

Japan Patent Office (JP0)  
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 (JP0) 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: 1204161  
Mark: BIOPLAST (with figurative elements)  
Date of international registration: 2013/11/29  
Holder of the international registration:  
Bio-tec Biologische Naturverpackungen GmbH & Co. KG

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/10/2014 by

TAKANO Kazuyuki (Mr.)  
Examiner  
Madrid Protocol Division  
Facsimile: +81-3-3593-2398  
Telephone: +81-3-3501-2392

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 JP0 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.

\* All communications via telephone and facsimile except for general inquiries will be recorded and stored in the file wrapper disclosed by request in order to secure transparency.

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\* A request for territorial extension to Japan under the Protocol relating to the Madrid Agreement is deemed as a trademark application made in Japan in accordance with Section 68-9 of the Japanese Trademark Law.

The date of pronouncement: 2014/11/20

## 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 05 Sanitary products (included in this class) capsules (filled) for medical purposes (included in this class).

---> It is considered that this indication is combining two indications of goods. Please separate a indication of each good using a semicolon.

Class 17 Packing, stopping and insulating materials.

---> The above indication is inappropriate as an indication for the designated goods and services in class 17 because it is too vague. Therefore, it should be amended/limited to specific indications, such as "Packing [cushioning, stuffing] materials of rubber or plastics; cotton wool for packing [caulking]; pipes (Joint packings for -); stops of rubber; stoppers (Rubber -); insulators; asbestos packing".

Class 20 Plastic tubes.

---> The above indication is inappropriate as an indication for the designated goods and services in class 20 because it is too vague. Therefore, it should be amended/limited to specific indications, such as "Packaging containers in the form of plastic tubes".

Class 42 Scientific and technological services and research and design relating thereto.

---> The above indication is inappropriate as an indication for the designated goods and services in class 42 because it is too vague. Therefore, it should be amended/limited to specific indications, such as "Scientific and technological research and development; computer software design; industrial design".

\* Please note that the above examples can resolve Ground 1 only. This application still falls under Ground 3 for refusal even if the indications are appropriately amended/limited according to the above examples. ---> See Ground 3

## Ground 2

The trademark of this application does not conform to the requirements as provided in the main paragraph of Section 3(1) of the Trademark Law because of the following reason:

The main paragraph of Section 3(1) requires that registerable trademarks either be currently in use or will be put into use in the near future; however, there is reasonable doubt as to whether the applicant currently uses or will use in the near future this trademark on the designated goods or services, as indicated below, because the designated goods or services come under too wide a scope within one class:

**All the designated goods or services in Classes 17 and 42**

However, the above reason for refusal will be resolved if the above-mentioned doubt, as to the use of or the intent to use this trademark, is eliminated by the applicant's taking any of the following procedures (a), (b) or (c):

## Continuation sheet

- (a) Proving that the applicant is conducting business connected with the above-mentioned designated goods or services in Japan by submitting some documents such as newspaper articles, catalogs, business documents etc.;
- (b) Proving that the applicant is planning to conduct business connected with the above-mentioned designated goods or services in Japan within three to four years from the date of the international registration or the subsequent designation by submitting both of the following documents:
- (i) A written Declaration of Intention to Use stating when this trademark will begin to be used and what goods or services this trademark will be used for in Japan; and
  - (ii) Documents of Business Plan stating the current status of the applicant's business preparations; or
- (c) Limiting the above-mentioned designated goods or services to an appropriate range. For your reference, examples of amendments/limitations can be found in Item VI.

<Important notes for proving (a) or (b) above>

- (1) The Examination Guidelines are available on the JP0 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/pdf/tt1303-061_3_6.pdf)
- (2) The above-mentioned documents for proving (a) or (b) must be accompanied with a Japanese translation and submitted to the JP0 through the intermediary of a representative domiciled in Japan.

## Ground 3

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.: 1986644 - Registration date: 1987/09/21
- National application No.: S60-010140 - Application date: 1985/02/06
- Name and address of the holder: Alcare Kabushiki Kaisha  
21-10, Kyojima 1-chome, Sumida-ku, Tokyo, JAPAN

Mark:

**バイオプラスト**

Conflicting goods and/or services and their class(es), corresponding to class 05 covered in this application:

International class 05:

医療用油紙, 衛生マスク, オブラート, ガーゼ, カプセル, 眼帯, 耳帯, 生理帯, 生理用タンポン, 生理用ナプキン, 生理用パンティ, 脱脂綿, ばんそうこう, 包帯, 包帯液, 胸当てパッド, 歯科用材料

International class 10:

おしゃぶり, 氷まくら, 三角きん, 支持包帯, 手術用キャットガット, 吸い飲み, スポイト, 乳首, 氷のう, 氷のうつり, ほ乳用具, 魔法ほ乳器, 綿棒, 指サック, 避妊用具, 人工鼓膜用材料, 補綴充てん用材料 (歯科用のものを除く。)

## Continuation sheet

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 1 and 16 remain unchanged.

- 5 Pharmaceutical and veterinary products.
- 17 Semi-processed plastic substances, including biodegradable plastics, in the form of granules; plastics in extruded form for use in manufacture; rubber envelopes and pouches for packaging; packing [cushioning, stuffing] materials of rubber or plastics; cotton wool for packing [caulking]; pipes (Joint packings for -); stops of rubber; stoppers (Rubber -); insulators; asbestos packing; plastic film, not for wrapping.
- 20 Packaging containers of plastic, in particular biodegradable plastic; packaging containers for foodstuffs of plastic, in particular biodegradable plastic; packaging containers in the form of plastic tubes.
- 42 Scientific and technological research and development; computer software design; industrial design; industrial analysis and research services; services of a chemico-physical laboratory for testing and development of biodegradable plastics; scientific and technological consultancy in the field of testing and development of biodegradable plastics.

## 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, 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 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 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 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 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 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. 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 6. 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) or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") shall be entitled to obtain a regional collective trademark registration with respect of any of the following, provided that the trademark is used by its members and, as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members, notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)):

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

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

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

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

#### Article 8. Prior application

(1) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on different dates, only the applicant who filed the application for trademark registration on the earlier date shall be entitled to register the trademark in question.

(2) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on the same date, only one applicant who is to be determined by consultations among the applicants who filed such applications shall be entitled to register the trademark in question.

(3) Where an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial decision on an application for trademark registration becomes final and binding, such application shall, for the purposes of the application of the preceding two paragraphs, be deemed never to have been filed.

(4) In the case of paragraph (2), the Commissioner of the Patent Office shall require the applicants for trademark registration to arrange consultations among the applicants as set forth in the said paragraph and to report the result thereof, designating a reasonable time limit for such purpose.

(5) Where no agreement is reached in the consultations held pursuant to paragraph (2) or no report is submitted within the designated time limit set forth in the preceding paragraph, only one applicant, selected by a lottery in a fair and just manner conducted by the Commissioner of the Patent Office, shall be entitled to register the trademark in question.

#### Article 15. Examiner's decision of refusal

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

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

#### Article 15-3

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

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

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

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

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

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

#### Japanese Patent Law:

##### Article 26 Effect of treaties

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

#### Notice

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

( Creation Date: June 17, 2013 )