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 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: 955953
Mark: (figurative elements)
Date of international registration: 2007/11/12
Holder of the international registration:
Open Joint Stock Company ROSINTER RESTAURANTS HOLDING

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 November/10/2008 by

TAKIMOTO Sayoko (Ms.)
Examiner
Madrid Protocol Division
Facsimile: +81-3-3593-2398
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IV. The trademark of this application can be protected subject to amendments to be made by the holder of the international registration as suggested under Item VI. The amendment must be made through the intermediary of a representative domiciled in Japan within three months from the date of pronouncement, as indicated below. If any, the holder may submit to the JPO a written opinion against this provisional refusal through the intermediary of a representative domiciled in Japan by the same date. Alternatively, the holder may request a limitation of the list of goods and/or services in accordance with Rule 25(1)(a) of the Common Regulations. This request must be presented to the International Bureau of WIPO by Official Form MM6.

* 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: 2008/11/20

Continuation sheet

V. The grounds for refusal

Ground 1

[1]

With regard to "litigation services" designated in class 45, the trademark of this application does not conform to the requirements (a trademark shall be used with respect to goods and services in connection with his/her business) as provided in the main paragraph of Section 3(1) of the Trademark Law because it is uncertain as to whether the applicant is qualified for undertaking such services, which is to be undertaken by qualified individuals and firms in Japan, such as a lawyer and qualified corporation. To this end, it is requested that the said services shall be deleted from the list of the designated services.

[2]

The trademark which falls within the category of trademarks registrable in accordance with the main paragraph of Section 3(1) of the Trademark Law is a trademark which is used now or is intended to use in the near future. However, the veracity of use or intention of use of the trademark in regard to all the designated goods or designated services is doubted, since the designation of goods or services ranges widely in class 41 in this application. Thus it is sort that this application does not conform to the requirements as provided in the main paragraph of Section 3(1) of the Trademark Law.

However, this does not apply where the use or intention of use of the trademark would be ascertained by next (i) or (ii).

(i) To prove that the applicant is carrying out business connected with the designated goods or designated services in JAPAN by submitting some documents such as newspapers, catalogs, business documents etc.

(ii) To prove that the applicant is planning to start to use the trademark connected with the designated goods or designated services in JAPAN within 3 to 4 years from the date of international registration or subsequent designation by submitting a written declaration of use of the trademark and documents stating his/her business preparation status, when to start to use the trademark and what goods or services the trademark will be used for.

Please note that the above reason for refusal will be cleared, provided that the designated goods/services of this trademark application are limited to the appropriate range.[Please refer to examples for amendment in item VI.]

[Note1] This ground for refusal may apply to the international trademark applications which are registered or designated subsequently on or after April 1, 2007 according to the revised Examination Guidelines for Trademarks corresponding to the amendment of the Japanese Trademark Law that took effect on April 1, 2007.

*The above Examination Guidelines are located on the JPO website at
http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1303-061_3_6.pdf
http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-001.htm

[Note2] The above mentioned document, which is translated into Japanese, shall be submitted to the JPO by the intermediary of a representative domiciled in Japan.

VI. The trademark of this application will be protected if the goods and services are amended/limited as follows: (Examples are underlined. The underlined goods/services are the examples of amendment/limitation of the goods/services shown in V. Sometimes there are no underlined goods/services.)

Class 43 remains unchanged.

41 Academies (education); booking of seats for shows; videotaping; nursery schools; physical education; discotheque services; education information; recreation information; entertainment information; movie studios; health club services; club services (entertainment or education); night clubs; layout services, other than for advertising purposes; microfilming; production of radio and television programmes;

Continuation sheet

game services provided on-line from a computer network; religious education; correspondence courses; practical training (demonstration); organization of balls; arranging and conducting of concerts; holiday camp services (entertainment); organization of shows (impresario services); organization of sports competitions; amusement parks; television entertainment; providing karaoke services; providing amusement arcade services; cinema presentations; presentation of live performances; theatre productions; educational examination; electronic desktop publishing; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio entertainment; entertainer services; amusements; party planning (entertainment); music composition services; sport camp services; educational services; scriptwriting services; ticket agency services (entertainment); digital imaging services; photography; photographic reporting; circuses; boarding schools; production of shows.

45 Security consultancy; intellectual property consultancy; intellectual property watching services; licensing of intellectual property; licensing of computer software (legal services); legal research; mediation; inspection of factories for safety purposes; registration of domain names (legal services); chaperoning; copyright management; dating services.

Extract from the Japanese Trademark Law

Art. 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, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;

(iv) consists solely of a mark indicating, in a common manner, a common surname or name of a legal entity;

(v) consists solely of a very simple and common mark; or

(vi) in addition to what is 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) through (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.

Art. 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 which has been designated by the Minister of Economy, Trade and Industry;

(iv) is identical with, or similar to, the emblems or titles in Article 1 of the Law Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Law No.159 of 1947) or the distinctive emblem in Article 158(1) of the Law Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Law No.112 of 2004);

(v) consists 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 contravene public order or morality;

(viii) contains the portrait, name of another person, famous pseudonym, professional name, pen name 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 "Government, etc.") or by those who are not the Government, etc. but designated 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 well known among consumers as that indicating goods or services in connection with another person's business or a trademark similar thereto, 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 in connection with which the said registered trademark is registered (refers to goods or services designated in accordance with Article 6(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(1)), hereinafter the same) or goods or services similar thereto;

(xii) is identical with a registered defensive mark of another person (refers 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 in connection with which the defensive mark is registered;

(xiii) is a trademark of another person (excluding those which had not been used by the said person for a period of one year or longer from the date the trademark right became extinguished) the right to which has been extinguished for a period of shorter than one year from the date of the extinguishment of the said trademark right or the date on which a ruling to the effect that the trademark registration is to be rescinded or a trial decision to the effect that the trademark registration is to be invalidated is rendered, the same shall apply hereinafter) or a trademark similar thereto, if such a trademark is used in connection with the designated goods or designated services in connection with the trademark right of such other person or goods or services similar thereto;

(xiv) is identical with, or similar to, the name of a variety registered in accordance with Article 18(1) of the Agricultural Seed and Seedlings Law (Law No. 33 of 1998), if such a trademark is used in connection with 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 cause confusion 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 a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function; 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 the said item, Item (vi) of the preceding paragraph 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.

(4) Where a trial decision to the effect that a registration of a trademark is to be rescinded pursuant to Article 53-2 becomes final and conclusive, and the demandant of the said trial files a trademark application for the trademark pertaining to the rescinded registration following the said decision, or a trademark similar thereto, Item (xii) of Paragraph (1) shall not apply.

Art. 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 classifications of goods and services specified by Cabinet Order.

(3) The classifications of goods and services provided for in the preceding paragraph shall not be perceived as prescribing the scope of similarities of goods or services.

Art. 7. Collective trademarks

(1) Any incorporated association established pursuant to Article 34 of the Civil Code (Law No. 89 of 1896), any other incorporated association (except those which are not legal entities or corporations), or other association established pursuant to a special law including business cooperative (except those which are not legal entities), or a foreign legal entity 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 Article 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 legal entity that falls under Paragraph (1).

Art. 7-2. Regionally based collective trademark

(1) Any association established by special law, including a business cooperative (except those which are not legal entities and limited to those which are established by a special law prescribing that the association shall not refuse the enrollment of any person who is eligible to become a member without a justifiable reason 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) or a foreign legal entity equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regionally based collective trademark with respect to 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 shall mean the place of origin of the goods or the location of provision of services for which the trademark pertaining to the said application has been used by the applicant or its members even prior to the filing of such application, or the name or abbreviated name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent.

(3) For the purpose of the application of Article 3(1) (limited to those relating to item (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 regionally based 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 set forth in Paragraph (2).

Art. 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 shall be entitled to register the trademark in question, to be determined by consultations between the applicants who filed such applications.

(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 conclusive, 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 between 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.

Art. 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 registerable 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 Law or Article 25 of the Patent Law as applied mutatis mutandis under 77(3) of this Law;

(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 6(1) or 6(2).

Art. 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 intended to be 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(1) 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.

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I. 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.

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Notice

With the revision of the Trademark Law, Article 7-2 (regionally based collective trademark) was introduced, and a reference to 7-2 (1) was added in Article 15.

This revision shall be applied to an international application for which the date of international registration or date of subsequent designation is on or after April 1, 2006.

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