application for trademark registration, the term "where the registration fee under Article 40(1) or the registration fee due and payable within thirty days from the date of service of a transcript of an examiner's decision or a trial decision to the effect that the trademark is to be registered under Article 41-2(1) is paid" in the said paragraph shall be replaced with "where the communication is made by the International Bureau notifying that the payment of the individual fee in the amount prescribed in Article 68-30(1)(ii) has been recorded in the International Register."  
(2) For the purpose of application of Article 18(3) to the international application for trademark registration, in item (ii) of the said paragraph the portion "the number and date of the application for trademark registration" shall be replaced with "the number and the date of international registration (in the case of the international application for trademark registration pertaining to the subsequent designation, the date of subsequent designation)" and in item (v) of the said paragraph the portion "the registration number and the date of registration of establishment" shall be replaced with "the number of international registration and the date of registration of the establishment."

(Effect of the lapse of international registration)

Article 68-20 (1) Where all or a portion of the international registration on which the international application for trademark registration is based has lapsed, the international application for trademark registration shall be deemed to have been withdrawn in respect of all or the portion of the designated goods or designated services that have lapsed.  
(2) Where all or a portion of the international registration on which the international registration is based has lapsed, the trademark right based on such international registration the establishment of which has been registered under Article 18(2) as applied upon reading the specified terms in accordance with Article 68-19(1) (hereinafter referred to as the "trademark right based on international registration") shall be deemed to have lapsed in respect of all or the portion of the designated goods or designated services that have lapsed.

(3) The preceding two paragraphs shall take effect as of the date the international registration lapses in the International Register.

(Duration of trademark right based on international registration)

Article 68-21 (1) The duration of a trademark right based on international registration shall expire after ten years from the date of the international registration (where the duration of the international registration has been renewed prior to the registration of the establishment of the trademark right, the date of most recent renewal).

(2) The duration of a trademark right based on international registration may be renewed based on the renewal of the duration of the international registration.

(3) Where the duration of international registration is renewed, the duration of the trademark right based on international registration shall be renewed at the time of expiration of the duration.

(4) Where the duration of international registration is not renewed, the trademark right based on international registration shall be deemed to have extinguished retroactively at the time of expiration of the duration.

(Special provisions concerning registration of renewal of duration)

Article 68-22 (1) Articles 19 to 22, 23(1) and 23(2) shall not apply to a trademark right based on international registration.

(2) For the purpose of application of Article 23(3) relating to a trademark right based on international registration, the portion "registration as set forth under the preceding two paragraphs" in the said paragraph shall be replaced with "renewal of the duration of international registration" and the portion "the registration number and the date of registration of renewal" in item (ii) of the said paragraph shall be replaced with "the number of international registration and the date of renewal of the duration of international registration."

(Special provisions concerning division of trademark right)

Article 68-23 Article 24 shall not apply to a trademark right based on international registration.

(Special provisions pertaining to transfer of collective trademark right)

Article 68-24 (1) A collective trademark right based on international registration may not be transferred, unless the document provided in Article 7(3) is submitted.

(2) Article 24-3 shall not apply to a trademark right based on international registration.

(Special provisions concerning waiver of trademark right)

Article 68-25 (1) The holder of trademark right based on international registration may abandon the trademark right.

(2) Article 97(1) of the Patent Act as applied mutatis mutandis pursuant to Article 35 of this Act shall not apply to a trademark right based on international registration.

(Special provisions concerning effects of registration of trademark right)

- Article 68-26 (1) A transfer, extinguishment by waiver or restriction on disposition of a trademark right based on international registration shall have no effect unless registered.
- (2) Articles 98(1)(i) and 98(2) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 35 of this Act shall not apply to a trademark right based on international registration.

(Special provisions concerning registration in the Trademark Registry)

- Article 68-27 (1) For the purpose of application of Article 71(1)(i) to a trademark right based on international registration, the term "the establishment, renewal of the duration, division, transfer, modification, extinction, restoration or restriction on disposition of a trademark right" in the said item shall be replaced with "the establishment or restriction on disposition of a trademark right."
- (2) The renewal of the duration, the transfer, the modification or the extinction of a trademark right based on international registration shall have effect in accordance with that registration in the International Register.

(Special provisions concerning amendment of proceedings)

- Article 68-28 (1) Any amendment to the designated goods or designated services stated in the international application for trademark registration may be made only within the time limit designated in Article 15-2 (including cases where it is applied mutatis mutandis pursuant to Article 55-2(1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2(2))) or Article 15-3 (including cases where it is applied mutatis mutandis pursuant to Article 55-2(1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2(2))).
- (2) Article 68-40 shall not apply to an international application for trademark registration.

(Extra provisions relating to special provisions on trademark right covering two or more designated goods or designated services)

- Article 68-29 For the purpose of the application of Article 69 relating to a trademark right based on international registration, the portion "20(4) or 33(1) of this Act, Article 97(1) or 98(1)(i) of the Patent Act as applied mutatis mutandis pursuant to Article 35 of this Act" in Article 69 shall be replaced with "33(1), 68-25(1) or 68-26(1)" and the term "Article 71(1)(i)" in Article 69 shall be replaced with "71(1)(i) as applied mutatis mutandis upon reading the specified terms in accordance with Article 68-27(1), 68-27(2)."

(Individual fee for trademark right based on international registration)

- Article 68-30 (1) Any person who desires to obtain a registration of establishment of a trademark right based on international registration shall pay to the International Bureau, as the individual fee provided in Article 8(7)(a) of the Protocol (hereinafter referred to as the "individual fee") for each registration in the following amounts:

- (i) the amount equivalent to 4,800 yen plus 15,000 yen for each class of the goods and services; and
  - (ii) the amount equivalent to 66,000 yen multiplied by the number of classes of the goods and services.
- (2) The individual fee in the amount prescribed in item (i) of the preceding paragraph shall be paid prior to the international registration and the individual fee in the amount prescribed in item (ii) thereof shall be paid within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry.
- (3) Where an examiner's decision or a trial decision is rendered to the effect that a trademark pertaining to an international application for trademark registration is to be registered, the Commissioner of the Patent Office shall notify the International Bureau of the time limit for the payment of the individual fee pertaining to the application, in the amount prescribed in item (ii) of paragraph (1).
- (4) Where the individual fee in the amount prescribed in items (ii) of paragraph (1) is not paid, and as a result the international registration on which the international application for trademark registration is based is rescinded, the said application shall be deemed to have been withdrawn.
- (5) A person requesting the renewal of the duration of a trademark right based on international registration shall pay as the individual fee to the International Bureau for each registration the amount equivalent to 151,000 yen multiplied by the number of classes.
- (6) Articles 40 to 43 and 76(2) (limited to the portion listed under item (i) of the appended table) shall not apply to an application for international trademark registration and a trademark right based on the international registration.

(Delegation to Ordinance of the Ministry of Economy, Trade and Industry)

Article 68-31 In addition to the provisions of Articles 68-9 to 68-30, details of matters required for the implementation of the Protocol and the regulations thereunder shall be provided by Ordinance of the Ministry of Economy, Trade and Industry.

### **SECTION 3 SPECIAL PROVISIONS CONCERNING APPLICATION FOR TRADEMARK REGISTRATION, ETC.**

(Special provisions concerning application for trademark registration after rescission of international registration)

Article 68-32 (1) Where an international registration relating to a trademark that was the subject of an international registration designating Japan is rescinded pursuant to Article 6(4) of the Protocol in respect of all or some of the goods or services listed in the international registration, the person who was the registered holder of the international registration may file an application for trademark registration in relation to all or some of the said goods or services.

- (2) Where an application for trademark registration under the preceding paragraph falls under all

of the following items, the application shall be deemed to have been filed on the date of international registration (where the international registration under the said paragraph is related to the subsequent designation, the date of the subsequent designation pertaining to the said international registration) of the international registration under the said paragraph.

- (i) the application for trademark registration under the preceding paragraph is filed within three months from the date on which the international registration under the said paragraph was rescinded;
  - (ii) the trademark for which the registration is sought is identical with the trademark that was the subject of the international registration under the preceding paragraph; and
  - (iii) the designated goods or designated services in connection with the application for trademark registration under the preceding paragraph are within the scope of the goods or services listed in the international registration under the preceding paragraph.
- (3) Where an international application for trademark registration pertaining to an international registration under paragraph (1) enjoyed a right of priority pursuant to Article 4 of the Paris Convention, the application for trademark registration under the said paragraph shall also enjoy the same right of priority.
- (4) The preceding paragraph shall also apply to the case where an international application for trademark registration pertaining to an international registration under paragraph (1) enjoyed a right of priority pursuant to Article 43-2(2) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 9-3 or 13(1) of this Act.
- (5) For the purpose of the application of Article 10(1) to an application for trademark registration under paragraph (1), the portion of the said paragraph "part of an application" shall be replaced with "part of an application(limited to the goods or services that fall under the scope of those listed in the international registration under Article 68-32(1))."

(Special provisions concerning application for trademark registration after denunciation of Protocol)

Article 68-33 (1) Where, pursuant to Article 15(5)(b) of the Protocol, the registered holder of the international registration designating Japan becomes no longer entitled as a person eligible to file the international application pursuant to Article 2(1) of the Protocol, the person who was the registered holder of the said international registration may file an application for trademark registration in connection with the goods or services listed in the said international registration.

- (2) The provisions of paragraphs (2) to (5) of Article 68-32 shall apply mutatis mutandis to an application for trademark registration under paragraph (1). In this case, the portion "within three months from the date on which the international registration under the said paragraph was rescinded" in item (i) of Article 68-32(2) shall be deemed to be replaced with "within two years from the date on which the denunciation under Article 15(3) of the Protocol took effect."

(Special provisions concerning reasons for refusal)

Article 68-34 (1) For the purpose of the application of Article 15 to an application for trademark registration pursuant to Article 68-32(1) or 68-33(1), the portion "falls under any of the following items" in Article 15 shall be replaced with "falls under any of the following items or where an application for trademark registration under Article 68-32(1) or 68-33(1) does not comply with the requirements provided in Article 68-32(1), 68-33(1) or each item of 68-32(2) (including cases where applied mutatis mutandis upon reading the specified terms in accordance with Article 68-33(2))."

(2) The provision of Article 15 (limited to the part pertaining to item (i) and (ii)) shall not apply to an application for trademark registration under Article 68-32(1) or 68-33(1) pertaining to a trademark right that was related to the international registration (referred to in Article 68-37 and 68-39 as "re-filing of trademark right pertaining to former international registration").

(Special provisions concerning registration of establishment of trademark right)

Article 68-35 Notwithstanding Article 18(2), where, in connection with an application for trademark registration under Article 68-32(1) or 68-33(1), the examiner's decision or the trial decision to the effect that the trademark is to be registered has been rendered within ten years from the date of international registration of the international registration pertaining to the said application (where the duration of the international registration has been renewed, the date of most renewal) and the individual fee in the amount prescribed in Article 68-30(1)(ii) has been paid to the International Bureau prior to the date on which the international registration pertaining to the said application is rescinded pursuant to Article 6(4) of the Protocol or to the date on which the denunciation under Article 15(3) of the Protocol takes effect, the establishment of the trademark right shall be registered.

(Special provisions concerning duration)

Article 68-36 (1) The duration of a trademark right provided in Article 68-35 shall expire after ten years from the date of the international registration of the international registration pertaining to the said application (where the duration of the international registration has been renewed, the date of most recent renewal).

(2) Article 19(1) shall not apply to the duration of a trademark right provided in the preceding paragraph.

(Special provisions concerning opposition to registration)

Article 68-37 For the purpose of application of Article 43-2 to a trademark registration pertaining to the re-filing of a trademark right pertaining to a former international registration, the term "trademark registration" in the said article shall be replaced with "trademark registration (in the case of a trademark registration pertaining to the re-filing of a trademark right pertaining to a former international registration, except any trademark registration for which the term provided in this Article has lapsed without any opposition to registration of the former trademark registration pertaining to the former international registration)."

(Special provisions concerning trial for invalidation of trademark registration)

Article 68-38 For the purpose of the trial prescribed in Article 46(1) for the trademark registration pertaining to an application for trademark registration under Article 68-32(1) or 68-33(1), the term "falls under any of the following items" in the said paragraph shall be replaced with "falls under any of the following items or has been made in violation of the provision of Article 68-32(1), 68-33(1) or each item of Article 68-32(2) (including cases where applied mutatis mutandis upon reading the specified terms in accordance with Article 68-33(2))."

Article 68-39 For the purpose of the application of Article 47 to a trademark registration pertaining to the re-filing of a trademark right pertaining to a former international registration, the portion "may not be filed" in the said article shall be replaced with "may not be filed. The same shall also apply, in relation to the trademark registration pertaining to the re-filing of the trademark right pertaining to former international registration, even prior to a lapse of five years from the date of registration of the establishment of the trademark right, when a request for trial under Article 46(1) can be no longer filed pursuant to this article pertaining to the trademark registration pertaining to the former international registration."

## **CHAPTER 8 MISCELLANEOUS PROVISIONS**

(Amendment of proceedings)

Article 68-40 (1) The person undertaking a procedure before the Patent Office with regard to an application for trademark registration, an application for defensive mark registration, any requests or any other procedures relating to trademark registration or defensive mark registration, may make amendments relating thereto only when the case is pending in examination, examination on opposition to registration, trial or retrial.

(2) Notwithstanding the preceding paragraph, a person who has applied for trademark registration may, at the time of payment of the registration fee under Article 40(1) or 41-2(1), make amendments to reduce the number of classes pertaining to the application for trademark registration.

(Special provisions on trademark right covering two or more designated goods or designated services)

Article 69 For the purpose of the application of Article 13-2(4) (including where it is applied mutatis mutandis pursuant to Article 68(1)), 20(4) and 33(1) of this Act, Article 97(1) or 98(1)(i) of the Patent Act as applied mutatis mutandis pursuant to Article 35 of this Act, Article 43-3(3), 46(2), 46-2 or 54 of this Act, Article 132(1) of the Patent Act as respectively applied mutatis mutandis pursuant to Article 56(1) of this Act or Article 174(2) of the Patent Act as applied mutatis mutandis pursuant to Article 61 of this Act, Article 59, 60, 71(1)(i) or 75(2)(iv) of this Act, to the trademark registration or trademark right covering two or more designated goods or designated services, the trademark shall be deemed to have been



registered or the trademark right shall be deemed to exist, for each of the designated goods or designated services.

(Special provisions on trademarks, etc., similar to registered trademarks)

- Article 70 (1) The term "registered trademark" as used in Article 25, 29, 30(2), 31(2), 31-2(1), 34(1), 38(3), 50, 52-2(1), 59(i), 64, 73 or 74 shall include trademarks similar to the registered trademark that would be regarded as being identical with the registered trademark if they were in the same color(s) as the registered trademark.
- (2) The term "registered defensive mark" as used in Article 4(1)(xii) or 67 shall include marks similar to the registered defensive mark that would be regarded as being identical with the registered defensive mark if they were in the same color(s) as the registered defensive trademark.
- (3) The term "trademark similar to the registered trademark" as used in Article 37(i) or 51(1) shall not include any trademark similar to the registered trademark that would be regarded as being identical with the registered trademark if they were in the same color(s) as the registered trademark.

(Registration in Trademark Registry)

- Article 71 (1) The following matters shall be registered in the Trademark Registry maintained in the Patent Office:
- (i) the establishment, renewal of the duration, division, transfer, modification, extinguishment, restoration or restriction on disposition of a trademark right;
  - (ii) the establishment, renewal of the duration, transfer or extinguishment of right based on defensive mark registration;
  - (iii) the establishment, maintenance, transfer, modification, extinguishment or restriction on disposition of exclusive right to use or non-exclusive right to use; and
  - (iv) the establishment, transfer, modification, extinguishment or restriction on disposition of a right of pledge on a trademark right, exclusive right to use or non-exclusive right to use.
- (2) The Trademark Registry may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media using a similar method that may record or reliably store certain matters; the same shall apply hereinafter).
- (3) In addition to those provided in this act, matters relating to the registration shall be provided by Cabinet Order.

(Issuance of certificate of trademark registration, etc.)

- Article 71-2 (1) Upon registration of the establishment of a trademark right or upon registration of the establishment of rights based on defensive mark registration, the Commissioner of the Patent Office shall issue a certificate of trademark registration or defensive mark registration to the holder of trademark right.
- (2) The re-issuance of a certificate of trademark registration or defensive mark registration shall be provided by Ordinance of the Ministry of Economy, Trade and Industry.

(Request for certificate, etc.)

Article 72 (1) Any person may file a request with regard to trademark registration or defensive mark registration to the Commissioner of the Patent Office to issue a certificate, a transcript of documents or an extract of documents, to allow the inspection or copying of documents, or to issue documents stored on the magnetic tapes that constitute a part of the Trademark Registry; provided, however, that if the Commissioner of the Patent Office considers it necessary to keep such documents confidential, this provision shall not apply in the case of the following documents:

- (i) documents pertaining to a trial under Article 46(1) (including cases where it is applied *mutatis mutandis* pursuant to Article 68(4)), 50(1), 51(1), 52-2(1), 53(1) or 53-2 (including cases where it is applied *mutatis mutandis* pursuant to Article 68(4)) or a retrial of the final and binding trial decision rendered in the said trial, with respect to which the party in the case or an intervener has given notice that a trade secret owned by the said party in the case or intervener has been described (trade secret as provided in Section 2(6) of the Unfair Competition Prevention Act (Act No. 47 of 1993));
  - (ii) documents which are likely to cause damage to an individual's reputation or peaceful existence; and
  - (iii) documents which are likely to cause damage to public policy.
- (2) Where the Commissioner of the Patent Office approves of the request under the main clause of the preceding paragraph with regard to the documents as provided in item (i) or (ii) of the said paragraph, the Commissioner of the Patent Office shall notify the person who submitted the said documents thereof and reasons therefor.
- (3) Provisions of the Act Concerning Access to Information Held by Administrative Organs (Act No. 42 of 1999) shall not apply to the documents concerning trademark registration or defensive mark registration and the part of the Trademark Registry stored on magnetic tapes.
- (4) Provisions in Chapter 4 of the Act Concerning Protection of Personal Information Possessed by Administrative Organs (Act No. 58 of 2003) shall not apply to the possessed Personal Information (referring to the possessed Personal Information as provided in Article 2(3) of the said Act) recorded in the documents concerning trademark registration or defensive mark registration and the part of the Trademark Registry stored on magnetic tapes.

(Indication of trademark registration)

Article 73 Where the holder of trademark right, exclusive right to use or non-exclusive right to use affixes the registered trademark to the designated goods, packages of the designated goods or articles to be used for the provision of the designated services, or affixes, in the provision of the designated services, the registered trademark to the goods pertaining to the provision of the designated services that belong to the person receiving the designated services pursuant to the provisions of Ordinance of the Ministry of Economy, Trade and Industry, he/she shall make efforts to affix to the trademark an indication (hereinafter referred to as an "indication of trademark registration") stating that the trademark is a registered trademark.

(Prohibition of false indication)

Article 74 It shall be prohibited for a person to do the following acts:

- (i) in using a trademark that is not a registered trademark, to affix an indication of trademark registration or an indication confusing therewith to the trademark;
- (ii) in using a registered trademark for goods or services that are not the designated goods or designated services, to affix an indication of trademark registration or an indication confusing therewith to the trademark;
- (iii) the possession, for the purpose of assignment or delivery, of articles affixed on goods or on their packages, a trademark other than a registered trademark, articles affixed on goods other than the designated goods, or on their packages, a registered trademark in connection with goods, or articles affixed on goods or on their packages, a registered trademark in connection with services, where the indication of trademark registration or an indication confusing therewith is affixed to the said trademark;
- (iv) the possession or importation of articles affixed with a trademark other than a registered trademark, that are used in the course of the provision of services by a person who receives the said services, articles affixed with a registered trademark in connection with services, that are used in the course of the provision of services other than the designated services by a person who receives the said services, or articles affixed with a registered trademark in connection with goods, that are used in the course of the provision of services by a person who receives the said services, where the indication of trademark registration or an indication confusing therewith is affixed to the said trademark (hereinafter referred to in the following item as "articles with a false indication of trademark registration pertaining to services"), for the purpose of the provision of the said services through use of the said articles; and
- (v) the assignment, delivery, or possession or importation for the purpose of assignment or delivery of articles with a false indication of trademark registration pertaining to services, for the purpose of causing the provision of the said services through use of the said articles;

(Trademark Gazette)

Article 75 (1) The Patent Office shall publish the trademark gazette

(2) In addition to those matters provided in this Act, the trademark gazette shall contain the following matters:

- (i) examiner's decisions to the effect that an application is to be refused, or the waiver, withdrawal or dismissal of applications for trademark registration or applications for defensive mark registration after laying open of application;
- (ii) succession of right deriving from an application for trademark registration after laying open of application;
- (iii) amendments made to the designated goods or designated services stated in an application, to the trademark for which the registration is sought, or to the mark for which the defensive mark registration is sought after laying open of application;

- (iv) extinguishments of trademark rights (except due to the expiration of the duration and the provision of Article 41-2(4));
- (v) filing of an opposition to registration or request a trial or a retrial, or withdrawal thereof;
- (vi) final and binding decisions on the opposition to registration, final and binding trial decisions or the final and binding decision or trial decision on retrial; and
- (vii) final and binding judgments in actions under Article 63(1).

(Fees)

Article 76 (1) Fees shall be paid by the following persons in an amount to be provided by Cabinet Order in view of the actual costs:

- (i) persons notifying of succession under Article 34(4) of the Patent Act as applied mutatis mutandis pursuant to Article 13(2) of this Act;
  - (ii) persons filing a request for an extension of the term under Article 17-4 of the Design Act as applied mutatis mutandis pursuant to Article 17-2(2) (including cases where it is applied mutatis mutandis pursuant to Article 68(2)) of this Act, Article 41(2) (including cases where it is applied mutatis mutandis pursuant to Article 41-2(6)) or 43-4(3) (including cases where it is applied mutatis mutandis under Article 68(4)) of this Act, Article 65-8(3) or Article 4 or 5(1) of the Patent Act as applied mutatis mutandis pursuant to 77(1) of this Act, or a change of the date under Article 5(2) of the Patent Act as applied mutatis mutandis pursuant to Article 77(1) of this Act.
  - (iii) persons filing an application for international registration to the Commissioner of the Patent Office pursuant to Article 68-2;
  - (iv) persons presenting to the Commissioner of the Patent Office a request for subsequent designation pursuant to Article 68-4;
  - (v) persons filing an application for renewal of the duration of international registration to the Commissioner of the Patent Office pursuant to Article 68-5;
  - (vi) persons filing a request to the Commissioner of the Patent Office for the recording of a change in the ownership of international registration pursuant to Article 68-6;
  - (vii) persons filing a request for the re-issuance of a certificate of trademark registration or defensive mark registration;
  - (viii) persons filing a request for the issuance of a certificate pursuant to Article 72(1);
  - (ix) persons filing a request for the issuance of a transcript of documents or an extract of documents pursuant to Article 72(1);
  - (x) persons filing a request to allow the inspection or copying of documents pursuant to Article 72(1); and
  - (xi) persons filing a request for the issuance of documents whose contents are stored on magnetic tapes that constitute part of the Trademark Registry pursuant to Article 72(1).
- (2) The persons listed in the center column of the attached table shall pay fees in the amount as provided by Cabinet Order within the range of the amounts specified in the corresponding right-hand column of the table.
- (3) The preceding two paragraphs shall not apply where the person to pay the fee in accordance

with these paragraphs is the State.

- (4) Where the State has co-ownership of a trademark right, a right deriving from an application for trademark registration or a right based on an application for defensive mark registration with a person other than the State, and the portion of their respective shares of the said right has been agreed, notwithstanding the provisions of paragraph (1) or (2), the fees payable thereunder (limited to those provided by Cabinet Order) shall be determined as the sum of the provided fees multiplied by the ratios of the share of each person other than the State, and, the person(s) other than the State shall pay such sum.
- (5) Where the amount of the fees calculated under the preceding paragraph has a fractional figure of less than ten yen, the said portion shall be discarded.
- (6) The payment of the fees under paragraph (1) or (2) shall be made by patent revenue stamps as provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.
- (7) Fees paid in excess or in error shall be refunded upon the request of the person who made payment thereof.
- (8) No request for a refund of the fees under the preceding paragraph may be filed after one year from the date on which the payment thereof has been made.

(Mutatis mutandis application of Patent Act)

- Article 77 (1) The provisions of Articles 3 to 5 (time periods and dates) of the Patent Act shall apply mutatis mutandis to time periods and dates provided in this Act. In this case, the term "Article 121(1)" of Article 4 of the Patent Act shall be deemed to be replaced with "Article 44(1) or 45(1) of the Trademark Act."
- (2) Articles 6 to 9, 11 to 16, 17(3) and 17(4), 18 to 24 and 194 (procedures) of the Patent Act shall apply mutatis mutandis to an application for trademark registration, an application for defensive mark registration, any petitions or any other procedures pertaining to trademark registration or defensive mark registration. In this case, the portion "file a request for the examination of an application" in Article 6(1)(i) of the Patent Act shall be deemed to be replaced with "file an opposition to registration," the portion "an adverse party files a petition for a trial or retrial" in Article 7(4) of the Patent Act shall be deemed to be replaced with "an opposition to registration in relation to the trademark right or the right based on defensive mark registration is filed or a trial or retrial is filed by an adverse party," the portion "trial against an examiner's decision of refusal" in Article 9 of the Patent Act shall be deemed to be replaced with "trial under Article 44(1) or 45(1) of the Trademark Act," the portion "trial against an examiner's decision of refusal" in Article 14 of the Patent Act shall be deemed to be replaced with "trial under Article 44(1) or 45(1) of the Trademark Act," the portion "(ii) where the procedures do not comply with the formal requirements provided by this Act or an order thereunder" in Article 17(3) of the Patent Act shall be deemed to be replaced with "(ii) where the procedures do not comply with the formal requirements provided by this Act or an order thereunder; (ii)-2 where, pertaining to the procedures, the registration fee under Article

40(2) of the Trademark Act or the registration fee (including the registration surcharge due and payable pursuant to Article 43(1) or 43(2) of the Trademark Act) payable at the time of application for registration of renewal pursuant to Article 41-2(2) of the Trademark Act is not paid," the portion "not amendable" in Article 18-2(1) of the Patent Act shall be deemed to be replaced with "not amendable (except cases filing under any of the items in Article 5-2(1) of the Trademark Act (including cases where it is applied mutatis mutandis pursuant to Article 68(1) of the Trademark Act)), " the term "trial" in Article 23(1) and 24 of the Patent Act shall be deemed to be replaced with "examination and decision on an opposition to registration, trial" and the term "trial" in Article 194(1) of the Patent Act shall be deemed to be replaced with "opposition to registration, trial."

- (3) The provision of Article 25 (Enjoyment of rights by foreign nationals) of the Patent Act shall apply mutatis mutandis to a trademark right and other rights relating to the trademark registration.
- (4) Article 26 (Effect of treaties) of the Patent Act shall apply mutatis mutandis to the trademark registration and defensive mark registration.
- (5) The provisions of Articles 189 to 192 (Service) of the Patent Act shall apply mutatis mutandis to service provided in this Act.
- (6) Article 195-3 of the Patent Act shall apply mutatis mutandis to dispositions under this Act or under an order based on this Act.
- (7) Article 195-4 (Restriction on appeals under Administrative Appeal Act) of the Patent Act shall apply mutatis mutandis to an examiner's decision, a ruling to dismiss an amendment, a rescission decision, a trial decision, a ruling to dismiss a written opposition, a ruling to dismiss a written request for a trial or retrial under this Act and to a disposition against which no appeal lies in accordance with this act.

(Transitional measures)

Article 77-2 Where an order is established, revised or abolished pursuant to this Act, transitional measures (including transitional measures relating to penal provisions) to the extent deemed reasonably necessary for the establishment, revision or abolishment may be provided by the said order.

## **CHAPTER 9 PENAL PROVISIONS**

(Crime of infringement)

Article 78 An infringer of a trademark right or an exclusive right to use (excluding one who has committed an act that shall be deemed to constitute infringement of a trademark right or an exclusive right to use under Article 37 or Article 67) shall be punished by imprisonment with work for a term not exceeding ten years or a fine not exceeding 10,000,000 yen or combination thereof.

Article 78-2 Any person who has committed an act that shall be deemed to constitute

infringement of a trademark right or an exclusive right to use under Article 37 or Article 67 shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(Crime of fraud)

Article 79 Any person who has obtained a trademark registration, defensive mark registration, registration of renewal of the duration of trademark right or right based on defensive mark registration, decision on opposition to registration or trial decision by means of a fraudulent act shall be punished by imprisonment with work for a term not exceeding three years or a fine not exceeding 3,000,000 yen.

(Crime of false indication)

Article 80 Any person who fails to comply with Article 74 shall be punished by imprisonment with work for a term not exceeding three years or a fine not exceeding 3,000,000yen.

(Crime of perjury, etc.)

Article 81 (1) A witness, an expert witness or an interpreter who has taken an oath under this Act and made a false statement or given a false expert opinion or a false interpretation before the Patent Office or a court commissioned thereby, shall be punished by imprisonment with work for a term of between three months and ten years.

(2) Where a person who has committed the offense in the preceding paragraph has made a voluntary confession before a transcript of the judgment on the case has been served, or a decision on an opposition to registration or trial decision has become final and binding, the punishment may be reduced or waived

(Crime of breach of confidentiality order)

Article 81-2 (1) Any person who fails to comply with an order pursuant to Article 105-4(1) (including cases where it is applied mutatis mutandis pursuant to Article 13-2(5)) of the Patent Act as applied mutatis mutandis pursuant to Article 39 of this Act shall be punished by imprisonment with work for a term not exceeding five years or a fine not exceeding 5,000,000yen or combination thereof.

(2) The prosecution of the crime under the preceding paragraph may not be instituted unless a complaint is filed.

(3) The crime under paragraph (1) shall apply to a person who commits the crime under the said paragraph while outside Japan.

(Dual liability)

Article 82 (1) Where a representative of a juridical person or an agent, employee or other staff member of a juridical person or an individual has committed, in the course of performing social activities for the juridical person or individual, any act in violation of the provisions prescribed in the following items, in addition to the offender, the juridical person shall be

punished by fine as provided in the corresponding items and the individual shall be punished by fine as provided in each article prescribed in the following items:

- (i) Article 78, Article 78-2 or 81-2(1), a fine not exceeding 300 million yen; and
  - (ii) Article 79 or 80, a fine not exceeding 100 million yen.
- (2) In the case of the preceding paragraph, a complaint under Article 81-2(2) against the offender shall also have effect on the juridical person or individual and a complaint against the juridical person or individual shall also have effect on the offender.
- (3) Where a fine is imposed on a juridical person or individual pursuant to paragraph (1) with regard to a violation of Article 78, 78-2 or 81-2(1), the period of prescription shall be governed by the same rules as for crimes in the provisions thereof.

(Non-penal fine)

Article 83 Where a person who has taken an oath under Article 207(1) of the Code of Civil Procedure as applied mutatis mutandis pursuant to Article 151 of the Patent Act as applied mutatis mutandis pursuant to Article 71(3) of the Patent Act as applied mutatis mutandis pursuant to Article 28(3) (including cases where it is applied mutatis mutandis pursuant to Article 68(3) of this Act) of this Act, Article 43-8 (including cases where it is applied mutatis mutandis pursuant to Article 60-2(1) and 68(4) of this Act) or Article 56(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(4) of this Act), Article 174(2) of the Patent Act as applied mutatis mutandis pursuant to Article 61 (including cases where it is applied mutatis mutandis pursuant to Article 68(5) of this Act), Article 58(2) of the Design Act as applied mutatis mutandis pursuant to Article 62(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(5) of this Act), or Article 58(3) of the Design Act as applied mutatis mutandis pursuant to Article 62(2) (including cases where it is applied mutatis mutandis pursuant to Article 68(5) of this Act) has made a false statement before the Patent Office or a court commissioned thereby, the said person shall be liable to a non-penal fine not exceeding 100,000 yen.

Article 84 A person who has been summoned by the Patent Office or a court commissioned thereby in accordance with this Act and fails to appear or refuses to take an oath, make a statement, testify, give an expert opinion or interpret without a just cause shall be liable to a non-penal fine not exceeding 100,000yen.

Article 85 A person who has been ordered by the Patent Office or a court commissioned thereby to submit or present documents or other materials for the purpose of examination or preservation of evidence in accordance with this Act, and fails to comply with the order without a just cause shall be liable to a non-penal fine not exceeding 100,000yen.

### **Supplementary provisions (Extract)**

Attached Table (In relation to Article 76)



	Person responsible for payment	Amount
1	Person filing an application for trademark registration	6,000 yen per case plus 15,000 yen for each class
2	Person filing an application for defensive mark registration or for registration of renewal of the duration of a right based on defensive mark registration	12,000 yen per case plus 30,000 yen for each class
3	Person requesting the division of a trademark right	30,000 yen per case
4	Person requesting an advisory opinion pursuant to Article 28(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(3))	40,000 yen per case
5	Person filing an opposition to registration	3,000 yen per case plus 8,000 yen for each class
6	Person requesting to intervene in proceedings of an opposition to registration	11,000 yen per case
7	Person filing a request for a trial or retrial	15,000 yen per case plus 40,000 yen for each class
8	Person requesting to intervene in a trial or retrial	55,000 yen per case