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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: 1408132
Mark: foto (with figurative elements)
Date of international registration: 2017/12/26
Holder of the international registration:
Xiaomi Singapore Pte. Ltd.

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 April/23/2019 by

Kobayashi Masakazu (Mr.)
Examiner
Madrid Protocol Division
Facsimile: +81-3-3593-2398
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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.

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.

Any inquiries about this notification should be addressed to the examiner of the JPO<PA1T40@po.go.jp>.

* 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: 2019/05/09

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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 Smartwatches; watches that communicate data to smartphones.

Class 38 Advisory services relating to communications equipment; provision of communications information; provision of information relating to communications; computer transmission services.

Class 42 Computer design; computer design services; computer network services; computer program advisory services; computer security services [programming and software installation, repair and maintenance services]; computer security services [testing and risk assessment of computer networks]; preparation of reports relating to computer programs; preparation of reports relating to computers; testing of computer installations.

==> Please refer to the examples for the limitation/amendment in item VI.

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.

9 Adapter plugs; cables, electric; cases for smartphones; covers for smartphones; carriers adapted for mobile phones; cases adapted for mobile phones; cases for mobile phones; cell phone cases; cell phone straps; cell phones; cellular phones; computer game software for use on mobile and cellular phones; conference phones; devices for hands-free use of mobile phones; digital phones; door phones; downloadable graphics for mobile phones; downloadable ring tones for mobile phones; dustproof plugs for jacks of mobile phones; earbuds; ear phones; flip covers for smart phones; hands free devices for mobile-phones; hands free kits for phones; holders adapted for mobile phones; keyboards for mobile phones; keyboards for smartphones; leather cases for mobile phones; mobile phone cases; mobile phone covers; mobile phone sets; mobile phone straps; mobile phones; mobile phones for use in vehicles; monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm phone appliances; phone covers; phone extension jacks; phone extension leads; phone plugs; protective cases for smartphones; protective covers for smartphones; protective films adapted for smartphones; smartphones; smartphones in the shape of a watch; personal digital assistants in the shape of a watch; stands adapted for mobile phones; straps for mobile phones; personal digital assistants in the shape of a watch that communicate data to smartphones; wireless headsets for smartphones; wrist-mounted smartphones; video phones.

38 Advisory services relating to telecommunications; telecommunications advisory services relating to communications equipment; audio communications services; audiovisual communication services; cellular communications services; cellular telephone communication; communication by mobile telephone; communications by cellular phones; communications by means of mobile phones; communications by mobile phones; communications consultancy; communications via fibre-optic networks; consultancy services relating to telecommunications; data communication by electronic means; data communication services; electronic communication services; electronic network communications; mobile radio communications; mobile radio telephone services; mobile telephone communication; mobile telephone communication services; mobile telephone services; mobile telephony; operation of cellular communications systems; provision of telecommunications information; provision of

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electronic communications facilities; provision of information in the field of telecommunications; provision of private mobile radio communication services; rental of communications apparatus; rental of smartphones; car telephone communications services; cellular radio telephone services; communication between computers; communication by computer; communication by electronic computer terminals; communication of information by computer; communication services between computers; communication services over computer networks; communications by computer terminals; communications by telephone; computer aided transmission of images; computer aided transmission of information and images; computer aided transmission of messages; computer aided transmission of messages and images; computer bulletin board services; computer communication services; computer communications for the transmission of information; computer data transmission services; computer intercommunication; computer network communication services; computer telephony services; computer transmission of information accessed via a code or a terminal; computer transmission of messages and images; computer-aided transmission of messages; electronic communication service by means of computer; electronic transmission of data and documents via computer terminals and electronic devices; forwarding of messages by telephone; maritime radio-telephone network services; netcasting [broadcasting over a global computer network]; paging services [radio, telephone or other means of electronic communication]; pay telephone communication services; providing access to computer networks; providing access to computer software; providing access to online computer databases; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information; providing on-line forums for transmission of messages among computer users; providing telecommunications connections to a global computer network; providing user access to a global computer network; providing user access to computer programmes in data networks; providing user access to global computer network and online sites containing information on a wide range of topics; providing user access to global computer networks; provision of access to a global computer network; provision of communications between computers; provision of communications by telephone; radio telephone communication services; radio/telephone paging services; rental of access time to global computer networks; rental of cellular telephones; rental of computer communication apparatus and instruments; rental of telecommunication equipment including telephones and facsimile apparatus; rental of telephone apparatus; rental of telephone circuits; rental of telephone lines; rental of telephones; secure telecommunications services [providing secure telecommunication connections and access including to computers and the global computer network]; telephone communication services; telephone communications; telephone paging services; telephone services; telephone voice messaging services; transmission of data by computer; transmission of information by computer; transmission of information by telephone; transmission of information on a wide range of topics, including online and over a global computer network; transmission of information via computers connected to the same telematic network; transmission of messages by computer; transmission of messages by telephone; transmission of telephone calls; video telephone services; web portal services [providing user access to global computer network]; wireless telephone services.

- 42 Design and development of software in the field of mobile applications; design of mobile telephones; smartphone software design; unlocking of mobile phones; updating of smartphone software; advice relating to the design of computer hardware; advisory services relating to computer programming; advisory services relating to computer software; advisory services relating to computer system analysis; advisory services relating to computer system design; advisory services relating to the design and development of computer hardware; analytical services relating to computers; back-up of computer data; computer aided design of moulds; computer aided graphic design; computer analysis; computer database design consultancy services; design of computer hardware; consultancy in the field of computer hardware design; computer disaster recovery services; computer engineering; computer firewall services; computer graphics design services; computer hardware design; computer hire; computer network configuration services; computer network design for others; design of computer networks; consultancy in the field of computer programming; computer program maintenance services; computer program updating services; computer programming;

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computer programming consultancy; computer programming in the medical field; computer programming of computer games; computer programming of video games; computer programming services for commercial analysis and reporting; computer rental; computer research services; computer security consultancy; computer security engineering; computer security services [design and development of secure computer hardware, software and systems]; ~~computer security services, namely computer programming and installation, repair and maintenance of computer software; computer security services, namely testing and risk assessment of computer networks;~~ computer security threat analysis for protecting data; computer services in the nature of hosting web sites for others; computer site design; computer software advisory services; computer software consultancy; computer software consulting; computer software design; computer software development; computer software programming services; computer software rental; computer software development; computer software programming services; computer software rental; computer system analysis; computer system design; computer system integration services; computer systems analysis; computer systems design; computer systems integration services; computer technology consultancy; computer time-sharing; computer virus protection services; computer website design; configuration of computer software; consultancy in the design and development of computer hardware; consultancy in the field of computer security; consultancy in the field of computer software; consultation services relating to computer software; conversion of computer programs and data, other than physical conversion; copying of computer software; creating of computer programs; creating of home pages for computer networks; data conversion of computer programs and data, not physical conversion; debugging computer software for others; design and development of computer game software; design and development of computer hardware; design and development of computer hardware and software; design and development of computer hardware for the manufacturing industries; design and development of computer software; design and development of wireless computer networks; design and maintenance of computer sites for third parties; design and writing of computer software; design of computer codes; design of computer databases; design of computer hardware; design of computer languages; design of computer programs; design of computer software; design of computers; design of computers for others; design of mobile telephones; design of telephones; design, maintenance, development and updating of computer software; design, maintenance, rental and updating of computer software; designing computer software for controlling self-service terminals; developing computer programs for electronic cash register systems; developing computer software; development and creation of computer programmes for data processing; development of computer based networks; development of computer codes; development of computer hardware for computer games; development of computer programmes; development of computer software; development of computer software application solutions; development of computer system diagnosis of faults in computer software; digital compression of computer data; document data transfer from one computer format to another; duplication of computer programs; engineering services relating to computer programming; engineering services relating to computers; hosting computer sites [web sites]; installation and maintenance of computer software; installation of computer software; installation, maintenance and repair of computer software; installation, maintenance and repair of software for computer systems; installation, repair and maintenance of computer software; installing computer programs; rental of computers in a cafe environment; leasing of computer apparatus; leasing of computer programs; leasing of computers; maintenance and updating of computer software; maintenance and upgrading of computer software; maintenance of computer programs; maintenance of computer programs; maintenance of computer software; maintenance of computer software relating to computer security and prevention of computer risks; maintenance of computer software used for operating filling apparatus and machines; modifying of computer programs; monitoring of computer systems by remote access; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems to detect breakdowns; personal computer hire; ~~preparation of reports relating to computer program research; preparation of technical reports relating to computer hardwares;~~ professional consultancy relating to computer security; providing information on computer technology and programming via a web site; providing information, including

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online, about design and development of computer hardware and software; provision of information relating to computer programming; provision of information relating to computer programs; remote computer backup services; rental and maintenance of computer software; rental of computer apparatus; rental of computer equipment; rental of computer firmware; rental of computer hardware; rental of computer hardware and computer peripherals; rental of computer hardware and computer software; rental of computer hardware and software; rental of computer middleware; rental of computer programs; rental of computer software; rental of computer software and programs; rental of computers; renting computer software; repair of computer software; repair of damaged computer programs; research and development of computer software; research relating to computer programming; research relating to computers; research, development, design and upgrading of computer software; scientific computer programming services; security assessment services for computer networks; security risk assessment services relating to computer systems; services for maintenance of computer software; services for renting computers; services for reproducing computer programs; services for updating computer software; technical advice relating to operation of computers; testing relating to computer software installations; testing of computer programs; testing of computer software; testing of computers; updating of computer software; updating of computer programs; updating of computer programs for third parties; updating of computer software; updating of computer software relating to computer security and prevention of computer risks; updating of home pages for computer networks; updating of computer programs for memory banks of computer systems; upgrading of computer software; writing and updating computer software; writing of computer programs; writing of computer software; recovery of computer data; development of computer programs recorded on data media (software) designed for use in construction and automated manufacturing (cad/cam); computer software design for others.

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)