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January 11, 2017

Ms. Wang Binying
Deputy Director General
WORLD INTELLECTUAL PROPERTY ORGANIZATION
34, chemin des Colombettes
1211 Geneva 20, Switzerland
(sct.forum@wipo.int)

Re: WIPO Request for Comments (SCT/36) (Deadline: January 15, 2017)

Dear Ms. Wang Binying

The Japan Patent Attorney Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has about 10,000 members practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including patent, trademark and design law as well as copyright and unfair competition.

In response to the request dated November 3, 2016, which is based on the SCT thirty-sixth session (document SCT/36/5, paragraph 13), the JPAA would like to submit comments on the Possible Areas of Convergence that were identified in document SCT/35/4 relating to the Protection of Country Names Against Registration and Use as Trademarks. Our comments mainly consist of an introduction of applicable regulations corresponding to the Possible Areas of Convergence No. 1 (Notion of Country Name), No. 2 (Non-registrable if Considered Descriptive), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark), including practical examples of how these principles are applied in Japan.

Possible Areas of Convergence No. 1 (Notion of Country Name)

The document SCT/35/4 indicates in relation to the above possible areas of convergence that “At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.”, and Japanese guidelines and manuals have related stipulations as mentioned below.



Specifically, the Examination Guidelines for Trademarks relating to Article 3-1-3 of the Trademark Act stipulates as follows (excerpt);

Examination Guidelines for Trademarks
Chapter I: Article 3(1) (Requirements for Trademark Registration)
Part 5: Article 3(1)(iii) (Indication of Origin, Place of Sale, Quality and other Characteristics of the Goods, or Indication of Location, Quality and other Characteristics of Provision of the Services)
Paragraph 2: “Origin or Place” and of “Place of Sale” of goods and “Location of Provision” of services
(1) Where trademarks are composed of a geographical name in Japan and overseas (a name or a map indicating a nation, an old nation, a capital, a province, an administrative area (a prefecture, a municipality, a special city ward, etc.), a state, the capital of a state, a county, the capital of a province, an old country, an old area, a busy downtown street, a sightseeing area (including its location and surrounding areas), a lake, a mountain, a river, or a park, etc.), they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services,” where a consumer or a trader generally recognizes that the designated goods will be produced or sold or the designated services will be provided at the place indicated by the geographical name.
(2) Where trademarks are composed of a state name (including abbreviations of state names and former state names of existing countries) or famous geographical names in Japan and overseas, they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services.”

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https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1302-002/1-5.pdf

In addition, the Trademark Examination Manual 41.103.01 stipulates as follows (excerpt);

Trademark Examination Manual
Item 41.103.01: Trademarks Related to Foreign Geographical Names

Trademarks Related to Foreign Geographical Names
1. Country names
A name of a country, an abbreviation of a country’s name, and the former name of an existing country will be refused in principle if used to indicate the place of origin, the place of sales (place of transaction) of the goods, or the place of the provision of services (place of transaction).
Names that are indicated in characters used in the home country, in the Japanese language, and other foreign languages, will be subject to this restriction in principle.

2. Geographical names
In the cases of (a) the name of a capital, (b) the name of a state, (c) the name of a prefecture, (d) the name of a state capital, (e) the name of a province, (f) the name of the capital of a province, (g) the name of a county, (h) the name of the capital of a



prefecture, (i) a former country name, (j) an old regional name, (k) the name of a district, (l) the name of a city, or special district, (m) the name of a famous affluent district, (n) the name of a famous sightseeing spot, even though these names may not be directly described in a dictionary or other documents/material as the place of origin, place of manufacturing or sales (location of transaction) of the goods, or a location of provision of services (location of transaction), if a factor exists that establishes a connection between the goods and the name as a place of manufacturing and sales (location of transaction), or the location of the provision of services (location of transaction), in principle, the trademark will be refused on the grounds that it indicates the location where the goods are manufactured and sold (location of transaction) or the location of provision of services (location of transaction).

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https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/41-103-01.pdf

As mentioned above, at least for the purposes of examination of marks in Japan, a country name may cover-

- (1) “a geographical name including a name indicating a nation, an old nation”,
- (2) “a state name (including abbreviations of state names and former state names of existing countries)”,
- (3) “country names that are indicated in characters used in the home country, in the Japanese language, and other foreign languages” and,
- (4) “geographical names which include a former country name”.

The JPAA would appreciate if it is defined in a little more detail as to the scope of "transliteration" and "abbreviated form" of country name in relation to the Possible Area of Convergence No. 1 in future SCT sessions.

There could be various “transliterations” in Japanese characters for the same foreign words. For example, there are several possible Japanese transliterations of an African country, namely “Togo”, and such transliterations can be recognized not only as country names but also as Japanese male given names.

There could also be various “abbreviated forms” to indicate country names, but some among these may not be necessarily recognized as country name in the context of trademark use. For example, both “CA” and “CAN” are used as abbreviated forms of a country name of Canada, and both “KE” and “KEN” stands for a country name of Kenya, but especially each latter abbreviation does not necessarily bring only one thing to mind.

Therefore, even establishing some guidelines for “transliteration” and “abbreviated forms” in relation to country names, it should be taken into account that a vague guideline may eventually serve as an overregulation.



Possible Areas of Convergence No. 2 (Non-registrable if Considered Descriptive)

The document SCT/35/4 indicates in relation to the above possible areas of convergence that “At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.”, and Japanese trademark law, guidelines and manuals have related stipulations as mentioned below.

Specifically, Article 3-1-3 of the Trademark Act stipulates as follows (excerpt):

Trademark Act

Article 3-1-3:

Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

...

(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, shape (including shape of packages, the same shall apply in items (ii) and (iii) of Article 26(1).), the method of production or use, time or other characteristics, quantity or price, or, in the case of services, the location of provision, articles to be used in such provision, efficacy, intended purpose, modes, time or other characteristics, quantity or price or method of provision;

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https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1302-002/1-1.pdf

Please also refer to "the Examination Guidelines for Trademarks (relating to Article 3-1-3 of the Japanese Trademark Act)" and "the Trademark Examination Manual 41.103.01" mentioned in the section before which define “the place of origin, the place of sales”.

Trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services in Japan in principle based on the above regulation (Basic regulation: Article 3-1-3 of Trademark Law).

Set out below are the examples of precedent refusal decision of JPO appeal board:

- (1) Trademark "**SCOTCH with Japanese characters**" (Class 1: chemical preparations, etc.), Case No. "Showa 42nen Appeal No.5047" decided on December 1st, 1969
- (2) Trademark "**MEXICO**" (Class 30: confectionery, etc.), Case No. "Showa 43nen Appeal No.2525" decided on June 24, 1971
- (3) Trademark "**French's**" (Class 29: tea, etc.), Case No. "Showa 45nen Appeal No.10296" decided on November 6, 1972,



Other reference information (excerpt from the court decision relating to the trademark which consists of geographical indication):

"Even if the designated goods are not actually produced or sold at the land indicated by the trademark, "places for producing, places for selling" include the places where consumers deem such goods to be generally produced or sold at the land indicated by the trademark." (Trademark "GEORGIA" (Class 29 "Coffee, etc."), Supreme Court case (Showa 60nen (Gyo-tsu)No.68) decided on January 23,1986)

Possible Areas of Convergence No. 5 (Invalidation and Opposition Procedures)

The document SCT/35/4 indicates in relation to the above possible areas of convergence that "The grounds for refusal described in possible areas of convergence No. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.", and the Trademark Act has related stipulations as mentioned below.

Specifically, as regards trademark opposition, Article 43 bis of the Trademark Act stipulates as follows (excerpt);

Trademark Act

Article 43 bis:

Any person may file with the Commissioner of the Patent Office an opposition to registration within two months from the date of publication of the bulletin containing the trademark, on the grounds that the trademark registration falls under any of the following items; in this case, an opposition to registration may be filed for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or designated services:

(i) where the trademark registration has been made in violation of Article 3, 4(1), 7-2(1), 8(1), 8(2), 8(5), 51(2) (including 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 Article 77(3) of this Act; and...

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In addition, as regards trademark invalidation trial, Article 46 and 47 of the Trademark Act stipulates as follows (excerpt);

Trademark Act

Article 46:

Where a trademark registration falls under any of the following items, a request for a trial for invalidation of the trademark registration may be filed; In this case, where the trademark has been registered in connection with two or more designated goods or designated services, a request may be filed for each of the designated goods or designated services:

(i) where the trademark registration has been made in violation of Article 3, 4(1),



7-2(1), 8(1), 8(2), 8(5), 51(2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 77(3) of this Act;...

Article 47:

(1) Where a trademark registration has been made in violation of Article 3, 4(1)(viii), 4(1)(xi) to 4(1)(xiv), 8(1), 8(2) or 8(5), where a trademark registration has been made in violation of Article 4(1)(x) or 4(1)(xvii) (excluding the case where a trademark has been registered for the purpose of unfair competition), where a trademark has been registered in violation of Article 4(1)(xv) (excluding the case where a trademark has been registered for unfair purposes), or where a trademark registration falls under Article 46(1)(iii), a request for a trial relating to the trademark registration under Article 46(1) may not be filed after a lapse of five years from the date of registration of the establishment of the trademark right.

....

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Trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services in principle, under “Article 3-1-3 of the Trademark Act” which is also the grounds of trademark opposition and invalidation trial.

Trademarks which are likely to mislead as to the quality of the goods or services should be refused, and the basic regulation is “Article 4 (1)(xvi) of the Trademark Act”, and trademarks including a state name, a geographical name (including country name), etc. which is recognized to indicate the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services and used for goods produced and sold or services provided in a country or a place other than those where it is inherently produced and sold or provided falls under the aforesaid stipulation which is also the grounds of trademark opposition and invalidation trial.

Possible Areas of Convergence No. 6 (Use as a Mark)

The document SCT/35/4 indicates in relation to the above possible areas of convergence that “Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.”. While the Trademark Act in Japan has no relevant regulation on enforcement for such cases, the followings would be applicable.



[Other laws and guidelines in Japan]

- (1) "Unfair Competition Prevention Act"
- (2) "Act against Unjustifiable Premiums and Misleading Representations" and "Guidelines for the Interpretation of the Notification concerning Unfair Representation of the Country of Origin"
- (3) "Customs Act"
- (4) "Export and Import Transaction Act" also has related stipulations as shown below.

(1) Article 2-(1)-14 and 3 of "Unfair Competition Prevention Act" stipulates as follows (excerpt);

Unfair Competition Prevention Act

Article 2:

(1) The term "Unfair Competition" as used in this Act means any of the following:

...

(xiv) the act of using an indication on goods or services, in an advertisement thereof, or in trade documents or electronic correspondence thereof, in a way that is likely to cause a misconception as to the place of origin, quality, contents, manufacturing process, purpose, or quantity of said goods, or the quality, contents, purpose, or quantity of said services, or the act of assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through a telecommunications line goods so indicated, or the act of providing services so indicated;

Article 3:

(1) A person whose business interests have been infringed or are likely to be infringed due to Unfair Competition may make a demand to suspend or prevent that infringement, against the person that infringed or is likely to infringe said business interests.

(2) When making the demand under the preceding paragraph, the person whose business interests have been infringed or are likely to be infringed due to Unfair Competition may demand the destruction of Things that constituted the act of infringement (including Things created through the act of infringement; the same applies in Article 5, paragraph (1)), removal of equipment used for the act of infringement, or other act required for suspending or preventing the infringement.

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(2) Article 4(1)(iii), 5(1)(iii) and 7 of "Act against Unjustifiable Premiums and Misleading Representations" stipulate as follows (excerpt);



Act against Unjustifiable Premiums and Misleading Representations

Article 4(1)(iii)

In addition to what is listed in the preceding two items, any representation by which any particular relating to transactions of goods or services is likely to be misunderstood by general consumers and which is designated by the Prime Minister as such, and considered likely to induce customers unjustly and to interfere with general consumers' voluntary and rational choice-making.

Article 5(1)(iii)

In addition to what is listed in the preceding two items, any representation by which any particular relating to transactions of goods or services is likely to be misunderstood by general consumers and which is designated by the Prime Minister as such, and considered likely to induce customers unjustly and to interfere with general consumers' voluntary and rational choice-making.

Article 7

When the Prime Minister finds it necessary in order to prevent unjust inducement of customers and secure general consumers' voluntary and rational choice-making, the Prime Minister may limit the maximum value of a Premium or the total amount of Premiums, the kind of Premiums or means of offering of a Premium, or any other matter relating thereto, or may prohibit the offering of a Premium.

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(Note: This English version is translated from the previous act before 2014.)

"Guidelines for the Interpretation of the Notification concerning Unfair Representation of the Country of Origin" stipulates as follows (excerpt);

(The guidelines have been established in relation to Article 5(1)(iii) of Act against Unjustifiable Premiums and Misleading Representations.)

Guidelines for the Interpretation of the Notification concerning Unfair Representation of the Country of Origin

(October 16, 1973 Secretary General Notice No.12)

On the basis of the decision made by the Fair Trade Commission, we have laid down the Guidelines for the Interpretation for enforcing the Codes on "unfair representations concerning the country of origin of a product" (FTC Notification No.34, 1973) as follows.

1. Representations in the Notice Clause 1 Clause 1 and Clause 2 Clause 1 include the representations of an abbreviation or alias of the name of a country or the name of a place, the name of an area, a map of a country, etc.(for example, "U.S.A.", "England",



"Yo-roppa (Europe)"

2. While including the name of a country or the name of a place of a foreign country, an representations obviously representing the name of a Japanese entrepreneur shall not come under the representations in Notice Clause 1 Clause 1. (for example, "00 ya (shop)" etc. "00 represents the name of a country or the name of a place of a foreign country")

3. While including the name of a country, name of a place of a foreign country or the name of a entrepreneur, etc., an representations which is a common name of a product and which does not show that the country of origin is a foreign country shall not come under the representations in Circular Notice Clause 1 Clause 1 or Clause 2. (for example, representations in Japanese such as "Furansu-pan(Frenchbread)", "Rosia-keki (Russian cake)", "Boston-bakku(Boston-bag)", "Honkon-shatsu (Hongkong shirt)", etc.

4. "The entrepreneur of XX country" in Circular Notice Clause 1 Paragraph 2 and Clause 2 Paragraph 2 means a entrepreneur who has its main office in that country. (for example, a entrepreneur having its main office in Japan shall not be included in "the foreign entrepreneur in Circular Notice Clause 1 Paragraph 2 even if it is the so-called foreign affiliated firm.

5. The representations in Circular Notice Clause 1 Paragraph 1 and 2 as well as Clause 2 Paragraph 1 and 2 may be placed in Japanese or foreign letters.

...

7. Even representations prescribed in the passages of the Circular Notice Clause 1 shall not come under the misleading representations in the Notification Clause 1 where it is explicitly indicated that the product concerned is a domestic product by the following methods except the case of the Enforcement Standard Clause 8.

(1) "Domestically produced", "Made in Japan" etc. shall be indicated clearly. (2) "Manufactured by XX Co.", "Manufacturer XX Co." etc. shall be indicated explicitly.

(3). In cases where the name of a entrepreneur is indicated in foreign letters (including the case of Roman spelling), the name of a factory with the name of place in Japan (prefixing the name of location in the case of a factory without the name of a place) shall be indicated explicitly in combination.

(4) "Made in Japan" shall be indicated in a conspicuous manner.

8. Even with the representations in the passages of the Circular Notice Clause 1 already put, when the country of origin of the product is obscure even after the representations in the preceding Clause has been put, it is likely to come under the misleading representations in the circular Notice Clause 1 unless the relation between the name of a country of a foreign country, etc. and the product is indicated explicitly in Japanese along with these representations. (For example, where "Fabric, made in England", "Material, imported from France" or simply "Italy/Japan" are indicated,



"Made in Japan, "Fabric is manufactured in England", "Materials are imported from France and manufactured at XX Co., XX factory", "Sewed at XX Co. by an Italian design" etc. may be indicated.)

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<http://www.cftc.jp/english/03-02.html>

(3) Article 71(1) of "Customs Act" stipulates as follows (excerpt);

Customs Act

Article 71(1)

No import permission shall be granted, if foreign goods, either directly or indirectly, bear and false or deceptive indication or origin.

[URL (Reference translation made by Japan Tariff Association)]

http://www.kanzei.or.jp/kanzei_law/S29HO061.en.html

(4) Article 2(ii), 3 and 4 of "Export and Import Transaction Act" stipulate as follows (excerpt);

Export and Import Transaction Act

Article 2

The term "Unfair Export Transaction" as used in this Act refers to the following:

...(ii) export transactions of goods carrying a false indication of origin;...

Article 3

Exporters must not engage in Unfair Export Transactions.

Article 4

(1) The Minister of Economy, Trade and Industry may issue an admonition to exporters who have violated the provisions of the preceding Article.

(2) If an exporter violates the provisions of the preceding Article and such violation is found to seriously damage the international reputation of Japanese exporters, the Minister of Economy, Trade and Industry may order the exporter to suspend the export of goods for a period of not more than one year, while designating the item of goods or the destination, in lieu of issuing an admonition under the provisions of the preceding paragraph, unless the exporter proves that the violation was not committed intentionally or with negligence.

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The JPAA appreciates the opportunity to submit the comments on Possible Areas of Convergence. We would be pleased to answer any questions about these comments.

Sincerely,

A handwritten signature in black ink, appearing to read "Masaru Itami". The signature is fluid and cursive, with a long horizontal stroke at the end.

Masaru ITAMI

President

Japan Patent Attorneys Association