

Japan Patent Office (JPO)  
4-3, Kasumigaseki 3-chome  
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: 1251408  
Mark: TESLA (with figurative elements)  
Date of subsequent designation: 2016/03/03  
Holder of the international registration:  
Internet group d.o.o.

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 December/08/2016 by

UCHIDA Naoki (Mr.)  
Examiner  
Madrid Protocol Division  
Facsimile: +81-3-3593-2398  
Telephone: +81-3-3501-2392

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.

Note: 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.

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\* 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.

The date of pronouncement: 2016/12/22

## 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 07 Degreasers [machines].

## Ground 2

The trademark of this application does not conform to the requirements as provided in the main paragraph of Section 3(1) of the Trademark Law because of the following reason:

The main paragraph of Section 3(1) requires that registerable trademarks either be currently in use or will be put into use in the near future; however, there is reasonable doubt as to whether the applicant currently uses or will use in the near future this trademark on the designated goods or services, as indicated below, because the designated goods or services come under too wide a scope within one class:

**[All the designated goods or services in Class(es) 7, 9 and 11 ]**

However, the above reason for refusal will be resolved if the above-mentioned doubt, as to the use of or the intent to use this trademark, is eliminated by the applicant's taking any of the following procedures (a), (b) or (c):

(a) Proving that the applicant is conducting business connected with the above-mentioned designated goods or services in Japan by submitting some documents such as newspaper articles, catalogs, business documents etc.;

(b) Proving that the applicant is planning to conduct business connected with the above-mentioned designated goods or services in Japan within three to four years from the date of the international registration or the subsequent designation by submitting both of the following documents:

(i) A written Declaration of Intention to Use stating when this trademark will begin to be used and what goods or services this trademark will be used for in Japan; and

(ii) Documents of Business Plan stating the current status of the applicant's business preparations; or

(c) Limiting the above-mentioned designated goods or services to an appropriate range.

For your reference, examples of amendments/limitations can be found in Item VI.

<Important notes for proving (a) or (b) above>

(1) The Examination Guidelines are available on the JPO website at [http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/pdf/tt1303-061\\_3\\_6.pdf](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1303-061_3_6.pdf)

(2) The above-mentioned documents for proving (a) or (b) must be accompanied with a Japanese translation and submitted to the JPO through the intermediary of a representative domiciled in Japan.

## Ground 3

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). Please note that the cited trademarks indicated below include the subject of application procedures, and the trademark of this application will fall under Section 4(1)(xi) once registration procedures with respect to the above-mentioned trademark(s) are completed in due course.

## Continuation sheet

Cited registered trademark(s)

No. 1

- National registration No.: 2324676                      - Registration date: 1991/07/31
- National application No.: S63-093164                - Application date: 1988/08/12
- Name and address of the holder: Fukui Megane Kogyo Kabushiki Kaisha  
(& 1 Other holder(s))  
2-11, Kitano-cho 2-chome, Sabae-shi, Fukui-ken, JAPAN

Mark:

**TESLA**

Conflicting goods and/or services and their class(es), corresponding to class 09 covered in this application:

International class 09:  
眼鏡

No. 2

- National registration No.: 5244727                      - Registration date: 2009/07/03
- National application No.: 2008-030232                - Application date: 2008/04/17
- Name and address of the holder: NVIDIA Corporation  
2701 San Tomas Expressway, Santa Clara, CA 95050, USA

Mark:

T E S L A

Conflicting goods and/or services and their class(es), corresponding to class 09 covered in this application:

International class 09:  
コンピュータハードウェア, コンピュータソフトウェア, 集積回路, 半導体素子, マイクロプロセッサ, 電子新聞, 電子雑誌, コンピュータハードウェア・コンピュータソフトウェア・集積回路・半導体素子・マイクロプロセッサに関するユーザーマニュアルを内容とする電子出版物

No. 3

- National registration No.: 5379250                      - Registration date: 2010/12/24
- National application No.: 2009-080933                - Application date: 2009/10/26
- Name and address of the holder: Tesla Motors Inc.  
3500, Deer Creek Road, Palo Alto, CA 94304, USA

Mark:

T E S L A

Conflicting goods and/or services and their class(es), corresponding to class 09 and 11 covered in this application:

International class 12:  
電気自動車, 電気自動車の部品, 陸上の乗物用の駆動原動機, 完全電池電気式高性能スポーツ自動車, 乗物用車軸, 自動車用車体, 陸上の乗物用ブレーキパッド及びブレーキライニング, 陸上の乗物用のブレーキキャリパー, 自動車用ブレーキ, 自動車用バンパー, 自動車用クラッチ, 差動歯車, クラッチ用メインドライブシャフト, 変速機のギアチェンジレバー, 陸上の乗物用のトランスミッション, 陸上の乗物用トランスミッションのシャフト, 自動車用ラジエーターグリル, 陸上の乗物用油圧緩衝器, 陸上の乗物用の連結器, 陸上の乗物用のベアリング, 動力伝導用ベルト, 自動車用シャシー, 自動車用のパワーステアリング装置, 自動車のシート

## Continuation sheet

ベルト、座席、自動車用サンルーフ、乗物用車輪用ハブ、乗物用車輪、自動車用方向指示器、扉、自動車用ドアハンドル、警音器、バックミラー、荷台、車用スキーキャリアー、泥よけ、タイヤチェーン、自動車用ヘッドレスト、ルーフラック、緩衝器、ばね、スタビライザーバー、ハンドル、サスペンション、乗物用トーションバー、自動車用窓、ワイパー、自動車用アームレスト、乗物用車輪のバランスおもり、自動車用エンジン、制動装置、自動車用動力伝動装置、自動車用の変速機、自動車の燃料タンク、自動車用荷物台、予備車輪支持具、自動車用トリムパネル、陸上の乗物用の動力機械（その部品を除く。）、陸上の乗物用の機械要素、陸上の乗物用の交流電動機又は直流電動機（その部品を除く。）、自動車並びにその部品及び付属品

No. 4

- National registration No.: 5379251      - Registration date: 2010/12/24
- National application No.: 2009-080934      - Application date: 2009/10/26  
(priority date under the Paris Convention: 2009/07/21)
- Name and address of the holder: Tesla Motors Inc.  
3500, Deer Creek Road, Palo Alto, CA 94304, USA

Mark:



Conflicting goods and/or services and their class(es), corresponding to class 09 and 11 covered in this application:

International class 12:

電気自動車、電気自動車の部品、陸上の乗物用の駆動原動機、完全電池電気式高性能スポーツ自動車、乗物用車軸、自動車用車体、陸上の乗物用ブレーキパッド及びブレーキライニング、陸上の乗物用のブレーキキャリパー、自動車用ブレーキ、自動車用バンパー、自動車用クラッチ、差動歯車、クラッチ用メインドライブシャフト、変速機のギアチェンジレバー、陸上の乗物用のトランスミッション、陸上の乗物用トランスミッションのシャフト、自動車用ラジエーターグリル、陸上の乗物用油圧緩衝器、陸上の乗物用の連結器、陸上の乗物用のベアリング、動力伝導用ベルト、自動車用シャーシ、自動車用のパワーステアリング装置、自動車のシートベルト、座席、自動車用サンルーフ、乗物用車輪用ハブ、乗物用車輪、自動車用方向指示器、扉、自動車用ドアハンドル、警音器、バックミラー、荷台、車用スキーキャリアー、泥よけ、タイヤチェーン、自動車用ヘッドレスト、ルーフラック、緩衝器、ばね、スタビライザーバー、ハンドル、サスペンション、乗物用トーションバー、自動車用窓、ワイパー、自動車用アームレスト、乗物用車輪のバランスおもり、自動車用エンジン、制動装置、自動車用動力伝動装置、自動車用の変速機、自動車の燃料タンク、自動車用荷物台、予備車輪支持具、自動車用トリムパネル、陸上の乗物用の動力機械（その部品を除く。）、陸上の乗物用の機械要素、陸上の乗物用の交流電動機又は直流電動機（その部品を除く。）、自動車並びにその部品及び付属品

No. 5

- National registration No.: 5422700      - Registration date: 2011/07/01
- National application No.: 2010-002706      - Application date: 2010/01/18  
(priority date under the Paris Convention: 2009/07/21)
- Name and address of the holder: Tesla Motors Inc.  
3500, Deer Creek Road, Palo Alto, CA 94304, USA

Mark:

TESLA

Conflicting goods and/or services and their class(es), corresponding to class 09 and 11 covered in this application:

International class 07:

陸上の乗物用交流発電機

International class 09:

蓄電池（乗物用）

## Continuation sheet

## International class 12:

電気自動車, 電気自動車の部品, 陸上の乗物用の駆動原動機, 完全電池電気式高性能スポーツ自動車, 乗物用車軸, 自動車用車体, 陸上の乗物用ブレーキパッド及びブレーキライニング, 陸上の乗物用のブレーキキャリパー, 自動車用ブレーキ, 自動車用バンパー, 自動車用クラッチ, 差動歯車, クラッチ用メインドライブシャフト, 変速機のギアチェンジレバー, 陸上の乗物用のトランスミッション, 陸上の乗物用トランスミッションのシャフト, 自動車用ラジエーターグリル, 陸上の乗物用油圧緩衝器, 陸上の乗物用の連結器, 陸上の乗物用のベアリング, 動力伝導用ベルト, 自動車用シャーシ, 自動車用のパワーステアリング装置, 自動車のシートベルト, 座席, 自動車用サンルーフ, 乗物用車輪用ハブ, 乗物用車輪, 自動車用方向指示器, 扉, 自動車用ドアハンドル, 警音器, バックミラー, 荷台, 車用スキーキャリアー, 泥よけ, タイヤチェーン, 自動車用ヘッドレスト, ルーフラック, 緩衝器, ばね, スタビライザーバー, ハンドル, サスペンション, 乗物用トーションバー, 自動車用窓, ワイパー, 自動車用アームレスト, 乗物用車輪のバランスおもり, 自動車用エンジン, 制動装置, 自動車用動力伝動装置, 自動車用の変速機, 自動車の燃料タンク, 自動車用荷物台, 予備車輪支持具, 自動車用トリムパネル, 陸上の乗物用の動力機械 (その部品を除く。), 陸上の乗物用の機械要素, 陸上の乗物用の交流電動機又は直流電動機 (その部品を除く。), 自動車並びにその部品及び付属品, 船舶並びにその部品及び付属品, 航空機並びにその部品及び付属品, 鉄道車両並びにその部品及び付属品, 二輪自動車・自転車並びにそれらの部品及び付属品

No. 6

- National application No.: 2015-077356 - Application date: 2015/08/11  
(priority date under the Paris Convention: 2015/02/11)
- Name and address of the holder: NVIDIA Corporation  
2701 San Tomas Expressway, Santa Clara, CA 95050, USA

Mark:

**TESLA**

Conflicting goods and/or services and their class(es), corresponding to class 09 covered in this application:

## International class 09:

すべての住居・建物及び人工設備への電力の貯蔵及び供給用の電池システム・機器, 電力網その他の発電源により又はそれらに供給される電力の貯蔵・供給・送電及び安定化に使用される電池システム・機器, 前記電池システムへの及びそれらからのエネルギーの貯蔵・伝送及び放出の監視・最適化及び調整用のコンピュータソフトウェア, 太陽電池, 電池, 電子応用機械器具及びその部品

No. 7

- National application No.: 2015-077358 - Application date: 2015/08/11  
(priority date under the Paris Convention: 2015/02/11)
- Name and address of the holder: NVIDIA Corporation  
2701 San Tomas Expressway, Santa Clara, CA 95050, USA

Mark:

**TESLA**

Conflicting goods and/or services and their class(es), corresponding to class 09 covered in this application:

## International class 09:

すべての住居・建物及び人工設備への電力の貯蔵及び供給用の電池システム・機器, 電力網その他の発電源により又はそれらに供給される電力の貯蔵・供給・送電及び安定化に使用される電池システム・機器, 前記電池システムへの及びそれらからのエネルギーの貯蔵・伝送及び放出の監視・最適化及び調整用のコンピュータソフトウェア, 太陽電池, 電池, 電子応用機械器具及びその部品

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.)

7 Electric blenders for household use; bottle washing machines; central vacuum

## Continuation sheet

cleaning installations; cleaning appliances utilizing steam; The metalworking machine instrument for surface-of-metal degreasing washing processing; dishwashers; high pressure washers; electric machines and apparatus for polishing; electric shoe polishers; spin driers; vacuum cleaner accessories for disseminating perfumes and disinfectants; vacuum cleaner hoses; vacuum cleaners; vacuum cleaner bags; laundry washing machines; washing apparatus; coin-operated washing machines; whitewashing machines; ironing machines; aerated beverage-making machines; aerated water making apparatus; electric beaters; electromechanical apparatus for beverage preparation; bread cutting machines; brewing machines; butter machines; churns; coffee grinders, other than hand-operated; cream/milk separators; electric food processors; flour mill machines; electric food processors; electromechanical food preparation machines; electric fruit presses for household use; grating machines for vegetables; electric food mills; kneading machines; meat choppers [machines]; mills for household use other than hand-operated; apparatus for making mineral water; machines for making pasta; pepper mills other than hand-operated; electric whisks for household use.

- 9 Coin-operated mechanisms for television sets; television apparatus; 3D spectacles; acidimeters for batteries; acoustic conduits; acoustic couplers; acoustic [sound] alarms; adding machines; antennas; aerometers; electric alarm bells; alarms (instruments); alcohol meters; alidades; altimeters; ammeters; amplifiers; telephone answering machines; anti-theft warning apparatus; apertometers [optics]; receivers [audio, video]; audiovisual teaching apparatus; audio and video devices for monitoring babies; balances [steelyards]; balancing apparatus; barometers; luminous beacons; bells [warning apparatus]; binoculars; blueprint apparatus; boiler control instruments; cabinets for loudspeakers; calibrating rings; calipers; photographic apparatus; cassette players; cell phone straps; cleaning apparatus for sound recording discs; compact disc players; comparators; compasses [measuring instruments]; correcting lenses [optics]; counters; darkroom lamps [photography]; detectors; dictating machines; diffraction apparatus [microscopy]; digital photo frames; directional compasses; distance measuring apparatus; distance recording apparatus; enlarging apparatus [photography]; epidiascopes; ergometers; facsimile machines; flash-bulbs [photography]; fluorescent screens; galena crystals [detectors]; global positioning system gps apparatus; head cleaning tapes; headphones; heat regulating apparatus; heliographic apparatus; hemline markers; horns for loudspeakers; automatic indicators of low pressure in vehicle tires; intercommunication apparatus; invoicing machines; jigs [measuring instruments]; coin-operated musical automata [juke boxes]; lactodensimeters; lactometers; logs [measuring instruments]; electric loss indicators; loudspeakers; sound transmitting apparatus; magic lanterns; magnetic wires; magnifying glasses [optics]; masts for wireless aerials; mathematical instruments; megaphones; mercury levels; meteorological balloons; meteorological instruments; microphones; microscopes; kilometer recorders for vehicles; money counting and sorting machines; electric monitoring apparatus; navigation apparatus for vehicles [on-board computers]; navigational instruments; optical lenses; optical lamps; photometers; apparatus for use in phototelegraphy; plane tables [surveying instruments]; planimeters; plumb lines; polarimeters; portable media players; prisms [optics]; probes for scientific use; projection screens; projection apparatus; record players; refractometers; refractors; remote control apparatus; satellite navigation apparatus; screens [photography]; screw-tapping gauges; slide projectors; sound recording strips; speed checking apparatus for vehicles; speed indicators; speed regulators for record players; spherometers; spirit levels; spools [photography]; personal stereos; stereoscopes; stereoscopic apparatus; tachometers; tape recorders; taximeters; telephone apparatus; telephone transmitters; portable telephones; hands-free kits for telephones; radiotelegraphy sets; telephone receivers; teleprinters; telerupters; telescopes; temperature indicators; labels indicating temperature, other than for medical purposes; material testing instruments and machines; thermometers, not for medical use; thermostats; thermostats for vehicles; thread counters; time recording apparatus; time clocks [time recording devices]; tone arms for record players; transmitters of electronic signals; transmitters [telecommunication]; transmitters [telecommunication]; transponders; vacuum gauges; variometers; vehicle radios; verniers; video telephones; video cassettes; video

## Continuation sheet

recorders; video screens; video devices for monitoring babies; videotapes; voting machines; walkie-talkies; weighbridges; weighing machines; weighing apparatus and instruments; weights; whistle alarms; wire connectors [electricity]; electric wires.

11 Lamp reflectors; lamps for lighting; electric lamps; electric light bulbs; light bulbs; light-emitting diode [LED] lighting apparatus; lighting apparatus and installations; electric lights for Christmas trees; flashlights; safety lamps; street lamps; flashlights for lighting; luminous tubes for lighting; electric pressure cookers; bakers' ovens; barbecues; beverage-cooling apparatus; bread baking machines; bread-making machines; coffee roasters; electric coffee percolators; electric coffee machines; cookers (cooking stoves); cooking rings; electric cooking utensils; cooking apparatus and installations; electric deep friers; extractor hoods for kitchens; fruit roasters; heating showcases; electric heaters for feeding bottles; heating plates; hot plates; electric kettles; kitchen ranges [ovens]; malt roasters; microwave cooking apparatus; microwave ovens for industrial use; oven fittings made of fire clay; pasteurizers; plate warmers; electric pressure cooking saucepans; roasters; grills [cooking appliances]; roasting jacks; roasting spits; rotisseries; electric waffle apparatus; water softening apparatus and installations; electric appliances for making yogurt; filters for drinking water; electric fans for personal use; air driers; cooling installations and machines; cooling apparatus and installations; cooling installations for liquids; cooling installations for tobacco; freezers; ice machines and apparatus; ice cube machines; milk-cooling equipment; refrigerating cabinets; refrigerating chambers; refrigerating display cabinets [display cases]; refrigerating apparatus and installations; refrigerators; bread toasters; air deodorizing apparatus; air filtering installations; air-purifying apparatus and machines; deodorizing apparatus not for personal use; germicidal lamps for purifying air; humidifiers for central heating radiators; ventilation hoods.

## 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

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