

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



日本国特許庁  
〒100-8915  
東京都千代田区霞が関3-4-3

## NOTIFICATION OF PROVISIONAL REFUSAL

This notification is issued by the Japan Patent Office (JPO) in accordance with Rule 17(1) and (2) of the 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: 1672527  
Mark: shimmer (with figurative elements)  
Date of international registration: 2021/12/29  
Holder of the international registration:  
IOTA Stiftung

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/17/2023 by

Sasaki Yugen (Mr.)  
Examiner  
Madrid Protocol Division  
Facsimile: +81-3-3593-2398  
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>

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.

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

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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.

## 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 Downloadable e-wallets; machine- to-machine [m2m] applications.

Class 36 Virtual currency services; electronic payment processing for virtual currencies; cryptocurrency services, namely, issuing virtual currency or digital tokens for use by members of an online community via a global computer network; cryptocurrency services, namely, issuing of a peer-to-peer digital currency that incorporates cryptographic protocols, operates over the internet, and is used as a method of payment for goods and services; issuing of tokens of value, namely, issuing of stablecoins, stable tokens, tokenized fiat, tokenized assets, virtual currency and digital tokens of value using smart contracts, asset-backed tokens, fiat-backed tokens and digital assets; electronic financial trading services, namely digital assets trading services; currency transfer services, namely, transfer of digital assets; financial services, namely for buying, selling and trading non-fungible tokens; decentralised finance services.

Class 42 Technical advisory services relating to distributed ledger technology, including cryptocurrencies, non-fungible tokens and other digital assets; expert consultancy services in connection with computing networks.

## 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.: 5932318 - Registration date: 2017/03/17  
- National application No.: 2015-056220 - Application date: 2015/06/12  
(priority date under the Paris Convention: 2014/12/12)  
- Name and address of the holder: Fallyn LLC  
103 Foulk Road, Suite 202 Wilmington, DE 19803, USA

Mark:

S H I M M E R

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

International class 09:

フィクション・ノンフィクション及びテレビジョン放送用娯楽番組の分野における書籍・雑誌及び定期刊行物の性質を有するダウンロード可能な電子出版物を含む電子出版物、フィクション・ノンフィクション及びテレビジョン放送用娯楽番組の分野における書籍の内容を録音した

## Continuation sheet

記録媒体、映画及びテレビジョン番組を記録した記録済みのCD・DVDその他の記録媒体、放送用機械器具、無線インターネット接続を介してテキスト・画像・音声を受信・送信及び再生するための携帯電子機器、書籍の内容を録音した記録媒体、電子書籍、音楽及び書籍を内容とするダウンロード可能なMP3ファイル、MP3形式で記録された録音済みの記録媒体、MP4形式で記録された録音済みの記録媒体、ダウンロード可能なデジタル音声ファイル、ダウンロード可能な動画ファイル及びポッドキャスト、テレビジョン娯楽に関連した画像・写真・雑誌・新聞・定期刊行物・ニューズレター・ジャーナルを内容とする電子出版物、ビデオカメラ、DVDプレーヤー、DVDレコーダー、DVDレコーダー及びプレーヤー用の遠隔制御装置、ビデオディスクレコーダー及びプレーヤー用の遠隔制御装置、記録装置用の遠隔制御装置、デジタルオーディオプレーヤー、オーディオレコーダー、デジタルビデオプレイヤー、音楽の記録用・送信用又は再生用の携帯機器、映像の記録用・送信用又は再生用の携帯機器、映像の記録用・送信用又は再生用のその他の機器、テレビジョン受信機用のモニター、テレビジョン受信機、テレビジョン送信機、テレビジョン受信機用の遠隔制御装置、テレビチューナー、ラジオ受信機用の遠隔制御装置、指導及び教育用の電子応用機械器具、テレビ及びラジオ受信機及びテレビ送信機、映画機械器具、セットトップボックス、テレビ受信機及びテレビ送信機、遠隔制御装置、使用者が感受することのできる音及び振動を含む感覚器官からの反応を知らせるための電子制御装置、パレンタルコントロール用コンピュータソフトウェア、ヘッドフォン、イヤホン、テレビジョン娯楽を内容とする電子出版物に関連して使用されるコンピュータソフトウェア、テレビジョン娯楽番組を検索・推薦する機能を有するコンピュータソフトウェア、コンピュータ、電子出版物を制作・公表又は配信するためのコンピュータソフトウェア、様々なトピックに関する書籍・雑誌・新聞・定期刊行物・ニューズレター・ガイド・クイズ・テスト・ジャーナル・マニュアル・テレビジョン娯楽を内容とするダウンロード可能な音声ファイル・画像ファイル・動画ファイル、携帯情報端末、電子手帳、電子メモ帳、未記録の磁気データ記録媒体、記録済み磁気データ記録媒体、電話機、携帯電話機、テレビ電話機、カメラ、ラジオ受信機、ラジオ送信機、コンピュータハードウェア及びソフトウェア、コンピュータソフトウェア、コンピュータファームウェア、パーソナルコンピュータ・手持型コンピュータ及び携帯デジタル電子機器のためのアプリケーション開発用ツールプログラムの性質を有するオペレーティングシステムプログラム及びデータ同期用プログラム、文字認識用コンピュータソフトウェア、電話操作管理用のコンピュータソフトウェア、携帯電話機・スマートフォン・タブレット用のコンピュータソフトウェア、電話機を利用した情報検索性コンピュータソフトウェア及びコンピュータハードウェア、メッセージ転送のためのコンピュータソフトウェア、携帯電話機能の特徴とする携帯電話機・スマートフォン・タブレット端末のためのコンピュータアプリケーションソフトウェア、携帯電話機・スマートフォン・タブレット端末のためのコンピュータアプリケーションソフトウェア及び内蔵型コンピュータアプリケーションソフトウェア、ソーシャルネットワークを目的とするソーシャルメディアにおいて共有される携帯電話機・スマートフォン・タブレット端末上のカメラで撮影された写真・動画を発見するコンピュータソフトウェア、オンラインデータベースのアクセス・閲覧・検索のためのコンピュータプログラム、コンピュータ化されたグローバル情報ネットワークと統合された電話通信を提供するコンピュータハードウェア及びコンピュータソフトウェア、手持型及び携帯型デジタル電子機器のための部品及び付属品、携帯電話機・スマートフォン・タブレット型コンピュータ用のカバー及びケース、携帯電話機・スマートフォン・タブレット型コンピュータ用の電池及び充電式電池、携帯電話機・スマートフォン・タブレット型コンピュータ用の充電器及び電池用充電器、携帯電話機・スマートフォン・タブレット型コンピュータ用のデータ送信用ケーブル、携帯電話機・スマートフォン・タブレット型コンピュータ用の電気ケーブル、携帯電話機・スマートフォン・タブレット型コンピュータ用のヘッドフォン、携帯電話機・スマートフォン・タブレット型コンピュータ用のスピーカー、携帯電話機・スマートフォン・タブレット型コンピュータ用のヘッドセット、パーソナルステレオスピーカー機器、マイクロフォン、カーオーディオ機器、携帯型又は手持型電気通信機械器具又は電子応用機械器具用の接続ケーブル及び充電器、電気通信機械器具又は電子応用機械器具のユーザーマニュアルを内容とする電子出版物、グローバルコンピュータネットワーク上でコンピュータアプリケーションへアクセスし管理するためのダウンロード可能なコンピュータソフトウェア、文字認識用コンピュータソフトウェア、音声認識用コンピュータソフトウェア、電子メール用及びメッセージ送受信用のコンピュータソフトウェア

## International class 42:

科学及び科学技術の調査・研究及びそれらに関する設計、工業上の分析及び調査、コンピュータハードウェア及びソフトウェアの設計及び開発、オペレーティングシステム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のウェブサイトのホスティング、インターネットを介したオペレーティングシステム及びコンピュータアプリケーションのホスティング、インターネットを介してアクセス可能な仮想コンピューティング環境の提供、データ記憶領域が可変式のコンピュータ及びコンピュータに於けるサーバの記憶装置の記憶領域の貸与、コンピュータアプリケーションを管理するためのグローバルコンピュータネットワーク上で接続可能

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なダウンロード不可能なコンピュータソフトウェアの提供, 電子商取引用のインターネットプラットフォーム用ソフトウェアの作成, オンラインサービス・インターネット・データ保管・他人のためのウェブサイトの作成及び管理のための電子的手段によって保存されたウェブページの制作, 他人のためのウェブサイトの保守, ウェブサーバーの貸与, ウェブサイトの管理・制作・ホスティング, アプリケーションサービスプロバイダーによるコンピュータソフトウェアの提供, 電子商取引用・オンライン決済用・ウェブサイトの設計用・データの保存用及び共有されたコンピュータの能力の計測用のコンピュータソフトウェアの提供, ホスティング, 設計及び保守, 電子メール用のコンピュータソフトウェアの提供, インターネット上のユーザートラフィックを分析し, ウェブサイトの閲覧ランキングを計算するためのコンピュータプログラムの設計・作成または保守, コンピュータプログラミング, マルチメディア用アプリケーションソフトウェアの保守・使用及び操作方法に関する質問に対する助言, コンピュータハードウェア及びコンピュータソフトウェアの設計, コンピュータシステムとネットワークの環境設定, コンピュータシステムの分析, コンピュータネットワークシステムの設計及び開発, コンピュータシステムの設計・作成または保守に関する助言, マルチメディアアプリケーション管理用のコンピュータプログラムの提供, プレゼンテーション・管理・調査・データベース管理・設備管理・アウトソーシング用のコンピュータソフトウェアの提供, 音楽・書籍・映画・動画・テレビ番組・ゲーム・おもちゃ・スポーツ用品・エレクトロニクス・マルチメディアプレゼンテーション・動画・DVD・その他の家庭用商品の小売又は卸売における自動オンライン検索及び商品の発注又は受注に使用するコンピュータアプリケーションソフトウェアのウェブサイトのホスティング, 個人の嗜好を分析し分析結果に基づいた商品又は役務の推薦を提供するコンピュータプログラムの提供, 多岐にわたる一般的な興味ある情報を内容とするインターネットを介したオンラインデータベースのホスティング, 一般的な興味ある情報を取得するための検索エンジンの提供, 音楽・書籍・映画・動画・テレビ番組・ゲーム・おもちゃ・スポーツ用品・エレクトロニクス・マルチメディアプレゼンテーション・動画・DVD・その他の家庭用品又は消費財に関するコンピュータユーザー及び定期購読者間のメッセージの伝送用の双方向のデータベースのホスティング, オンラインによるダウンロード不可能なインターネットブラウザ用コンピュータソフトウェアの提供, コンピュータ・モバイルコンピュータ・モバイル通信機器を介したインターネットへのモバイルアクセスを強化するためのダウンロード不可能なモバイル通信機器用のコンピュータソフトウェアの提供, コンピュータハードウェア及びソフトウェア問題及びモバイルコンピュータ・モバイル通信機器のハードウェア及びソフトウェア問題のトラブルシューティング (技術支援), コンピュータハードウェア及びソフトウェアのコンサルティング及び設計, 他人のためのコンピュータソフトウェアの設計, モバイルコンピュータ及びモバイル通信機器・コンピュータハードウェア及びソフトウェアのコンサルティング及び設計, 他人のためのモバイルコンピュータ及びモバイル通信機器用のコンピュータソフトウェアの設計, 第三者のコンテンツ・写真・動画・テキスト・データ・画像・ウェブサイト・その他の電子作品のウェブサイトのホスティング, 検索エンジンの提供, 写真・動画・テキスト・データ・画像・電子作品を閲覧・利用するための検索エンジンの提供, ユーザーがユーザー自身の写真・動画・テキスト・データ・画像をオンラインにより発表及び共有することを可能にする双方向型ウェブサイトのホスティング, ユーザーが討論に参加しフィードバックを取得し仮想コミュニティを形成するソーシャルネットワーキングサービス用コンピュータプログラムの提供, コンピュータに関連したコンピュータソフトウェアの保守及び更新, コンピュータにおけるウィルスの検出・排除及び感染の防止・パスワードに基づくインターネット情報及びオンライン情報の盗用の防止等の安全確保のためのコンピュータプログラムによる監視, インターネットその他のコンピュータネットワーク・通信ネットワークによる天文学に関する調査及び研究に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる気象情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる環境保全に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによるインテリアデザインに関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる科学技術に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによるコンピュータ・ソフトウェア・コンピュータ周辺機器・コンピュータハードウェアに関する技術情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる地質学に関する調査及び研究に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる工学に関する調査及び研究に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる建築物の設計に関する情報の提供, インターネットその他のコンピュータネットワーク・通信ネットワークによる医学研究に関する情報の提供, コンピュータソフトウェアのインストール及び保守, ウェブサイトを通じたコンピュータソフトウェア・ハードウェアに関連した技術情報の提供, コンピュータハードウェアの設計及び開発に関するコンサルティング, コンピュータシステムの設計に関するコンサルティング, コンピュータプログラムの設計, コンピュータプログラムの提供, あるコンピュータフォーマットから他のコンピュータフォーマットへの文書データの変換, グロー

## Continuation sheet

バルコンピュータネットワーク・無線ネットワーク・電子通信ネットワークにおけるデジタルコンテンツのホスティング、ユーザーがコンテンツ・テキスト・視覚作品・聴覚作品・視聴覚作品・文学作品・データ・ファイル・ドキュメント・電子作品を要求し又は受信することを可能にするサーチプラットフォームの提供、ユーザーによるコンピュータソフトウェアへのアクセス及びダウンロードを可能にするダウンロード不可能なコンピュータソフトウェアの提供、ユーザーの選択・好みに基づくコンピュータソフトウェアアプリケーションのカスタマイズされた提案を生成するダウンロード不可能なオンラインコンピュータソフトウェアの一時的な使用の提供、安全を目的としたコンピュータデータ・コンピュータシステム及びコンピュータネットワークの監視、他人のためのオンラインデータベースのホスティング、データベース管理に使用されるコンピュータソフトウェアを内容とするクラウドコンピューティング、クラウドコンピューティング、データベース管理用のコンピュータソフトウェアの提供、ウェブサイトを通じたデータベース管理用のコンピュータソフトウェアの提供、インターネットを介したホストされたオペレーティングシステム及びコンピュータアプリケーションの提供、グローバルコンピュータネットワークを介したコンピュータアプリケーションの管理用のダウンロード不可能なアクセス可能なコンピュータソフトウェアの提供・開発・設計、討論用のオンラインフォーラム用コンピュータソフトウェアの設計、オンラインサービス及びインターネット用の電子的に保存されたウェブページの制作、データ保管用の記憶領域の貸与、第三者のためのウェブサイトの作成及び保守、ウェブサイトの保守・制作及びホスティング、ソーシャル・ビジネス・コミュニティーネットワーキングにおいてユーザーが様々なプリント・写真・グラフィック画像・音声及び動画コンテンツをレビューし、インプット・好き嫌い・編集・変更・修正・意見・提案・コメントを提供するためのカスタムテンプレートを使用することを可能にするウェブサイトのホスティング、娯楽及び娯楽産業の分野において登録したユーザーが討論に参加しフィードバックを仲間から得て仮想コミュニティーを形成するためのソーシャルネットワーキングサービス用ウェブサイトのホスティング、コンピュータゲームソフトウェアの設計及び開発、ビデオゲーム機用ゲームソフトウェアの設計、電子ゲームの設計及び開発のためのオンラインによるダウンロード不可能なコンピュータソフトウェア開発ツールの一時的な使用の提供、ストリーミング方式で提供される音声及び動画ファイル・ゲーム・ソーシャルネットワーク・テキストファイル・マルチメディアファイルにアクセスするためのオンラインによるダウンロード不可能なコンピュータソフトウェアの提供、コンピュータゲームソフトウェア問題のトラブルシューティング（技術支援）、ダウンロード不可能なコンピュータソフトウェアアプリケーションの提供、電子的なデータ保管において使用されるオンラインによるダウンロード不可能なクラウドコンピューティングソフトウェアの提供、モバイルアプリケーションの分野におけるコンピュータソフトウェアの開発、通信機器の使用に関する技術支援の提供、ソーシャルネットワーキングユーザー向けの友達探しの為のオンラインによるコンピュータデータベース及びオンラインで検索可能なデータベースを提供するためのウェブサイトの設計・作成又は保守

No. 2

- International registration No.: 1563582
- International registration date: 2020/10/27
- The date of granting protection: 2022/08/12  
(priority date under the Paris Convention: 2020/04/27)
- Name and address of the holder: SCIMIAN PTY LTD  
PO BOX 586 NORTH CARLTON VIC 3054, Australia

Mark:

**SHIMMR**

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

International class 09:

Advertising display apparatus (electric or luminous) for use in displaying advertisements within lightshow spectacles, shown at sporting or entertainment events; computer software, computer software (programs) and computer software applications (downloadable) for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; instruments for the projection of graphic images, being instruments for projecting lightshow spectacles at sporting and entertainment events; visual display apparatus and visual display screens for use in lightshow spectacles displayed at sporting and entertainment events; illuminated advertisements featured within lightshow spectacles displayed at sporting and entertainment events; video editing apparatus for use in creating and editing video files for use in a mobile software

## Continuation sheet

application to generate lightshows for display at sporting and entertainment events.  
International class 42:

Advisory services relating to computer software; computer software design; computer software development; computer software engineering; consultancy in the design and development of computer software; development of computer software application solutions; installation and maintenance of computer software; rental of computer software; upgrading of computer software; writing of computer software; platform as a service (PaaS); hosting of software as a service (SaaS); software as a service (SaaS); all the foregoing services only being in relation to software that enables the creation and generation of lightshows by electronic mobile devices for display at sporting and entertainment events; technological research for the transfer of images between different media, to use images in video files within lightshows that are generated through mobile electronic devices, for display at sporting and entertainment events; graphic design of promotional materials; graphic design of promotional matter; visual design; all the foregoing design services only being in relation to designing the content of lightshow displays to be shown in sporting and entertainment venues.

- 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.)

Classes 9 and 42 should be deleted.

- 36 Electronic transfer of crypto assets for use by members of an on-line community via a global computer network; electronic payment processing for crypto-assets; cryptocurrency services, namely, issuing of tokens of value for use by members of an online community via a global computer network; cryptocurrency services, namely, issuing of tokens of value that incorporates cryptographic protocols, operates over the internet, and is used as a method of payment for goods and services; issuing of tokens of value, namely, issuing of stablecoins, stable tokens, tokenized fiat, tokenized assets, virtual currency and digital tokens of value using smart contracts, asset-backed tokens, fiat-backed tokens and digital assets; electronic financial trading services, namely crypto-assets trading services; currency transfer services, namely, transfer of crypto-assets; financial trading services, namely for buying, selling and trading non-fungible tokens; decentralised bill payment services.

## Extract from the Japanese Trademark Law

### Article 3 Requirements for trademark registration

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

### Article 4 Unregistrable trademarks

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

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

### Article 5 Application for trademark registration

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

### Article 6 Single trademark on each application

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

### Article 7 Collective trademarks

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

### Article 7-2 Regional collective trademarks

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

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

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

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

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

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

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

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

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

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## 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.

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

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

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