

Trademark Act

(Act No. 127 of April 13, 1959)

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Chapter I General Provisions

(Purpose)

Article 1 The purpose of this Act is to ensure that the business of a person who uses a trademark can maintain credibility, as a result, contributing to industry development and protecting the interests of consumers, through the protection of trademarks.

(Definitions)

Article 2 (1) In this Act, "trademark" means any character, figure, symbol, three-dimensional shape or color, or any combination of these, sounds, or anything

- else specified by Cabinet Order (hereinafter referred to as a "mark") that is recognizable to human perception, and stated in the following which is :
- (i) used by a person in connection with goods 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 (excluding those listed in the preceding item).
- (2) The service, referred to in item (ii) of the preceding paragraph, includes the provision of benefits to customers in retail and wholesale business.
- (3) In this Act, "use" with respect to a mark, refers to any of the following actions:
- (i) the act of affixing a mark to goods or its packaging;
 - (ii) the act of transferring, delivering, exhibiting for the purpose of transfer or delivery, exporting, importing or providing through a telecommunications line, goods or its packaging that is affixed with a mark;
 - (iii) the act of affixing a mark to items (including items to be transferred or loaned; the same applies hereinafter) to be used by a person receiving a service when that service is being provided;
 - (iv) the act of providing a service using an item that is affixed with a mark, which is to be used by a person who receives that service when that service is being provided;
 - (v) the act of displaying an item that is affixed with a mark which is to be used in the provision of a service (including items to be used by a person who receives those services; the same applies hereinafter) when that service is being provided;
 - (vi) the act of affixing a mark to an item related to the provision of a service to be used by a person receiving that service while that service is being provided;
 - (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 cannot be recognized by the human perception; the same applies hereinafter), when to provide those services by displaying a mark on the image viewer;;
 - (viii) the act of displaying or distributing advertisements, price lists or transaction documents for goods or services and affixing the mark to them, or affixing the mark to information containing this content and providing it 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 the case of a mark listed in the following items, affixing a mark to goods or

other items provided for in the preceding paragraph is to include each as stated below:

- (i) a mark of any character, figure, symbol or three-dimensional shape, or any combination of these, or any combination of these with color: to use the goods or its packaging, items to be used for the provision of services, advertisement materials related to goods or services as the shape of the mark; and
 - (ii) sound marks: to record a mark onto a recording medium that is affixed to goods, items to be used for the provision of services, or advertisement materials related to goods or services (including when the goods, items to be used for the provision of services, or advertisement materials related to goods or services themselves are recording media).
- (5) In this Act, "registered trademark" means a trademark that has been registered.
- (6) In this Act, the scope of what is considered similar to goods is to include services, and the scope of what is considered similar to services is to include goods.
- (7) In this Act, the act of importing includes the act through which a person in a foreign country has another person bring an item from the foreign country into Japan.

Chapter II Trademark Registration and Applications for Trademark Registration

(Requirements for Trademark Registration)

Article 3 (1) Any trademark used in relation to goods or services related to an applicant's business may be registered, unless the trademark:

- (i) consists solely of an indicator signifying, in a common manner, the common name of the related goods or services;
- (ii) is commonly used in relation to the related goods or services;
- (iii) consists solely of a mark indicating, in a common manner, in 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 time of production or use or other characteristics, quantity, price, or, in the case of services, the location of service, quality, items to be used, efficacy, intended purpose, mode, method or time of service or other characteristics, quantity or price of service;
- (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 related 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 related to a business of a particular person.

(Trademarks that Cannot Be Registered)

Article 4 (1) Notwithstanding the preceding Article, a trademark may not 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 the national flag of any country party to the Paris Convention, a member of the World Trade Organization or a Contracting Party 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 amended 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, or 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 below);
 - (a) is identical with, or similar to, a trademark that is well-known among consumers as indicating goods or services related to the applicant's business, and is used in relation to the goods or services or goods or services similar to those; and
 - (b) is identical with, or similar to, a mark indicating an abbreviation of an international organization, which has been used for goods or services that is not likely to be mistaken regarding its connection to that 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 (Act No.159 of 1947) or the special emblem in Article 158, paragraph (1) of the Act Concerning the Measures for Protection of the People in Armed Attack Situations (Act No.112 of 2004);
- (v) is identical with, or similar to, a seal or symbol designated by the Minister

- of Economy , Trade, and Industry, which is used for the supervision or certification of 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, and is used in relation to goods or services identical with, or similar to those in which such a seal or symbol is used;
- (vi) is identical with, or similar to, a famous mark indicating the national government, a local government, an agency of these, a non-profit, public interest organization, or a non-profit, public interest business;
 - (vii) is likely to cause damage to public order;
 - (viii) contains the portrait of another person or the name of another person (limited to the name that is well-known among consumers in the field of goods or services in which the trademark is used), famous pseudonym, stage name or pen name of another person, or famous abbreviations of those (excluding 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 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 by them (excluding 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 indicating the goods or services in relation to the other person's business, and is used in relation to goods or services identical with, or similar to, the goods or services;
 - (xi) is identical with, or similar to, another person's registered trademark which was filed before the application date of the applicant's trademark, and is used in relation to goods or services identical with, or similar to, the designated goods or designated services related 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);
 - (xii) is identical with another person's registered defensive mark (referring to a mark registered as a defensive mark; the same applies hereinafter), and is used in relation to designated goods or designated services related to that defensive mark;
 - (xiii) deleted;
 - (xiv) is identical with, or similar to, the name of a variety registered pursuant

- to Article 18, paragraph (1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if the trademark is used in relation to seeds and seedlings of the variety or goods or services similar to those;
- (xv) is likely to cause confusion in relation to the goods or services related to a business of another person (excluding those listed in items (x) through (xiv) of the preceding paragraph);
- (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 specified region, if the mark is used in relation to wines or spirits not originating from the specified regions;
- (xviii) consists solely of characteristics naturally possessed by the goods, etc. (meaning goods, or their packaging, or services; the same applies in Article 26, paragraph (1), item (v)) that were specified by Cabinet Order; or
- (xix) is identical with, or similar to, a trademark which is well-known among consumers in Japan or abroad as indicating goods or services related to a business of another person, and that is used for wrongful purposes (referring to gaining wrongful profits, causing loss or damage to others, or any other wrongful purpose, the same applies hereinafter) (excluding those provided for in each of the preceding items).
- (2) If the national government or a local government, an agency of these, a non-profit, public interest organization, or a person undertaking a non-profit, public interest business files an application for trademark registration falling under item (vi) of the preceding paragraph, then the provisions of those items do not apply.
- (3) These provisions do not apply to a trademark which falls under Paragraph (1), items (viii), (x), (xv), (xvii) and (xix), but 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 (xi), if the applicant for trademark registration has obtained the consent of another person, as specified in that item (xi), to obtain trademark registration, and the applicant's goods and services are unlikely to cause confusion with the goods or services related to the business of the holder of trademark right, the exclusive trademark license, or the non-exclusive trademark license related to the other person's registered trademark, 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 which 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 the goods or services provided by Cabinet Order as specified in Article 6, paragraph (2).
- (2) If a person desires to register any of the following trademarks, then it must be indicated in a statement on the application:
- (i) a trademark which consists of any character, figure, symbol or three-dimensional shape or color, or any combination of these, where those characters, figures, symbols or three-dimensional shapes or colors in relation to that trademark will be changed;
 - (ii) a trademark which consists of any three-dimensional shape (including the combination with any character, figure, symbol or colors, or any combination of these) (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) a trademark, beyond those listed in each of the preceding items, provided by Order of the Ministry of Economy, Trade and Industry.
- (3) If 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"), then it must be indicated in a statement on the application.
- (4) If a person desires to register any trademark provided by Order of the Ministry of Economy, Trade and Industry, then 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 attach 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 registration is sought.
- (6) Where a portion of the trademark for which 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 certify the filing date of an application for trademark registration as the application date, 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 is not clear enough 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) If an application for trademark registration falls under any of the items of the preceding paragraph, then the Commissioner of the Patent Office must order the person registering the trademark to supplement the application, and designate a reasonable time 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) If an applicant who has been required to supplement an application for trademark registration under paragraph (2) supplements that application within the designated period as provided for in that paragraph, then 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) If 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, then the Commissioner of the Patent Office may dismiss that application for trademark registration.

(One Trademark Per Application)

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

(Collective Trademarks)

- Article 7 (1) A general incorporated association or other association (excluding those without corporate status and companies), or business cooperative or other association established pursuant to a special Act (excluding those without corporate status), or a foreign corporation equivalent to these, is

entitled to obtain a collective trademark registration for the 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 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) Notwithstanding Article 3, (except in cases falling under Article 3, paragraph (1), item (i) or (ii)), any association established under special Act, including a business cooperative (excluding those without corporate status, and limited to those established by special Act providing, without just cause, that the association must not refuse to admit any person who is eligible to become a member, or impose conditions any prospective member that are greater than those imposed on its existing members when they joined), a commercial and industrial association, the chamber of commerce and industry 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 to those (hereinafter referred to as an "association, etc.") is entitled to obtain a regional collective trademark registration with respect to any of the following, provided that the trademark is used by its members and, as a result of its use, that trademark be well-known among consumers as indicating the goods or services related to the business of the applicant or its members:

- (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 related 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 to indicate the goods or services related 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 related to the business of the applicant or its members or the names that are customarily used to indicate these, and characters that are customarily used to indicate the place of origin of the goods or the location of provision of services.
- (2) The term "name of the region" as used in the preceding paragraph means the name of the place of origin of the goods, the location of provision of services for

which the trademark that is being filed has been used by the applicant or its members since before the filing of the application for trademark registration, or the name or abbreviation of the region which is considered to be closely related with those goods or services to that same extent.

- (3) The provisions of Article 3, paragraph (1) (limited to the part related to items (i) and (ii)) in the case of paragraph (1), the term "applicant" in the paragraph is 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 that is being registered contains the name of a region as provided in paragraph (2).

(Prior Applications)

- Article 8 (1) If two or more applications for trademark registration for identical or similar trademarks which are to be used in relation to identical or similar goods or services have been filed on different dates, then only the applicant who filed on the earlier date is entitled to register that trademark. However, if 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 of the applicant who has applied for trademark registration on an earlier date to obtain trademark registration (When there are multiple applicants for this trademark application, those multiple applicants for trademark registration, will be 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 is registered, the goods or services related to the business of the holder of trademark right, the exclusive trademark licensee, or the non-exclusive trademark licensee related to the registered trademark), then the later applicant can also obtain the trademark registration for that trademark.
- (2) If two or more applications for trademark registration for identical or similar trademarks which are to be used in relation to identical or similar goods or services have been filed on the same date, then only one applicant, who is to be selected by consultations from among the applicants, 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) If an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial decision on an application for trademark registration becomes final and binding, then 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 in the main clause of paragraph (2), the Commissioner of the Patent Office must require the applicants for trademark registration to arrange consultations as stated in the main clause of the paragraph and to report those results, designating a reasonable period for doing so.
- (5) If 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 in the preceding paragraph (except as provided in the proviso to paragraph (2)), then only the first applicant on the list for trademark registration, in an order determined by 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 that the lottery placed later on the list for trademark registration, (hereinafter referred to as the "subsequent applicant" in this paragraph) has obtained the consent of the earlier applicant on the list (when there is more than one applicant for trademark registration, they are hereinafter referred to as the "earlier order applicant" in this and the following paragraph) to obtain the trademark registration, and it is not likely to cause confusion between the goods or services in which the subsequent applicant uses the trademark and the goods or services in which the earlier order applicant uses the trademark (the goods or services related to the business of the holder of trademark right, the exclusive trademark licensee, or the non-exclusive trademark licensee when the relevant trademark is a registered trademark), the subsequent 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 previous applicant or the earlier order applicant has been registered and the trademark right related to the trademark registration has been transferred, the holder of trademark right related to the trademark registration is deemed to be the previous applicant or the applicant with first priority, and these provisions is to be applied.

(Special Provisions Concerning the Time of Filing an Application)

Article 9 (1) If a trademark is used in relation to goods or services exhibited at an exhibition held by the government, etc., at an exhibition held by those other than the government, etc. that conforms to the standards specified by the Commissioner of the Patent Office, or at an international exhibition held

within the territory of a country affiliated with the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or by those authorized to do so, or at an international exhibition held within the territory of a country which in neither a country affiliated to the Paris Convention, a member of the World Trade Organization nor a Contracting Party to the Trademark Law Treaty or by those authorized to do so, and conforms to the standards specified by the Commissioner of the Patent Office, and the exhibitor of the goods or services bearing the trademark has filed an application for trademark registration of the goods and services as designated goods and services within six months from the date of exhibition, then that application is deemed to have been filed at the time of exhibition of the goods or services.

- (2) Any person who intends to apply the provisions of the preceding paragraph to a trademark related to an application for trademark registration must submit a document stating so to the Commissioner of the Patent Office at the same time as the filing the application, and submit documents certifying the trademark related to the application for trademark registration and its designated goods or 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 the application for trademark registration.
- (3) If a person submitting a certificate is unable to submit the certificate within the period prescribed in the preceding paragraph, then 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 Ministry of Economy, Trade and Industry, even after the expiration of the period.
- (4) If a person submitting a certificate is unable to submit the certificate within the period permitted under the provisions of the preceding paragraph due to reasons beyond their control, notwithstanding the provisions of the same 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 cease to be applicable, but no later than six months after the expiration of that period.

(Priority Claims Pursuant to the Paris Convention)

Article 9-2 Priority based on an application for registration of a trademark filed in a country party to the Paris Convention (limited to those equivalent to the trademark provided in Article 2, paragraph (1), item (ii)) may be claimed in accordance to the same rules provided in Article 4 of the Paris Convention for priority based on an application for the registration of a trademark equivalent

to the trademark provided in item (i) of the same paragraph.

Article 9-3 Priority may be claimed in relation to an application for trademark registration in accordance with Article 4 of the Paris Convention 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.

| | |
|---|---|
| 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 |

(Amendments and Outline Changes to Designated Goods or Trademarks Being Registered)

Article 9-4 If an amendment made to the designated goods or to the designated services stated in the application or to the trademark for which registration is sought is found to alter the outline to any of those, after the registration of the establishment of the trademark right, then the application for trademark registration is deemed to have been filed when the amendment is submitted.

(Division of Applications for Trademark Registration)

Article 10 (1) An applicant for trademark registration may file one or more new applications for trademark registration 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 is pending in an examination, trial or appeal, or retrial or that an appeal against a decision to refuse the application is pending in court, and the fees payable under Article 76, paragraph (2) for the application for trademark registration has been paid.

(2) In the case of the preceding paragraph, the new application for trademark registration is to have been filed at the time of the original application for trademark registration; provided, however, that this does not apply to the application of the provisions 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 in Article 13, paragraph (1) (including cases where these provisions apply mutatis mutandis pursuant under Article 43-3, paragraph (3) of the same Act as applied mutatis mutandis under Article 13, paragraph (1)).

- (3) If a new application for trademark registration is filed as provided in paragraph (1), written statements or documents submitted in relation to the original application for trademark registration (in cases where the document is submitted pursuant to the provisions of 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 written statements or documents provided by electronic or magnetic means) which must be submitted in relation to the new application for trademark registration pursuant to Articles 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 9, paragraph (2) or Article 13, paragraph (1) of this Act (including the cases where these provisions are applied mutatis mutandis under Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 13, paragraph (1)) are deemed to have been submitted to the Commissioner of the Patent Office at the same time as the filing of the new application for trademark registration.

(Conversion of Application)

- Article 11 (1) An applicant for trademark registration may convert an application for registration for trademark registration of a collective trademark into a regular application for trademark registration (This refers 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 regional 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 regional collective trademark.
- (4) No conversion of an application for trademark registration pursuant to the preceding three paragraphs may be made after an examiner's decision or a trial decision on the application for trademark registration becomes final and binding.

- (5) If the conversion of an application for trademark registration is made pursuant to the provisions of paragraphs (1) through (3), the original application for trademark registration is deemed to have been withdrawn.
- (6) The provisions of paragraphs (2) and (3) of the preceding Article apply mutatis mutandis to the conversion of an application for trademark registration pursuant to the provisions of paragraphs (1) through (3).

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

- (2) No conversion of an application under the provisions of the preceding paragraph may be made after an examiner's decision or a trial decision on the application for a defensive mark registration becomes final and binding.
- (3) The provisions of Article 10, paragraphs (2) and (3), and the preceding Article, paragraph (5) apply mutatis mutandis to the conversion of an application pursuant to paragraph (1).

(Publication of Applications)

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

- (2) The publication of a trademark application is made by publishing the following matters in the trademark gazette; provided, however, that this does not apply to matters listed in items (iii) and (iv) above, if the Commissioner of the Patent Office finds that publishing those particulars in the trademark gazette is likely to cause damage to public policy:

- (i) the name and the domicile or residence of the trademark registration applicant;
- (ii) the number and date of the trademark registration application;
- (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 matters beyond those 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 specified by Order of the Ministry of Economy, Trade and Industry" in Article 43, paragraph (1) of that Act is to be replaced with "at the time of filing of the application for trademark registration", "the description, patent claims or utility model

registration claims, and drawings" in paragraph (2) of that Article is 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 to be replaced with "three months from the filing date of an application for trademark registration"; "a person who has received a notice prescribed in the preceding paragraph" in paragraph (7) of that Article is to be replaced with "a person who submits the priority certificate, etc. is unable to submit the priority certificate, etc. within the period specified 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 to be replaced with "the priority certificate, etc. as specified by Order of the Ministry of Economy, Trade and Industry"; "a person that has received a notice provided under paragraph (6)" in paragraph(8) of that Article is 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 specified in the preceding paragraph" in paragraph (8) of that Article is to be replaced with "the priority certificate, etc. within the period specified by Order of the Ministry of Economy, Trade and Industry in the preceding paragraph", "the preceding paragraph" in paragraph(8) of that Article is to be replaced with "that paragraph"; "the priority certificate, etc. or the document" is 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 to be replaced with "the priority certificate, etc."; "or a member state of the World Trade Organization" in Article 43-3, paragraph (2) of that Act is to be replaced with "members of the World Trade Organization or Contracting Parties to the Trademark Law Treaty"; "or the national of a member of the World Trade Organization" in the same paragraph is 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 to be replaced with "Article 43"; and "preceding two paragraphs" in paragraph (3) of that paragraph is 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 arising from an application for trademark registration.

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

Article 13-2 (1) If an applicant for trademark registration has filed an

application for trademark registration and then issued a warning by presenting a document stating the contents of the application, then the applicant may claim compensation for an amount equivalent to the business loss incurred due to use from any person who has used the trademark related to the application, for the designated goods or designated services in the application during the period from the warning up to the registration of the establishment of the trademark right.

- (2) The right to claim under the provisions of the preceding paragraph may not be exercised until after 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: if an application for trademark registration is abandoned, withdrawn or dismissed; if an examiner's decision or trial decision to refuse an application for trademark registration becomes final and binding; if a ruling to rescind a trademark under Article 43-3, paragraph (2) becomes final and binding; or if, excluding the cases falling under the proviso to Article 46-2, paragraph (1), a trial decision to invalidate a trademark registration 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 exercising of the right to claim under paragraph (1). In this case, if the person with the claim knew of the use of the trademark registration and the person who used it before the registration of the establishment of the trademark right, then the phrase "when the victim or their legal representative comes to know the damage and the identity of the perpetrator" in item (i) of the same Article, is to be replaced with "on the day the trademark right is registered".

Chapter III Examination

(Examination by an Examiner)

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

(Decision of Refusal)

Article 15 If an application for trademark registration falls under any of the following items, then the examiner must make a decision to refuse the application:

- (i) the trademark related 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 related 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 If the examiner intends to make a decision to refuse an application, then the examiner must notify the applicant for trademark registration of the reasons for refusal and provide the applicant with an opportunity to submit a written opinion, designating a reasonable period for doing so.

Article 15-3 (1) If a trademark related to an application for trademark registration is identical with, or similar to, another person's trademark related to an application for trademark registration filed before the filing date of that application, and if that trademark is used for goods or services identical with, or similar to, the designated goods or designated services related to that other person's trademark, then 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 period for doing so.

(2) If the notification stated in the preceding paragraph has already been served and that other person's trademark is registered, then the examiner is not required to serve the notification stated in the preceding Article.

(Examiner's Decision on Trademark Registrations)

Article 16 If no reason for refusal is found with an application for trademark registration within the period specified by Cabinet Order, then the examiner must make a decision to grant the trademark registration.

(Dismissal of Amendments)

- Article 16-2 (1) If 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 related outline, 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 for doing so.
- (3) If a ruling dismissing an amendment under paragraph (1) is made, then the examiner must not make any decision on the applications for trademark registration before the expiration of a three-month period from the date of service of a certified copy of the ruling
- (4) If 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), then the examiner must suspend the examination 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 Examiner's Decisions) and Article 54 (Relationship with Litigation) of the Patent Act apply mutatis mutandis to the examination 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 Amended Design) 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 period 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) If 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 certified copy of an examiner's decision or a trial decision indicating that a trademark is to be registered pursuant to Article 41-2, paragraph (1) is paid, then the establishment of the trademark right is registered.
- (3) Upon registration stated in the preceding paragraph, the following matters must be published in the trademark gazette:
- (i) the name and the domicile or residence of the holder of trademark right;
 - (ii) the number and date of the application for trademark registration;
 - (iii) the trademark stated in the application;
 - (iv) the designated goods or designated services;
 - (v) the registration number and the date of registration of establishment; and
 - (vi) other necessary matters beyond those listed in the preceding items.
- (4) The Commissioner of the Patent Office must make application documents and their annexed items available for public inspection at the Patent Office for two months from the date of issuance of the trademark gazette containing matters listed in each item of the preceding paragraph (hereinafter referred to as "trademark publication gazette") pursuant to the provisions of the preceding paragraph; provided, however, that this does not apply to documents or items 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 items 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 stated in the preceding paragraph, the Commissioner of the Patent Office must notify the person who submitted the documents or the related items of this and the reasons for that.

(Trademark 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) If the renewal of the term of the trademark right is registered, the term is 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 matters:

- (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 matters 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 before the expiration of the trademark right to the date of expiration.
- (3) If the holder of trademark right is unable to file an application for registration of renewal within the period provided in the preceding paragraph, then 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) If 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, then 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 trademark right which is 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) If an application for registration of renewal is filed under the preceding paragraph, then 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 the preceding Article, paragraph (2) may not extend to the following acts committed after the expiration of the period for filing the application for registration of renewal under Article 20, paragraph (3) and before the registration of the renewal of the trademark right by application under the preceding Article, paragraph (1):
- (i) the use of the registered trademark in relation to the designated goods or designated services; and
 - (ii) the acts provided for in each item of Article 37.

(Registration of Term Renewal)

- Article 23 (1) If the registration fee under Article 40, paragraph (2) or the registration fee due and payable at the time of the filing of the application for registration of renewal pursuant to the provisions of Article 41-2, paragraph (7) is paid, then the term renewal of the trademark right is registered.
- (2) Notwithstanding the preceding paragraph, if an application for registration of renewal is filed pursuant to Article 20, paragraph (3) or Article 21, paragraph (1), then the term 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 the 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 stated under the preceding two paragraphs, the following matters are to be published in the trademark gazette:
- (i) the name and the domicile or residence of the holder of trademark right;
 - (ii) the registration number and the date of registration of renewal; and
 - (iii) other necessary matters beyond those listed in the preceding two items.

(Division of Trademark Rights)

- Article 24 (1) If there are two or more designated goods or designated services for which a trademark right applies, then the trademark right may be divided for each of the designated goods or designated services.
- (2) If a request for a trial is filed under Article 46, paragraph (3), then the division provided for in the preceding paragraph may be made even after the extinction of the trademark right, provided that a trial or appeal, retrial or court proceeding in relation to the case is pending.

(Transfer of Trademark Rights)

- Article 24-2 (1) If there are two or more designated goods or designated services, then the trademark right may be divided into each of the designated goods or services in transferring this right.
- (2) A trademark right in relation to an application for trademark registration which falls under Article 4, paragraph (2) filed by the national government, a local government, an agency of these, or a non-profit, public interest organization, may not be assigned.
- (3) A trademark right in relation to an application for trademark registration that falls under Article 4, paragraph (2) filed by a person undertaking a non-profit, public interest business, may not be transferred unless the business is transferred together with the right.
- (4) A trademark right in relation to a regional 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) If the right holder of a collective trademark desires to transfer the trademark right as the collective trademark right, then the right holder must submit an application for registration of transfer accompanied by a document stating so, and the documents provided in Article 7 paragraph (3), to the Commissioner of the Patent Office.

(Request for Indicator to Prevent Confusion Regarding Transfer of Trademark Rights)

Article 24-4 If, due to the following grounds, the trademark right to a similar registered trademark to be used in relation to identical goods or services, or the trademark right to an identical or similar registered trademark to be used in relation to similar goods or services becomes owned by a different holder of trademark right, and if the use of one of the registered trademarks for its designated goods or designated services by its holder of trademark right, the exclusive trademark licensee, or the non-exclusive trademark licensee is likely to damage business interests (limited to those related to the designated goods or designated services using those other registered trademark) of the other holder of trademark right or exclusive trademark licensee, then the other holder of trademark right or exclusive trademark licensee may request the holder of trademark right, the exclusive trademark licensee, or the non-exclusive trademark licensee to affix an appropriate indicator that may prevent any confusion between the goods or services related 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 after the date on which a certified copy of an examiner's decision or trial decision to grant the trademark registration is served.
- (iv) the trademark right has been transferred.

(Effects of Trademark Rights)

Article 25 The holder of trademark right has the exclusive right to use the

registered trademark in relation to the designated goods or designated services; provided, however, that when an exclusive trademark license is established in relation to the trademark right, this does not apply to the extent that the exclusive trademark licensee 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, stage name, pen name or famous abbreviation of these;
 - (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 to these, or the common name, location of provision, quality, items 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, items 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 to these, 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 to these; 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 related 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, stage name, pen name or famous abbreviation of these is used for the purpose of unfair competition.
- (3) A trademark right has no effect against any of the following acts; provided, however, that this only applies if the act is not performed for the purpose of unfair competition:
- (i) the act of affixing a geographical indicator 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") (referred to as a "geographical indicator" in the following item and item (iii)) to specific agricultural, forestry, and fishery products, etc. prescribed in Article 2 (2) of the Specific Agricultural, Forestry and Fishery Product Name Protection Act related to the registration under Article 6 of the Act, also pursuant to the provisions of Article 3 (1) of the Act (The term "specific agricultural, forestry, or fishery product related to registration" includes agricultural, forestry, and fishery products, etc. prescribed in paragraph 1 of that Article, which are manufactured or processed using specific agricultural, forestry, and fishery products, etc. related to that registration as main, raw materials or ingredients. Referred to as "specified agricultural, forestry, and fishery products, etc. related to registration" in the following item and item (iii)) (including cases where applied mutatis mutandis pursuant to Article 30 of that Act following the replacement of terms; the same applies in the following item and item (iii));

- (ii) the act of assigning, delivering, displaying for the purpose of assignment or delivery, import or export of specified agricultural, forestry, and fishery products, etc. related to registration or goods or packages of goods to which a geographical indicator has been affixed pursuant to the provisions of Article 3 (1) of the Specific Agricultural, Forestry and Fishery Product Name Protection Act
- (iii) the act of displaying or distributing advertisements, price lists or transaction documents for specified agricultural, forestry, and fishery products, etc. related to registration pursuant to the provisions of Article 3 (1) of the Specific Agricultural, Forestry and Fishery Product Name Protection Act or providing information containing the same by electronic or magnetic means with a geographical indicator affixed to it.

(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) If the Commissioner of the Patent Office is commissioned by a court to provide an expert opinion on the effects of a trademark right, then the Commissioner must designate three administrative judges to provide their expert opinion.

- (2) The provisions of Article 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 If the use of a registered trademark in relation to its designated goods or designated services infringes upon another person's right to a patent, utility model or design for which an application has been filed before the filing date of an application of that registered trademark or upon another person's copyright or neighboring right arising before the filing date of the same trademark registration, then the holder of trademark right, the exclusive trademark licensee, and the non-exclusive trademark licensee may not use the registered trademark on the infringing part of the designated goods or designated services.

(Exclusive Trademark License)

- Article 30 (1) The holder of trademark right may establish an exclusive trademark license for the trademark to which they hold the right; provided, however, that this does not apply to the trademark right related to an application for trademark registration provided in Article 4, paragraph (2) or a regional collective trademark.
- (2) The exclusive trademark licensee will have an exclusive right to use a registered trademark in relation to the designated goods or designated services to the extent provided by the agreement under which the right is granted.
 - (3) The exclusive trademark license may be transferred only when the consent of the holder of trademark right is obtained or when the transfer falls under due inheritance or other general succession.
 - (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) (Effect of Registration) of the Patent Act apply *mutatis mutandis* to an exclusive trademark license.

(Non-Exclusive Trademark License)

- Article 31 (1) The holder of trademark right may grant another person a non-exclusive trademark license for that trademark.
- (2) The non-exclusive trademark licensee 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 trademark license may be transferred only when the consent of the holder of trademark right is obtained (in the case of a non-exclusive trademark license granted for an exclusive trademark license, the holder of trademark right and the exclusive trademark licensee) or when the transfer falls under due inheritance or other general succession.
- (4) When a non-exclusive trademark license is registered, it affects the trademark right or exclusive trademark license, or any person who subsequently acquires the exclusive trademark license for the trademark right.
- (5) The transfer, conversion, extinction or restriction on disposition of a non-exclusive trademark license has no effect on a 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 trademark license.

(Rights of Members of Corporations or Associations)

- Article 31-2 (1) A member of a corporation provided in Article 7, paragraph (1) holding a trademark right to a collective trademark (hereinafter referred to as a "collective member") or a member of an association, etc. holding a trademark right to a regional collective trademark (hereinafter referred to as a "regional collective member") has the right to use a registered trademark related to a collective trademark or a regional collective trademark for the designated goods or designated services as provided by that corporation or association, etc.; provided, however, that when an exclusive trademark license has been established for the registered trademark right (limited to the trademark right related to a collective trademark) this does not apply to the extent to which the exclusive trademark licensee has the exclusive right to use the registered trademark.
- (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, a collective member or regional collective member is deemed to be a non-exclusive trademark licensee.
- (4) To apply Article 33, paragraph (1), item (iii) to a registered trademark related to a collective trademark and a regional collective trademark, the phrase "or a

person who has the non-exclusive trademark license which is effective regarding the trademark right or the exclusive trademark license under Article 31, paragraph (4) of this Act" from the same item is to be replaced with "or a person who has the non-exclusive trademark license which is effective regarding the trademark right or the exclusive trademark license 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 Based on Prior Use)

Article 32 (1) As a result of using a trademark in Japan that is identical with, or similar to, a trademark that is filed by another person in relation to the designated goods or designated services of the trademark that is filed, or in relation to goods or services similar to those, without the intention of unfair competition, from the time prior to the filing of the other person's application for the 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 the amendment under Article 9-4 of this Act or Article 17-3, paragraph (1) of the Design Act as applied mutatis mutandis pursuant to 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))), if the trademark is widely recognized among consumers as indicating the goods or services related to the person's business, then the person has the right to use the trademark in relation to those goods or services if that person continues to use the trademark for those goods or services. The same applies to those who have succeeded to that business.

(2) The holder of trademark right or exclusive trademark licensee may request the person who has the right to use the trademark pursuant to the preceding paragraph to affix an indicator that may sufficiently prevent any confusion between the goods or services related 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 that is identical with, or similar to, a regional collective trademark that is filed by another person in relation to the designated goods or designated services of the trademark that is filed, or in relation to goods or services similar to those, without the intention of unfair competition, prior to the filing of the other person's application for trademark registration, then the person has the right to use the trademark in relation to those goods or services if that person continues to use the trademark for those goods or services. The same applies to those who have succeeded to that 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 indicator that may sufficiently prevent any confusion between the goods or services related to the business of that person and those of its own or its members.

(Right to Use a Trademark Based on Use Before Registration of a Request for an Invalidation Trial)

Article 33 (1) If, before 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 to those in Japan in relation to the designated goods or designated services or goods or services similar to those without any knowledge of that trademark registration which falls under any of the items of that paragraph, and that trademark is widely recognized among consumers as indicating goods or services related to its business, then the person has the right to use the trademark in relation to the goods or services as far as that person continuously uses the trademark for the goods or services. The same applies to those who have succeeded to that business:

- (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 relation to 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 relation to identical or similar designated goods or designated services has been 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 trial under Article 46, paragraph (1), has the exclusive trademark license of the trademark right of the trademark registration which has been invalidated or a person who has the non-exclusive trademark license which is effective regarding the trademark right or the exclusive trademark license under Article 31, paragraph (4) of this Act.
- (2) The holder of trademark right or exclusive trademark licensee 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 a Patent Term)

Article 33-2 (1) If a patent right of an application that has been filed before 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, then upon expiration of that patent term, the original patentee has the right to use the registered trademark or a trademark similar to it in relation to the designated goods or designated services specified in the application, or goods or services similar to those, within the limits of the original patent right; provided, however, that the trademark may not be 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*, if a utility model or design right of an application that has been filed before 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) If a patent right of an application that has been filed before 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, then upon expiration of that patent term, 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 to it, within the limits of the original patent right, in relation to the designated goods or designated services specified in the application for trademark registration, or goods or services similar to those; provided, however, that the trademark may not be 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*, if a utility model or a design right of an application which has been filed before 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) If a pledge is established on a trademark right, an exclusive trademark license, or non-exclusive trademark license, unless otherwise provided for by contract, then the pledgee may not use the registered trademark in relation to the designated goods or designated services.

- (2) The establishment, transfer, conversion, extinction, or restriction on disposition of a pledge on a non-exclusive trademark license may not be asserted against a third party without registration.
- (3) The provisions of Article 96 (Extension of a Security Interest to the Proceeds of the Collateral) of the Patent Act apply mutatis mutandis to pledges on a trademark right, exclusive trademark license, or non-exclusive trademark license.
- (4) The provisions of Article 98, paragraph (1), item (iii) and paragraph (2) (effect of registration) of the Patent Act apply mutatis mutandis to pledges on a trademark right, or exclusive trademark license.

(Waiver of Trademark Rights)

Article 34-2 If there is an exclusive trademark licensee, a pledgee, or a non-exclusive trademark licensee, then the holder of trademark rights may waive those rights only with their consent.

(Mutatis Mutandis Application of the Patent Act)

Article 35 The provisions of Article 73 (Joint ownership), Article 76 (Forfeiture of a Patent Right in Absence of an 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 (other than due inheritance or other general succession)" in Article 98, paragraph (1), item (i) of the Patent Act is to be replaced with "division and transfer (other than due inheritance or other general succession)".

Section 2 Infringement of Rights

(Right to Demand an Injunction)

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

- (2) In making the demand under the preceding paragraph, the holder of trademark right or exclusive trademark licensee may demand the person to take measures necessary for the prevention of the infringement, including the destruction of items 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 trademark license:

- (i) the use of a trademark similar to the registered trademark in relation to the

- designated goods or designated services, or the use of the registered trademark or a trademark similar to it in relation to 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 to it on the goods or their packaging;
 - (iii) the possession or importation of items affixed with the registered trademark or a trademark similar to it, 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 items;
 - (iv) the assignment, delivery, or possession, or importation for the purpose of assignment or delivery of items affixed with the registered trademark or a trademark similar to it, 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 items;
 - (v) the possession of items indicating the registered trademark or a trademark similar to it, for the purpose of using the registered trademark or a trademark similar to it in relation to the designated goods or designated services, or goods or services similar to those;
 - (vi) the assignment, delivery, or possession for the purpose of assignment or delivery, of items indicating the registered trademark or a trademark similar to it, for the purpose of causing the registered trademark or a trademark similar to it to be used in relation to the designated goods or designated services, or goods or services similar to those;
 - (vii) the manufacture or importation of items indicating the registered trademark or a trademark similar to it, for the purpose of using or causing to be used the registered trademark or a trademark similar to it in relation to the designated goods or designated services, or goods or services similar to those; and
 - (viii) the manufacture, assignment, delivery, or importation, as a business, of items to be used exclusively for the manufacturing of items indicating the registered trademark or a trademark similar to it.

(Presumption of the Amount of Loss or Damage)

Article 38 (1) If a holder of trademark right or an exclusive trademark license claims against an infringer compensation for loss or damages sustained as a result of the intentional or negligent infringement of the trademark right or exclusive trademark license, and the infringer assigned the goods that

constitute the act of infringement, then the amount of loss or damage sustained by the holder of trademark right or exclusive trademark license may be the total amount 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 exclusive trademark license 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 exclusive trademark license 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) will be deducted) proportionate to the ability of the holder of trademark right or exclusive trademark license to use the goods (referred to as "appropriate usage quantity" in the same item) within the quantity of goods transferred by the infringer who has committed the infringement of the trademark right or exclusive trademark license (referred to in the next item as "transferred quantity") ;
 - (ii) the amount equivalent to the amount of money to be received for the use of the registered trademark related to the trademark right or exclusive trademark license according to the quantity in the case where there is a quantity that exceeds the appropriate usage quantity within the transferred quantity, or a specified quantity (excluding in the case where it is not recognized that the holder of trademark right or exclusive trademark licensee could have established an exclusive trademark license or granted a non-exclusive trademark license for the trademark right of the holder of trademark right, or grant a non-exclusive trademark license for the exclusive trademark licensee's exclusive right).
- (2) If the holder of trademark right or exclusive trademark licensee claims against an infringer compensation for loss or damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive trademark license, and the infringer earned profits from the act of infringement, then the amount of profits earned by the infringer is presumed to be the amount of loss or damage sustained by the holder of trademark right or exclusive trademark license.
- (3) The holder of trademark right or an exclusive trademark license may claim, against an infringer compensation for loss or damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive trademark license, by regarding the amount the holder of trademark right or an exclusive trademark license would have been entitled to receive for the use of the registered trademark as the amount of loss or 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 exclusive trademark licensee would obtain if the holder of trademark right or exclusive trademark licensee agreed on the compensation of the use of the registered trademark related to the trademark right or the exclusive trademark license with the infringer on the premise that the trademark right or exclusive trademark license had been infringed.

(5) If a holder of trademark right or an exclusive trademark licensee claims against an infringer compensation for loss or damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive trademark license, and the infringement has been committed by using a registered trademark (including a trademark 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 the Latin alphabet, 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 applies in Article 50.) in relation to the designated goods or designated services, the amount of loss or damage sustained by the holder of trademark right or exclusive trademark licensee may 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 does not prevent any relevant party from claiming compensation for loss or damage in an amount exceeding the amount provided. In this case, if the infringer committed the infringement of the trademark right or the exclusive trademark license without intent or gross negligence, then the court may take these circumstances into consideration in determining the amount of loss or damages to be awarded.

(Limits on Assertions)

Article 38-2 If the following trial decisions or rulings have become final and binding after the final judgment on a litigation related to infringement of the trademark right or the exclusive right to use trademark 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, then a person who was a party to that litigation may not claim that the trial decisions or rulings have become final and binding in the retrial against those final judgments (including the provisional attachment order against the obligee for the purpose of claiming compensation for loss or

damages on the merits of a lawsuit and also the provisional disposition order against the obligee for the purpose of claiming loss or damages or the restoration of unjust enrichment on the merits of a lawsuit.):

- (i) a trial decision to invalidate the trademark registration; or
- (ii) a ruling to revoke the trademark registration.

(Mutatis Mutandis Application of the Patent Act)

Article 39 The provisions of Article 103 (Presumption of Negligence), Article 104-2 (Obligation to Clarify Specific Circumstances); Article 104-3, paragraphs (1) and (2) (Restriction on Exercise of Rights by the Patentee), Articles 105 (Submission of documents), 105-2-12 through 105-6 (Expert Opinion for Calculation of Damages; Approval of Reasonable Amount as the Value of Damages; Confidentiality Protective Orders; Vacating a Confidentiality Protective Order; and Notice of a Request to Inspect a Case Record) and Article 106 (Measures to Restore Credibility) of the Patent Act apply mutatis mutandis to the infringement of a trademark right and an exclusive trademark license.

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 classifications (referring to classifications 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 classifications 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) If a trademark right is held under the co-ownership of the national government and a person other than the national government, and the portion of their respective shares of that trademark right has been agreed on, 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 that person.

- (5) Registration fees calculated pursuant to the preceding paragraph are to be rounded down to the nearest multiple of ten yen.
- (6) The registration fee under paragraphs (1) or (2) must be paid with patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that in cases specified by Order of the Ministry of Economy, Trade and Industry, 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 date of service of a certified copy of an examiner's decision or a trial decision to grant a trademark registration.
- (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) If 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), then 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) If, a person required to pay a registration fee is unable to pay the registration fee within the period for payment of the registration fee provided in the preceding paragraph due to reasons beyond their control, notwithstanding the provisions of that paragraph, that person may 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 same time as the 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 classifications of goods or services, for each trademark registration within 30 days from the service of a certified copy of an examiner's decision or trial decision to register a trademark, and must also pay the amount specified by Cabinet Order not exceeding 19,100 yen, multiplied by the number of

classifications of goods or services, for each trademark registration no later than five years before 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 date of service of a certified copy of an examiner's decision or trial decision to grant the trademark registration pursuant to the provisions of the preceding paragraph (hereinafter, referred to as "an earlier-installment 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) If 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 (if the period under the preceding paragraph is extended, then within the extended period), then 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) If a person required to pay an earlier-installment registration fee is unable to pay the earlier-installment registration fee within the period for as provided in the preceding paragraph due to reasons beyond their control, notwithstanding the provisions of that paragraph, that person may pay the registration fee within 14 days (two months for overseas residents) from the date on which the reasons for not paying the fee ceased to be applicable, but no later than six months after the expiration of that period.
- (5) If a person required to pay a registration fee due and payable no later than five years before 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, then the person may make a late payment of the second-installment registration fee even after the expiration of this period, but no later than 6 months following the expiration of that period.
- (6) If 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, then the trademark right is deemed to have expired retroactive to the day which is five years before 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 classifications 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 classifications of goods or services, for each trademark registration no later than five years before 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 no later than five years before the expiration of the trademark right under the preceding paragraph, is made. In this case, the term "paragraph (1)" in paragraph (5) is 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 trademark right that is 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) If 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 existed retroactively since the day preceding the five years before 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 before 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 existed, pursuant to paragraph (2) of the preceding Article, under Article 41-2, paragraph (5):

- (i) the use of the registered trademark in relation to 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 under the preceding paragraph may claim reimbursement for those expenses to the extent of the actual benefit obtained by the person that is required to pay the registration fees.

(Refunding Registration Fees Already Paid)

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

- (i) a registration fee paid in excess, or in error; or
 - (ii) a registration fee due and payable no later than five years before 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 invalidating a trademark registration becomes final and binding no later than five years before 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 date of payment in the case of registration fees provided for in item (i) of the preceding paragraph or after six months from the date on which a ruling to cancel under Article 43-3, paragraph (2) or, a trial decision becomes final and binding in the case of registration fees provided for in item (ii) of the preceding paragraph.
- (3) If a person filing a request for refund a registration fee is unable to file the request within the period as provided in paragraph (1) due to reasons beyond their control, notwithstanding that paragraph, that person may 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 no 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) If 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) If 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 before 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 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 due to reasons beyond their control, the holder is not required to pay the registration surcharge.

(4) The surcharges under the preceding three paragraphs must be paid with patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that in cases specified by Order of the Ministry of Economy, Trade and Industry, the payment may be made in cash, if permitted by Order of the Ministry of Economy, Trade and Industry.

Chapter IV-2 Filing of an Opposition to Registration

(Filing of an 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 trademark publication gazette, 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 relation to two or more designated goods or designated services:

- (i) if 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) if the trademark registration has been made in violation of a treaty; or
- (iii) if 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) Proceedings and ruling on opposition to registration is to be conducted by a panel consisting of three or five administrative judges.
- (2) If the administrative judges find the trademark registration related to a filing of an opposition to registration falls under any of the items of Article 43-2, they must make a ruling revoking the trademark registration (hereinafter referred to as a "ruling to revoke").
 - (3) If the ruling to revoke becomes final and binding, then the relevant trademark right is deemed to never have existed.
 - (4) If the administrative judges find the trademark registration related to a filing of an opposition to registration does not fall under any of the items of Article 43-2, they must make a ruling maintaining the trademark registration.
 - (5) The ruling under the preceding paragraph is not 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 Japan Patent Office a written opposition to registration of a trademark stating the following matters:

- (i) the name and the domicile or residence of the opponent to the registration and their representative;
 - (ii) the indication of the trademark registration related to the opposition to registration; and
 - (iii) the indication that is needed as evidence and the grounds of the opposition to registration.
- (2) An amendment of the written opposition to registration submitted under the preceding paragraph must not change the gist; provided, however, that these

provisions do not apply to any amendment with respect to the matters provided for in item (iii) of the preceding paragraph that is made no later than thirty days from the lapse of the term provided in Article 43-2.

- (3) The Commissioner of the Japan 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 the panel.

(Trial Clerks)

- Article 43-5-2 (1) The Commissioner of the Japan 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 of Proceedings)

- Article 43-6 (1) Proceedings on opposition to registration are to be conducted by documentary proceedings; provided, however, that the chief administrative judge may decide to conduct oral proceedings upon a motion of the holder of trademark right, the registration opponent, or 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) If any grounds for suspension or termination of proceedings are applicable to one of the joint holders of trademark rights for proceedings and ruling on an opposition to registration, that suspension or termination will have effect on all of joint holders of trademark rights.

(Intervention)

Article 43-7 (1) In proceedings of an opposition to registration, any person who has an interest in the trademark right, including a person who has a right

related to the trademark right , may intervene in the proceedings in order to assist the holder of trademark right until a ruling on opposition to registration is made.

- (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 proceedings of opposition to registration.

(Ex Officio Examination Proceedings)

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

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

(Consolidate or Separate Proceedings of Opposition)

Article 43-10 (1) If two or more oppositions to registration are filed in relation to the same trademark right, unless special circumstances exist, the proceedings are to be consolidated.

- (2) Proceedings consolidated in accordance with the preceding paragraph may later be separated.

(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 Revocation)

Article 43-12 If a chief administrative judge intends to make a ruling to revoke a trademark registration, the chief administrative judge must notify the holder of trademark right and the intervenor of the reasons for revocation of the trademark registration and give them an opportunity to submit a written opinion, designating a reasonable period.

(Formal Requirements for Rulings)

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

- (i) the case number of the opposition to registration;
 - (ii) the name and the domicile or residence of the holder of the trademark right, the registration opponent, the intervenor and their representatives;
 - (iii) the indication of the trademark registration on which the ruling was made;
 - (iv) the conclusions of and reasons for the ruling; and
 - (v) the date of the ruling.
- (2) If a ruling has been made, the Commissioner of the Japan Patent Office must serve a certified copy of the ruling to the holder of trademark right, the registration opponent, the intervenor and any person whose request to intervene at the examination on the opposition to registration has been refused.

(Scope of Final and Binding Ruling)

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

(Mutatis Mutandis Application of Provisions of 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 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 an Examiner's Decision of Refusal)

- Article 44 (1) Any person who has received an examiner's decision that an application is refused, and is dissatisfied with that decision, may file a request for an appeal against the examiner's decision of refusal within three months from the date the certified copy of the examiner's decision was served.
- (2) If a person filing a request for an appeal pursuant to the preceding paragraph is unable to file the request within the period as provided in the preceding paragraph due to reasons beyond their control, notwithstanding that

paragraph, that person may 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 an Examiner's Decision to Dismiss Amendments)

Article 45 (1) Any person who has received a ruling of dismissal of amendments under Article 16-2, paragraph (1) and is dissatisfied with that ruling, may file a request for appeal against the ruling within three months from the date the certified copy of the ruling has been served; provided, however, that this does 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 for Invalidation of Trademark Registration)

Article 46 (1) If a trademark registration falls under any of the following items, a request for a trial for invalidation of the trademark registration may be filed. In this case, if the trademark has been registered in relation to two or more designated goods or designated services, a request may be filed for each of the designated goods or designated services:

- (i) if 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 pursuant to Article 77, paragraph (3) of this Act;
- (ii) if the trademark registration has been made in violation of a treaty;
- (iii) if the trademark registration has been made for an application not satisfying the requirements under Article 5, paragraph (5);
- (iv) if the trademark registration has been made for an application by a person who has not succeeded the rights deriving from the application for trademark registration;
- (v) if, 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) if, after the trademark registration, the registered trademark has become a trademark that falls under any of Articles 4, paragraph (1), item (i) through item (iii), item (v), item (vii) or item (xvi); or

- (vii) if, after the trademark registration of a regional collective trademark, the holder of trademark right has ceased to be a member in a partnership, etc., or the registered trademark has ceased to be a trademark well-known among consumers as that indicating goods or services in relation to 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 expiration of the trademark right.
- (4) If a request for a trial is filed under paragraph (1), the chief administrative judge must notify any person who holds a registered rights with regard to the trademark registration thereof, including a holder of the exclusive right to use trademark, of this.

Article 46-2 (1) If a trial decision to invalidate a trademark registration becomes final and binding, the trademark right is deemed to never have existed; provided, however, that if the trademark registration falls under any of items (v) through (vii) of Article 46, paragraph (1) and a trial decision to invalidate a trademark registration becomes final and binding, the trademark right is deemed to never 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, if 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 filing of the request for the invalidation trial of that trademark registration.

Article 47 (1) If a trademark registration has been made in violation of Article 3, Article 4, paragraph (1), item (viii), or , items (xi) through (xiv), Article 8, paragraph (1), (2) or (5), or if 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), if a trademark registration has been made in violation of item (xv) of that paragraph (excluding the case where a trademark has been registered for unfair purposes), or if a trademark registration falls under Article 46, paragraph (1), item (iv), a request for a trial related 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) If 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 relation to 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 if the registered trademark is well-known among consumers as that indicating goods and services in relation to the business of the holder of trademark right or its members, a request for a trial related to the trademark registration under Article 46, paragraph (1) may not be filed.

Articles 48 and 49 Deleted

(Trials for Rescission of Registration of Trademark)

Article 50 (1) If a registered trademark has not been used in Japan in relation to any of the designated goods or designated services for three consecutive years or longer by any of the holders of trademark rights, exclusive rights to use or non-exclusive rights to use, any person may file a request for a trial for rescission of registration of trademark in relation to the relevant designated goods or designated services.

(2) If a request for a trial under the preceding paragraph is filed, unless the demandee proves that any of the holder of trademark right, exclusive rights to use or non-exclusive rights to use has used the registered trademark in Japan in relation to any of the designated goods or designated services related to the request within three years before the registration of the request for the trial, the holder of trademark right may not prevent the rescission of the trademark registration in relation to the relevant designated goods or designated services; provided, however, that this does not apply if the demandee shows just causes for non-use of the registered trademark in relation to the relevant designated goods or designated services.

(3) If the registered trademark in relation to the designated goods or designated services related 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 before the filing of the request for a trial under paragraph (1) to the date of the registration of the filing of the request, and if 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) If a holder of trademark right intentionally uses either a trademark similar to a registered trademark in relation to the designated goods or designated services, or a registered trademark in relation to goods or services similar to the designated goods or designated services or a trademark similar to those, in a manner that misleads as to the quality of the goods or services or can be confused with the goods or services related to business of another person, any person may file a request for a trial to rescind 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 to it in relation to the designated goods or designated services for which the trademark registration has been canceled, or in relation to goods or services similar to them, until after a lapse of five years from the date the trial decision to revoke the trademark registration 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) If a trademark right to a similar registered trademark to be used in relation to identical goods or services, or a trademark right to an identical or similar registered trademark to be used in relation to similar goods or services becomes owned by a different holder of trademark right on the grounds stated in the items of Article 24-4, and 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 related to the business of any of the holders of trademark right, exclusive rights to use or non-exclusive rights to use of the other registered trademark, any person may file a request for a trial for rescission 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) If a holder of an exclusive right to use or a non-exclusive right to use uses a registered trademark in relation to the designated goods or designated services or in relation to goods or services similar to them, or a trademark similar to it, in a manner that misleads as to the quality of the goods or services or can be confused with the goods or services related 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 to it in relation to the designated goods or designated services for which the trademark registration has been rescinded, or in relation to goods or services similar to them, until after the lapse of five years from the date the trial decision to rescind the trademark registration 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 If a registered trademark is a trademark related to a right to a trademark (limited to a right equivalent to a trademark right) held by a person in a Country of the Union to the Paris Convention, a member state of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or a trademark similar to it, and the designated goods or designated services of it are goods or services related to those right or goods or services similar to them, and further, the application for trademark registration was filed without the approval of the person who has the right related to the trademark, without just cause, by their agent or representative or by their former agent or representative within one year before the filing date of the trademark registration, then the person who has the right related 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) If a trial decision to rescind the trademark registration becomes final and binding, the trademark right will be lapsed after that.

- (2) Notwithstanding the preceding paragraph, if a trial decision to rescind the trademark registration becomes final and binding by a trial under Article 50, paragraph (1), the trademark right is deemed to have lapsed 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 for Appeals Against Examiner's 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 the provisions do not apply where a decision to carry out further examinations on an appeal 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.

(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 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 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 decisions 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 good or designated service becomes final and binding for each designated good or designated service.

(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 appeal, administrative judge, trial or appeal procedures, relation to litigation, and cost of trial or appeal) of the Patent Act apply mutatis mutandis to trial or appeal. In this case, the term "the grounds for the request stated in paragraph (1), item (iii) of the preceding Article in the course of filing a request for a trial or appeal other than a trial for patent invalidation" in Article 131-2, paragraph (1), item(i) of the Patent Act is to be replaced with "the grounds for the request

stated 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 a trial and appeal other than a trial under Article 46, paragraph (1) of the Trademark Act", the term "trial for patent invalidation or a trial for patent invalidation concerning the registration of a patent term extension " in Articles 132, paragraph (1) and 167 of the Patent Act and the term "trial for patent invalidation and a trial for patent invalidation concerning the registration of a patent term extension in Articles 145, paragraph (1) and 169, paragraph (1) of the Patent Act are 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, "when a case...in a trial other than a trial for patent invalidation" in Article 156, paragraph (1) of the Patent Act is to be replaced with "when a case...", the terms "appeal against an examiner's decision of refusal" in Article 161 of the Patent Act and "appeal against an examiner's decision of refusal or a trial for correction" in Article 169, paragraph (3) of the Patent Act are to be replaced with "appeals under Article 44, paragraph (1) or Article 45, paragraph (1) of the Trademark Act".

- (2) The provision of Article 155, paragraph (3) (withdrawal of a request for trial) 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 Retrials and Reappeals and Litigation

(Request for a Retrial and Reappeals)

Article 57 (1) A party or intervenor in a case may file a request for a retrial or reappeals against a final and binding ruling to revoke 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 or reappeal under the preceding paragraph.

Article 58 (1) If the demandant of trials in conspiracy with the demandee has had a trial decision made 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 decisions.

- (2) A request for a retrial under the preceding paragraph must be filed against

the demandee and the demandee in the trial as joint demandees.

(Limitations of Effects of Trademark Rights Restored by a Retrial)

Article 59 If a trademark right related to a revoked, invalidated, or rescinded trademark registration has been restored by a retrial or reappeal, the trademark right has no effect on any of the following acts:

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

Article 60 (1) If a trademark right related to a revoked, invalidated, or rescinded trademark registration has been restored by a retrial or reappeal or, if the establishment of a trademark right with respect to an application for trademark registration refused by an appeal decision has been registered through a reappeal, and if a person, after the ruling to revoke or trial decision becomes final and binding but before the registration of a request for a retrial or reappeal, uses the registered trademark or a trademark similar to it in Japan in good faith in relation to the designated goods or designated services or in relation to goods or services similar to them, and as a result, the trademark has become well-known among consumers as that indicating goods or services related to the business of the person at the time of registration of the filing of a request for a retrial or reappeal, then the person has the right to use the trademark in relation to the goods or services as far as the 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 of 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 revoke.

- (2) The provisions of Article 55-2 and Article 55-3 apply mutatis mutandis to a reappeal against a final and binding decision on appeal under Article 44, paragraph (1).
- (3) The provisions of Article 55-3 and Article 56-2 apply mutatis mutandis to a reappeal against a final and binding decision on appeal under Article 45, paragraph (1).
- (4) The provisions of Article 55-3 apply mutatis mutandis to a retrial against a final and binding decision on trial 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 or reappeal) and Article 174, paragraphs (3) and (5) (Application mutatis mutandis of provisions regarding trials) of the Patent Act apply mutatis mutandis to a request for a retrial or reappeal. In this case, the term "Articles 167 through 168" in paragraph (3) of Article 174 is to be replaced with "Article 167, Article 168", the term "trial for patent invalidation or a trial for invalidation concerning the registration of a patent term extension" in that paragraph is 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".

(Mutatis Mutandis Application of the Design Act)

- Article 62 (1) The provision of Article 58, paragraph (2) (mutatis mutandis application of provisions of trials and appeals) of the Design Act applies mutatis mutandis to a reappeal against a final and binding decision on appeal 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 to be replaced with "Article 168".
- (2) The provisions of Article 58, paragraph (3) of the Design Act apply mutatis mutandis to a reappeal against a final and binding decision on appeal 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 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 revoke or trial or appeal decision, actions 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 actions 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) (statute of limitations for filing an action, etc.), Articles 179 through 182 (The Proper Defendant; Notice of the Filing of Action, Opinion of the Commissioner of the Japan Patent Office in Litigation Rescinding a Decision on a Trial or Appeal; Rescission of a Decision on a Trial or Appeal, or Ruling; and Sending of the Original of the Judicial Decision) of the Patent Act apply mutatis mutandis to the actions under the preceding paragraph. In this case, the term "trial for patent invalidation, or a trial for invalidation concerning the registration of a patent term extension" in Article 179 of the Patent Act is 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 Marks

(Requirements for Defensive Mark Registration)

- Article 64 (1) If a registered trademark related to goods is well-known among consumers as that indicating the designated goods in relation to the business of a holder of a trademark right, then the holder of the trademark right may, if the use by another person of the registered trademark in relation to goods other than the designated goods related to the registered trademark or goods similar to them, or in relation to 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 related to their own business, obtain a defensive mark registration for the mark identical with the registered trademark in relation to the goods or services for which the likelihood of confusion exists.
- (2) If a registered trademark related to services is well-known among consumers as that indicating the designated services in relation to the business of a holder of trademark right, then the holder of trademark right may, if the use by another person of the registered trademark in relation to services other than the designated services related to the registered trademark or services similar to them, or in relation to 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 related to their own business, obtain a defensive mark registration for the mark identical with the registered trademark in relation to the services or goods for which the likelihood of confusion exists.

- (3) To apply the preceding two paragraphs in relation to defensive mark registrations related to a trademark right related to a regional collective trademark, the phrase "their own" in those paragraphs is 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 decision on the application for trademark registration becomes final and binding.

- (3) The provisions of Article 10, paragraph (2) and, (3), and Article 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, matters 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 before the expiration of the right based on defensive mark registration to its date of expiration.
- (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. However, 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) If an application for registration of renewal of a right based on defensive mark registration is filed, then the term is deemed to have been renewed upon expiration (if an application is filed under the preceding paragraph, then upon filing of the application); provided, however, that this does not apply to cases where the examiner's decision or trial decisions refusing the application becomes final and binding or the renewal of a right based on defensive mark registration is registered.

Article 65-4 (1) If an application for registration of renewal of a right based on defensive mark registration falls under any of the following items, then the examiner must make a decision to refuse the application:

- (i) the registered defensive mark related 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) If no reasons for refusal are found in relation to an application for registration of renewal of a right based on defensive mark registration, then the examiner must make a decision to register the renewal.

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

- (2) Upon registration under the preceding paragraph, the following matters must be published in the trademark gazette:
- (i) the name and the domicile or residence of the person who has the right based on defensive mark registration;
 - (ii) the registration number and the date of registration of renewal; and
 - (iii) other necessary matters 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 classifications 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 classifications 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 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 certified copy of the examiner's decision or trial decisions registering a defensive mark.
- (2) A registration fee under Article 65-7, paragraph (2) must be paid within 30 days from the service of a certified copy of the examiner's decision or the trial decisions registering the renewal of the right based on defensive mark registration (if the service is made before the expiration of the right based on defensive mark registration, then 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) If a person required to pay a registration fee is unable to pay the registration fee within the period under paragraph (1) or (2) (if 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) If a person paying a registration fee is unable to pay the registration fee within the period provided in the preceding paragraph due to reasons beyond their control, notwithstanding the paragraph, that person may 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) An interested person who makes the payment of the registration fee under the preceding paragraph may claim reimbursement for those expenses to the extent of the actual benefit obtained by the person that is required to pay the registration fees.

(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) If a person filing a request for a registration fee refund as prescribed in paragraph (1) is unable to file the request within the period prescribed in the preceding paragraph due to reasons beyond their control, notwithstanding the provisions of paragraph (1), that person may file the request within 14 days (within 2 months for overseas residents) from the date on which the reasons ceased to be applicable, but no later than 6 months after the expiration of that period.

(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 related to it is divided.

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

(3) When a trademark right expires, the right based on a defensive mark registration related to it also expires.

(4) If a trademark right is deemed to have expired under Article 20, paragraph (4), the effects of the right based on defensive mark registration related 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) If a trademark right is deemed to have expired under Article 41-2 paragraph (6), the effect of the right based on defensive mark registration related to the trademark right restored under Article 41-3 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 making late payment of a second-

installment registration fee, but before the registration to make the trademark right deem to have existed under Article 41-3, paragraph (2), pursuant to Article 41-2, paragraph (5).

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

(Acts that Constitute Infringement)

Article 67 The following acts constitute infringement of a trademark right or an exclusive trademark license:

- (i) the use of the registered defensive mark in relation to 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 items 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 items ;
- (iv) the assignment, delivery, or possession or importation for the purpose of assignment or delivery of items 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 items ;
- (v) the possession of items indicating a registered defensive mark, for the purpose of using the registered defensive mark in relation to the designated goods or designated services;
- (vi) the assignment, delivery, or possession for the purpose of assignment or delivery, of items indicating a registered defensive mark, for the purpose of having the registered defensive mark used in relation to the designated goods or designated services; and
- (vii) the manufacture or importation of items indicating a registered defensive mark, for the purpose of using the registered defensive mark or having the registered defensive mark used in relation to 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 specified in Article 6, paragraph (2) " in Article 5, paragraph (1) is to be replaced with "(iii) the designated goods or designated services and the class of the goods or services provided by Cabinet Order as specified in Article 6, paragraph (2), (iv) the registration number of the trademark registration related 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 to be replaced with "(iv) the designated goods or designated services are not stated, (v) the registration number of the trademark registration related to the application for defensive mark registration is not stated" and the term "Article 37" in Article 13-2, paragraph (5) is to be replaced with "Article 67 (excluding the part related to item (i))".
- (2) The provisions of Articles 14 through 15-2 and 16 through 17-2 apply mutatis mutandis to the examination 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 the case of its mutatis mutandis application under Article 52-2, paragraph (2)), Article 53, paragraph (2)" in Article 15, item (i) is 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 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 certified copy of an examiner's decision or a trial decision indicating that a trademark is to be registered pursuant to Article 41-2, paragraph (1)" in Article 18, paragraph (2) is to be replaced with "the registration fee under Article 65-7, paragraph (1)".
- (4) The provisions of Article 43-2 (excluding item (iii)) through 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 related 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 its mutatis mutandis application under Article 52-2, paragraph (2)), and Article 53 paragraph (2)" in Article 43-2, item (i) and Article 46, paragraph (1), item (i) is to be replaced with "Article 64" and the

phrase "if ... the registered trademark has become a trademark that falls under any of Article 4, paragraph (1), items (i) through item (iii), item (v), item (vii), or item (xvi)" in Article 46, paragraph (1), item (vi) is to be replaced with "if ... the trademark registration becomes in violation of Article 64".

- (5) The provisions of the preceding Chapter apply mutatis mutandis to a retrial and a reappeal and litigation related to defensive mark registration. In this case, the term "each of the items in Article 37" in Article 59, item (ii) is to be replaced with "Article 67, items (ii) through (vii)", the term "a trademark right related to ... trademark registration" in Article 60 is to be replaced with "a right based on defensive mark registration in relation to ... defensive mark registration", the term "an application for trademark registration" in the same Article is to be replaced with "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 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 to it ... or in relation to goods or services similar to them" in the same Article is 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 in 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, if requirements provided by Order of the Ministry of Economy, Trade and Industry are applicable, then 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 country name(s) of the Contracting Party to the Protocol in which the protection of the trademark related to the application for international registration is sought; and
 - (ii) the goods or services in relation to which the protection of the trademark related to the application for international registration is sought and the classification 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 relation to a trademark or a mark related to the application for international registration must state this in the application and the color or the combination of colors claimed and append to the application copies of the trademark or indicator related 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, if the matters stated in the application correspond to the matters stated in the basic application for trademark registration, etc. or in the basic trademark registration, etc., then the Commissioner of the Patent Office must state that fact in the application 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") following 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 related 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 matters based on 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 its regulations 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 related 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) Matters stated in the left column of the following table contained in the International Register for the international registration designating Japan are deemed to be matters 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 specified by Cabinet Order as stated in Article 6, paragraph (2); |
| Among matters stated in the International Register, those required for interpreting the meaning of the description of a trademark subject to international registration as specified by Order 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) If a registered trademark (hereinafter referred to as a "registered trademark based on international registration" in this Article) related 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 referred to as an "international application for trademark registration" in this Chapter) is identical with the registered trademark before the trademark registration (excluding registered trademarks based on international registration, hereinafter referred to as a "registered trademark based on national registration" in this Article) and the designated goods or designated services related 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, then the international application for trademark registration is deemed to have been filed on the date of filing of the application for trademark registration related 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 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 Matters to be Contained in the Trademark Gazette

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 to be replaced with "the number and the date of the international registration (in the case of the international application for trademark registration related 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 "Commissioner of the Patent Office, except in the case of general successions including inheritance" in that paragraph is to be replaced with " 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 If all or part 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, then 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 certified copy of the examiner's decision under that paragraph 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 certified copy specified in that paragraph is deemed to have been served.

(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 "if 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 certified copy of an examiner's decision or a trial decision registering the trademark under Article 41-2, paragraph (1) is paid" in that paragraph is to be replaced with "if an examiner makes an examiner's decision or trial decision that a trademark is to be registered".

- (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 to be replaced with "the number and the date of international registration (in the case of the international application for trademark registration related 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 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) If all or part of the international registration on which the international application for trademark registration is based has expired, then the international application for trademark registration is deemed to have been withdrawn in respect of all or part of the designated goods or designated services that have expired.
- (2) If all or part of the international registration on which the international registration is based has expired, then 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 part 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 trademark term based on international registration expires after ten years from the date of the international registration (if the term of the international registration has been renewed before the registration of the establishment of the trademark right, then the date of most recent renewal).
- (2) The trademark term based on international registration may be renewed based on the renewal of international registration.
- (3) If the term of international registration is renewed, the trademark term based on international registration must be renewed at the time of expiration.
- (4) If 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) related to a trademark right based on international registration, the term "registration as stated under the preceding two paragraphs" in this paragraph is 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 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 under a 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, conversion, extinction, restoration or restriction on disposition of a trademark right" in that item is to be replaced with "the establishment, conversion due to trust or restriction on disposition of a trademark right".

(2) The renewal, the transfer, the conversion (excluding a conversion 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, trial or appeal, or retrial.

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

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

Article 68-29 To apply Article 69 related 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 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 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 classification 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, before international registration.

- (2) Any 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 classifications 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 international application for 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, the details of matters required for the implementation of the Protocol and regulations based on that Protocol 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) If an international registration related 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 to all or part of the goods or services listed in the international registration, then the person who was the registered holder of the international registration may file an application for trademark registration in relation to all or part of those goods or services.

(2) If an application for trademark registration under the preceding paragraph falls under all of the following items, then the application is deemed to have been filed on the date of international registration (if the international registration provided in that paragraph relates to subsequent designation, then it is the date of the subsequent designation related to the international registration) of the international registration under that paragraph.

(i) the application for trademark registration under the preceding paragraph is filed within three months from the date on which the international registration provided in the paragraph was rescinded;

(ii) the trademark for which registration is sought is identical with the trademark that was the subject of the international registration provided in the preceding paragraph; and

(iii) the designated goods or designated services in relation to the application for trademark registration provided in the preceding paragraph are within the scope of the goods or services listed in the international registration provided in the preceding paragraph.

(3) If an international application for trademark registration related to an international registration under paragraph (1) enjoyed a right of priority pursuant to Article 4 of the Paris Convention, then 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 related 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 provided in paragraph (1), the term "part of an application" in that paragraph is 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 provided in Article 68-32, paragraph (1))".
- (6) If a person filing an application for trademark registration provided in paragraph (1) is unable to file the application within the period as provided for in paragraph (2), item (i), that item due to reasons beyond their control, notwithstanding that item, 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 provided in the preceding paragraph is deemed to have been filed at the time of expiration of the time limit provided in paragraph (2), item (i).

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

Article 68-33 (1) If, 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, then the person who was the registered holder of that international registration may file an application for trademark registration in relation to 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 provided in the preceding paragraph. In this case, the phrase "within three months from the date on which the international registration provided in the paragraph was rescinded" in paragraph (2), item (i) of that Article is to be replaced with "within two years from the date on which the denunciation provided in 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 to be replaced

with "falls under any of the following items or if 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 related 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) related to a trademark right that was related to the international registration (referred to in Articles 68-37 and 68-39 as "re-filing of trademark right related to previous international registration").

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

Article 68-35 Notwithstanding Article 18, paragraph (2), if, in relation to an application for trademark registration under Article 68-32, paragraph (1) or Article 68-33, paragraph (1), the examiner makes an examiner's decision or the trial decision to register the trademark within ten years from the date of international registration of the international registration associated with that application (if the term of the international registration has been renewed, then the date of most recent renewal), then registration establishing the trademark right is made.

(Special Provisions on Trademark Term)

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 related to that application (if the term of the international registration has been renewed, then 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 related to a previous international registration, the term "trademark registration" in that Article is to be replaced with "trademark registration (in the case of a trademark registration for the re-filing of a trademark right related to a previous international registration, except any trademark registration for which the term provided in this Article has lapsed without any opposition to registration having been filed against the trademark registration related to the previous 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 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 related to a previous international registration, the phrase "may not be filed" in that Article is 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 related to previous international registration, even before 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 no longer be filed pursuant to this article for the trademark registration related to the previous 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 related to trademark registration or defensive mark registration, may make amendments related to those 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 classifications of goods or services related 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 if 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 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 is to include 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 is to 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) is not to 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 matters are registered in the trademark register, kept in the Patent Office:
- (i) the establishment, renewal, division, transfer, conversion, 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, conversion, extinction or restriction on disposition of exclusive trademark license or non-exclusive trademark license; and
 - (iv) the establishment, transfer, conversion, extinction, or restriction on disposition of a right of pledge on a trademark right, exclusive trademark license or non-exclusive trademark license.
- (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, matters related 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 concerning trademark registration or defensive mark registration to the Commissioner of the Patent Office to issue a certificate, a certified copy 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 finds it necessary to keep these documents or materials confidential, then these provisions do not apply in the case of the following documents:

- (i) documents related 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 decision made in that trial, with respect to which the party in the case or an intervenor has given notice that a trade secret owned by that party in the case or intervenor 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 applies 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 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) If the Commissioner of the Patent Office approves of the request under the main clause of the preceding paragraph concerning the documents as provided in item (i) through (iii) of that paragraph, then the Commissioner of the Patent Office notifies the person who submitted those documents of this and reasons for approval.
- (3) Provisions of the Act on 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 trademark licensee or non-exclusive trademark licensee affixes the registered trademark to the designated goods, packaging of the designated goods or items 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 related 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 indicator (hereinafter referred to as an "indicator of trademark registration") stating that the trademark is a registered trademark.

(Prohibition of Misrepresentation)

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

- (i) affixing an indicator of trademark registration, or an indicator which could be confused as a trademark registration, in using a trademark that is not a

- registered trademark;
- (ii) affixing an indicator of trademark registration, or an indicator 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 items affixed on goods or on their packaging, a trademark other than a registered trademark, items affixed on goods other than designated goods, or on their packaging, a registered trademark in relation to goods, or items affixed on goods or on their packaging, a registered trademark in relation to services, where the indicator of trademark registration or an indicator which could be confused in the same way is affixed to that trademark;
 - (iv) the possession or importation of items 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, items affixed with a registered trademark in relation to 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 items affixed with a registered trademark in relation to goods, that are used in the course of the provision of services by a person who receives those services, where the indicator of trademark registration or an indicator which could be confused in the same way is affixed to those trademark (hereinafter referred to in the following item as "items with a false indicator of trademark registration related to services"), for the purpose of the provision of those services through use of those items; and
 - (v) the assignment, delivery, or possession or importation for the purpose of assignment or delivery of items with a false indicator of trademark registration related to services, for the purpose of causing the provision of those services through use of those items;

(Trademark Gazette)

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

- (2) Beyond the matters provided in this Act, the trademark gazette must contain the following:
- (i) an examiner's decision rejecting an application, 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 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 of any of these;
- (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 person in an amount to be provided by Cabinet Order in view of the actual costs:

- (i) a person 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) a person 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 4 or Article 5, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to 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)), Article 65-8, paragraph (3) or Article 77, paragraph (1) of this Act, or for 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) a person filing an application for international registration to the Commissioner of the Patent Office pursuant to Article 68-2 (excluding paragraph (5));
- (iv) a person presenting to the Commissioner of the Patent Office a request for subsequent designation pursuant to Article 68-4;
- (v) a person filing an application for renewal of international registration to the Commissioner of the Patent Office pursuant to Article 68-5;
- (vi) a person 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) a person filing a request for the re-issuance of a certificate of trademark registration or defensive mark registration;

- (viii) a person filing a request for the issuance of a certificate pursuant to Article 72, paragraph (1);
 - (ix) a person filing a request for the issuance of a certified copy of documents or an extract of documents pursuant to Article 72, paragraph (1);
 - (x) a person 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) a person 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 person 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 if the person required to pay the fee in accordance with these paragraphs is the national government.
 - (4) If 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 on, notwithstanding the provisions of paragraph (1) or (2), then the fees payable as a result (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 person other than the national government must pay the sum.
 - (5) If the fees calculated under the preceding paragraph have a fractional figure of less than ten yen, that portion must be discarded.
 - (6) The fees under paragraph (1) or (2) must be paid with patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that in cases specified by Order of the Ministry of Economy, Trade and Industry, the payment may be made in cash if permitted under Order of the Ministry of Economy, Trade and Industry.
 - (7) Fees paid in excess or in error must be refunded upon the request of the person that paid them.
 - (8) No refund of the fees may be requested under the preceding paragraph after one year has passed since the date of payment.
 - (9) If a person filing a request for a refund of fee pursuant to paragraph (7) is unable to file the request within the period provided in the preceding paragraph due to reasons beyond their control, notwithstanding the provisions of this paragraph, that person may file the request within 14 days (within 2 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 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 related to trademark registration or defensive mark registration. In this case, the phrase "appeal against an examiner's decision of refusal " in Article 9 of the Patent Act is to be replaced with "appeal under Article 44, paragraph (1) or Article 45, paragraph (1) of the Trademark Act", the phrase "appeal against an examiner's decision of refusal " in Article 14 of the Patent Act is to be replaced with "appeal under Article 44, paragraph (1) or Article 45, paragraph (1) of the Trademark Act", the phrase "(ii) the procedure does not comply with the formal requirements specified by this Act or to an order that is based on this Act;" in Article 17, paragraph (3) of the Patent Act is to be replaced with "(ii) the procedures do not comply with the formal requirements specified by this Act or an order that is based on this Act ; (ii)-2 related to the procedures, the registration fee under Article 40 paragraph (2) of the Trademark Act or the registration fee (including the registration surcharge due and payable pursuant to Article 43, paragraph (1) or (2) of the Trademark Act) payable at the time of application for registration of renewal pursuant to Article 41-2, paragraph (7) of the Trademark Act is not paid", the term "any of the items of Article 38-2, paragraph (1)" in Article 18-2, paragraph (1) of the Patent Act is to be replaced with "any of the items in Article 5-2, paragraph (1) of the Trademark Act (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph (1) of the Trademark Act)".
- (3) The provisions of Article 25 (Enjoyment of Rights by Foreign Nationals) of the Patent Act apply mutatis mutandis to a trademark right and other rights related to the trademark registration.
- (4) The provisions of Article 26 (Effect of Treaties) of the Patent Act apply mutatis mutandis to the trademark registration and defensive mark registration.
- (5) The provisions of Articles 189 through 192 (Service) of the Patent Act apply mutatis mutandis to service provided in this Act.
- (6) The provisions of Article 195-3 of the Patent Act apply mutatis mutandis to

dispositions under this Act or under an order based on this Act.

(7) Article 195-4 (Restriction on Request for Administrative Review Under the Provisions of the Administrative Complaint Review Act) of the Patent Act applies *mutatis mutandis* to an examiner's decision, a ruling to dismiss an amendment, revocation decision, or trial decision, for a ruling to dismiss a statement of opposition to registration of a trademark, for a written request for a trial or retrial, or for a disposition against which no appeal may be filed pursuant to this Act, or inactions thereof.

(Transitional Measures)

Article 77-2 When an order is established, revised or repealed pursuant to this Act, transitional measures (including transitional measures related to penal provisions) to the extent reasonably necessary for the establishment, revision or repeal may be provided by that order.

Chapter IX Penal Provisions

(Crime of Infringement)

Article 78 An infringer of a trademark right or an exclusive trademark license (excluding one who has committed an act that is deemed to constitute infringement of a trademark right or an exclusive trademark license 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 trademark license 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 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 by them, 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 certified copy 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.

(Provisions for Dual Liability)

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 business 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 the relevant Article:

(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 corporation 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 those

provisions.

(Civil 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 by them, that person is subject to a civil fine not exceeding 100,000 yen.

Article 84 Any person who has been summoned by the Patent Office or a court commissioned by them 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 civil fine not exceeding 100,000yen.

Article 85 Any person who has been ordered by the Patent Office or a court commissioned by them 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 just cause is subject to a civil fine not exceeding 100,000yen.

Appended Table (Re: Article 76)

| | A person who must pay the fees | Amounts |
|---|---|--|
| 1 | A person filing an application for trademark registration | 6,000 yen per case plus 15,000 yen for each class |

| | | |
|----|--|--|
| 2 | A person filing an application for defensive mark registration or for registration or renewal of a right based on a defensive mark registration | 12,000 yen per case plus 30,000 yen for each class |
| 3 | A person responsible for the procedures under Article 9, paragraph(3), Article 43, paragraph(7) of the Patent Act as applied mutatis mutandis under Article 13, paragraph(1), Article 41, paragraph(3), Article 41-2, paragraph(3), Article 65-8, paragraph(4) or Article 5, paragraph(3) of the Patent Act as applied mutatis mutandis under Article 77, paragraph(1) | 4,200 yen per case |
| 4 | A person requesting the division of a trademark right | 30,000 yen per case |
| 5 | A 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 the 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 | A person requesting an advisory opinion pursuant to Article 28, paragraph (1) (including cases where it is applied mutatis mutandis pursuant to Article 68, paragraph(3)) | 40,000 yen per case |
| 7 | A person filing an opposition to registration | 3,000 yen per case plus 8,000 yen for each class |
| 8 | A person requesting to intervene in proceedings of an opposition to registration | 11,000 yen per case |
| 9 | A person filing a request for a trial or retrial | 15,000 yen per case plus 40,000 yen for each class |
| 10 | A person requesting to intervene in a trial or retrial | 55,000 yen per case |