

Japan Patent Office (JPO)
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Chiyoda-ku
Tokyo 100-8915
JAPAN



日本国特許庁
〒100-8915
東京都千代田区霞が関3-4-3

NOTIFICATION OF PROVISIONAL REFUSAL

This notification is issued by the Japan Patent Office (JPO) in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement and Section 15-2 and 15-3 of the Japanese Trademark Law.

I. International registration number: 1290408
Mark: VITRA
Date of international registration: 2015/12/02
Holder of the international registration:
VITRA PATENTE AG

II. This trademark application* shall be totally refused protection. The grounds for refusal are indicated under Item V. A copy of the corresponding provisions of the Japanese Trademark Law is attached to this notification.

III. This refusal is issued on August/23/2016 by

Meguro Jun (Mr.)
Examiner
Madrid Protocol Division
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IV. The trademark of this application can be protected subject to amendments to be made by the holder of the international registration as suggested under Item VI. The amendment must be made through the intermediary of a representative domiciled in Japan within three months from the date of pronouncement, as indicated below. If any, the holder may submit to the JPO a written opinion against this provisional refusal through the intermediary of a representative domiciled in Japan by the same date. Alternatively, the holder may request a limitation of the list of goods and/or services in accordance with Rule 25(1)(a) of the Common Regulations. This request must be presented to the International Bureau of WIPO by Official Form MM6.

*All communications via telephone and facsimile except for general inquiries will be recorded and stored in the file wrapper disclosed upon request in order to secure transparency.

* A request for territorial extension to Japan under the Protocol relating to the Madrid Agreement is deemed as a trademark application made in Japan in accordance with Section 68-9 of the Japanese Trademark Law.

Continuation sheet

V. The grounds for refusal

Ground 1

This application does not conform to the requirements provided for under Section 6(1) of the Trademark Law because some of the designated goods and services are inappropriately described in this application in a vague/broad manner(see below).

[vague/broad description]

Class 09 Starter motors for fluorescent tubes; cable junction unit, energy distribution units, control units.

<Example for amendment>

1) starter motors for fluorescent tubes;
--> electronic starters for fluorescent tubes;

2) cable junction unit,
--> junction sleeves for electric cables;

3) energy distribution units,
--> electrical energy distribution apparatus;

4) control units,
--> regulating apparatus, electric;

Class 11 Beacons, mobile projector installations consisting of beacons and electronic voltage transformers.

<Example for amendment>

1) beacons,

*NOTE

We have no suggestion. Those terms should be limited goods/services referring to the alphabetical list of the Nice Agreement, or be deleted.

2) mobile projector installations consisting of beacons and electronic voltage transformers;
--> mobile light projectors consisting of beacons and electronic voltage transformers;

Class 19 Partitions, in particular for shop fittings and parts for shop fittings.

<Example for amendment>

1) Partitions, in particular for shop fittings and parts for shop fittings;
--> Partitions in particular for shop fittings and parts for shop fittings, not of metal;

Class 20 Shelf supports (furniture); shelf brackets, in particular shelf brackets with hanging fittings for clothes shops, tray holders and bars for clothing; panels for indicating price and size, included in this class; building elements (furniture) for display stands window, decorations and sales stores; lower tray parts and separating walls not of metal, in particular for shop fittings; tray holders and bars of metal for clothing; lower tray parts of metal, in particular for shop fittings and parts for shop fittings.

<Example for amendment>

1) shelf supports (furniture);
--> shelf supports (not of metal);

2) shelf brackets, in particular shelf brackets with hanging fittings for clothes shops,

Continuation sheet

--> shelf brackets for furniture, not of metal, in particular shelf brackets with hanging fittings for clothes shops;

3) tray holders and bars for clothing;

--> trays for clothing and clothes rails, not of metal;

4) panels for indicating price and size, included in this class;

--> panels being parts for furniture, included in this class;

5) building elements (furniture) for display stands window, decorations and sales stores;

--> building elements (furniture) for display stands, window, decorations and sales stores;

6) lower tray parts and separating walls not of metal, in particular for shop fittings;

--> lower tray parts and wall screens (furniture), not of metal, in particular for shop fittings;

7) tray holders and bars of metal for clothing; lower tray parts of metal, in particular for shop fittings and parts for shop fittings;

*NOTE

We have no suggestion. Those terms should be limited goods/services referring to the alphabetical list of the Nice Agreement, or be deleted.

Class 42 Lighting engineering services; lighting planning; drafting of lighting installations.

<Example for amendment>

1) lighting engineering services;

--> engineering services for the measuring of light;

2) lighting planning;

--> lighting design;

3) drafting of lighting installations.

--> design services relating to lighting apparatus.

*Please note that this suggestion is applied to Ground 1 only. This application, however, still falls under other ground for refusal even if the above description is appropriately amended.

Ground 2

The trademark of this application falls under Section 4(1)(xi) of the Trademark Law because this trademark is identical with or similar to the following trademark(s) and is to be used for the goods and/or services identical with or similar to the designated goods and/or services covered by this(these) trademark registration(s).

Cited registered trademark(s)

No. 1

- International registration No.: 1164936
- Subsequent designation date: 2013/07/02
- The date of granting protection: 2015/06/19
- Name and address of the holder: ECZACIBASI HOLDING ANONIM SIRKETI
Kanyon Ofis Buyukdere Cad. No: 185 Levent Istanbul

Mark:

VitrA

Continuation sheet

Conflicting goods and/or services and their class(es), corresponding to class 06, 19 and 20 covered in this application:

International class 06:

Metal valves not being parts of machines; metal bath grab bars.

International class 19:

Drain pipes not of metal or plastic; water control valves, water inlet valves and outlet valves, water pipe valves and water regulating valves, none of metal or plastic; tiles, not of metal; ceramic wall tiles, ceramic floor tiles, porcelain floor tiles, tiles for adjoining partitions, not of metal, external tiles for buildings, not of metal.

International class 21:

Ceramics for household purposes; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; dispensers and holders for paper wipes, hand towels and toilet paper; toilet brushes and toilet brush holders; towel rings; towel rails and towel rail mountings; soap dispensers.

- VI. The trademark of this application will be protected if the goods and services are amended/limited as follows: (Examples are underlined. The underlined goods/services are the examples of amendment/limitation of the goods/services shown in V. Sometimes there are no underlined goods/services.)

Class 35 remains unchanged.

Classes 6 and 19 should be deleted.

- 9 Electric cables, wires, conductors and fittings for related connections and switches; brightness regulators; electrical components, included in this class, namely switches, resistors, batteries, plugs, sockets, plug connectors; electric wires; cable ducts; electronic starters for fluorescent tubes; junction sleeves for electric cables; fuse boxes, energy distribution installations, namely installations for the distribution of electricity to lamps and sockets; electrical energy distribution apparatus; lighting control installations for turning lights on and off, reducing brightness of lamps, regulating apparatus, electric; electronic installations for reducing the consumption of lamps, power regulators, transformers.
- 11 Lighting installations and apparatus and their parts, in particular lamps and lighting units for commercial, industrial and private use, lamps and their accessories and mounting devices for lamps, in particular wall or ceiling fasteners, lamps, lighting articles, particularly light bulbs, fluorescent tubes, halogen lamps; lamp shades; lighting apparatus; solar lamps, street lamps, workshop and warehouse lamps, mobile light projectors consisting of beacons and electronic voltage transformers; office lamps.
- 20 Furniture, in particular showcases; shelf supports (not of metal); curtain rods and rods for clothing (parts of furniture); shelves, in particular for shops and display stands; shelves, shelf brackets for furniture, not of metal, in particular shelf brackets with hanging fittings for clothes shops; trays for clothing and clothes rails, not of metal; angled tables, in particular for shops, building elements (furniture) for display stands, window, decorations and sales stores; lower tray parts and wall screens (furniture), not of metal, in particular for shop fittings; display boards of wood or plastic; deflection mirrors.
- 42 Architectural services; industrial design; design of packaging; interior design services; services of an interior decorator; technical project study; technical design and planning of lighting apparatus, installations and concepts; engineering services for the measuring of light; lighting design; design services relating to lighting apparatus.

Extract from the Japanese Trademark Law

Article 3 Requirements for trademark registration

- (1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:
- (i) consists solely of a mark indicating, in a common manner, the common name of the goods or services;
 - (ii) is customarily used in connection with the goods or services;
 - (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages; the same shall apply in Article 26(1)(ii) and (iii)), the method or features including time of production or use, quantity, price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or features including time, quantity or price of provision;
 - (iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person;
 - (v) consists solely of a very simple and common mark; or
 - (vi) is in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.
- (2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.

Article 4 Unregistrable trademarks

- (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:
- (i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;
 - (ii) is identical with, or similar to, the coats of arms or any other State emblems (except national flags of any country of the Union to the Paris Convention, member of the World Trade Organization or Contracting Party to the Trademark Law Treaty) of a country of the Union to the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967; the same shall apply hereinafter), a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty designated by the Minister of Economy, Trade and Industry;
 - (iii) is identical with, or similar to, a mark indicating the United Nations or any other international organization (referred to as "international organization" in (b)) which has been designated by the Minister of Economy, Trade and Industry (excluding those listed in the following);
 - (a) is identical with, or similar to, a trademark which is well known among consumers as that indicating goods or services in connection with the applicant's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto; and
 - (b) is identical with, or similar to, a mark indicating abbreviation of any international organization, which has been used for goods or services that is not likely to mislead as to connection to the international organization;
 - (iv) is identical with, or similar to, the emblems or titles in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Act No.159 of 1947) or the distinctive emblem in Article 158(1) of the Act Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Act No.112 of 2004);
 - (v) is comprised of a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national or a local government of Japan, a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if such a trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used;
 - (vi) is identical with, or similar to, a famous mark indicating the State, a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest;
 - (vii) is likely to cause damage to public policy;
 - (viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);
 - (ix) is comprised of a mark identical with, or similar to, a prize awarded at an exhibition held by the national or a local government (hereinafter referred to as the "Government, etc.") or by those who are not the Government, etc. that conforms to the standards specified by the Commissioner of the Patent Office, or at an international exhibition held in a foreign country by the Government, etc. of the foreign country or those authorized thereby (except those used by the recipient of such a prize as part of his/her own trademark);
 - (x) is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;
 - (xi) is identical with, or similar to, another person's registered trademark which has

- been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (referring to goods or services designated in accordance with Article 6(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(1)); the same shall apply hereinafter), or goods or services similar thereto;
- (xii) is identical with a registered defensive mark of another person (referring to a mark registered as a defensive mark; the same shall apply hereinafter), if such a trademark is used in connection with designated goods or designated services relating to the defensive mark;
 - (xiii) deleted
 - (xiv) is identical with, or similar to, the name of a variety registered in accordance with Article 18(1) of the Plant Variety Protection and Seed Act (Act No. 83 of 1998), if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto;
 - (xv) is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);
 - (xvi) is likely to mislead as to the quality of the goods or services;
 - (xvii) is comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by the said member from being used on wines or spirits not originating from the region of the said member, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of the said member;
 - (xviii) consists solely of features provided by Cabinet Order among features that are naturally provided to goods, etc. (goods, or packages of goods, or services; the same shall apply in Article 26(1)(v)); or
 - (xix) is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);
- (2) Where the State or a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a person undertaking a non-profit activity for public interest files an application for trademark registration falling under item (vi) of the preceding paragraph, the provision of the said item shall not apply.
- (3) Items (viii), (x), (xv), (xvii) and (xix) of paragraph (1) shall not apply to a trademark falling under any of the said items which does not fall under the said item at the time of filing of an application for trademark registration.

Article 5 Application for trademark registration

- (4) Where a person desires to register any trademark provided by Cabinet Order of the Ministry of Economy, Trade and Industry, the application shall state the detailed description of the trademark in the application pursuant to Ordinance of the Ministry of Economy, Trade and Industry, or affix materials provided by Ordinance of the Ministry of Economy, Trade and Industry to the application.
- (5) The statement and materials in the preceding paragraph shall specify the trademark for which a registration is sought.

Article 6 Single trademark on each application

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

Article 7 Collective trademarks

- (1) A general incorporated association or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto shall be entitled to obtain a collective trademark registration with respect to a trademark to be used by their members.
- (2) For the purpose of the application of Article 3(1), in the case of the preceding paragraph, "applicant" in the said paragraph shall read "applicant or its members."
- (3) Any person who desires to register a collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1).

Article 7-2 Regional collective trademarks

- (1) Any association established by a special Act, including a business cooperative (those which do not have juridical personality are excluded, and limited to those which are established by a special Act providing, without a just cause, that the association shall not refuse the enrollment of any person who is eligible to become a member or that the association shall not impose on any of its prospective members any condition that is heavier than those imposed on its existing members), a commerce and industry association, chambers of commerce and industry or specified non-profit corporation specified in Article 2(2) of Act on

- (i) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members;
- (ii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the name customarily used as a name indicating the goods or services pertaining to the business of the applicant or its members; or
- (iii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members or the name customarily used as a name indicating thereof, and characters customarily added in indicating, in a common manner, the place of origin of the goods or the location of provision of the services.

(2) The term "name of the region" as used in the preceding paragraph means, even prior to the filing of the said application, the name of the place of origin of the goods, the location of provision of services, or the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent, for which the trademark pertaining to the said application has been used by the applicant or its members, or abbreviation thereof.

(3) For the purpose of the application of Article 3(1) {limited to the part pertaining to items (i) and (ii)} in the case of paragraph (1), "applicant" in the said paragraph shall read "applicant or its members."

(4) Any person who desires to register a regional collective trademark pursuant to paragraph (1) shall, at the time of filing of an application for trademark registration pursuant to Article 5(1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is an Association, etc. and documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in paragraph (2).

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

Where an application for trademark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused:

- (i) the trademark pertaining to an application for trademark registration is not registrable pursuant to the provisions of Articles 3, 4(1), 7-2(1), 8(2), 8(5), 51(2) (including the case of its *mutatis mutandis* application under Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied *mutatis mutandis* under 77(3) of this Act;
- (ii) the trademark pertaining to an application for trademark registration is not registrable pursuant to the provisions of a relevant treaty; or
- (iii) the application for trademark registration does not comply with the requirements provided in Article 5(5), or Article 6(1) or 6(2).

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

(Creation Date :Sep 1,2015)