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JAPAN



日本国特許庁
〒100-8915
東京都千代田区霞が関3-4-3

NOTIFICATION OF PROVISIONAL REFUSAL

This notification is issued by the Japan Patent Office (JPO) in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement and Section 15-2 and 15-3 of the Japanese Trademark Law.

I. International registration number: 828519
Mark: RYE HONEY
Date of international registration: 2004/03/03
Holder of the international registration:
BREYFIELD Trust reg.

II. This trademark application* shall be totally refused protection. The grounds for refusal are indicated under Item V. A copy of the corresponding provisions of the Japanese Trademark Law is attached to this notification.

III. This refusal is issued on December/15/2004 by

TAKANO Kazuyuki (Mr.)
Examiner
Madrid Protocol Division
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IV. This provisional refusal affects all the goods and/or services covered in this application. The holder of the international registration may submit to the JPO a written opinion against this provisional refusal through the intermediary of a representative domiciled in Japan within three months from the date of pronouncement, as indicated below. If the holder wishes to amend the designated goods and/or services, the amendment must be made through the intermediary of a representative domiciled in Japan by the same date.

* 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: 6/ 1/ 2005

Continuation sheet

V. The grounds for refusal

Ground 1

The trademark of this application falls under Section 3(1)(iii) and 4(1)(xvi) of the Trademark Law because of the following reasons:

The trademark consists of the word "RYE HONEY" with a commonly used indication way. It is considered that this trademark only indicates the qualities and ingredient of the goods when being used for the designated goods, because of the fact that alcoholic drinks made from rye or honney is on sale.

Further to the above, if the applicant uses it for goods other than "alcoholic drinks made from rye and honney", it also falls under Section 4(1)(xvi) of the said Law as it is liable to be misleading as to the quality of goods.

Extract from the Japanese Trademark Law

3. Registrability of trademarks

(1) Any person may obtain a trademark registration of a trademark to be used in respect of goods or services in connection with his business, except in the case of the following trademarks:

- (i) trademarks which consist solely of a mark indicating, in a common way, the common name of the goods or services;
- (ii) trademarks which are customarily used in respect of the goods or services;
- (iii) trademarks which consist solely of a mark indicating in a common way, the origin, place of sale, quality, raw materials, efficacy, use, quantity, shape (including packaging shape) or price of the goods, or the method or time of manufacturing or using them, or the location of provision of the services, quality, articles for use in such provision, efficacy, use, quantity, modes, price or method or time of the provision of services;
- (iv) trademarks which consist solely of a mark indicating, in a common way, a commonplace surname or name of a legal entity;
- (v) trademarks which consist solely of a very simple and commonplace mark;
- (vi) in addition to those mentioned in each of the preceding paragraphs, trademarks which do not enable consumers to recognize the goods or services as being connected with a certain person's business.

(2) In the case of a trademark falling under paragraphs (ii) to (v) of the preceding subsection, where, as a result of the use of such trademarks, the consumers are able to recognize the goods or services as being connected with a certain person's business, trademark registration may be obtained notwithstanding the preceding subsection.

4. Unregistrable trademarks

(1) Notwithstanding Section 3, trademark registration shall not be effected in the case of the following trademarks:

- (i) trademarks which are identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal of merit, or a foreign national flag;
- (ii) trademarks which are identical with or similar to, a State coat of arms or other emblem (other than a national flag) of a country party to the Paris Convention (meaning 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 — hereinafter referred to as "the Paris Convention"), a Member of the World Trade Organization or a contracting party to the Trademark Law Treaty which have been designated by the Minister of Economy, Trade and Industry;
- (iii) trademarks which are identical with, or similar to, a mark indicating the United Nations or any other international organization and designated by the Minister for Economy, Trade and Industry;
- (iv) trademarks which are identical with, or similar to, the Red Cross emblem on a white ground or the title Red Cross or Geneva Cross;
- (v) trademarks comprising a mark identical with, or similar to, an official seal or sign which indicates supervision or certification by the Government of Japan or by the Government of a country party to the Paris Convention or a Member of the World Trade Organization or a contracting party to the Trademark Law Treaty, or by a local public entity and which has been designated by the Minister for Economy, Trade and Industry, which are used on goods or services identical with, or similar to, the goods or services in respect of which such seal or sign is used;
- (vi) trademarks which are identical with, or similar to, a famous mark indicating a State or a local public entity or an agency thereof or a non-profit organization or enterprise working in the public interest;
- (vii) trademarks liable to contravene public order or morality;
- (viii) trademarks containing the portrait of another person or the name, famous pseudonym, professional name or pen name of another person or the famous abbreviation thereof (except where the consent of the person concerned has been obtained);
- (ix) trademarks comprising a mark which is identical with, or similar to, a prize awarded at an exhibition held by the Government or a local public entity (hereinafter referred to as the "Government, etc.") or at one which is not held by the Government, etc. but has been designated by the Commissioner of the Patent Office or at an international exhibition held in a foreign country by its government, etc. or a person authorized thereby (except where the recipient of such a prize uses the mark as part of his trademark);
- (x) trademarks which are well known among consumers as indicating the goods or services as being connected with another person's business, and trademarks similar thereto, and which are used in respect of such goods or services or similar goods or services;
- (xi) trademarks which are identical with, or similar to, another person's registered trademark applied for prior to the filing date of the trademark application concerned and which are used on the designated goods or designated services (meaning the goods or services designated in accordance with Section 6(1) (including its application under Section 68(1)) — hereinafter referred to as "the designated goods or designated services") covered by the trademark registration referred to or on similar goods or services;
- (xii) trademarks which are identical with another person's registered defensive mark (meaning a mark registered as a defensive mark — hereinafter referred to as a "registered defensive mark"), and which are used on the designated goods or designated services covered by the defensive mark registration;
- (xiii) trademarks which are identical with another person's trademark (other than a trademark which had not been used by that person during a period of at least one year prior to the day on which the trademark right became extinguished) where one year has not elapsed since the date of extinguishment of the trademark right (or the date on which a ruling that a trademark registration is to be revoked or a trial decision that a trademark registration is to be invalidated becomes final and conclusive — hereinafter referred to as the "date of extinguishment of the trademark right"), or with a trademark similar to such a trademark, and which are used in respect of the designated goods or designated services covered by the trademark right or in respect of similar goods or services;
- (xiv) trademarks which are identical with, or similar to, the name of a variety registered under Section 18(1) of the Agricultural Seed and Seedlings Law (Law No. 83 to 1938), and which are used on the seeds or seedlings of the variety concerned or in respect of similar goods or services;
- (xv) trademarks which are liable to cause confusion with goods or services connected with another person's business (other than the trademarks mentioned in paragraphs (x) to (xiv));
- (xvi) trademarks liable to be misleading as to the quality of the goods or services;
- (xvii) trademarks comprising a mark indicating an origin of wines or spirits in Japan which has been designated by the Commissioner of the Patent Office or a mark indicating an origin of wines or spirits in a Member of the World Trade Organization prohibited to be used on wines or spirits not originating in the region in that member, which are used in respect of wines or spirits not originating in the region in Japan or that member;
- (xviii) trademarks consisting solely of a three-dimensional shape of goods or their packaging with the shape being indispensable to secure the functions of the goods or their packaging;
- (xix) trademarks which are well known among consumers in Japan or abroad as indicating the goods or services as being connected with another person's business, and trademarks identical with or similar thereto,

and which are used by the applicant for unfair intention (intention to gain an unfair profit, intention to cause damage to such another person and other unfair intentions — hereinafter the same) (other than the trademarks mentioned in each of the preceding paragraphs) in respect of such goods or services.

(2) Where registration of a trademark falling under paragraph (vi) of the preceding subsection is applied for by the State, a local public entity or an agency thereof or a non-profit organization working in the public interest or a person carrying on a non-profit enterprise working in the public interest, the said paragraph shall not apply.

(3) In the case of a trademark falling under paragraphs (vii), (x), (xv), (xvii) or (ix) of Subsection (1), the respective provisions shall not apply where the trademark does not fall under the respective paragraph at the time when the trademark application is filed.

(4) Where a trial decision that a trademark registration is to be canceled under Section 53bis has become final and conclusive and the demandant in the trial applies for registration of the trademark covered by the registration canceled by the trial decision, or a trademark similar thereto, paragraph (vii) of Subsection (1) shall not apply.

5. Unity in application

(1) An application for a trademark registration shall relate to a single trademark and shall designate one or more items of goods or services in respect of which the trademark is to be used.

(2) A designation under the preceding paragraph shall be made according to the classes of the classification of goods and services, prescribed by Cabinet Order.

(3) The classes of goods and services referred to in the preceding subsection shall not be determinative of the scope of similarity of goods or services.

7. Collective trademarks

(1) Aggregate corporation established under the provision of Section 34 of the Civil Code (Law No. 89 of 1986) or industrial business corporate association and other association established under the special law (excluding those which are not legal entities), or foreign legal entities corresponding thereto shall be entitled to obtain a collective trademark registration with respect of a trademark for use by their members.

(2) For the purposes of the provision of Section 3(1), "this business" in that section shall read "their members or them."

(3) Any person desiring the registration of a collective trademark under Subsection (1) shall submit to the Commissioner of the Patent Office with respect to a trademark application under Section 5(1) a document proving that the applicant is a legal entity referred to Subsection 1.

8. First-to-file rule

(1) Where two or more trademark applications relating to identical or similar trademarks which are to be used on identical or similar goods or services are filed on different dates, only the earliest applicant may obtain a trademark registration for the trademark concerned.

(2) Where two or more trademark applications relating to identical or similar trademarks which are to be used on identical or similar goods or services are filed on the same date, only one applicant, agreed upon after mutual consultations among all the applicants, may obtain a trademark registration for the trademark.

(3) Where a trademark application is a surrendered, withdrawn or dismissed or where an examiner's decision or trial decision on a trademark application has become final and conclusive, such application shall, for the purposes of the two preceding subsections, be deemed never to have been made.

(4) The Commissioner of the Patent Office shall, in the case of Subsection (2), order the applicants to hold consultations for an agreement under that subsection and to report the result thereof, within an adequate time limit.

(5) Where no agreement is reached in the consultations under Subsection (2) or where the report under the preceding subsection is not made within the time limit designated in accordance with that subsection, registration of the trademark concerned may be obtained only by one applicant chosen by the drawing of lots conducted in a fair and just manner by the Commissioner of the Patent Office.

15. Examiner's decision of refusal

The examiner shall make a decision that a trademark application is to be refused where it falls under any of the following paragraphs:

- (i) the trademark in the trademark application is not registrable in accordance with Section 3, 4(1), 8(2) or 6(1), 51(2) (including its application under Section 52bis(2)) or 53(2) of this Law of Section 25 of the Patent Law as applied under Section 77(3) of this Law;
- (ii) the trademark in the trademark application is not registrable in accordance with the provisions of a treaty;
- (iii) the trademark application does not comply with the requirements of Section 6(1) or (2).

15ter. Notification of reasons for refusal

(1) Where a trademark for which the registration is sought in a trademark application is a trademark which are identical with, or similar to, another person's trademark applied for prior to the filing date of the trademark application concerned and which are used on the designated goods or designated services covered by the trademark referred to or on similar goods or services, the examiner may notify the applicant that his trademark application may fall under Section 15(i) if the other party's trademark is registered, and give him an opportunity to submit a statement of his arguments, designating an adequate time limit.

(2) Where a notification referred to in the preceding subsection has been served and the other applicant's trademark is registered, the examiner shall not be required to serve a notification referred to in the preceding section.

1. The Japanese Patent Law

(Effect of treaties)

26-- Where there are specific provisions relating to patents in a treaty, such provisions shall prevail.

The Japanese Trademark Law

(Application mutatis mutandis of Patent Law)

77--(4) Section 26 (effect of treaties) of the Patent Law shall apply mutatis mutandis to trademark and defensive mark registrations.

Subsection (1) to (3), and (5) to (7) are omitted.