

# **Trademark Act (Article 4, Article 8, Article 24-4, Article 52-2 unenforced (Tentative translation))**

(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 upholding the reputation of businesses of persons who use trademarks, thereby contributing to the development of the industry and the protection of the interests of consumers.

### (Definitions)

Article 2 (1) "Trademark" in this Act means, among those which can be perceived

by people, any character, figure, sign or three-dimensional shape or color, or any combination thereof; sounds, or anything else specified by Cabinet Order (hereinafter referred to as a "mark") which is:

- (i) used by a person in connection with a good which the person produces, certifies or assigns as its business; or
  - (ii) used by a person in connection with the services which the person provides or certifies as its business (except those provided for in the preceding item).
- (2) "Services", as set forth in item (ii) of the preceding paragraph, are to include 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 refers to any of the following acts:
- (i) affixing a mark to goods or packaging of goods;
  - (ii) assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing or providing through a telecommunications line, goods with affixed marks or goods with marks affixed on their packaging;
  - (iii) in the course of the provision of services, to affix a mark to articles to be used by a person who receives those services (including articles to be assigned or loaned; the same applies hereinafter);
  - (iv) in the course of the provision of services, to provide those services by using articles to which a mark is affixed and which are to be used by a person who receives those services;
  - (v) for the purpose of providing services, to display articles to be used in the provision of those services (including articles to be used by a person who receives those services; the same applies hereinafter) to which a mark is affixed;
  - (vi) in the course of providing services, to affix a mark to articles pertaining to services received by a person;
  - (vii) in the course of the provision of services through use of a screen, by electronic or magnetic means (meaning by electronic means, magnetic means, or other means that is impossible to perceive through the human senses alone; the same applies hereinafter ), to provide those services by displaying a mark on the screen;
  - (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 this content, to which a mark is affixed by electronic or magnetic means;
  - (ix) in the case of sound marks, beyond what is listed in the preceding items, the act of producing sounds when transferring or delivering goods, or providing services; and
  - (x) Beyond those listed in the preceding items, acts specified by Cabinet Order.

- (4) In cases of marks listed in the following items, affixing a mark to goods or other articles provided for in the preceding paragraph is to include those listed in each of those items:
- (i) a mark of any character, figure, sign or three-dimensional shape, or any combination thereof, or any combination thereof with colors: formed in the shape of goods, packaging of goods, articles to be used for the provision of services, or advertisement materials relating to goods or services; and
  - (ii) sound marks: when a sound mark is recorded on a recording medium affixed to goods, articles to be used for the provision of services, or advertisement materials relating to goods or services (including when the goods, articles to be used for the provision of services, or advertisement materials relating to goods or services themselves are recording media).
- (5) "Registered trademark" in this Act means a trademark that has been registered as a trademark.
- (6) In this Act services may be included within the scope of what is considered similar to goods, and goods may in turn be included within the scope of what is considered similar to services.
- (7) In this Act, "importing" includes an act through which a person in a foreign country has another person bring the relevant item into Japan from a foreign country.

## **Chapter II Trademark Registration and Applications for Trademark Registration**

(Requirements for Trademark Registration)

Article 3 (1) Any trademark 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 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, shape (including shape of packaging; the same applies in Article 26 paragraph (1), items (ii) and (iii)), the method or features including time of production or use, quantity, price, or, in the case of services, the location of provision, quality, articles to be used in the provision, efficacy, intended purpose, modes, method or features including time, quantity or price of provision;
- (iv) consists solely of a mark indicating, in a common manner, a common surname name or name;
- (v) consists solely of a very simple and common mark; or

(vi) is beyond 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) through (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 may be registered if the trademark:

(i) is identical with, or similar to, the Japanese 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 national government emblems (excluding national flags of any country party to the Paris Convention, members of the World Trade Organization or Contracting Parties to the Trademark Law Treaty) of a country party 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 applies 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 representing the United Nations or any other international organization (referred to as an "international organization" in (b)) which has been designated by the Minister of Economy, Trade and Industry (excluding those listed in the following);

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

(b) is identical with, or similar to, a mark indicating an abbreviation of any international organization, which has been used for goods or services, that is not likely to be mistaken regarding its connection to the international organization;

(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, paragraph (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 party 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 the 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 a national government, a local government, an agency thereof, a non-profit organization undertaking business for public interest, or a non-profit enterprise undertaking business for public interest;
- (vii) is likely to negatively affect public policy;
- (viii) contains the portrait of another person or the name (limited to the name that is well known among consumers in the field of goods or services using the trademark), 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), or contains the name of another person and does not fall under the requirements specified by Cabinet Order;
- (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. that conforms to the standards specified 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 their 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 the trademark is used in connection with the 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 that trademark, if such a trademark is used in connection with the designated goods or designated services relating to that registered trademark (referring to goods or services designated in accordance with Article 6, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (1)); the same applies 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 applies hereinafter), if

- the trademark is used in connection with designated goods or designated services relating to the defensive mark;
- (xiii) deleted;
- (xiv) is identical with, or similar to, the name of a variety registered in accordance with Article 18, paragraph (1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if the 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) through (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 those members from being used on wines or spirits not originating from the region of those members, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of those members;
- (xviii) consists solely of features provided by Cabinet Order among features that are naturally provided to goods, etc. (goods, or packaging of goods, or services; the same applies in Article 26, paragraph (1), item (v)); 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 the trademark is used for unfair purposes (referring to gaining unfair profits, causing damage to the other persons, or any other unfair purpose, the same applies hereinafter) (except those provided for in each of the preceding items).
- (2) Where the national government or a local government, an agency thereof, a non-profit organization undertaking business for public interest, or a person undertaking non-profit activities for public interest files an application for trademark registration falling under item (vi) of the preceding paragraph, the provisions of those items do not apply.
- (3) Paragraph (1), items (viii), (x), (xv), (xvii) and (xix) do not apply to a trademark falling under any of those items which does not fall under those items at the time of filing of an application for trademark registration.
- (4) Even if the trademark falls under paragraph (1), item 11, if the applicant for trademark registration has obtained the consent of another person under that item to obtain the trademark registration, and it is not likely to cause confusion between the goods or services using the trademark and the goods or services pertaining to the business of the holder of the trademark right, the exclusive right to use the trademark, or the non-exclusive right to use the

trademark pertaining to another person's registered trademark under that item, the provisions of that item do not apply.

(Application for Trademark Registration)

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

(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, paragraph (2).

(2) Where a person desires to register a trademark listed as follows, the application must contain a statement indicating thereof:

(i) a trademark which consists of any character, figure, sign or three-dimensional shape or colors, or any combination thereof, where those characters, figures, signs or three-dimensional shapes or colors in connection with that trademark change;

(ii) a trademark which consists of any three-dimensional shape (including the combination with any character, figure, sign or three-dimensional shape or colors, or any combination thereof) (excluding those listed in the preceding item);

(iii) a trademark which consists solely of colors (excluding those listed in item (i));

(iv) a trademark which consists solely of sounds; or

(v) beyond those listed in each of the preceding items, trademarks provided by Order of the Ministry of Economy, Trade and Industry.

(3) When 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 must contain a statement indicating thereof.

(4) When a person desires to register any trademark provided by Order of the Ministry of Economy, Trade and Industry, the person must state a detailed description of the trademark in the application pursuant to Order of the Ministry of Economy, Trade and Industry, and affix materials provided by Order of the Ministry of Economy, Trade and Industry to the application.

(5) The statement and materials in the preceding paragraph must specify the trademark for which a registration is sought.

(6) Where a portion of the trademark for which a registration is sought is in the same color as that of the column in which such a trademark is required to be stated, that portion of the trademark is deemed not to be a part of the

trademark; provided, however, that this does not apply to an area specified and identified as an area to be colored in the same color as that of the column.

(Approval of Filing Dates)

Article 5-2 (1) The Commissioner of the Patent Office must approve the filing date of an application for trademark registration as that of 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 the trademark is unclear;
- (ii) the name of the applicant for the trademark registration is not stated or the statement thereof is not sufficient to identify the applicant;
- (iii) the trademark for which registration is sought is not stated in the application; or
- (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 must order the person who desires to register the trademark to supplement the application, designating a reasonable period for doing so.

(3) Supplementing an application for trademark registration must 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 that application within the designated period as provided in that paragraph, the Commissioner of the Patent Office must approve 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 that application within the designated period as provided for in that paragraph, the Commissioner of the Patent Office may dismiss that application for trademark registration.

(Single Trademarks on Each Application)

Article 6 (1) An application for trademark registration must 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 must 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 must not be perceived as prescribing the scope of similarities of goods or services.

(Collective Trademarks)

- Article 7 (1) A general incorporated association or other association (except those which do not have legal personality, and companies), or any other association established pursuant to a special Act including business cooperative (except those which do not have legal personality), or a foreign corporation equivalent thereto is entitled to obtain a collective trademark registration with respect to a trademark to be used by its members.
- (2) To apply Article 3, paragraph (1) in the case of the preceding paragraph, the term "applicant" in that paragraph is deemed to be replaced with "applicant or its members".
- (3) Any person who desires to register a collective trademark pursuant to paragraph (1) must, at the time of filing of an application for trademark registration pursuant to Article 5, paragraph (1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is a corporation 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 legal personality are excluded, and limited to those which are established by a special Act providing, without just cause, that the association must not refuse the enrollment of any person who is eligible to become a member, or that the association must not impose on any of its prospective members any condition that is greater than those imposed on its existing members), a commercial transaction, commercial and industrial association or specified non-profit corporation specified in Article 2, paragraph (2) of Act on Promotion of Specified Non-profit Activities (Act No. 7 of 1998), or a foreign corporation equivalent thereto (hereinafter referred to as an "association, etc.") is 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 that trademark, that trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provisions of Article 3 (except in cases falling under Article 3, paragraph (1), item (i) or (ii)):
- (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 that 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 those goods or services to the equivalent extent, for which the trademark pertaining to that application has been used by the applicant or its members, or abbreviation thereof.
- (3) To apply Article 3, paragraph (1) (limited to the part pertaining to items (i) and (ii)) in the case of paragraph (1), the term "applicant" in the paragraph is deemed to be replaced with "applicant or its members".
- (4) Any person who desires to register a regional collective trademark pursuant to paragraph (1) must, at the time of filing of an application for trademark registration pursuant to Article 5, paragraph (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 Applications)

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 is entitled to register the trademark in question. However, in cases where an applicant who has applied for trademark registration on a later date (hereinafter referred to as the "later applicant" in this paragraph) has obtained the consent for trademark registration of the applicant who has applied for trademark registration on an earlier date to obtain the trademark registration (the applicants for trademark registration if there is more than one applicant for trademark registration; hereinafter referred to as the "prior applicant" in this paragraph and paragraph (6)), and it is not likely to cause confusion between the goods or services in which the later applicant uses the trademark and the goods or services in which the prior applicant uses the trademark (if that trademark has been registered, the goods or services pertaining to the business of the holder of the trademark right, the exclusive right to use the trademark, or the non-exclusive right to use the trademark pertaining to the

registered trademark), the later applicant can also obtain the trademark registration for that trademark.

- (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 the applications is entitled to register the trademark in question. However, in cases where all applicants for trademark registration have mutually agreed to obtain trademark registration and it is not likely to cause confusion between the goods or services using the respective trademarks, all applicants for trademark registration can obtain trademark registration for the respective trademarks.
- (3) Where an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial or appeal decision on an application for trademark registration becomes final and binding, the application is, for the purposes of the application of the preceding two paragraphs, deemed never to have been filed.
- (4) In cases such as that in the main clause of paragraph (2), the Commissioner of the Patent Office must require the applicants for trademark registration to arrange consultations among the applicants as set forth in the main clause of the paragraph and to report the result thereof, designating a reasonable period for doing so.
- (5) Where no agreement is reached in the consultations held pursuant to the main clause of paragraph (2) or no report is submitted within the designated period set forth in the preceding paragraph (except as provided in the proviso to paragraph (2)), only the first applicant for trademark registration in the order determined by a lottery in a fair and just manner conducted by the Commissioner of the Patent Office, is entitled to register the trademark in question. However, in cases where the applicant for trademark registration in the later order determined by the lottery (hereinafter referred to as the "later order applicant" in this paragraph) has obtained the consent of the applicant for trademark registration in the earlier order to obtain the trademark registration (the applicants for trademark registration if there is more than one applicant for trademark registration; hereinafter referred to as the "earlier order applicant" in this paragraph and the following paragraph), and it is not likely to cause confusion between the goods or services in which the later order applicant uses the trademark and the goods or services in which the earlier order applicant uses the trademark (if the trademark has been registered, the goods or services pertaining to the business of the holder of the trademark right, the exclusive right to use the trademark or the non-exclusive right to use the trademark pertaining to the registered trademark), the later order

applicant can also obtain the trademark registration for that trademark.

- (6) In the case falling under the proviso to paragraph (1) or the proviso to the preceding paragraph, if the trademark of the prior applicant or the earlier order applicant has been registered and the trademark right pertaining to the trademark registration has been transferred, the holder of the trademark right pertaining to the trademark registration is deemed to be the prior applicant or earlier order applicant, and these provisions shall be applied.

(Special Provisions Concerning the Time of Filing an 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. that conforms to the standards specified by the Commissioner of the Patent Office, an international exhibition held by the government, etc. of a country party 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 the exhibition in its territory, or an international exhibition held by the government, etc. of a country which is not a country party 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 the exhibition in its territory that conforms to the standards specified by the Commissioner of the Patent Office, by the exhibitor of the goods or services bearing the trademark within six months from the date of exhibition of the goods or services, that application is be deemed to have been filed at the time of exhibition of the goods or services.

- (2) Any person who intends to apply the preceding paragraph in connection with a trademark relating to an application for trademark registration must 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 that paragraph (referred to as a "certificate" in the following paragraph and paragraph (4)), within thirty days from the filing date of an application for trademark registration.

- (3) Where a person submitting a certificate is unable to submit the certificate within the period under the preceding paragraph, that person may, in accordance with Order of the Ministry of Economy, Trade and Industry, submit the certificate to the Commissioner of the Patent Office only within the period as provided in Order of the Ministry of Economy, Trade and Industry, even after the expiration of the period.

- (4) Where, due to any grounds not attributable to the person, the person

submitting a certificate is unable to submit the certificate within the period for submission of the certificate pursuant to the preceding paragraph, notwithstanding the paragraph, submit the certificate to the Commissioner of the Patent Office within 14 days (two months for overseas residents) from the date on which the reasons for not submitting ceased to be applicable, but not later than six months after the expiration of that period.

(Priority Claims 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 party to the Paris Convention (limited to a trademark equivalent to a trademark provided in Article 2, paragraph (1), item (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, paragraph (1), item (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 of the Paris Convention)	A member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty
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 or Trademarks for which Registration is Sought and Changes to Their Outline)

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 outline thereof, the application for trademark registration is deemed to have been filed at the time of submission of the

written amendment relating thereto.

(Division of Applications 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 an examination proceeding, trial or appeal, or retrial examination, or that a suit against a decision on appeal to refuse the application is pending in court and that the applicant has paid the fees payable under Article 76, paragraph (2) for the application for trademark registration.

(2) In the case of the preceding paragraph, the new application for trademark registration is deemed to have been filed at the time of filing of the original application for trademark registration; provided, however, that this does not apply for the purpose of Article 9, paragraph (2) of this Act and Articles 43, paragraphs (1) and (2) of the Patent Act (Act No.121 of 1959) as applied mutatis mutandis pursuant to Article 13, paragraph (1) of this Act (including cases where they are applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (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 (in the case of a submission under Article 43, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (1)), including statements or documents provided by electronic or magnetic means) which are required to be submitted in connection with the new application for trademark registration pursuant to Article 9, paragraph (2) of this Act or Articles 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (1) of this Act (including its mutatis mutandis application pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (1) of this Act) is 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 applies 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 or appeal 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) through (3), the original application for trademark registration is deemed to have been withdrawn.
- (6) The provisions of Article 10, paragraphs (2) and (3) apply *mutatis mutandis* to the conversion of an application for trademark registration pursuant to paragraphs (1) through (3).

Article 12 (1) An applicant for a defensive mark registration may convert the 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 or appeal decision on the application for a defensive mark registration becomes final and binding.
- (3) The provisions of Article 10, paragraphs (2) and (3), and Article 11, paragraph (5) apply *mutatis mutandis* to the conversion of an application pursuant to paragraph (1).

#### (Publication of Applications)

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

- (2) The publication of a trademark application is effected by stating the following particulars in the trademark bulletin; provided, however, that this does not apply to the particulars listed in items (iii) and (iv), where the Commissioner of the Patent Office finds that publishing those particulars 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, paragraph (3), the trademark represented in standard characters; the same applies hereinafter);
- (iv) the designated goods or designated services; and
- (v) other necessary particulars beyond those matters listed in the preceding items.

(Mutatis Mutandis Application of the Patent Act)

Article 13 (1) The provisions of Article 43, paragraphs (1) through (4) and paragraphs (7) through (9) and Article 43-3, paragraphs (2) and (3) of the Patent Act apply mutatis mutandis to an application for trademark registration. In this case, the phrase "within the period provided by Order of the Ministry of Economy, Trade and Industry" in Article 43, paragraph (1) of that Act is deemed to be replaced with "at the time of filing of the application for trademark registration", "the description, scope of claims for patent or claim of utility model and drawings" in paragraph (2) of that Article is deemed to be replaced with "the statement of the trademark for which registration is sought and the designated goods or designated services", "one year and four months from the earliest of the following dates" in paragraph (2) of that Article is deemed to be replaced with "three months from the filing date of an application for trademark registration"; "a person who has received a notice provided under the preceding paragraph" in paragraph (7) of that Article is deemed to be replaced with "where a person who submits the priority certificate, etc. is unable to submit the priority certificate, etc. within the period provided in paragraph (2), even after the expiration of that period", "the priority certificate, etc. or the document specified in paragraph (5)" in paragraph(7) of that Article is deemed to be replaced with "the priority certificate, etc. as provided by Order of the Ministry of Economy, Trade and Industry"; "a person who has received a notice provided under paragraph (6)" in paragraph(8) of that Article is deemed to be replaced with "a person who submits the priority certificate, etc.", "the priority certificate, etc. or the document specified in paragraph (5) within the period provided in the preceding paragraph" in paragraph (8) of that Article is deemed to be replaced with "the priority certificate, etc. within the period provided by Order of the Ministry of Economy, Trade and Industry in the preceding paragraph", ", the preceding paragraph" in paragraph(8) of that Article is deemed to be replaced with ", that paragraph"; "the priority certificate, etc. or the document" is deemed to be replaced with "the priority certificate, etc."; "the priority certificate, etc. or the document specified in paragraph (5)" in paragraph (9) of that Article is deemed to be replaced with "the priority certificate, etc."; "or

members of the World Trade Organization" in Article 43-3, paragraph (2) of that Act is 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 is deemed to be replaced with "nationals of members of the World Trade Organization or nationals of Contracting Parties to the Trademark Law Treaty"; "preceding two Articles" in paragraph (3) of that Article is deemed to be replaced with "Article 43"; and "preceding two paragraphs" in paragraph (3) of that paragraph is deemed to be replaced with "preceding paragraph".

- (2) The provisions of Articles 33, paragraphs (1) through (3) and Article 34, paragraphs (4) through (7) (Right to obtain patent) of the Patent Act apply mutatis mutandis to the rights deriving from an application for trademark registration.

(Right to Monetary Claims prior to the Registration of Establishment of Trademark Rights)

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 the 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) Exercising the right to claim under paragraph (1) does not preclude exercising the trademark right.
- (4) The right to claim under paragraph (1) is 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 or appeal decision to the effect that an application for trademark registration is to be refused becomes final and binding; where a ruling to cancel a trademark under Article 43-3, paragraph (2) becomes final and binding; or where, excluding the cases falling under the proviso to Article 46-2, paragraph (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, Article 104-3, paragraphs (1) and (2), Article 105, Article 105-2-12, Articles 105-4 through 105-6 and Article 106 of the Patent Act as applied mutatis mutandis under Article 39 of this Act, and Article 168, paragraphs (3) through (6) of the Patent Act as applied

mutatis mutandis under Article 56, paragraph (1) of this Act and Article 719 and Article 724 (Tort) of the Civil Code (Act No.89 of 1896) 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 phrase "by the victim or their legal representative within three years from the time when they come to know of the damages and the identity of the perpetrator" in Article 724 of that Code is deemed to be replaced with "by the person having the right to claim within three years from the date of the registration of the establishment of the trademark right".

### **Chapter III Examination Proceedings**

(Examination Proceedings by an Examiner)

Article 14 The Commissioner of the Patent Office must direct the examination proceedings 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 must 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, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (2) and (5), Article 51, paragraph (2) (including the case of its mutatis mutandis application under Article 52-2, paragraph (2)), Article 53, paragraph (2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under Article 77, paragraph (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 5, paragraph (5), or Article 6, paragraph (1) or (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 must 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 doing so.

- 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 that application, if that trademark is used for goods or services identical with, or similar to, the designated goods or designated services pertaining to that other person's trademark, the examiner may notify the applicant for trademark registration of the fact that application for trademark registration will fall under Article 15, item (i) when the other person's trademark is registered, and provide the applicant with an opportunity to submit a written opinion, designating a reasonable time limit for doing so.
- (2) Where the notification set forth in the preceding paragraph has already been served and that other person's trademark is registered, the examiner is not required to serve the notification set forth in the preceding Article.

(Examiner's Decisions on Trademark Registrations)

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

(Dismissal of Amendments)

- 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 outline thereof, the examiner must dismiss the amendment by a ruling.
- (2) The ruling dismissing an amendment under the preceding paragraph must be made in writing and state reasons therefor.
- (3) Where a ruling dismissing an amendment under paragraph (1) is rendered, the examiner does not render any decision on the applications for trademark registration before the expiration of a three-month period from the date of service of a transcript of the ruling
- (4) Where an applicant for trademark registration files a request for an appeal under Article 45. paragraph (1) against the ruling dismissing an amendment under paragraph (1), the examiner must suspend the examination proceedings of the application for trademark registration until the appeal decision becomes final and binding.

(Mutatis Mutandis Application of the Patent Act)

Article 17 The provisions of Articles 47, paragraph (2) (Qualification of

Examiners), Article 48 (Exclusion of Examiners), Article 52 (Formal Requirements for Examination Proceedings) and Article 54 (Relationship with Litigation) of the Patent Act apply mutatis mutandis to the examination proceedings of applications for trademark registration.

(Mutatis Mutandis Application of the Design Act)

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

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

## **Chapter IV Trademark Rights**

### **Section 1 Trademark Rights**

(Registration of the Establishment of Trademark Rights)

Article 18 (1) A trademark right is formed upon registration of establishment of the right.

(2) Where the registration fee under Article 40, paragraph (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 or appeal decision to the effect that a trademark is to be registered pursuant to Article 41-2, paragraph (1) is paid, the establishment of the trademark right is registered.

(3) Upon registration set forth in the preceding paragraph, the following particulars must to 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 particulars beyond those listed in the preceding items.

(4) The Commissioner of the Patent Office must 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 particulars 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 does 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) When 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 that 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 must notify the person who submitted the documents or the articles thereof and the reasons therefor.

(Term)

Article 19 (1) A trademark right expires after ten years from the date of registration of establishment of the right.

- (2) 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 term of the trademark right is registered, the term is to be deemed to have been renewed at the time of expiration of the original term.

(Application for Registration of Renewal of a Trademark Right)

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

- (i) the name and the domicile or residence of the applicant;
- (ii) the registration number of the trademark registration; and
- (iii) beyond those listed in the preceding two items, the particulars provided by Order of the Ministry of Economy, Trade and Industry.
- (2) An application for registration of renewal must be filed during the period from six months prior to the expiration of the 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 period provided in the preceding paragraph, the holder of trademark right may file that application within the period as provided by Order of the Ministry of Economy, Trade and Industry, even after the expiration of that period.
- (4) Where the holder of trademark right fails to file an application for registration of renewal within the period for the request pursuant to the provisions of the preceding paragraph, the trademark right is deemed to have expired retroactively from the time of the expiration of its term.

(Restoration of Trademark Rights)

Article 21 (1) Pursuant to Order of the Ministry of Economy, Trade and Industry, the original holder of a trademark right which was deemed to have expired pursuant to Article 20, paragraph (4) may file an application for registration of renewal, but only within the period provided for by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the original holder is found to have intentionally failed to file an application for registration of renewal within the period during which it is permissible to file an application pursuant to Article 20, paragraph (3).

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

(Limitations of Effects of Restored Trademark Rights)

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

Article 23 (1) Where the registration fee under Article 40, paragraph (2) or the registration fee due and payable at the time of filing of the application for registration of renewal pursuant to the provisions of Article 41-2, paragraph (7) is paid, the renewal of the trademark right will be registered.

(2) Notwithstanding the preceding paragraph, where an application for registration of renewal is filed pursuant to Article 20, paragraph (3) or Article 21, paragraph (1), the renewal of the trademark right will be registered at the time of payment of the registration fee under Article 40, paragraph (2) and the registration surcharge under Article 43, paragraph (1), or the registration fee due and payable at the time of filing of the application for registration of renewal under Article 41-2, paragraph (7) and the registration surcharge under Article 43, paragraph (2).

(3) Upon registration as set forth under the preceding two paragraphs, the following matters are to 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 particulars beyond those listed in the preceding two items.

(Division of Trademark Rights)

Article 24 (1) Where there are two or more designated goods or designated services for which a trademark right applies, 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, paragraph (3), the division provided for in the preceding paragraph may be made even after the extinction of the trademark right, provided that a trial, retrial or court proceeding in connection with the case is pending.

(Transfer of Trademark Rights)

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 this right.

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

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

(Transfer of Collective Trademark Rights)

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

(2) Where the right holder of a collective trademark desires to transfer the collective trademark right, the right holder must submit an application for registration of transfer accompanied by a document stating thereof, and the documents provided in Article 7 paragraph (3), to the Commissioner of the Patent Office.

(Request for Indication to Prevent Confusion Arising from Transfer of Trademark Rights)

Article 24-4 Where, due to the following grounds, 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 the 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 those 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.

- (i) The trademark registration has been made pursuant to the provisions of Article 4, paragraph (4).
- (ii) The trademark registration has been made pursuant to the provisions of the proviso to Article 8, paragraph (1), the proviso to Article 8 paragraph (2) or the proviso to Article 8, paragraph (5).
- (iii) The right deriving from an application for trademark registration has been succeeded on and after the service of a transcript of an examiner's decision or trial or appeal decision to the effect that a trademark is to be registered.
- (iv) The trademark right has been transferred.

#### (Effects of Trademark Rights)

Article 25 The holder of trademark right has an exclusive right to use the registered trademark in connection with the designated goods or designated services; provided, however, that when an exclusive right to use the trademark is established in connection with the trademark right, this does 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 Rights)

Article 26 (1) A trademark right has 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, shape, the method or features including time of production or use, quantity or price of the designated goods or goods similar thereto, or the common name, location of provision, quality, articles to be used in the provision, efficacy, intended purpose, modes, method or features including time of provision,

- quantity or price 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 the provision, efficacy, intended purpose, modes, method or features including time, quantity or price 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, modes, the method or features including time of production or use, quantity or price 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 features provided by Cabinet Order among features that are naturally provided to goods, etc.; and
  - (vi) beyond those listed in each of the preceding items, a trademark which is not used in the mode that consumers may recognize the goods or services as those pertaining to the business of a particular person.
- (2) Item (i) of the preceding paragraph does 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.
- (3) A trademark right shall have no effect against any of the following acts; provided, however, that this shall apply only if such act is not performed for the purpose of unfair competition:
- (i) to affix a geographical indication prescribed in Article 2 (3) of the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs (Act No. 84 of 2014; hereinafter referred to as the "Specific Agricultural, Forestry and Fishery Product Name Protection Act") (hereinafter referred to as a "geographical indication" in the following item and item (iii)) to goods or packages of goods pursuant to the provisions of Article 3 (1) of the said Act (including cases where applied mutatis mutandis pursuant to Article 30 of the said Act following the deemed replacement of terms; the same shall apply in the following item and item (iii));
  - (ii) to assign, deliver, display for the purpose of assignment or delivery, import or export goods or packages of goods to which a geographical indication has been affixed pursuant to the provisions of Article 3 (1) of the Specific Agricultural, Forestry and Fishery Product Name Protection Act;
  - (iii) to display an invoice of goods with a geographical indication affixed thereto pursuant to the provisions of Article 3 (1) of the Specific Agricultural, Forestry and Fishery Product Name Protection Act.

(Scope of Registered Trademarks)

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

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

(3) In the case of paragraph (1), meanings of statement of the trademark stated in the application is to be interpreted by considering the statement and materials of Article 5, paragraph (4).

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 must designate three administrative judges and have them make an advisory opinion.

(3) The provisions of Articles 71, paragraphs (3) and (4) of the Patent Act 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 must designate three administrative judges and have them provide the expert opinion.

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

#### (Relationship with Another Person's Patent Right)

Article 29 When 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 that registered trademark or upon another person's copyright or neighboring right 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 for the trademark to which they hold the right; provided, however, that this does not apply to the trademark right pertaining to an application for trademark registration provided in Article 4, paragraph (2) or a regionally-based collective trademark.

- (2) The holder of an exclusive right to use will 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 the right is granted.
- (3) The exclusive right to use may be transferred only when the consent of the holder of trademark right is obtained or when the transfer falls under general succession including inheritance.
- (4) The provisions of Articles 77, paragraphs (4) and (5) (establishment of pledge, etc.), Article 97, paragraph (2) (waiver), and Article 98, paragraph (1), item(ii) and Article, 98 paragraph (2) (effects of registration) of the Patent Act 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 of the trademark to which they hold the right.

- (2) The holder of a non-exclusive right to use will have the right to use the registered trademark for the designated goods or designated services to the extent provided by the agreement under which the right is granted.
- (3) A non-exclusive right to use may be transferred only when the consent of the holder of trademark right (the holders of a trademark right and of an 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 when the transfer falls under general succession including inheritance.
- (4) When a non-exclusive right to use is registered, the non-exclusive right to use has an effect on any person who subsequently acquires the trademark right or the exclusive right to use, or the exclusive right to use on the trademark right.
- (5) The transfer, modification, extinction or restriction on disposition of a non-exclusive right to use has no effect on any third party unless registered.
- (6) The provisions of Article 73, paragraph (1) (joint ownership), Article 94, paragraph (2) (establishment of right of pledge) and Article 97, paragraph (3) (waiver) of the Patent Act apply mutatis mutandis to a non-exclusive right to use.

#### (Right of Members of Corporations or Associations)

Article 31-2 (1) Members of a corporation provided in Article 7, paragraph (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") have the right to use a registered trademark relating to a collective trademark or a regionally-based collective trademark for the designated goods or designated services as provided by that corporation or

- association, etc.; provided, however, that this is in the case where 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) To apply Article 24-4, Article 29, Article 50, Article 52-2, Article 53 and Article 73, collective members or regional collective members is deemed to be holders of non-exclusive right to use.
- (4) To apply Article 33, paragraph (1), item (iii) in relation to registered trademarks in connection with collective trademarks and regionally-based collective trademarks, the phrase "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 31, paragraph (4) of this Act" in that item is deemed to be replaced with "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 31, paragraph (4) of this Act, or collective members or regional collective members who have the right to use that trademark".

(Right to Use a 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 the other person's application for the 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, paragraph (1) of the Design Act as applied mutatis mutandis under Article 17-2, paragraph (1) or Article 55-2, paragraph (3) of this Act (including its mutatis mutandis application under Article 60-2, paragraph (2))), the trademark has become well known among consumers as that indicating goods or services pertaining to the business of the person, the person has the right to use the trademark in connection with the goods or services as far as that person continuously uses the trademark for the goods or services. The same applies to those by whom the 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 that 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 that other person's application for trademark registration of that regionally-based collective trademark, has the right to use the trademark in connection with the goods or services as far as those person continuously uses the trademark in connection with the goods or services. The same applies to those who succeeded to the relevant business.

(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 that person and those of its own or its members.

(Right to Use Trademarks Arising from Use Prior to Registration of a Request for an Invalidation Trial)

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

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

- (iii) in the case of the preceding two items, a person who, at the time of registration of the request for a trademark under Article 46, paragraph (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 31, paragraph (4) of this Act.
- (2) The holder of trademark right or of exclusive right to use is entitled to receive reasonable compensation from the person who has the right to use the trademark pursuant to the preceding paragraph.
- (3) The provisions of Article 32, paragraph (2) apply mutatis mutandis to paragraph (1).

(Right to Use a Trademark after Expiration of the Term of Patent Rights)

- 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 term of that patent right, the original patent right holder has 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 the trademark is not used for the purpose of unfair competition.
- (2) The provisions of Article 32, paragraph (2) apply mutatis mutandis to the preceding paragraph.
- (3) The preceding two paragraphs 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 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 term of that patent right, the person who, at the time of expiration of the patent right, has the exclusive license to work the patent right, or a non-exclusive license to work which is effective on the patent right or on the exclusive license to work, has 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 the trademark is not used for

the purpose of unfair competition.

- (2) The provisions of Articles 32, paragraph (2) and Article 33, paragraph (2) apply mutatis mutandis to the preceding paragraph.
- (3) The preceding two paragraphs 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 utility model right or design right.

(Pledges)

- Article 34 (1) Where a pledge is established on a trademark right, an 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) The establishment, transfer, modification, extinction or restriction on disposition of a pledge on a non-exclusive right to use has no effect on any third party without registration.
  - (3) The provisions of Article 96 (subrogation) of the Patent Act apply mutatis mutandis to pledges on a trademark right, exclusive right to use or non-exclusive right to use.
  - (4) The provisions of Article 98, (1)(iii) and (2) (effects of registration) of the Patent Act apply mutatis mutandis to pledges on a non-exclusive right to use.

(Waiver of Trademark Rights)

Article 34-2 If there is a holder of an exclusive right to use a trademark, a pledgee, or a holder of a non-exclusive right to use a trademark, the holder of trademark rights may waive those rights only with the consent of that person.

(Mutatis Mutandis Application of the Patent Act)

Article 35 The provisions of Article 73 (Co-ownership), Article 76 (Lapse of patent rights in absence of heir), and Article 98, paragraph (1), item (i) and Article 98, paragraph (2) (Effect of registration) of the Patent Act apply mutatis mutandis to trademark rights. In this case, the term "transfer (excluding those by general succession including inheritance)" in Article 98, paragraph (1), item (i) of the Patent Act is deemed to be replaced with "division and transfer (excluding those by general succession including inheritance)".

## **Section 2 Infringement of Rights**

(Right to Demand an 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 suspend or prevent the infringement.

- (2) In making the 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 the 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 are 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 packaging;
- (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 those services, for the purpose of the provision of those services through use of those 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 those services, for the purpose of causing the provision of those services through use of those 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 the Amount of Damage)

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 constitute 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 total of the amounts provided in each of the following items.

- (i) 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 portion not exceeding the quantity (if there are circumstances due to which the holder of trademark right or of exclusive right to use would have been unable to sell the quantity of goods equivalent to all or part of the portion, the quantity due to such circumstances (referred to as "specified quantity" in the same item) shall be deducted) proportionate to the ability of the holder of trademark right or of exclusive right to use to work the goods (referred to as "usage equivalent quantity" in the same item) within the quantity of goods assigned by the infringer who has committed the infringement of the trademark right or of the exclusive right to use (referred to in the next item as "assigned quantity") ;
- (ii) the amount equivalent to the amount of money to be received for the use of the registered trademark relating to the trademark right or exclusive right to use according to the quantity in the case where there is a quantity that exceeds the usage equivalent quantity within the assigned quantity, or a specified quantity (except in the case where it is not recognized that the holder of trademark right or of exclusive right to use would have been able to establish the exclusive right to use or grant a non-exclusive right to use on the trademark right of the holder of trademark right or grant a non-exclusive right to use on the exclusive right to use of the holder of exclusive right to use).
- (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 is 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 an 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 a trademark right or of an exclusive right to use would have been entitled to receive for the use of the registered trademark as the amount of damage sustained.
- (4) When a court determines the amount equivalent to the amount of money to be received for the use of the registered trademark provided in paragraph (1) item (ii) and the preceding paragraph, the court may take into consideration compensation which the holder of trademark right or of exclusive right to use would obtain if the holder of trademark right or exclusive right to use agreed on the compensation of the use of the registered trademark relating to the trademark right or the exclusive right to use with the infringer on the premise that the trademark right or exclusive right to use had been infringed.
- (5) 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 infringement has been committed by using a registered trademark (including a trademark deemed identical from a 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 with those of the registered trademark; the same shall apply in Article 50) in connection with the designated goods or designated services, the amount of damage sustained by the holder of trademark right or of exclusive right to use may be presumed to be the amount equivalent to the expenses normally required for the acquisition and maintenance of the trademark right.
- (6) Paragraph (3) and 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.

(Limits on Assertions)

Article 38-2 Where the following appeal decisions or rulings have become final and binding after the final judgment on a litigation pertaining to infringement of the trademark right or the exclusive right to use or to a claim for payment of money as provided in Article 13-2, paragraph (1) (including cases where it is applied mutatis mutandis in Article 68, paragraph (1)) has become final and binding, a person who was a party of that litigation may not claim that the appeal decisions or rulings have become final and binding in the appeal for retrial against those final judgments (including appeals for the purpose of the claim of the compensation for damages against an obligee of a case of provisional seizure order in which that litigation is the case and appeals for the purpose of the claim of the compensation for damages and the return for unjust enrichment against an obligee of the case of provisional disposition order in which that litigation is the case):

- (i) appeal decision to the effect that the trademark registration is to be invalidated; or
- (ii) a ruling to the effect that the trademark registration is to be rescinded.

(Mutatis Mutandis Application of the Patent Act)

Article 39 The provisions of Article, 103 (Presumption of negligence), Article 104-2 (Obligation to clarify the specific condition); Article 104-3, paragraphs (1) and (2) (Restriction on exercise of rights of patentee, etc.), Articles 105(Production of documents, etc.), 105-2-12 to 105-6 (Expert opinion for calculation of damages; Determination of reasonable damages; Protective order; Rescission of protective order and Notice, etc. of a request inspection of record, etc.) and Article 106 (Measures to restore credibility) of the Patent Act 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 must pay the amount specified by Cabinet Order not exceeding 32,900 yen, multiplied by the number of classes (referring to classes of goods and services provided by Cabinet Order provided for in Article 6, paragraph (2), to which the designated goods or designated services belong; the same applies hereinafter), for each trademark registration as a registration fee.

(2) A person filing an application for the registration of renewal of a trademark right must pay the amount specified by Cabinet Order not exceeding 43,600 yen, multiplied by the number of classes of goods or services, for each trademark registration as a registration fee.

- (3) The preceding two paragraphs do not apply to trademark rights belonging to the national government.
- (4) When a trademark right is jointly owned by the national government and a person or persons other than the national government, and the portion of their respective shares of that trademark right has been agreed, notwithstanding paragraphs (1) and (2), the registration fee provided for in those paragraphs is to be the amount of the registration fee provided in those paragraphs multiplied by the total ratio of the share of each person other than the national government, which must be paid by the person or persons other than the national government.
- (5) Registration fees calculated pursuant to the preceding paragraph are to be rounded down to the nearest ten yen.
- (6) The registration fee provided for in paragraphs (1) and (2) must be paid by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that the payment may be made in cash if permitted under the Order of the Ministry of Economy, Trade and Industry.

(Time Limit For Payment of Registration Fees)

- Article 41 (1) The registration fee under Article 40, paragraph (1) must be paid within 30 days from the service of a transcript of an examiner's decision or a trial or appeal 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) When a person required to pay the registration fee is unable to pay the registration fee within the period under paragraph (1) (when the period under the preceding paragraph is extended, the extended period), that person may, in accordance with an Order of the Ministry of Economy, Trade and Industry, pay the registration fee only within the period as provided by Order of the Ministry of Economy, Trade and Industry, even after the expiration of the period.
  - (4) When, due to reasons beyond the control of a person required to pay a registration fee, the person is unable to pay the registration fee within the period for payment of the registration fee provided in the preceding paragraph, that person may, notwithstanding the provisions of that paragraph, pay the registration fee within 14 days (two months for overseas residents) from the date on which the reasons for not paying ceased to be applicable, but not later than six months after the expiration of that period.
  - (5) The registration fee under Article 40, paragraph (2) must be paid at the time of filing of an application for registration of renewal.

(Payment of Registration Fees by Installments)

Article 41-2 (1) Notwithstanding Article 40, paragraph (1), a person obtaining a registration of establishment of a trademark right may pay the prescribed registration fee by installments. In this case, that person must pay the amount specified by Cabinet Order not exceeding 19,100 yen, multiplied by the number of classes of goods or services, for each trademark registration within 30 days from the service of a transcript of an examiner's decision or trial or appeal decision to the effect that a trademark is to be registered, and must also pay the amount specified by Cabinet Order not exceeding 19,100 yen, multiplied by the number of classes of goods or services, for each trademark registration no later than five years prior to the expiration of the trademark right.

(2) Upon the request of a person required to pay the registration fee to be paid within 30 days from the service of a transcript of an examiner's decision or trial or appeal decision to the effect that a trademark is to be registered has been made under the preceding paragraph (hereinafter, referred to as "an earlier-installation registration fee"), the Commissioner of the Patent Office may extend the period as provided in that paragraph by a period not exceeding 30 days.

(3) Where a person required to pay an earlier-installment registration fee is unable to pay the fee within the period during which that person is required to pay the fee (where the period under the preceding paragraph is extended, within the extended period), that person may, in accordance with an Order of the Ministry of Economy, Trade and Industry, pay the earlier-installment registration fee only within the period as provided by Order of the Ministry of Economy, Trade and Industry, even after the expiration of the period.

(4) Where, due to reasons beyond the control of a person required to pay an earlier-installment registration fee, the person is unable to pay the earlier-installment registration fee within the period for as provided in the preceding paragraph, that person may, notwithstanding the provisions of that paragraph, pay the registration fee within 14 days (two months for a overseas residents) from the date on which the reasons for not paying the fee ceased to be applicable, but not later than six months after the expiration of that period.

(5) Where a person required to pay a registration fee due and payable no later than five years prior to the expiration of the trademark right under paragraph (1) (hereinafter referred to as "a second-installment registration fee") is unable to pay the second-installment registration fee within the period during which that person is required to pay the fee, the person may make a late payment of the second-installment registration fee even after the expiration of this period, but not later than 6 months following the expiration of that period.

(6) Where the second-installment registration fee and the registration surcharge payable pursuant to Article 43, paragraph (3) have not been paid within the period for late payment of the second-installment registration fee under the

preceding paragraph, the trademark right is deemed to have expired retroactive to the day which is five years prior to the expiration of the trademark right.

- (7) Notwithstanding Article 40, paragraph (2), a person filing an application for the registration of renewal of a trademark right may pay the prescribed registration fee by installments. In this case, that person must pay the amount specified by Cabinet Order not exceeding 25,400 yen, multiplied by the number of classes of goods or services, for each trademark registration at the time of filing of the application for the registration of renewal, and must also pay the amount specified by Cabinet Order not exceeding 25,400 yen, multiplied by the number of classes of goods or services, for each trademark registration no later than five years prior to the expiration of the trademark right.
- (8) The provisions of paragraphs (5) and (6) apply mutatis mutandis to the case where late payment of the registration fee to be paid not later than five years prior to the expiration of the trademark right under the preceding paragraph, is made. In this case, the term "paragraph (1)" in paragraph (5) is deemed to be replaced with "paragraph (7)".
- (9) The provisions of Article 40, paragraphs (3) through (5) apply mutatis mutandis to paragraphs (1) and (7).

(Restoration of a Trademark Right by Late Payment of a Second-Installment Registration Fee)

- Article 41-3 (1) Pursuant to Order of the Ministry of Economy, Trade and Industry, the original holder of a trademark right that was deemed to have expired pursuant to Article 41-2, paragraph (6) may make a late payment for the second-installment registration fee and the registration surcharge referred to in Article 43, paragraph (3), but only within the period provided for by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the original holder is found to have intentionally failed to pay the second-installment registration fee and the registration surcharge within the period during which it is permissible to make a late payment for the second-installment registration fee pursuant to Article 41-2, paragraph (5).
- (2) Where a late payment of the second-installment registration fee and the registration surcharge under Article 43, paragraph (3) is made under the preceding paragraph, the trademark right is deemed to have been existed retroactively since the day preceding the five years prior to the expiration.
  - (3) The provisions of the preceding two paragraphs apply mutatis mutandis where late payment of the registration fee to be paid not later than five years prior to the expiration of the trademark right and the registration surcharge under Article 43, paragraph (3) are made under paragraph (7) of the preceding Article.

(Limitations of Effects of Trademark Rights Restored by Late Payments of Second-Installment Registration Fees)

Article 41-4 (1) The effects of a trademark right restored pursuant to paragraph (2) of the preceding Article may not be effective against the following acts conducted after the expiration of the period for the late payment of a second-installment registration fee but before the registration that the trademark right is deemed to have been existed, pursuant to paragraph (2) of the preceding Article, under Article 41-2, paragraph (5):

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

(2) The provisions of the preceding paragraph apply mutatis mutandis to the effects of a trademark right restored pursuant to paragraph (2) of the preceding Article as applied mutatis mutandis pursuant to paragraph (3) of the preceding Article.

(Payment of Registration Fees by Interested Persons)

Article 41-5 (1) Any interested person may make payment of the registration fee (excluding the registration fee due and payable at the time of filing of an application for registration of renewal) even against the intention of the person by whom that 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 that fee was to have been paid, to the extent that person receives actual benefits therefrom.

(Refunding Registration Fees Already Paid)

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

- (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 trademark right under Article 41-2, paragraph (1) or 41-2, paragraph (7) (limited to the case where a ruling to cancel under Article 43-3, paragraph (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 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 ruling to cancel under

Article 43-3, paragraph (2) or, a trial or appeal decision becomes final and binding in the case of registration fees provided for in item (ii) of the preceding paragraph.

- (3) Where, due to reasons beyond the control of the person, the person filing a request for refund a registration fee is unable to file the request within the period as provided in paragraph (1), that person may, notwithstanding that paragraph, file the request within 14 days (two months for overseas residents) from the date on which the reasons for not filing ceased to be applicable, but not later than six months after the expiration of that period.

(Registration Surcharge)

Article 43 (1) In addition to the registration fee payable pursuant to Article 40, paragraph (2), a person filing an application for registration of renewal pursuant to Article 20, paragraph (3) or Article 21, paragraph (1) must pay a surcharge in an amount equivalent to the registration fee; provided, however, that if the person is unable to pay the registration fee within the period provided for in Article 20, paragraph (2) due to reasons beyond their control, the person is not required to pay the registration surcharge.

- (2) Where Article 41-2, paragraph (7) is applicable, in addition to the registration fee payable at the time of filing of the application for registration of renewal pursuant to Article 41-2, paragraph (7), a person filing an application provided for in the preceding paragraph must pay a surcharge in an amount equivalent to the registration fee; provided, however, that if the person is unable to pay the registration fee within the period provided for in Article 20, paragraph (2) due to reasons beyond their control, the person is not required to pay the registration surcharge.

- (3) Where Article 41-2, paragraph (5) (including cases where it is applied *mutatis mutandis* pursuant to paragraph (8) of the same Article; hereinafter the same applies in this paragraph) is applicable, in addition to the registration fee payable no later than five years prior to the expiration of the trademark right under paragraph (1) or (7) of that Article, the holder of trademark right must pay a surcharge in an amount equivalent to the registration fee; provided, however, that if, due to reasons beyond their control, the holder of the trademark right is unable to pay the second-installment registration fee provided for in Article 41-2, paragraph (5) within the period during which the holder is required to pay that fee, the holder is not required to pay the registration surcharge.

- (4) The surcharges under the preceding three paragraphs must be paid by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that the payment may be made in cash, if permitted by Order 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, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (1), (2) and (5), Article 51, paragraph (2) (including its mutatis mutandis application under Article 52-2, paragraph (2)), Article 53, paragraph (2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under Article 77, paragraph (3) of this Act; and
- (ii) where the trademark registration has been made in violation of a treaty; or
- (iii) where the trademark registration has been made for an application for trademark registration not satisfying the requirements under Article 5, paragraph (5).

### (Rulings)

Article 43-3 (1) Examination proceedings and ruling on opposition to registration is to be conducted by a panel consisting of three or five administrative judges.

(2) Where the administrative judges find the trademark registration pertaining to an opposition to registration falls under any of the items of Article 43-2, the administrative judges must render a ruling to the effect that the trademark registration is to be rescinded (hereinafter referred to as a "ruling to cancel").

(3) Where the ruling to cancel becomes final and binding, the relevant trademark right is deemed never to have existed.

(4) Where the administrative judges find the trademark registration pertaining to an opposition to registration does not fall under any of the items of Article 43-2, the administrative judges must render a ruling to the effect that the trademark registration is to be maintained.

(5) The ruling under the preceding paragraph does not be subject to appeal.

### (Formal Requirements for Filing an Opposition)

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

- (i) the name and the domicile or residence of the opponent to the registration and a representative 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 does not change the outline thereof; provided, however, that these provisions do not apply to any amendment with respect to the particulars provided for in item (iii) of the preceding paragraph 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 administrative judge must send a copy of the written opposition to the holder of trademark right.
- (5) The provisions of Article 46, paragraph (4) apply mutatis mutandis to the case where an opposition to registration is filed.

(Designation of Administrative Judges)

Article 43-5 The provisions of Articles 136, paragraph (2) and Articles 137 through 144 of the Patent Act as applied mutatis mutandis under Article 56, paragraph (1) of this Act apply mutatis mutandis to the panel under Article 43-3, paragraph (1) and the administrative judges constituting thereof.

(Trial Clerks)

Article 43-5-2 (1) The Commissioner of the Patent Office must designate a trial clerk for each case of opposition to registration.

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

(Procedure in Examination Proceedings)

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

(2) The provisions of Articles 145, paragraphs (3) through (7), Articles 146 and 147 of the Patent Act as applied mutatis mutandis under Article 56, paragraph (1) of this Act apply mutatis mutandis to oral proceedings provided for in the proviso to the preceding paragraph.

(3) Where any grounds for suspension or termination of examination proceedings is applicable to one of the joint holders of trademark rights for examination proceedings and ruling on an opposition to registration, that suspension or termination has effect on all such joint holders of trademark rights.

(Intervention)

Article 43-7 (1) In examination proceedings 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 proceedings in order to assist the holder of trademark right until the ruling on opposition to registration is rendered.

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

(Examination of and Preservation of Evidence)

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

(Ex Officio Examinations)

Article 43-9 (1) In examination proceedings 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 examination proceedings of an opposition to registration, no examination may be conducted on any designated goods or designated services for which the opposition to registration is not raised.

(Joint or Separate Filing of Opposition)

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 examination proceedings thereof are to be conducted jointly.

(2) Examination proceedings 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) The provisions of Article 155, paragraph (3) of the Patent Act as applied mutatis mutandis under Article 56, paragraph (2) of this Act apply mutatis

mutandis to the withdrawal of an opposition to registration.

(Notification of Reasons for Cancel)

Article 43-12 Where the chief administrative judge intends to render a ruling to cancel, the chief administrative judge must notify the holder of trademark right and the intervenor of the reasons for cancel of the trademark registration and give those parties an opportunity to submit a written opinion, designating a reasonable time limit.

(Formal Requirements of Rulings)

Article 43-13 (1) A ruling on an opposition to registration must be rendered in writing stating the following particulars:

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

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

(Scope of Final and Binding Rulings)

Article 43-14 A ruling with regard to an opposition to registration become final and binding for each case of opposition to registration; provided, however, that the ruling with regard to an opposition to registration filed against the designated goods or designated services becomes final and binding for each of the designated goods or services.

(Mutatis Mutandis Application of Provisions Concerning Trials and Appeals)

Article 43-15 (1) The provisions of Article 133, Article 133-2, Article 134, paragraph (4), Article 135, Article 152, Article 168, Article 169, paragraphs (3) through (6) and Article 170 of the Patent Act as applied mutatis mutandis under Article 56, paragraph (1) of this Act apply mutatis mutandis to examination proceedings and rulings on oppositions to registration.

(2) The provisions of Article 43-3, paragraph (5) of this Act apply mutatis mutandis to a ruling under Article 135 of the Patent Act as applied mutatis mutandis under the preceding paragraph.

## Chapter V Trials and Appeals

### (Appeals Against Decisions of Refusal)

- Article 44 (1) A person who has received an examiner's decision to the effect that an application is refused, and is dissatisfied with that decision, may file a request for appeal against the examiner's decision of refusal within three months 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 appeal pursuant to the preceding paragraph is unable to file the request within the period as provided in the preceding paragraph, that person may, notwithstanding that paragraph, file the request within 14 days (two months for overseas residents) from the date on which the reasons for not filing ceased to be applicable, but not later than six months after the expiration of that period.

### (Appeals Against Dismissal of Request for Amendments)

- Article 45 (1) Any person who has received a ruling of dismissal of amendments under Article 16-2, paragraph (1) and is dissatisfied may file a request for appeal against the ruling within three months from the date the transcript of the ruling has been served; provided, however, that these provisions do not apply where a new application for trademark registration provided in Article 17-3, paragraph (1) of the Design Act as applied *mutatis mutandis* pursuant to Article 17-2, paragraph (1) of this Act is filed.
- (2) The provisions of Article 44, paragraph (2) apply *mutatis mutandis* to a request for appeal under the preceding paragraph.

### (Trials on the Invalidation of Trademark Registration)

- Article 46 (1) Where a trademark registration falls under any of the following items, a request for a trial on the 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, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (1), (2), and (5), Article 51, paragraph (2) (including cases where it is applied *mutatis mutandis* pursuant to Article 52-2, paragraph (2)), Article 53, paragraph (2) of this Act or Article 25 of the Patent Act as applied *mutatis mutandis* pursuant to Article 77, paragraph (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 for an application for trademark registration not satisfying the requirements under Article 5,

- paragraph (5);
- (iv) 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;
  - (v) 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, paragraph (3) of this Act, or the trademark registration has become in violation of a treaty;
  - (vi) where, after the trademark registration, the registered trademark has become a trademark that falls under any of Articles 4, paragraph (1), item (i) through 4, paragraph (1), item (iii), 4, paragraph (1), item (v), 4, paragraph (1), item (vii) and 4, paragraph (1), item (xvi); or
  - (vii) 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, paragraph (1).
- (2) A request for a trial under the preceding paragraph may be filed only by an interested person.
- (3) A request for a trial under paragraph (1) may be filed even after the extinction of the trademark right.
- (4) Where a request for a trial is filed under paragraph (1), the chief administrative judge shall notify the holder of exclusive right to use the trademark right relating thereto or any other person who holds any right registered with regard to the trademark registration, of the fact.

- 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 is deemed never to have existed; provided, however, that where the trademark registration falls under any of items (v) through (vii) of Article 46, paragraph (1) and a trial decision to the effect that the trademark registration is to be invalidated becomes final and binding, the trademark right is deemed not to have existed from the time any of items (v) through (vii) of that 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 (v) through (vii) of Article 46, paragraph (1) first became applicable to the trademark registration cannot be specified, the trademark right is deemed not to have existed from the date of registration of the request for invalidation trial of that trademark registration.

Article 47 (1) Where a trademark registration has been made in violation of Article 3, 4, paragraph (1), item (viii), Article 4, paragraph (1), items (xi) through (xiv), Article 8, paragraph (1), (2) or (5), where a trademark registration has been made in violation of Article 4, paragraph (1), item (x) or (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 item (xv) of that paragraph (excluding the case where a trademark has been registered for unfair purposes), or where a trademark registration falls under Article 46, paragraph (1), item (iv), a request for a trial relating to the trademark registration under Article 46, paragraph (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, paragraph (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, paragraph (1) may not be filed.

Article 48 and Article 49 Deleted

(Trials for Rescission of Trademark Registration)

Article 50 (1) Where a registered trademark 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 the 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 holders of trademark rights, exclusive rights to use or non-exclusive rights 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 does 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 rights, exclusive rights to use or non-exclusive rights 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 request for a trial would be filed, the use of the registered trademark does not fall under the use of the registered trademark provided in paragraph (1); provided, however, that this does not apply to cases where the demandee shows just cause 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 can be confused with the goods or services pertaining to business of another person, any person may file a request for a trial for cancel of the trademark registration.

- (2) The previous holder of a 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 canceled, 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 canceled under the preceding paragraph becomes final and binding.

Article 52 A request for a trial under Article 51, paragraph (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 that 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 on the grounds set forth in the items of Article 24-4, 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 can be confused 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 cancellation of the trademark registration.

(2) The provisions of Articles 51, paragraph (2) and Article 52 apply mutatis mutandis to a trial under the preceding paragraph.

Article 53 (1) Where a holder of an exclusive right to use or a 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 can be confused with the goods or services pertaining to business of another person, any person may file a request for a trial for rescission of the trademark registration; provided, however, that this does not apply to cases where the holder of trademark right was not aware of the fact and exercised 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 canceled under the preceding paragraph becomes final and binding.

(3) The provisions of Article 52 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 party 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 those 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 their agent or representative or by their 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 canceled becomes final and binding, the trademark right expires thereafter.

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

Article 55 The provisions of Article 46 (4) apply mutatis mutandis to the case where a request for a trial is filed under Article 50, paragraph (1), 51, paragraph (1), Article 52-2, paragraph (1), Article 53, paragraph (1) or Article 53-2.

(Special Provisions on Appeals Against Examiner Decisions of Refusal)

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

(2) The provisions of Article 16 apply mutatis mutandis where a request for appeal under Article 44, paragraph (1) is found to have reasonable grounds; provided, however, that these provisions do not apply where a decision on an appeal to the effect that further examination proceedings are to be carried out under Article 160, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 56, paragraph (1) of this Act is rendered.

(3) The provisions of Article 16-2 of this Act and Article 17-3 of the Design Act apply mutatis mutandis to appeals under Article 44, paragraph (1) of this Act. In this case, the term "three months" in Article 16-2, paragraph (3) of this Act and Article 17-3, paragraph (1) of the Design Act is deemed to be replaced with "thirty days" and the phrase "files a request for an appeal under Article 45, paragraph (1)" in Article 16-2, paragraph (4) is deemed to be replaced with "institutes an action under Article 63, paragraph (1)".

(Scope of Final and Binding Trial or Appeal Decisions)

Article 55-3 Trial and appeal decision become final and binding for each trial or

appeal case; provided, however, that the trial decision of a request for trial under Article 46, paragraph (1) of this Act filed for each designated goods or designated services is final and binding for each designated goods or designated services.

(Mutatis Mutandis Application of the Patent Act)

- Article 56 (1) The provisions of Articles 131, paragraph (1), Article 131-2, paragraph (1) (excluding items (ii) and (iii)), Articles 132 through 133-2, Article 134, paragraphs (1), (3) and (4), Articles 135 through 154, Article 155, paragraphs (1) and (2), Article 156, paragraphs (1), (3) and (4), Article 157, Article 158, Article 160, paragraphs (1) and (2), Article 161, Article 167, Articles 168 through 170 (effect of trial or appeal decisions, requests for trial or appeals, administrative judge, trial or appeal procedures in relation to litigation, and costs of trials or appeals) of the Patent Act apply mutatis mutandis to trial or appeals. In this case, the term "ground for the request as provided in paragraph (1) item (iii) of the preceding Article in the course of filing a request for trials or appeals other than invalidation trial, or in the event that approval is granted by the chief administrative judge under the following paragraph" in Article 131-2, paragraph (1) of the Patent Act is deemed to be replaced with "ground for the request as provided in Article 131, paragraph (1), item (iii) of the Patent Act as applied mutatis mutandis pursuant to Article 56, paragraph (1) of this Act in the course of filing a request for trials and appeals other than trials under Article 46, paragraph (1) of the Trademark Act", the term "invalidation trial or invalidation trial of the registration of extension of term" in Articles 132, paragraph (1) and 167 of the Patent Act and the term "invalidation trial and an invalidation trial of the registration of extension of term" in Articles 145, paragraph (1) and 169, paragraph (1) of the Patent Act are deemed to be replaced with "trials under Article 46, paragraph (1), Article 50, paragraph (1), Article 51, paragraph (1), Article 52-2, paragraph (1), Article 53, paragraph (1) or Article 53-2 of the Trademark Act", the phrase ", in trials and appeals other than invalidation trial, notify" in Article 156, paragraph (1) of the Patent Act is deemed to be replaced with "notify", the terms "appeal against the examiner's decision of refusal" in Article 161 of the Patent Act and "appeal against an examiner's decision of refusal and correction trial" in Article 169, paragraph (3) of the Patent Act are deemed to be replaced with "appeals under Article 44, paragraph (1) or Article 45, paragraph (1) of the Trademark Act".
- (2) The provisions of Article 155, paragraph (3) (withdrawal of a request for trial or appeal) of the Patent Act apply mutatis mutandis to a trial under Article 46, paragraph (1) of this Act.

(Mutatis Mutandis Application of the Design Act)

Article 56-2 The provisions of Article 51 of the Design Act apply mutatis mutandis to an appeal under Article 45, paragraph (1) of this Act.

## **Chapter VI Retrial and Litigation**

(Request for a Retrial)

Article 57 (1) A party or intervener in a case may file a request for a retrial against a final and binding ruling to cancel or a final and binding decision on appeal.

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

Article 58 (1) Where the demandant of trials and appeals in conspiracy with the demandee has had trial or appeal decision 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 or appeal decisions.

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

(Limitations of Effects of Trademark Rights 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 has 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 ruling to cancel 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 ruling to cancel 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 trial decision has been registered through a retrial, and where a person, after the ruling to cancel 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, the 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 has the right to use the trademark in connection with the goods or services as far as those person continuously uses the trademark for the goods or services. The same applies to those by whom the business is succeeded.

(2) The provisions of Article 32, paragraph (2) apply mutatis mutandis to the preceding paragraph.

(Mutatis Mutandis Application of Provisions Concerning Trials and Appeals)

Article 60-2 (1) The provisions of Article 43-3, Articles 43-5 through 43-9 and Articles 43-12 through 43-15 of this Act, Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraph (3), Article 154, Article 155, paragraph (1) and Article 156, paragraphs (1), (3), and (4) of the Patent Act as applied mutatis mutandis pursuant to Article 56, paragraph (1) of this Act, and Article 155, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 56, paragraph (2) of this Act apply mutatis mutandis to a retrial against a final and binding ruling to cancel.

(2) The provisions of Article 55-2 and Article 55-3 apply mutatis mutandis to a retrial against a final and binding decision on appeal on appeals under Article 44, paragraph (1).

(3) The provisions of Article 55-3 and Article 56-2 apply mutatis mutandis to a retrial against a final and binding decision on appeal on appeals under Article 45, paragraph (1).

(4) The provisions of Article 55-3 apply mutatis mutandis to a retrial against a final and binding trial decision on trials under Article 46, paragraph (1), Article 50, paragraph (1), Article 51, paragraph (1), Article 52-2, paragraph (1), Article 53, paragraph (1) or Article 53-2.

(Mutatis Mutandis Application of the Patent Act)

Article 61 The provisions of Article 173 (Time limit for request for retrial) and Article 174, paragraph (3) and Article 174, paragraph (5) (Application mutatis mutandis of provisions regarding trials) of the Patent Act apply mutatis mutandis to a request for a retrial. In this case, the term "Articles 167 through 168" in paragraph (3) of those Article is deemed to be replaced with "Article 167, Article 168", the term "invalidation trial or invalidation trial of the registration of extension" in Article 174, paragraph (2) of the Patent Act is deemed to be replaced with "trials and appeals under Article 46, paragraph (1), Article 50, paragraph (1), Article 51, paragraph (1), Article 52-2, paragraph (1), Article 53, paragraph, (1) or Article 53-2 of the Trademark Act".

(Mutatis Mutandis Application of the Design Act)

Article 62 (1) The provisions of Article 58, paragraph (2) (mutatis mutandis application of provisions concerning appeals) of the Design Act apply mutatis mutandis to a retrial against a final and binding decision on appeal on appeals under Article 44, paragraph (1) of this Act. In this case, the term "the main clause of Article 167-2, Article 168" in Article 58, paragraph (2) of the Design Act is deemed to be replaced with "Article 168".

(2) The provisions of Article 58, paragraph (3) of the Design Act apply mutatis mutandis to a retrial against a final and binding decision on appeal on appeals under Article 45, paragraph (1) of this Act. In this case, the term "the main clause of Article 167-2, Article 168" in Article 58, paragraph (3) of the Design Act is deemed to be replaced with "Article 168".

(Actions against Trial or Appeal Decision)

Article 63 (1) The Tokyo High Court has exclusive jurisdiction over any action against a ruling to cancel or trial or appeal decision, an action against a ruling to dismiss an amendment under Article 16-2, paragraph (1) as applied mutatis mutandis pursuant to Article 55-2, paragraph (3) (including cases where it is applied mutatis mutandis pursuant to Article 60-2, paragraph (2)) and an action against a ruling to dismiss a written opposition or a written request for an trial or appeal, or retrial.

(2) The provisions of Article 178, paragraphs (2) through (6) (time limit for institution of action, etc.), Articles 179 through 182 (appropriate party as defendant, notice of institution of action, opinion of the Commissioner of the Patent Office in an action for revocation of a trial or appeal decision, rescission of a trial or appeal decision or ruling and delivery of original copy, etc. of judgment) of the Patent Act apply mutatis mutandis to the actions under the preceding paragraph. In this case, the term "invalidation trial or invalidation trial of the registration of extension " in Article 179 of the Patent Act is deemed to be replaced with "trials under Article 46, paragraph (1), Article 50, paragraph (1), Article 51, paragraph (1), Article 52-2 paragraph (1), Article 53, paragraph (1) or Article 53-2 of the Trademark Act".

## **Chapter VII Defensive Trademarks**

(Requirements for Defensive Trademark 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 a trademark right, the holder of the 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 those other person's goods or services and the designated goods pertaining to their 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 those other person's services or goods and the designated services pertaining to their 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) To apply the preceding two paragraphs in relation to defensive mark registrations pertaining to a trademark right pertaining to a regionally-based collective trademark, the phrase "their own" in those paragraphs is deemed to be replaced with "its own or its members".

#### (Conversion of Applications)

Article 65 (1) An applicant for a trademark registration may convert an application for trademark registration into an application for a 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 or appeal decision on the application for trademark registration becomes final and binding.
- (3) The provisions of Article 10, paragraph (2) and, (3), Article and 11, paragraph (5) apply mutatis mutandis to the conversion of an application under paragraph (1).

#### (Term of Rights based on Defensive Mark Registration)

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

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

(Registration of Renewal of the Duration of a Right based on Defensive Mark Registration)

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

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

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

(3) If a person filing an application for registration of renewal of a right based on defensive mark registration has been unable to file the application for registration of renewal within the period during which it is permissible to file that application pursuant to the preceding paragraph, that person may file the application pursuant to Order of the Ministry of Economy, Trade and Industry, but only within the period provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply if the person is found to have intentionally failed to file an application for registration of renewal within the period during which it is permissible to file that application pursuant to the preceding paragraph.

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

Article 65-4 (1) Where an application for registration of renewal of a right based on defensive mark registration falls under any of the following items, the examiner must 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 a right based on defensive mark registration, the

examiner must 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 Article 48 (exclusion of examiners) and Article 52 (formal requirements for examination proceedings) of the Patent Act apply mutatis mutandis to examination proceedings of an application for registration of renewal of a right based on defensive mark registration.

(Registration of Renewal of the Term of a Right based on Defensive Mark Registration)

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

(2) Upon registration under the preceding paragraph, the following particulars must 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 particulars beyond 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 must pay, as a registration fee for each defensive mark registration, the amount specified by Cabinet Order not exceeding 32,900 yen, multiplied by the number of classes of goods or services.

(2) A person obtaining a registration of renewal of a right based on defensive mark registration must pay, as a registration fee for each defensive mark registration, the amount specified by Cabinet Order not exceeding 37,500 yen, multiplied by the number of classes of goods or services.

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

(Time Limit for the Payment of Registration Fees)

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

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

expiration of the right based on defensive mark registration, the date of expiration).

- (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.
- (4) Where a person required to pay a registration fee is unable to pay the registration fee within the period under paragraph (1) or (2) (where the period under the preceding paragraph is extended, the extended period), that person may, in accordance with Order of the Ministry of Economy, Trade and Industry, pay that registration fee only within the period as provided by Order of the Ministry of Economy, Trade and Industry, even after the expiration of the period.
- (5) Where, due to reasons beyond their control, the person paying a registration fee is unable to pay the registration fee within the period provided in the preceding paragraph, that person may, notwithstanding that paragraph, pay the registration fee within 14 days (two months for overseas residents) from the date on which the reasons for not paying ceased to be applicable, but not later than six months after the expiration of that period.

#### (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 (2) even against the intention of the person by whom that 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 who was to make that payment to reimburse the payment expenses to the extent that person receives actual benefits therefrom.

#### (Refund of Registration Fees Paid in Excess or in Error)

- Article 65-10 (1) A registration fee under Article 65-7 (1) or (2) paid in excess or in error must 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 one year has passed since the date of payment.
  - (3) Where a person making a request for a registration fee refund as prescribed in paragraph (1) is unable to make the request within the period prescribed in the preceding paragraph due to reasons beyond their control, that person may make a request within 14 days (within 2 months for overseas residents) from the date the reason beyond their control ceased to be applicable, but no later than 6 months after the aforementioned one-year period has passed, notwithstanding the provisions of paragraph (1).

(Incidental Nature of Rights based on Defensive Mark Registration)

Article 66 (1) A right based on a defensive mark registration expires when the trademark right relating thereto is divided.

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

(3) When a trademark right expires, the right based on a defensive mark registration relating thereto also expires.

(4) Where a trademark right is deemed to have expired under Article 20, paragraph (4), the effects of the right based on defensive mark registration pertaining to the trademark right restored under Article 21, paragraph (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 period for the filing of an application for registration of renewal provided in Article 20, paragraph (3) but before the registration of renewal of the trademark right by an application under Article 21, paragraph (1).

(5) Where a trademark right is deemed to have been extinguished under Article 41-2 paragraph (6), the right based on defensive mark registration pertaining to the trademark right restored under Article 41-3 paragraph (2) is not effective against the acts provided in each of the items of Article 67 conducted after the expiration of the period for making late payment of a second-installment registration fee but before the registration to the effect that the trademark right is deemed to have been existed under Article 41-3, paragraph (2) is made, pursuant to Article 41-2, paragraph(5).

(6) The provisions of the preceding paragraph apply mutatis mutandis to the effects of the right based on defensive mark registration pertaining to the trademark right restored under Article 41-3, paragraph (2) as applied mutatis mutandis pursuant to Article 41-3, paragraph (3).

(Acts Deemed to Constitute Infringement)

Article 67 The following acts are 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 a registered defensive mark on those goods or their packaging;

(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 those services, for the purpose of the provision of those services through use of those 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 those services, for the purpose of causing the provision of those services through use of those 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 having the registered defensive mark 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 having the registered defensive mark used in connection with the designated goods or designated services.

(Mutatis Mutandis Application of Provisions Concerning Trademarks)

Article 68 (1) The provisions of Article 5, Article 5-2, Article 6, paragraph (1), Article 6, paragraph (2), Articles 9-2 through 10, Article 12-2, Article 13, paragraph (1), and Article 13-2 apply mutatis mutandis to an application for defensive mark registration. In this case, the phrase "(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, paragraph (2)" in Article 5, paragraph (1) is 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, paragraph (2), (iv) the registration number of the trademark registration pertaining to the application for defensive mark registration", the phrase "(iv) the designated goods or designated services are not stated" in Article 5-2, paragraph (1) is 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, paragraph (5) is deemed to be replaced with "Article 67 (except the part pertaining to item (i))".

(2) The provisions of Articles 14 through 15-2 and 16 through 17-2 apply mutatis mutandis to the examination proceedings of an application for defensive mark registration. In this case, the term "Article 3, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (2) and (5), Article 51, paragraph (2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2, paragraph (2)), Article 53, paragraph (2)" in Article 15, item (i) is deemed to be replaced with "Article 64", and the term "Article 5, paragraph (5), or Article 6,

paragraph (1) or (2)" in Article 15, item (iii) is deemed to be replaced with "Article 6, paragraph (1) or (2)".

- (3) The provisions of Article 18, Articles 26 through 28-2, Articles 32 through 33-3, Article 35, Article 38-2 and Article 69 of this Act and Article 104-3, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 39 of this Act apply to a right based on defensive mark registration. In this case, the term "the registration fee under Article 40, paragraph (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 trial or appeal decisions to the effect that the trademark is to be registered pursuant to Article 41-2, paragraph (1)" in Article 18, paragraph (2) is deemed to be replaced with "the registration fee under Article 65-7, paragraph (1)".
- (4) The provisions of Article 43-2 (except item (iii)) to Article 45, Article 46 (except paragraph (1), items (iii) and (vii)), Article 46-2, Article 53-2, Article 53-3, Article 54, paragraph (1) and Articles 55-2 through 56-2 apply mutatis mutandis to an opposition to registration and trial pertaining to defensive mark registration. In this case, the term "Article 3, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (1), (2) and (5), Article 51, paragraph(2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2, paragraph (2)), and Article 53 paragraph(2)" in Article 43-2, item (i) and Article 46, paragraph (1), item (i) is deemed to be replaced with "Article 64" and the phrase "where ... the registered trademark has become a trademark that falls under any of Article 4, paragraph (1), items (i) through (iii), (v), and (vii), or Article 4, paragraph (1), item (xvi)" in Article 46, paragraph (1), item (vi) is deemed to be replaced with "where ... the trademark registration becomes in violation of Article 64".
- (5) The provisions of the preceding Chapter 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, item (ii) is deemed to be replaced with "Article 67, items (ii) through (vii)", the term "a trademark right pertaining to ... trademark registration" in Article 60 is 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 is 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 a right based on defensive mark registration", the term "the establishment of a trademark right ... has been registered" in the same Article is deemed to be replaced with "the establishment of a right based on defensive mark registration or the renewal 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 is deemed to be replaced with "a trademark identical with the registered defensive mark".

**Chapter VII-2 Special Provisions under the Protocol Relating to the  
Madrid Agreement  
Section 1 Applications for International Registration**

(Applications for International Registration)

- Article 68-2 (1) A Japanese national or a foreign national domiciled or resident (or, in the case of a corporation, 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, paragraph (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") must file an application with the Commissioner of the Patent Office (hereinafter referred to as an "application for international registration") pursuant to Article 2, paragraph (2) of the Protocol based on any of the following items; in this case, where requirements provided by Order 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 must submit the prescribed application and required documents in foreign language pursuant to Order of the Ministry of Economy, Trade and Industry.
- (3) The application must state the following:
- (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, paragraph (2).
- (4) Any person who desires to apply Article 3, paragraph (3) of the Protocol in connection with a trademark or a mark pertaining to the application for international registration must 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.

- (5) Any person who desires to file an application for international registration by electronic or magnetic means (excluding the means specified by Cabinet Order) must pay an amount equivalent to the amount specified by Cabinet Order, in view of the actual costs to the International Bureau provided in Article 2 (1) of the Protocol (hereinafter referred to as the "International Bureau").

Article 68-3 (1) The Commissioner of the Patent Office must send the application for international registration and the required documents to the International Bureau.

- (2) In the case of the preceding paragraph, where the particulars stated in the application correspond to the particulars stated in the basic application for trademark registration, etc. or in the basic trademark registration, etc., the Commissioner of the Patent Office must 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 is to send to the applicant for international registration a copy of the application for international registration sent to the International Bureau.

(Subsequent Designations)

Article 68-4 The registered holder of an international registration may present to the Commissioner of the Patent Office, pursuant to Order of the Ministry of Economy, Trade and Industry, a request for territorial extension provided in Article 3-3 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 International Registration)

Article 68-5 The registered holder of international registration may file with the Commissioner of the Patent Office, pursuant to Order of the Ministry of Economy, Trade and Industry, an application for renewal of international registration provided in Article 7, paragraph (1) of the Protocol (hereinafter referred to as "renewal of international registration").

(Request for Recording Changes in the Ownership of International Registration)

Article 68-6 (1) The registered holder or transferee of international registration may, pursuant to Order 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 Applications for Trademark Registration)

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

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

Article 68-8 Beyond the provisions of Articles 68-2 through 68-7, details of particulars relating to applications for international registration, subsequent designation, applications for renewal 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 must be provided by Order of the Ministry of Economy, Trade and Industry.

## **Section 2 Special Provisions for International Applications for Trademark Registration**

(Applications for Trademark Registration based on Requests for Territorial Extension)

Article 68-9 (1) Any request for territorial extension to designate Japan is deemed to be an application for trademark registration filed on the date of international registration provided in Article 3 paragraph (4) of the Protocol (hereinafter referred to as the "date of international registration"); provided, however, that in the case of subsequent designation, the request is 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 3-3, paragraph (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, paragraph (1) (hereinafter referred

to as the "International Register").

(2) Particulars stated in the left column of the following table contained in the International Register for the international registration designating Japan are deemed to be the stated in the right column of that table contained in the application submitted pursuant to Article 5, paragraph (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);
Among matters stated in the International Register, those required for the interpretation of the meanings of statement of the trademark that is a subject of an international registration provided by Ordinance of the Ministry of Economy, Trade and Industry	Detailed description of the trademark

(Special Provisions on the Time of Filing of an 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, paragraph (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 is 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 apply mutatis mutandis to the international application for trademark registration under the preceding paragraph.

(Special Provisions on the Time of Filing of Applications)

Article 68-11 To apply Article 9, paragraph (2) to an international application for trademark registration, the phrase "at the paragraph time of filing of the application for trademark registration" in the paragraph is deemed to be replaced with "within thirty days from the date of the international application for trademark registration".

(Special Provisions on the Division of Applications)

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

(Special Provisions Concerning Conversion of Applications)

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

(Special Provisions on Particulars to be Contained in the Trademark Bulletin Regarding Publication of Applications)

Article 68-14 To apply Article 12-2, paragraph (2) to the international application for trademark registration, the term "the number and date of the application for trademark registration" in item (ii) of that paragraph is deemed to 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 on Proceedings for Priority Claims Governed by the Paris Convention)

Article 68-15 (1) The provisions of paragraphs (1) through (4), and (7) through (9) of Article 43 of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13, paragraph (1) of this Act do not apply to an international application for trademark registration.

(2) To apply Article 43, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13, paragraph (1) of this Act to the international application for trademark registration, the phrase "within the period provided by Order of the Ministry of Economy, Trade and Industry" in those paragraph is deemed to be replaced with "within thirty days from the date of the international application for

trademark registration".

(Special Provisions Concerning Rights Deriving from Applications for Trademark Registration)

Article 68-16 (1) To apply Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (2) of this Act to the international application for trademark registration, the phrase ", except in the case of general succession including inheritance, without the Commissioner of the Patent Office" in that paragraph is deemed to be replaced with "without notification to the International Bureau provided in Article 68-2, paragraph (5) of the Trademark Act".

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

(Treatment of International Applications for Trademark Registration in Cases 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 is deemed to have become applications for trademark registration with respect to each of the registered holders after the change.

(Special Provisions Concerning New Applications for Trademarks as Amended)

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

(Special Provisions on Formal Requirements for Examiner's Decisions for Trademark Registration)

Article 68-18-2 (1) To apply Article 52, paragraph (2) of the Patent Act, as applied mutatis mutandis pursuant to Article 17, to an international application for trademark registration, the Commissioner of the Patent Office, pursuant to Order of the Ministry of Economy, Trade and Industry, may notify the international registration's holder of the matters stated in an examiner's decision (limited to an examiner's decision that the trademark is to be

registered under Article 16) via the International Bureau, in lieu of serving a transcript of the examiner's decision under Article 52, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 17.

- (2) In the case referred to in the preceding paragraph, when the notice under that paragraph is recorded in the International Register, the service provided for in that paragraph is deemed to have been effected.

(Special Provisions Concerning Registration of Establishment of Trademark Rights)

Article 68-19 (1) To apply Article 18, paragraph (2) to the international application for trademark registration, the phrase "where the registration fee under Article 40, paragraph (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 or appeal decision to the effect that the trademark is to be registered under Article 41-2, paragraph (1) is paid" in that paragraph is deemed to be replaced with "if an examiner's decision or trial or appeal decision that a trademark is to be registered is rendered".

- (2) To apply Article 18, paragraph (3) to the international application for trademark registration, in item (ii) of this paragraph the term "the number and date of the application for trademark registration" is deemed to 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 that paragraph the term "the registration number and the date of registration of establishment" is deemed to be replaced with "the number of international registration and the date of registration of the establishment".

(Effect of the Expiration 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 expired, the international application for trademark registration is deemed to have been withdrawn in respect of all or a portion of the designated goods or designated services that have expired.

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

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

(Term of Trademark Right based on International Registration)

Article 68-21 (1) The term of a trademark right based on international registration expires after ten years from the date of the international registration (where the term 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 term of a trademark right based on international registration may be renewed based on the renewal of international registration.
- (3) Where the term of international registration is renewed, the term of the trademark right based on international registration must be renewed at the time of expiration.
- (4) Where the term of international registration is not renewed, the trademark right based on international registration is deemed to have become invalid retroactively at the time of expiration.

(Special Provisions Concerning Registration of the Renewal of a Term)

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

- (2) To apply Article 23, paragraph (3) relating to a trademark right based on international registration, the term "registration as set forth under the preceding two paragraphs" in this paragraph is deemed to be replaced with "renewal of international registration" and the term "the registration number and the date of registration of renewal" in item (ii) of that paragraph is deemed to be replaced with "the number of international registration and the date of renewal of international registration".

(Special Provisions Concerning the Division of a Trademark Right)

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

(Special Provisions for the Transfer of Collective Trademark Rights)

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

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

(Special Provisions for Waivers of Trademark Rights)

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

(2) Article 34-2 does not apply to a trademark right based on international registration.

(Special Provisions on Effects of the Registration of Trademark Rights)

Article 68-26 (1) A transfer, modification due to trust, extinction by waiver or restriction on disposition of a trademark right based on international registration has no effect unless registered.

(2) Article 98, paragraph (1), item (i) and Article 98, paragraph (2) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 35 of this Act does not apply to a trademark right based on international registration.

(Special Provisions for Registration in the Trademark Register)

Article 68-27 (1) To apply Article 71, paragraph (1), item (i) to a trademark right based on international registration, the term "the establishment, renewal, division, transfer, modification, extinction, restoration or restriction on disposition of a trademark right" in that item is deemed to be replaced with "the establishment, modification due to trust or restriction on disposition of a trademark right".

(2) The renewal, the transfer, the modification (excluding a modification due to trust) or the extinction of a trademark right based on international registration has effect in accordance with that registration in the International Register.

(Special Provisions for the Amendment of Proceedings)

Article 68-28 (1) After receiving a notification under 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))), any amendment to the designated goods or services stated in the international application for a trademark registration may be made only when the case is a pending examination, appeal/trial or retrial.

(2) The provisions of Article 68-40 do not apply to an international application for trademark registration, except for particulars deemed to be the detailed description of a trademark under Article 68-9, paragraph (2).

(Extra Provisions Relating to Special Provisions on Trademark Right Covering Two or More Designated Goods or Designated Services)

Article 68-29 To apply Article 69 relating to a trademark right based on international registration, the term "Article 20, paragraph (4), Article 33, paragraph (1) or Article 34-2 of this Act, Article 98, paragraph (1), item (i) of the Patent Act as applied mutatis mutandis pursuant to Article 35 of this Act" in Article 69 is deemed to be replaced with "Article 33, paragraph (1), Article 68-25, paragraph (1) or Article 68-26, paragraph (1)" and the term "Article 71, paragraph (1), item (i)" in Article 69 is deemed to be replaced with "Article 71, paragraph (1), item (i) as applied mutatis mutandis upon reading the specified terms in accordance with Article 68-27, paragraph (1), Article 68-27, paragraph (2)".

(Individual Fees for Trademark Rights 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 must pay an amount equivalent to the amount specified by Cabinet Order not exceeding 6,000 yen plus the amount specified by Cabinet Order not exceeding 47,900 yen for one class of goods or services to the International Bureau as the individual fee provided for in Article 8, paragraph (7), item (a) of the Protocol (hereinafter referred to as the "individual fee") for each registration, prior to international registration.
- (2) A person requesting the renewal of a trademark right based on international registration must pay as the individual fee to the International Bureau for each registration an amount equivalent to the amount specified by Cabinet Order not exceeding 43,600 yen, multiplied by the number of classes of goods or services.
- (3) Articles 40 through 43 and Article 76, paragraph (2) (limited to the portion listed under item (i) of the appended table) do not apply to an application for international trademark registration and a trademark right based on the international registration.

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

Article 68-31 Beyond the provisions of Articles 68-9 through 68-30, details of particulars required for the implementation of the Protocol and the regulations thereunder must be provided by Order of the Ministry of Economy, Trade and Industry.

### **Section 3 Special Provisions For Applications For Trademark Registration**

(Special Provisions for 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, paragraph (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 those goods or services.
- (2) Where an application for trademark registration under the preceding paragraph falls under all of the following items, the application is deemed to have been filed on the date of international registration (where the international registration under those paragraph is pertaining to the subsequent designation, the date of the subsequent designation pertaining to the international registration) of the international registration under those 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 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) When 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 paragraph also enjoys the same right of priority.
- (4) The preceding paragraph also applies to the cases where an international application for trademark registration pertaining to an international registration under paragraph (1) enjoyed a right of priority pursuant to Article 43-3, paragraph (2) of the Patent Act as applied *mutatis mutandis* upon reading the specified terms in accordance with Article 9-3 or Article 13, paragraph (1) of this Act.
- (5) To apply Article 10, paragraph (1) to an application for trademark registration under paragraph (1), the term "part of an application" in that paragraph is deemed to 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, paragraph (1))".
- (6) Notwithstanding paragraph (2), item (i), when the person filing an application for trademark registration under paragraph (1) is unable to file the application

within the period as provided for in that item due to reasons beyond their control, that person may file the application within 14 days (two months for overseas residents) from the date on which the reasons for not filing ceased to be applicable, but not later than six months after the expiration of that period.

- (7) The application for trademark registration filed under the preceding paragraph is deemed to have been filed at the time of expiration of the time limit under paragraph (2), item (i).

(Special Provisions Concerning Applications for Trademark Registration after Denunciation of Protocol)

Article 68-33 (1) When, pursuant to Article 15, paragraph (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, paragraph (1) of the Protocol, the person who was the registered holder of that international registration may file an application for trademark registration in connection with the goods or services listed in that international registration.

- (2) The provisions of Article 68-32, paragraphs (2) through (7) apply mutatis mutandis to an application for trademark registration under the preceding paragraph. In this case, the phrase "within three months from the date on which the international registration under that paragraph was rescinded" in paragraph (2), item (i) of that Article is deemed to be replaced with "within two years from the date on which the denunciation under Article 15, paragraph (3) of the Protocol took effect".

(Special Provisions on Reasons for Refusal)

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

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

(Special Provisions on Registration of the Establishment of Trademark Rights)

Article 68-35 Notwithstanding Article 18, paragraph (2), where, in connection with an application for trademark registration under Article 68-32, paragraph (1) or Article 68-33, paragraph (1), the examiner's decision or the trial or appeal 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 associated with that application (where the term of the international registration has been renewed, the date of most recent renewal), registration establishing the trademark right is made.

(Special Provisions on Terms for Trademarks)

Article 68-36 (1) The term of a trademark right provided in Article 68-35 expires after ten years from the date of the international registration of the international registration pertaining to that application (where the term of the international registration has been renewed, the date of most recent renewal).  
(2) The provisions of Article 19, paragraph (1) do not apply to the term of a trademark right provided in the preceding paragraph.

(Special Provisions on Opposition to Registration)

Article 68-37 To apply Article 43-2 to a trademark registration for the re-filing of a trademark right pertaining to a former international registration, the term "trademark registration" in that Article is deemed to be replaced with "trademark registration (in the case of a trademark registration for 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 on Invalidation Trials of Trademark Registration)

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

Article 68-39 To apply Article 47 to a trademark registration for the re-filing of a

trademark right pertaining to a former international registration, the phrase "may not be filed" in that Article is deemed to be replaced with "may not be filed. The same also applies, in relation to the trademark registration for 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, paragraph (1) can be no longer filed pursuant to this article for the trademark registration pertaining to the former international registration".

## **Chapter VIII 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 proceedings, examination proceedings on opposition to registration, trials and appeals or retrials.

(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, paragraph (1) or Article 41-2, paragraph (1), make amendments to reduce the number of classes of goods or services pertaining to the application for trademark registration.

(Special Provisions on Trademark Rights Covering Two or More Designated Goods or Designated Services)

Article 69 For the purpose of the application of Article 13-2, paragraph (4) (including where it is applied mutatis mutandis pursuant to Article 68, paragraph (1)), Article 20, paragraph (4), Article 33, paragraph (1), and Article 34-2 of this Act, Article 98, paragraph (1), item (i) of the Patent Act as applied mutatis mutandis pursuant to Article 35 of this Act, Article 43-3, paragraph (3), Article 46, paragraph (3), Article 46-2 or 54 of this Act, Article 132, paragraph (1) of the Patent Act as respectively applied mutatis mutandis pursuant to Article 56, paragraph (1) of this Act or Article 174, paragraph(3) of the Patent Act as applied mutatis mutandis pursuant to Article 61 of this Act, Article 59 or 60, Article 71, paragraph (1), item (i) or Article 75, paragraph (2), item (iv) of this Act, to a trademark registration or trademark right covering two or more designated goods or designated services, the trademark is deemed to have been registered or the trademark right is deemed to exist, for each of the designated goods or designated services.

(Special Provisions on Trademarks Similar to Registered Trademarks)

- Article 70 (1) The term "registered trademark" as used in Article 25, Article 29, Article 30, paragraph (2), Article 31, paragraph (2), Article 31-2, paragraph (1), Article 34, paragraph (1), Article 38, paragraph (1), item (ii) and paragraphs (3) through (5), Article 50, Article 52-2, paragraph (1), Article 59, item (i), Article 64, and Articles 73 and 74 includes trademarks similar to the registered trademark that would be regarded as being identical with the registered trademark if they were in the same colors as the registered trademark.
- (2) The term "registered defensive mark" as used in Article 4, paragraph (1), item (xii) or Article 67 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 colors as the registered defensive mark.
- (3) The term "trademark similar to the registered trademark" as used in Article 37, item (i) or 51, paragraph (1) does 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 colors as the registered trademark.
- (4) The preceding three paragraphs do not apply to a trademark that consists solely of colors.

(Registration in the Trademark Registry)

- Article 71 (1) The following particulars are registered in the trademark register, kept in the Patent Office:
- (i) the establishment, renewal, division, transfer, modification, extinction, restoration or restriction on disposition of a trademark right;
  - (ii) the establishment, renewal, transfer or extinction of right based on defensive mark registration;
  - (iii) the establishment, maintenance, transfer, modification, extinction or restriction on disposition of exclusive right to use or non-exclusive right to use; and
  - (iv) the establishment, transfer, modification, extinction 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 register may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media of a similar format that can record or reliably store certain information; the same applies hereinafter).
- (3) Beyond those provided in this act, particulars relating to the registration must be provided by Cabinet Order.

(Issuance of Certificates of Trademark Registration)

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 must 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 must be provided by Order of the Ministry of Economy, Trade and Industry.

(Requests for Certificates)

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 materials under Article 5 paragraph (4), or to issue documents stored on the magnetic tapes that constitute a part of the trademark register; provided, however, that if the Commissioner of the Patent Office considers it necessary to keep these documents or materials confidential, these provisions do not apply in the case of the following documents:

- (i) documents pertaining to a trial under Article 46, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (4)), Article 50, paragraph (1), Article 51, paragraph (1), Article 52-2, paragraph (1), Article 53, paragraph (1) or Article 53-2 (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (4)) or a retrial of the final and binding trial or appeal decision rendered in those trial, with respect to which the party in the case or an intervener has given notice that a trade secret owned by that party in the case or intervener has been described (a trade secret as provided in Article 2, paragraph (6) of the Unfair Competition Prevention Act (Act No. 47 of 1993); the same shall apply in the following item);
- (ii) documents concerning an advisory opinion on the effects of a trademark right, with respect to which a party in the case has given notice that a trade secret owned by the said party in the case has been described;
- (iii) documents which are likely to negatively affect an individual's reputation or disturb their peaceful existence; and
- (iv) 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) through (iii) of the same paragraph, the Commissioner of the Patent Office notifies the person who submitted those documents thereof

and reasons therefor.

- (3) Provisions of the Act Concerning Access to Information Held by Administrative Organs (Act No. 42 of 1999) do not apply to the documents concerning trademark registration or defensive mark registration and the part of the trademark register stored on magnetic tapes.
- (4) The provisions of Chapter V, Section 4 of the Act on the Protection of Personal Information (Act No. 57 of 2003) do not apply to the personal information an administrative agency holds (meaning the personal information an administrative agency holds that is provided in Article 60, paragraph (1) of that Act) that has been recorded in a document concerning a trademark registration or a defensive mark registration or in the part of the trademark register that is stored on magnetic tapes.

(Indication of Trademark Registration)

Article 73 When the holder of trademark right, exclusive right to use or non-exclusive right to use affixes the registered trademark to the designated goods, packaging 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 Order of the Ministry of Economy, Trade and Industry, they must 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 Misrepresentation)

Article 74 It is prohibited for any person conduct the following acts:

- (i) affixing an indication of trademark registration, or an indication which could be confused as a trademark registration, in using a trademark that is not a registered trademark;
- (ii) affixing an indication of trademark registration, or an indication which could be confused as a trademark registration, in using a registered trademark for goods or services that are not the designated goods or designated services;
- (iii) the possession, for the purpose of assignment or delivery, of articles affixed on goods or on their packaging, a trademark other than a registered trademark, articles affixed on goods other than designated goods, or on their packaging, a registered trademark in connection with goods, or articles affixed on goods or on their packaging, a registered trademark in connection with services, where the indication of trademark registration or an indication which could be confused as such is affixed to that 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 those 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 those 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 those services, where the indication of trademark registration or an indication confusing therewith is affixed to those 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 those services through use of those 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 those services through use of those articles;

(Trademark Bulletin)

Article 75 (1) The Patent Office publishes the trademark bulletin

(2) Beyond the particulars provided in this Act, the trademark bulletin must contain the following:

- (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 publication of application;
- (ii) succession of right deriving from an application for trademark registration after publication 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 publication of application;
- (iv) extinctions of trademark rights (except due to the expiration of the trademark and the provisions of Article 41-2, paragraph (6) (including cases where it is applied mutatis mutandis pursuant to Article 41-2, paragraph (8)));
- (v) filing of an opposition to registration or request trials and appeals or a retrial, or withdrawal thereof;
- (vi) final and binding decisions on the opposition to registration, final and binding trial decision or the final and binding decision or decision on a retrial; and
- (vii) final and binding judgments in actions under Article 63, paragraph (1).

(Fees)

Article 76 (1) Fees must 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, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (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, paragraph (2) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (2)) of this Act, Article 41, paragraph (2), Article 41-2, paragraph (2), 43-4, paragraph (3) (including cases where it is applied mutatis mutandis under Article 68, paragraph (4)) of this Act, Article 65-8, paragraph (3) or Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 77, paragraph (1) of this Act or Article 5, paragraph (1), or a change of the date under Article 5, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 77, paragraph (1) of this Act.
  - (iii) persons filing an application for international registration to the Commissioner of the Patent Office pursuant to Article 68-2 (except paragraph (5));
  - (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 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, paragraph (1);
  - (ix) persons filing a request for the issuance of a transcript of documents or an extract of documents pursuant to Article 72, paragraph (1);
  - (x) persons filing a request to allow the inspection or copying of documents or materials under Article 5, paragraph (4) pursuant to Article 72, paragraph (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 register pursuant to Article 72, paragraph (1).
- (2) The persons listed in the center column of the attached table must 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 do not apply where the person to pay the fee in accordance with these paragraphs is the national government.
- (4) Where the national government 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 national government, and the portion of their respective shares of that right has been agreed, notwithstanding the provisions of paragraph (1) or (2), the fees payable thereunder (limited to those provided by Cabinet Order) must be determined as the sum of the provided fees multiplied by the ratios of the share of each person other than the national government, and, the persons other than the national government must pay the sum.
- (5) Where of the fees calculated under the preceding paragraph has a fractional figure of less than ten yen, those portion must be discarded.
- (6) The payment of the fees under paragraph (1) or (2) must be made by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by Order of the Ministry of Economy, Trade and Industry, a cash payment thereof must be accepted.
- (7) Fees paid in excess or in error must 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.
- (9) When, due to reasons beyond their control, the person filing a request for a refund a registration fee is unable to file the request within the period provided in paragraph (7), that person may, notwithstanding this paragraph, file the request within 14 days (two months for overseas residents) from the date on which the reasons for not filing ceased to be applicable, but not later than six months after the expiration of that period.

(Mutatis Mutandis Application of the Patent Act)

Article 77 (1) The provisions of Articles 3 through 5 (time periods and dates) of the Patent Act apply mutatis mutandis to time periods and dates provided in this Act. In this case, the term "Article 121, paragraph (1)" of Article 4 of the Patent Act is deemed to be replaced with "Article 44, paragraph (1) or Article 45, paragraph (1) of the Trademark Act".

- (2) Articles 6 through 9, Articles 11 through 16, Article 17, paragraph (3) and Article 17, paragraph (4), Articles 18 through 24 and Article 194 (procedures) of the Patent Act 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 phrase "appeal against an examiner's decision of



## Chapter IX 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 is deemed to constitute infringement of a trademark right or an exclusive right to use under Article 37 or Article 67) is subject to punishment by imprisonment for a term not exceeding ten years or a fine not exceeding 10,000,000 yen or both.

Article 78-2 Any person who has committed an act that is deemed to constitute infringement of a trademark right or an exclusive right to use under Article 37 or Article 67 is subject to punishment by imprisonment for a term not exceeding five years or a fine not exceeding 5,000,000 yen or both.

### (Crime of Fraud)

Article 79 Any person who has obtained a trademark registration, defensive mark registration, registration of renewal of trademark right or right based on defensive mark registration, decision on opposition to registration or trial decision by means of a fraudulent act is subject to punishment 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 is subject to punishment by imprisonment for a term not exceeding three years or a fine not exceeding 3,000,000 yen.

### (Crime of Perjury)

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, is subject to punishment by imprisonment for a term of between three months and ten years.

(2) When 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 Breaching a Confidentiality Order)

Article 81-2 (1) Any person who fails to comply with an order pursuant to Article

- 105-4, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 13-2, paragraph (5)) of the Patent Act as applied mutatis mutandis pursuant to Article 39 of this Act is subject to imprisonment for a term not exceeding five years or a fine not exceeding 5,000,000 yen or both.
- (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) applies to a person who commits the crime under that paragraph while outside Japan.

(Dual Criminal Liability Provisions)

- Article 82 (1) When a representative of a corporation or an agent, employee or other staff member of a corporation or an individual has committed, in the course of performing social activities for the corporation or individual, any act in violation of the provisions prescribed in the following items, beyond the offender, the corporation is subject to punishment by a fine as provided in the corresponding items and the individual is subject to punishment by a fine as provided in each article prescribed in the following items:
- (i) Article 78, Article 78-2 or Article 81-2, paragraph (1), a fine not exceeding 300 million yen; and
- (ii) Article 79 or Article 80, a fine not exceeding 100 million yen.
- (2) In the case of the preceding paragraph, a complaint under Article 81-2, paragraph (2) against the offender also has effect on the corporation or individual and a complaint against the corporation or individual also has effect on the offender.
- (3) When a fine is imposed on a judicial person or individual pursuant to paragraph (1) with regard to a violation of Article 78, Article 78-2 or 81-2, paragraph (1), the period of prescription is governed by the same rules as for crimes in the provisions thereof.

(Non-Criminal Fines)

- Article 83 When a person who has taken an oath under Article 207, paragraph (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, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 28, paragraph (3) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (3) of this Act) of this Act, Article 43-8 (including cases where it is applied mutatis mutandis pursuant to Article 60-2, paragraph (1) and 68, paragraph (4) of this Act) or Article 56, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (4) of this Act), Article 174, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 61 (including cases where it is

applied mutatis mutandis pursuant to Article 68, paragraph (5) of this Act), Article 58, paragraph (2) of the Design Act as applied mutatis mutandis pursuant to Article 62, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (5) of this Act), or Article 58, paragraph (3) of the Design Act as applied mutatis mutandis pursuant to Article 62, paragraph (2) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (5) of this Act) has made a false statement before the Patent Office or a court commissioned thereby, that person is subject to a non-criminal 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 just cause is subject to a non-criminal 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 is subject to a non-criminal fine not exceeding 100,000yen.

Appended Table (Re: Article 76)

	A person(s) who shall pay fees	Amounts
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 responsible for the procedures under Article 43(7), Article 41(3), Article 41-2(3), Article 65-8(4) of the Patent Act as applied mutatis mutandis under Article 9(3) and Article 13(1), or Article 5(3) of the Patent Act as applied mutatis mutandis under Article 77(1)	4,200 yen per case
4	Person requesting the division of a trademark right	30,000 yen per case

5	Person undertaking any of the procedures pursuant to Article 20, paragraph (1), Article 41-3, paragraph (1), Article 65-3, paragraph (3), or Article 3, paragraph (3) of the Supplementary Provisions (excluding a person who needs to undertake any of the procedures prescribed in these provisions due to reasons beyond the person's control)	102,000 yen per case
6	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
7	Person filing an opposition to registration	3,000 yen per case plus 8,000 yen for each class
8	Person requesting to intervene in proceedings of an opposition to registration	11,000 yen per case
9	Person filing a request for appeal/trial or retrial	15,000 yen per case plus 40,000 yen for each class
10	Person requesting to intervene in a trial or retrial	55,000 yen per case