

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 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: 1664726  
Mark: SOLERA (with figurative elements)  
Date of international registration: 2021/10/28  
Holder of the international registration:  
Solera Global Technology Limited

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 March/29/2023 by

Watanabe Etsuko (Ms.)  
Examiner  
Madrid Protocol Division  
Facsimile: Not Available  
Telephone: +81-3-3501-2392

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>

Any inquiries about this notification should be addressed to the examiner of the JPO<PAIT40@jpo.go.jp>.

All communications via facsimile and email 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: 2023/04/13

## Continuation sheet

## V. The grounds for refusal

## Ground 1

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

[vague/broad description]

Class 09 Security and safety devices for automotive and other motorized vehicles in the nature of electronic sensors and cameras to detect and prevent security risks; accident prevention devices for automotive and other motorized vehicles in the nature of electronic sensors, GPS tracking devices, and internet of things (IoT) enabled computers used to detect and prevent driving risks.

[Suggestion for amendment/limitation]

security and safety devices for automotive and other motorized vehicles in the nature of electronic sensors and cameras to detect and prevent security risks;  
--> security and safety devices for automotive and other motorized vehicles in the nature of electronic sensors and cameras to detect and prevent security risks, namely event recorders;

accident prevention devices for automotive and other motorized vehicles in the nature of electronic sensors, GPS tracking devices, and internet of things (IoT) enabled computers used to detect and prevent driving risks.  
--> accident prevention devices for automotive and other motorized vehicles in the nature of electronic sensors, GPS tracking devices, and internet of things (IoT) enabled computers used to detect and prevent driving risks, namely computers for autonomous driving.

Class 35 Cost containment, referral, and auditing and coordinating services for the purchase, billing and installation of products or rendering of services by others in the automotive and insurance fields; financial record-keeping of electronic payment data; insurance claims auditing of vehicle damage insurance claims for others; insurance claims auditing of vehicle damage insurance claims for others; vehicle damage insurance claims auditing services; all pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair via a global network.

[Suggestion for amendment/limitation]

cost containment, referral, and auditing and coordinating services for the purchase, billing and installation of products or rendering of services by others in the automotive and insurance fields;  
--> business management advisory services relating to cost containment, referral, and auditing and coordinating services for the purchase, billing and installation of products or rendering of services by others in the automotive and insurance fields;

financial record-keeping of electronic payment data;  
--> compilation of information into computer databases for financial record-keeping of electronic payment data;

insurance claims auditing of vehicle damage insurance claims for others;  
--> no proposal.

insurance claims auditing of vehicle damage insurance claims for others;  
--> no proposal.

## Continuation sheet

vehicle damage insurance claims auditing services;  
--> no proposal.

all pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair via a global network.

--> no proposal.

\* The list of goods or services should be limited referring to the alphabetical list of the Nice Agreement, or please delete.

\*Please note that this suggestion(s) is applied to Ground 1 only. This application, however, still falls under ground 2 for refusal even if the above description is appropriately amended.

## Ground 2

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

## Cited registered trademark(s)

## No. 1

- National registration No.: 4434446                      - Registration date: 2000/11/24
- National application No.: H11-094804               - Application date: 1999/10/18
- Name and address of the holder: TOYOTA JIDOSHA KABUSHIKI KAISHA  
1, Toyota-cho, Toyota-shi, Aichi-ken JAPAN

Mark:

S O R E L L A

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

International class 12:

船舶並びにその部品及び附属品, 航空機並びにその部品及び附属品 (但し、航空機のタイヤ、チューブを除く), 鉄道車両並びにその部品及び附属品, 自動車並びにその部品及び附属品 (但し、自動車のタイヤ、チューブを除く), 乳母車, 車いす, 人力車, そり, 手押し車, 荷車, 馬車, リヤカー, 荷役用索道, カーダンパー, カープッシャー, カープラー, 牽引車, 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。), タイヤ又はチューブの修繕用ゴムはり付け片, 乗物用盗難警報器, 落下傘

## No. 2

- National registration No.: 5943919                      - Registration date: 2017/04/28
- National application No.: 2016-040931               - Application date: 2016/04/08  
(priority date under the Paris Convention: 2015/11/20)
- Name and address of the holder: Solera Holdings Inc.  
7 Village Circle, Suite 100, Westlake, TX 76262, USA

Mark:

Continuation sheet

# SOLERA

Conflicting goods and/or services and their class(es), corresponding to class 09, 35, 36, 37 and 42 covered in this application:

**International class 09:**

モバイル機器用のダウンロード可能なコンピュータソフトウェア及びコンピュータアプリケーションソフトウェア、ダウンロード可能な事業用のコンピュータソフトウェア及びコンピュータアプリケーションソフトウェア、業績追跡用のダウンロード可能なコンピュータソフトウェア及びコンピュータアプリケーションソフトウェア、乗物用部品の在庫追跡用のダウンロード可能なコンピュータソフトウェア及びコンピュータアプリケーションソフトウェア、データベース管理用ソフトウェア及びアプリケーションソフトウェア、その他のコンピュータソフトウェア及びコンピュータアプリケーションソフトウェア、ニュースレター形式のダウンロード可能な電子出版物、乗物用部品の分野におけるダウンロード可能なマニュアル及び電子的に情報が記録されたマニュアル、ダウンロード可能な取扱説明書及び電子的に情報が記録された取扱説明書、電子応用機械器具及びその部品、電気通信機械器具

**International class 35:**

乗物の中古部品の在庫に関する商取引情報の提供、乗物の中古部品及びリサイクル部品の在庫及び価格に関するオンラインデータベースによる商業に関する情報の提供、オンラインデータベースの管理、財産に関する市場調査及び分析、乗物の修理の分野における市場調査及び分析、製品の購買・請求事務及び納入又はサービスの提供におけるコスト削減の立案・会計士又は監査人のあっせん及び会計監査、自動車の販売業者用の販売促進・ダイレクトメールによる広告その他の広告及びマーケティングのための企画及び実行の代理、保険会社への事業リスク評価情報の提供、乗物の中古部品及びリサイクル部品の在庫及びコストに関するリストを備えたオンライン検索可能なデータベースによる商取引情報の提供、電子決済データの財務記録の管理・収集、乗物の技術者用の商取引に関する情報の提供、グローバルネットワークを経由して行う自動車修理の分野における保険金請求に関するサービスの質測定データの収集及び分析、グローバルネットワークを経由して行う建築物の再建工事及び修復の分野における保険金請求に関するサービスの質測定データの収集及び分析、グローバルネットワークを経由して行う乗物の修理並びに建築物の再建工事及び修復の分野における保険金請求に関する顧客関係の管理、グローバルネットワークを経由して行う乗物の修理並びに建築物の再建工事及び修復の分野における保険金請求に関する顧客満足度に関する情報の提供、広告業、ダイレクトメールによる広告、市場調査及び分析、商品の販売に関する情報の提供、原価分析、市場調査データの収集・分析・管理、企業の事業に関する情報の提供、会計監査、データベースの管理、コンピューターデータベースへの情報編集及び情報構築、コンピュータによるデータベースの管理、広告・マーケティング及び販売促進のための企画及びその実行の代理、コンピューターデータベースへの自動車の損傷診断・修理及びメンテナンスに関する情報編集及び情報構築

**International class 36:**

乗物の損害に関する保険金の請求及び支払の電子処理、構造物の損害に関する保険金の請求及び支払の電子処理、乗物の衝突事故における保険に関する指導及び助言、建築物その他の構造物の修理における保険に関する指導及び助言、保険金の請求及び支払いの処理、乗物の損害に関する保険請求額の査定及び裁定、構造物の損害に関する保険請求額の査定及び裁定、損害保険に係る乗物の損害の査定、損害保険に係る構造物の損害の査定、グローバルネットワークを経由して行う自動車の修理の分野における保険金額の査定及びこれに関する金融又は財務に関する情報の提供、グローバルネットワークを経由して行う建築物の再建工事及び修復の分野における保険金額の査定及びこれに関する金融又は財務に関する情報の提供、保険に関する助言及び情報の提供、財産及び災害保険の引受けに関するリスクの査定・評価・分析、財産及び災害保険の引受けに関するリスクの査定・評価及び報告用のオンラインコンピュータデータベースによる情報の提供、財務のリスクの評価、財務上のリスク管理、保険業者向けのリスク管理のための情報の提供及び金銭的リスク予測分析、保険業務、保険の契約内容の分析・検証、財産の引受け及び災害保険の分野における保険のリスクの査定・評価及び報告に用いるオンラインコンピュータデータベースによる情報の提供、乗物及び自動二輪車の保険業務の分野における保険業者用の財務リスク判断に用いるデータの分析及び編集、損害保険に係る損害額の査定、損害保険の引受け、保険料率の算出、修繕額の査定（保険に関するもの。）、保険に関する情報の提供、損害保険業務に係る自動車及び構造物の損傷の原価評価、乗物の損害保険金請求額の監査、電子上の料金の支払いの代行、構造物の損害保険金請求額の監査、損害保険業務に係る乗物の損傷の原価評価、支払代金の電子決済、送金事務の取扱い及び電子マネー利用者に代わってする支払代金の決済並びに料金の支払いの代行

**International class 37:**

オンラインコンピュータデータベースによる乗物の損傷診断・修理及びメンテナンスに関する

## Continuation sheet

情報の提供, 修理業者による所有者に対する乗物の修理状況に関するオンラインによる情報の提供, 乗物及び構造物の修理業における自動車及び構造物の修理に係る見積り, 乗物の修理業における乗物の修理に係る見積り

International class 42:

オンラインによるダウンロードが不可能な乗物及び構造物の損失評価・鑑定・損失推定・検査・修理用のソフトウェアの一時的使用の提供, オンラインによるダウンロードが不可能な自動車・乗物・消防及び保健衛生の分野における顧客関係の管理用のソフトウェアの提供, ダウンロードが不可能な業績及び収益の増大のための重要業績指標データの収集及び分析用のオンラインコンピュータソフトウェアの一時的使用の提供, インターネットプラットフォーム用ソフトウェアの設計・作成又は保守, データベースの設計及び開発, 電子計算機のプログラムの設計・作成又は保守, コンピュータデータベースプログラムの設計及び開発, データベースの保存用記憶領域の貸与, 交通違反追跡用のオンラインのダウンロード不可能なコンピュータプログラムの提供

- 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 39 remains unchanged.

Classes 9, 35, 36, 37 and 42 should be deleted.

## 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

Promotion of Specified Non-profit Activities (Act No. 7 of 1998), or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regional collective trademark registration with respect of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):

- (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).

**Article 8 Prior application**

- (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.

**Article 15 Examiner's decision of refusal**

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).

**Article 15-3**

- (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

reasonable time limit for such purpose.

- (2) Where the notification set forth in the preceding paragraph has already been served and the said other person's trademark is registered, the examiner shall not be required to serve the notification set forth in the preceding Article.

**Article 44 Trial against examiner's decision of refusal**

- (1) A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for a trial against the examiner's decision of refusal within three months from the date the transcript of the examiner's decision has been served.

**Article 77 Mutatis mutandis application of Patent Act**

- (4) Article 26 (Effect of treaties) of the Patent Act shall apply mutatis mutandis to the trademark registration and defensive mark registration.

**Japanese Patent Law:**

**Article 26 Effect of treaties**

Where specific provisions relating to a patent are provided by treaty, such provisions shall prevail.

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Notice

These are unofficial translations. Only the original Japanese texts of the Laws have legal effect.

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(Creation Date :Sep 1,2015)

## 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

Promotion of Specified Non-profit Activities (Act No. 7 of 1998), or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regional collective trademark registration with respect of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):

- (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).

**Article 8 Prior application**

- (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.

**Article 15 Examiner's decision of refusal**

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).

**Article 15-3**

- (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

reasonable time limit for such purpose.

- (2) Where the notification set forth in the preceding paragraph has already been served and the said other person's trademark is registered, the examiner shall not be required to serve the notification set forth in the preceding Article.

**Article 44 Trial against examiner's decision of refusal**

- (1) A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for a trial against the examiner's decision of refusal within three months from the date the transcript of the examiner's decision has been served.

**Article 77 Mutatis mutandis application of Patent Act**

- (4) Article 26 (Effect of treaties) of the Patent Act shall apply mutatis mutandis to the trademark registration and defensive mark registration.

**Japanese Patent Law:**

**Article 26 Effect of treaties**

Where specific provisions relating to a patent are provided by treaty, such provisions shall prevail.

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(Creation Date :Sep 1,2015)