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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 Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and Section 15-2 and 15-3 of the Japanese Trademark Law.

I. International registration number: 788585
Mark: (figurative elements)
Date of subsequent designation: 2019/06/26
Holder of the international registration:
Comité International Olympique

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 October/08/2020 by

Hayashi Keisuke (Mr.)
Examiner
Madrid Protocol Division
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IV. The holder may submit to the JPO a written opinion and/or an amendment against this provisional refusal within three months from the date of pronouncement. The written opinion and/or amendment must be submitted through a representative domiciled in Japan. The trademark claimed in this application can be protected, subject to amendments to be made by the holder of the international registration, as suggested under Item VI. Even if the above-mentioned time limit has past, the holder may submit to the JPO an amendment of the list of goods and/or services as long as the case is pending in examination, trial or retrial in JPO, provided that the date indicated in Item I is on and after April/01/2020. Alternatively, the holder may request a limitation of the list of goods and/or services in accordance with Rule 25(1)(a) of the Regulations under the Madrid Protocol. Such request must be submitted to the International Bureau of WIPO on 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
<mail to: PAIT40@jpo.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: 2020/10/22

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 06 Metal goods not included in other classes.

Class 07 Machines and machine tools.

Class 09 Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, monitoring, emergency (life-saving) and teaching apparatus and instruments.

Class 12 Vehicles; apparatus for locomotion by land, air or water.

Class 14 Precious metals and their alloys and goods made of or coated with these materials not included in other classes.

Class 16 Paper, cardboard and goods made from these materials, not included in other classes.

Class 20 Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 24 Fabrics and textile products not included in other classes.

Class 31 Agricultural, horticultural and forestry products and grains, not included in other classes.

Class 35 Retail services.

Class 36 Financial affairs; monetary affairs.

Class 37 Repairs.

Class 40 Treatment of materials.

Class 41 Sports and cultural activities.

[example of amendment]

[Class 06]

metal goods not included in other classes;

-->metal materials for building or construction; metal strong boxes; metal joinery fittings;

[Class 07]

Machines and machine tools;

-->Metalworking machines and tools;

[Class 09]

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, monitoring, emergency (life-saving) and teaching apparatus and instruments;

-->Electronic apparatus;

[Class 12]

Vehicles;

-->Land vehicles;

apparatus for locomotion by land, air or water.

-->aircraft; automobiles; bicycles; motorcycles; rolling stock for railways; ships;

[Class 14]

Continuation sheet

Precious metals and their alloys and goods made of or coated with these materials not included in other classes;

~~-->Precious metals and their alloys; works of art made of precious metals;~~

[Class 16]

Paper, cardboard and goods made from these materials, not included in other classes;

~~-->Paper, boxes of paper, table cloths of paper, table napkins of paper, cardboard and cardboard articles;~~

[Class 20]

goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

~~-->furniture, namely wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.~~

[Class 24]

Fabrics and textile products not included in other classes;

~~-->Fabric; household linen; sheets [textile]; table napkins of textile; table linen [textile]; tapestry [wall hangings], of textile;~~

[Class 31]

Agricultural, horticultural and forestry products and grains, not included in other classes;

~~-->Barley; grains (cereals); seeds; natural flowers; plants; seedlings; trees; fresh fruits and vegetables;~~

[Class 35]

retail services.

~~-->retail services or wholesale services for electrical machinery and apparatuses.~~

[Class 36]

financial affairs;
monetary affairs;

~~-->financial consultancy;~~

[Class 37]

repairs;

~~-->repair of medical machines and apparatus; repair of metalworking machines and apparatus; repair of office machines and apparatus; repair of telecommunication machines and apparatus; repair of computers;~~

[Class 40]

Treatment of materials.

~~-->Cloth treating; leather staining; metal treating; water treating;~~

[Class 41]

sports and cultural activities.

Continuation sheet

-->sporting activities; organization of exhibitions for cultural or educational purposes;

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:

[reason 1]

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) 06, 07, 09, 11, 16, 17, 21, 31, 35, 37, 41]

[reason 2]

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 retail/wholesale services (regarding services provided for in Section 2(2) of the Trademark Law) designated in this application, because two or more retail/wholesale services have been designated in this application, which are not similar to each other depending on the goods dealt in the said retail/wholesale services.

However, the above reason([reason 1]and[reason 2]) 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 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 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 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 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 <https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0102.pdf>

(2) The main points for filing an application regarding retail services or wholesale services are available on the JPO website at https://www.jpo.go.jp/e/system/trademark/gaiyo/document/notice_services/points.pdf

(3) 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.

- 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.)

Continuation sheet

Classes 1, 2, 3, 4, 5, 8, 10, 11, 13, 15, 17, 18, 19, 21, 22, 23, 25, 26, 27, 28, 29, 30, 32, 33, 34, 38, 39, 42, 43, 44 and 45 remain unchanged.

- 6 Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; metallic ironmongery and locksmithing articles; pipes of metal; safes; metal materials for building or construction; metal strong boxes; metal joinery fittings; ores.
- 7 Metalworking machines and tools; engines, other than engines for land vehicles; couplings and transmission components (excluding those for land vehicles); agricultural implements other than hand-operated; egg incubators.
- 9 Electronic apparatus; apparatus and instruments for conveying, distributing, transforming, storing, regulating or controlling electric current; apparatus for recording, transmitting and reproducing sound or images; magnetic data carriers, sound recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishers.
- 12 Land vehicles; aircraft; automobiles; bicycles; motorcycles; rolling stock for railways; ships.
- 14 Precious metals and their alloys; works of art made of precious metals; jewellery, bijouterie, precious stones; horological and chronometric instruments; commemorative pieces and medals.
- 16 Paper, boxes of paper, table cloths of paper, table napkins of paper, cardboard and cardboard articles; printing products; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' supplies; paintbrushes; typewriters and office articles (except furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; postage stamps.
- 20 Furniture, mirrors, frames; furniture, namely wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- 24 Fabric; household linen; sheets [textile]; table napkins of textile; table linen [textile]; tapestry [wall hangings], of textile; bed and table covers.
- 31 Barley; grains (cereals); seeds; natural flowers; plants; seedlings; trees; fresh fruits and vegetables; live animals; fresh fruit and vegetables; natural seeds, plants and flowers; animal feed, malt.
- 35 Advertising; business management; commercial administration; office tasks; promotion of goods and services of third parties, by means of partnership agreements (sponsorship) and licences in connection with international sports events; retail services or wholesale services for electrical machinery and apparatuses.
- 36 Insurance; financial consultancy; real estate business.
- 37 Construction; repair of medical machines and apparatus; repair of metalworking machines and apparatus; repair of office machines and apparatus; repair of telecommunication machines and apparatus; repair of computers; installation services.
- 40 Cloth treating; leather staining; metal treating; water treating.
- 41 Education; training; entertainment; sporting activities; organization of exhibitions for cultural or educational purposes.

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)