



# International IP Rights – Tips and Tricks International Trade-mark Applications

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Shunji SATO, Partner / Trademark Attorney  
TMI Associates, Japan



# Japan – Number of Trademark Applications



	2007	2008	2009	2010	2011	2012	2013	2014	2015	2016
総商標登録出願件数 Total Number of Trademark Applications	143,221	119,185	110,841	113,519	108,060	119,010	117,674	124,442	147,283	161,859
国際商標登録出願件数 Number of International Applications for Trademark Registration	12,295	12,586	10,641	10,825	12,412	11,788	13,696	12,672	15,984	13,835
国際商標登録出願を除く商標登録出願件数 Number of Trademark Applications excluding International Applications for Trademark Registration	130,926	106,599	100,200	102,694	95,648	107,222	103,978	111,770	131,299	148,024

(備考)  
 商標登録出願件数には、防護標章登録出願及び防護標章登録に基づく権利の存続期間の更新登録の出願の件数が含まれる。  
 国際商標登録出願件数は、マドリッド協定議定書に基づく国際出願であって日本国を指定し、かつ領域指定の通報が日本国特許庁に行われた出願の件数。当該件数については、領域指定の通報が日本国特許庁に行われた日を基準にカウントしている。

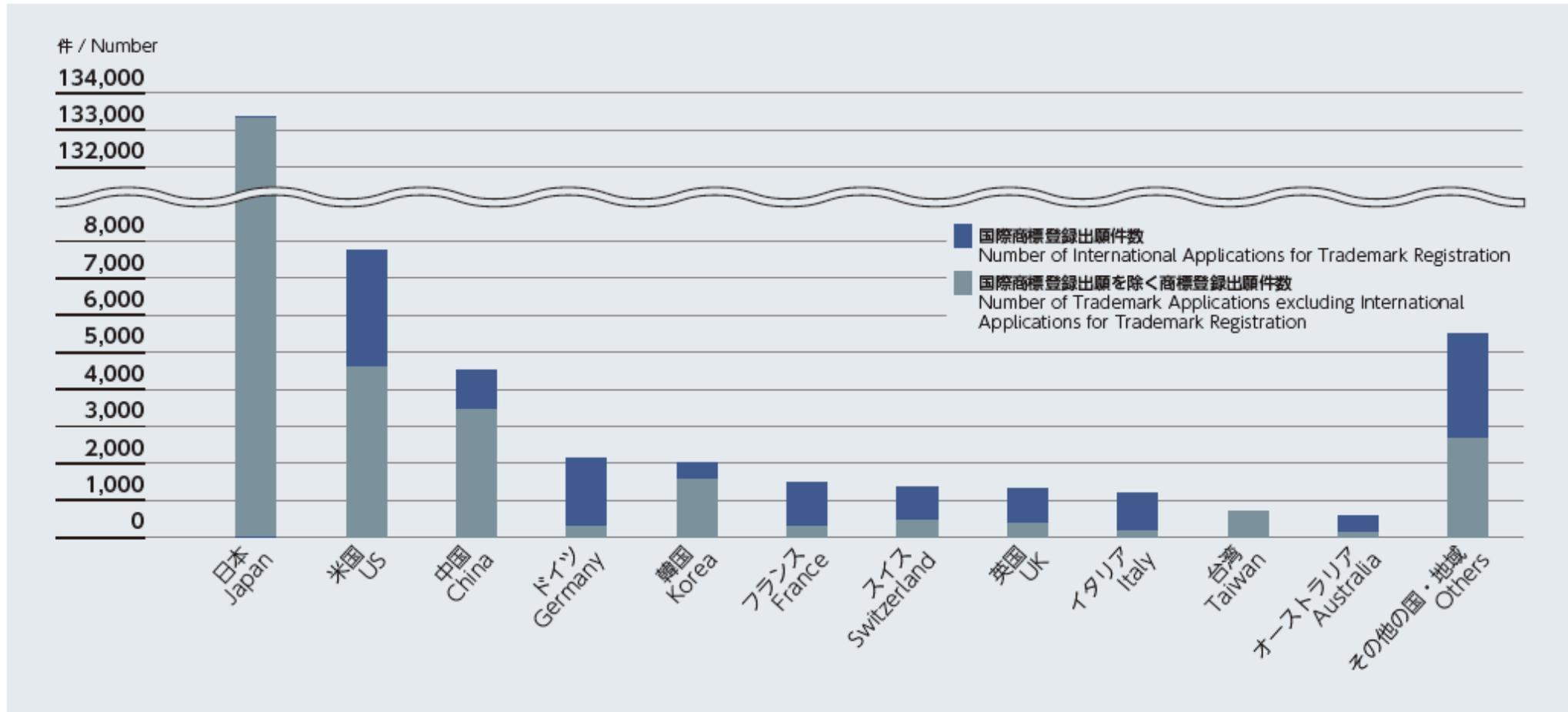
(Notes)  
 The number of trademark applications includes applications for defensive mark registration and for registration of extension of trademark term based on defensive mark registration.  
 The number of international applications for trademark registration represents those which designated Japan under the Madrid Protocol System and notified the JPO of their designated states. Said number was counted based on the date on which their designated states were notified to the JPO.

Source : JPO Status Report 2017

<https://www.ipo.go.jp/shiryuu/toukei/pdf/status2017/all.pdf>

# Japan – Number of Trademark Applications by Country of Origin of Applicant

Chart 1-1-20: Number of Trademark Applications by Country of Origin of Applicant (Top 10 Countries/Regions)



Source : JPO Status Report 2017

<https://www.ipo.go.jp/shiryuu/toukei/pdf/status2017/all.pdf>

# Japan – Number of Trademark Applications by Country of Origin of Applicant

	日本 Japan	米国 US	中国 China	ドイツ Germany	韓国 Korea	フランス France	スイス Switzerland	英国 UK	イタリア Italy	台湾 Taiwan	オーストラリア Australia	その他 Others
総商標登録出願件数 Total Number of Trademark Applications	133,337	7,739	4,530	2,141	2,027	1,461	1,359	1,313	1,175	699	594	5,484
国際商標登録出願件数 Number of International Applications for Trademark Registration	10	3,154	1,078	1,840	471	1,163	917	922	1,003	0	475	2,802
国際商標登録出願を除く商標登録出願件数 Number of Trademark Applications excluding International Applications for Trademark Registration	133,327	4,585	3,452	301	1,556	298	442	391	172	699	119	2,682

(備考)

共同出願については、筆頭出願人でカウントしている。  
国際商標登録出願については、筆頭出願人の居住国を出願人国籍とみなしてカウントしている。

(Notes)

Joint applications were counted by head applicants.  
The number of international applications for trademark registration was counted based on the country of residence of head applicants as the country of origin of applicants.

Source : JPO Status Report 2017

<https://www.ipa.go.jp/shiryu/toukei/pdf/status2017/all.pdf>

# Japan – 5<sup>th</sup> Most designated Madrid member

## Figure 6

Designations in international applications for the top 10 designated Madrid members, 2016



Source: Standard figure A12.

## Figure 8

Subsequent designations in international registrations for the top 10 designated Madrid members, 2016



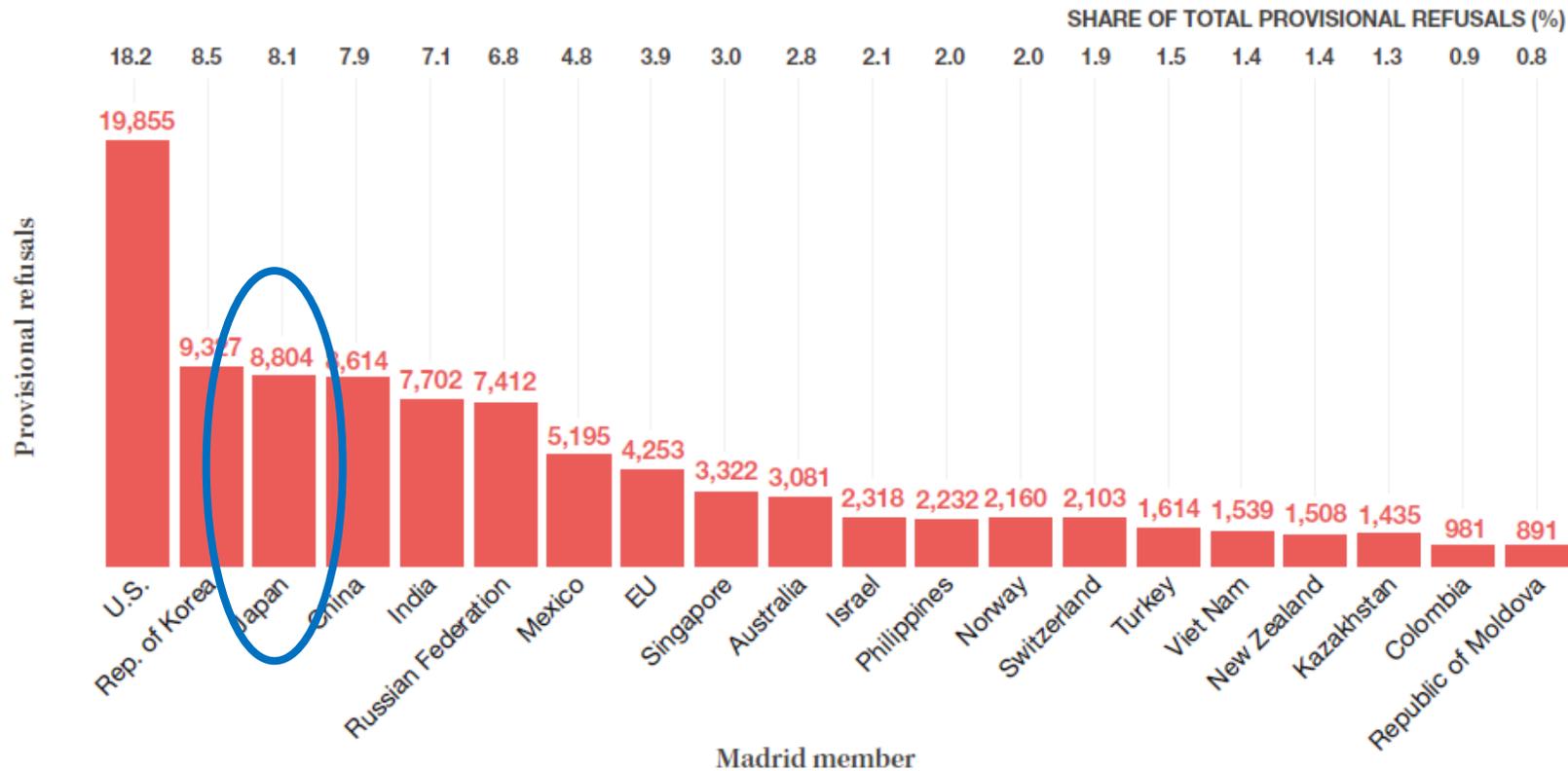
Source: WIPO Statistics Database, March 2017.

# Japan –3<sup>rd</sup> Biggest issuer of Provisional Refusals

**Figure B8**

Provisional refusals of designations by selected designated Madrid members, 2016

**The U.S. and the Republic of Korea issued the largest numbers of provisional refusals of designations in 2016.**



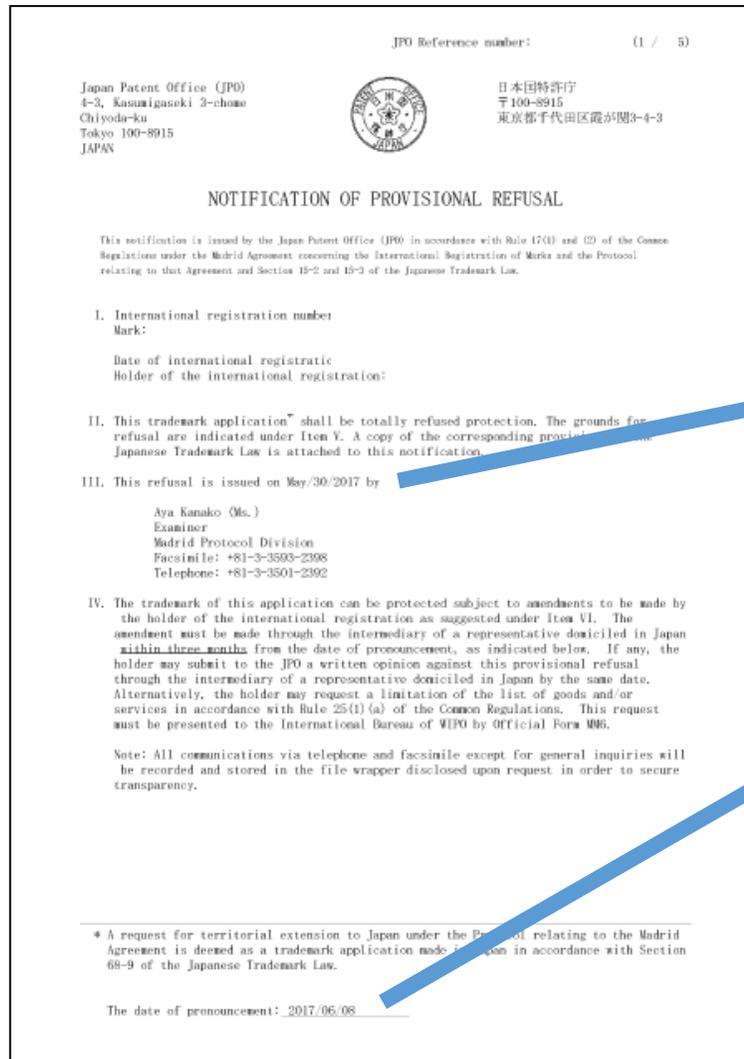
Source: WIPO Statistics Database, March 2017.



# When receiving a Provisional Refusal from the JPO



- Submit an original Power of Attorney to the JPO
  - Original Power of Attorney can be filed later
- Deadline to respond to a Provisional Refusal (PR)
  - ✗ 3 months from the date the PR is issued by the JPO or the WIPO
  - ○ **3 months from the date of pronouncement of the Notification of PR**
  - ✗ 3 months from the date of receipt of the PR notification by the Applicant
- Extension of time - Possible even after the deadline expires
  - One-month extension if a request is filed before the expiration
  - Two-month extension if a request is filed after the expiration



**3 months from the date of pronouncement**

III. This refusal is issued on May/30/2017 by

The date of pronouncement: 2017/06/08

2017/9/8



# Provisional Refusal - Earlier trademarks



- There exists
    - 1 identical prior mark in Class 3 and
    - 2 similar prior marks in Class 44
  - (1) bad faith filing for an identical trademark;
  - (2) similar trademarks likely to be solved with a Letter of Consent;
  - (3) earlier trademarks owned by the same applicant but the name/address are written differently
- 
- Partial provisional refusals cannot be issued in Japan



# Provisional Refusal - Earlier trademarks



- (1) Bad faith application for an identical trademark
  - Opposition
  - Invalidation Action
  - Non-use Cancellation Action
  - Third Party Observation
  
- Grounds
  - Lack of Intent to Use
  - Likelihood of Confusion
  - Bad Faith

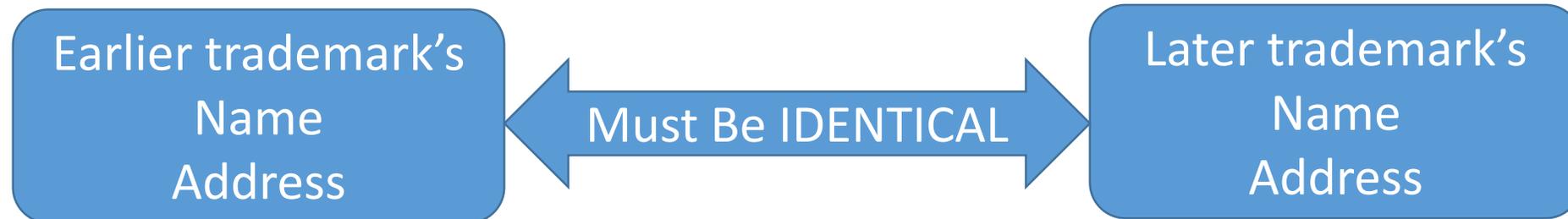


# Provisional Refusal - Earlier trademarks



- (2) Similar trademarks likely to be solved with a Letter of Consent
  - In general, **Letters of Consent** are **NOT** accepted in Japan
    - A “worldwide co-existence agreement” will be insufficient in itself
    - Accepted only between parent company and subsidiary since April 2017
  - Co-existence by way of an **“Assign-back arrangement”**
    - The later trademark applicant **temporarily assigns** its pending application to the prior trademark owner.
    - Once the pending application is **under the same ownership**, the ground for refusal is resolved and the Examiner will grant a decision of registration.
    - After the pending application has been registered at the JPO, the trademark will then be **assigned back** to the original applicant (the requesting party).

- (3) Earlier trademarks owned by the same applicant but the name/address are written differently
  - The JPO strictly examines the identity of both entities and requires both the names and addresses thereof to be identical
  - Citation cannot be overcome by only filing an Argument
  - Requires recordal procedures for the change of name/address





# Second part of the individual fees - Only Japan and Cuba



  
WIPO | MADRID  
The International  
Trademark System

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**Reminder - Second payment of fees for Japan**

Geneva, 15/08/2016

Our Ref.: 869/0985362001

On 26 May 2016, the International Bureau of WIPO sent you a notification concerning the payment of the second part of the individual fee for Japan for the international registration number (please see the enclosed copy of the notification).

Please note that, according to our records, the International Bureau has not received the payment. However, you are hereby required to pay the second part of the individual fee for Japan. The amount of 687.00 Swiss Francs should be paid by 26 August 2016.

If the second part of the individual fee is not paid in whole within the above-mentioned date, the international registration will be cancelled in respect of the Contracting party of Japan in accordance with Rule 34(3)(d) of the Common Regulations. The International Bureau will not issue any irregularity notice in case of insufficient payment.

JPO Reference number: 2015-357631 (1 / 1)

THE PROTOCOL RELATING TO THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

**NOTIFICATION OF SECOND PART OF INDIVIDUAL FEE**

This notification is issued pursuant to the Rule 34(3)(C) of the Common Regulations.

Drafting date: 2016/05/13

I. Office of a Designated Contracting Party:

Japan Patent Office (JPO) 4-3, Kasumigaseki 3-chome Chiyoda-ku Tokyo 100-8915 JAPAN  
Fax: +81-3-3580-8033

II. International registration number:  
Mark:

Date of international registration: 2014/10/23

III. Holder of the international registration:

IV. Number of classes of goods and services for which the mark is protected: \*

3

V. Date by which a second part of individual fee must be paid:

The payment shall be paid to the International Bureau by the following date.  
2016/08/26

\*Note  
Where the second part of the individual fee is not paid by the above-mentioned date, the International Bureau shall cancel the International registration in the International Register with respect to Japan. [Rule 34(3)(d)]

VI. Date on which the notification was pronounced: 2016/05/26

VII. Signature or official seal by the office:





# Thank you!

**Shunji SATO**

**Partner, Trademark / Design Attorney**

TMI Associates

23rd & 24th Floors, Roppongi Hills Mori Tower  
6-10-1 Roppongi Minato-ku

Tokyo 106-6123

JAPAN



TEL +81(0)3-6438-5611 FAX +81(0)3-6438-5622

E-mail: [ssato@tmi.gr.jp](mailto:ssato@tmi.gr.jp) <http://www.tmi.gr.jp/english>

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