

Japan Patent Office (JPO)
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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: 1033667
Mark: 28BLACK
Date of international registration: 2009/12/22
Holder of the international registration:
Calidris 28 AG (SA)

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 August/25/2010 by

YAGIHASHI Masao (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: 2010/09/09

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 32 Taurine beverages containing caffeine.

<Proposal amendment>

soft drinks containing taurine and caffeine;

Ground 2

The trademark of this application falls under Section 3(1)(vi) of the Trademark Law because of the following reason:

The trademark of this application consists of the word "28BLACK" with a commonly used indication way. It is considered that the word "BLACK" means "cosmetics for coloring in black, clothing in black, black [label] beverages ; i. -e. designated goods are coloring in black" and "28" is a two digits (i.-e. a pattern of numerals) which may be commonly used in trade to indicate a coloring number and/or number of serial-model and/or products numeral and/or number of the grades and/or length [28cm, 28inch] of designated goods (e.g. black label whisky 28 percent alcohol by volume... ; black [clothing] 28 ins.; etc.).

Therefore this trademark, seen as the combination of the above mentioned "28" and "BLACK" , fails to enable consumers to recognize the goods/services as being connected with a certain person's business if this trademark is used for the designated goods.

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.153 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. 83 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 (xiii) 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) 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 Law 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 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 of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):

(i) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members;

(ii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the name customarily used as a name indicating the goods or services pertaining to the business of the applicant or its members; or

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

(2) The term "name of the region" as used in the preceding paragraph 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 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 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.

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.

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.