

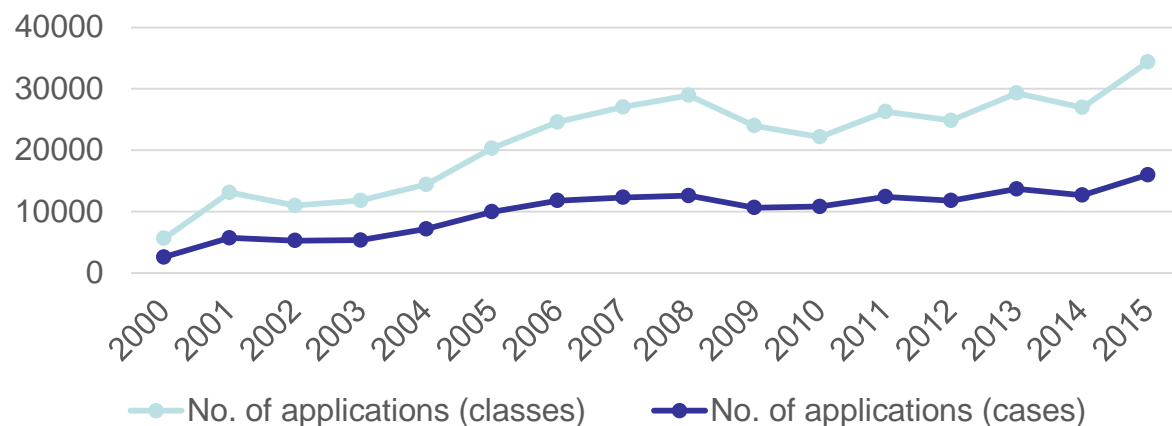
Improving the Efficiency of the Office in the Designated Contracting Party

December 14, 2016
Japan Patent Office

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1. Statistical data on the office in the designated contracting party - 1

The number of international applications to Japan under the Madrid Protocol system

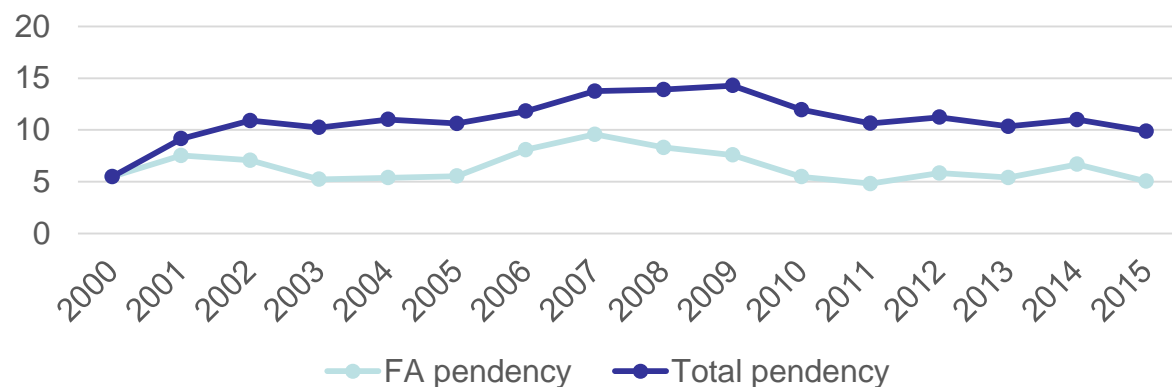


The number of international applications by country of origin of applicant (Top 10 countries/regions) (2015)

(No. of applications)

1	United States of America	3,876
2	EUIPO (Europe)	2,607
3	Germany	1,319
4	France	1,210
5	Switzerland	1,168
6	Italy	854
7	China	782
8	United Kingdom	702
9	Australia	605
10	Korea	533

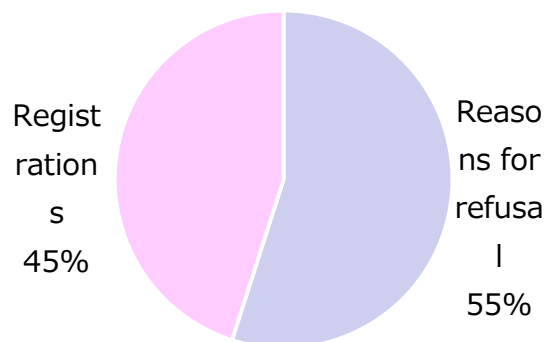
(Months) FA pendency/Total pendency



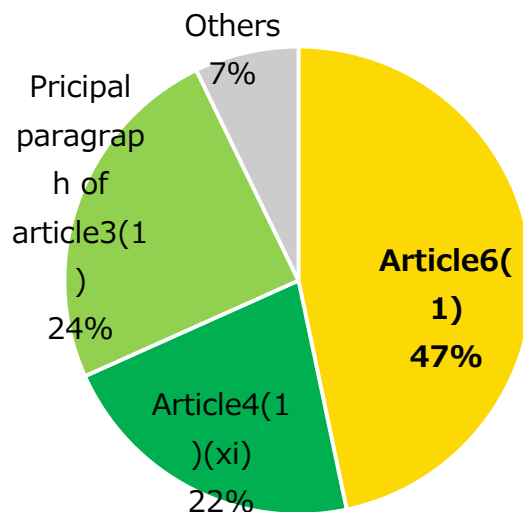
1. Statistical data on the office in the designated contracting party -2

- Main reasons for refusal, which examiners at the JPO frequently cited in notices issued for international applications being filed under the Madrid Protocol route:
 - (1) Unclear indication of designated goods and/or services (Article 6 (1));
 - (2) Similar to earlier registered trademarks of others (Article 4 (1) (xi));
 - (3) Concerns about applicants' own intentions to use their trademarks (the principal paragraph of Article 3 (1)).

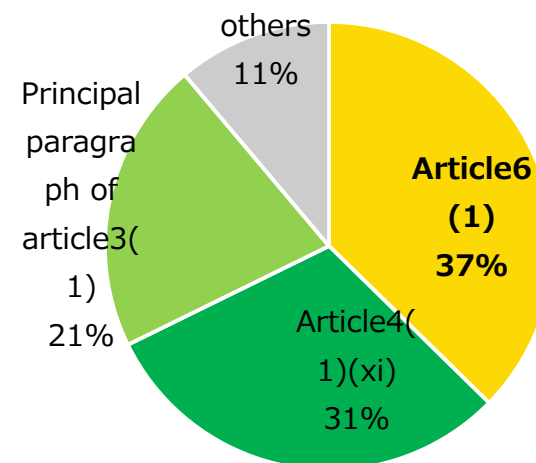
Examiner's decision
(first action)



Reasons for refusal
(first action)



Reasons for refusal
(final decision)



■ Major perspectives in examinations on international trademark applications

(in principle, the same Examination Guidelines for national applications)

- Whether designated goods and/or services are clearly indicated;
- Absolute reasons for refusal (distinctiveness);
- Relative reasons for refusal (similarities, etc.);
- Applicants' intention to use their trademarks.

■ Obligation to hire local agents in Japan to submit written opinions, etc.

■ Limited time periods for submitting written opinions and written amendments

[Note] The JPO does not have a partial refusal system. In case applicants do not respond to any notices of provisional refusal for international registrations, i.e. they do not submit any written opinions or amendments, the JPO will make final decisions to refuse registration of their applications in their entirety.

Differences between direct filings and applications under the Madrid Protocol Route

- (1) **Indications of designated goods and/or services, the names and addresses of applicants or rights holders are to be *determined in English in the International Register.***
- (2) **Applicants are allowed to *amend* their designated goods and/or services *by requesting a limitation (MM6)* of their goods and/or services.**
- (3) **Notices of provisional refusal for international registrations include indications of *goods and/or services that are not affected by the provisional refusal.***
⇒ In accordance with Rule 17 (2) (vi) of the Common Regulations under the Madrid Protocol (Provisional Refusal)
- (4) **Since international applications under the Madrid Protocol route are not subject to any violation of formality requirements, in some cases, *the JPO issues notices of provisional refusal* for international registrations to the applicants.**

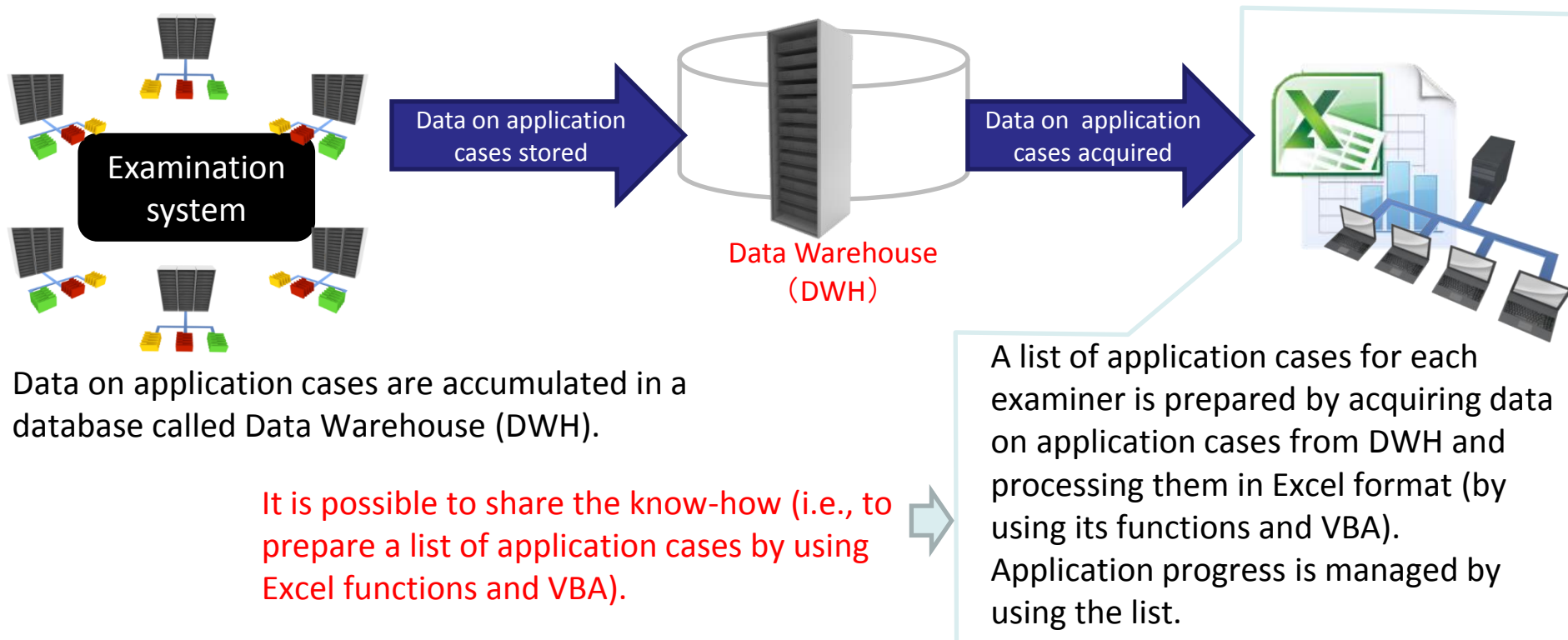
3. JPO's initiatives for speeding up the examination process-1

A) Setting the Targets/Managing the Progress (i)

Setting the Targets

- The processing plan and target of processing for each fiscal year are set for all trademark examinations.
- For each examiner, target figures (quota) in accord with the examination experience are set and evaluation in accord with the achievement percentage is conducted.

Management of Application Progress in Trademark Examination



3. JPO's initiatives for speeding up the examination process-1

A) Setting the Targets/Managing the Progress (ii)

(Ex.) A tool for managing application cases before FA



[Top page] Opening the tool, an examiner finds the situations of the examiner himself, his examination office and all examination offices displayed numerically.



[All processing-delayed cases] Processing-delayed application cases of all examination offices are all displayed on the list (Trademark, Applicant, Number of days elapsed, Memo, etc.)



[Application cases in stock held by individual examiners] The list indicates all application cases in stock held by individual examiners (Trademark, Applicant, Filing date, Number of days elapsed, etc.)



[Processing-delayed application cases held by individual examiners] The list indicates processing-delayed application cases held by individual examiners (Trademark, Applicant, Number of days elapsed, Memo, etc.)

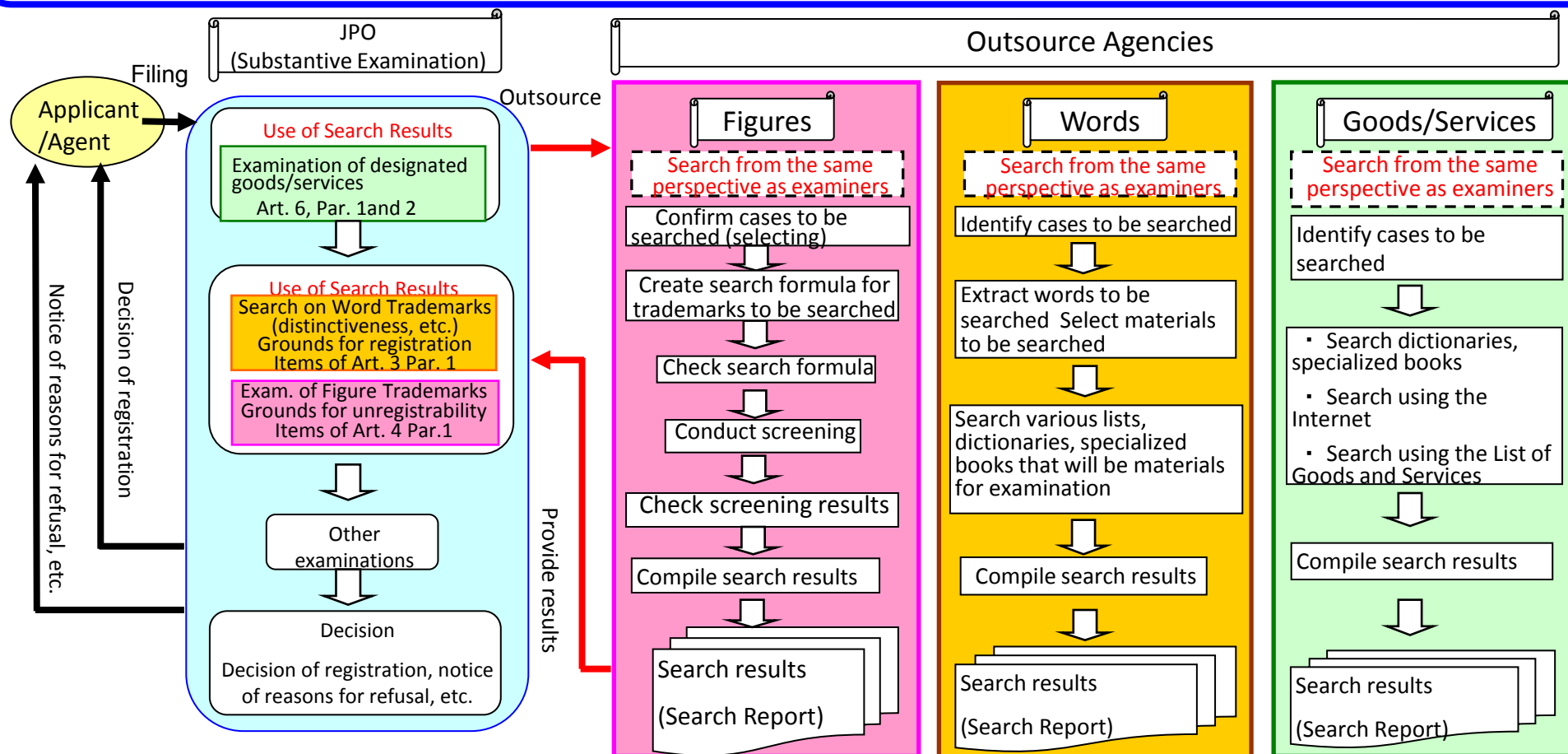
※ Managerial examiners are allowed to read the screen of all examiners in order to use relevant data in terms of managing respective examination progresses.

3. JPO's initiatives for speeding up the examination process-2

B) Outsourcing (i)

Various searches conducted before examining trademark registration applications

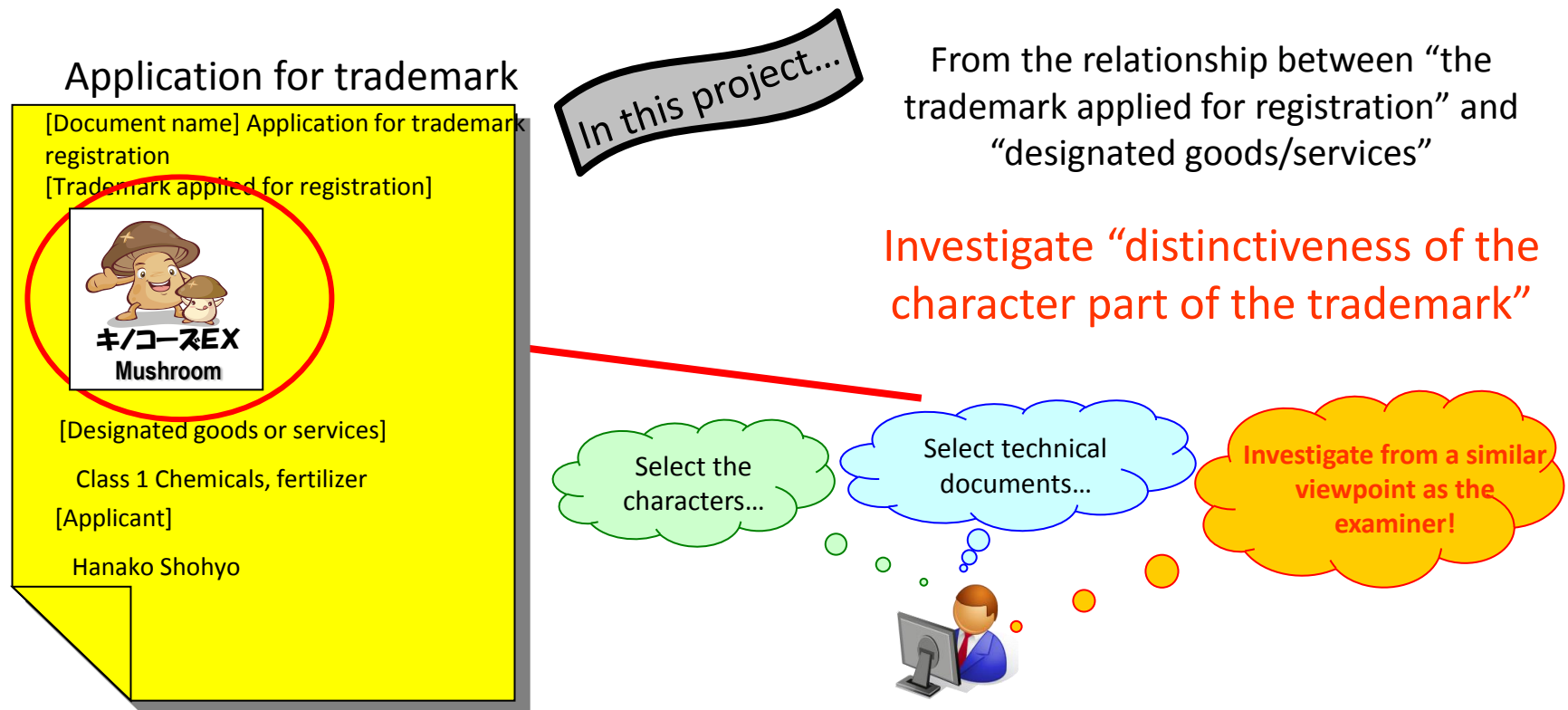
- Preliminary searches are outsourced to search agencies in examining trademark registration applications
 - (i) Search on prior figure trademarks that are similar to the filed figure trademarks
 - (ii) Search on the meaning of words which constitute word trademarks
 - (iii) Search to identify what the goods/services are when designated goods/services stated on requests are not clear



B) Outsourcing (ii)

Investigation on distinctiveness of character part of trademarks

- Select the characters to be examined from the character part composing the trademark applied for registration, and examine the meaning of the characters of interest by using materials, ordinary dictionaries and various technical documents lent by the JPO, and scrutinize the evidence of the reasons for refusal specified in the Trademark Act, such as whether the character can function as a trademark (has distinctiveness) or not.



3. JPO's initiatives for speeding up the examination process-2

B) Outsourcing (iii)

Investigation regarding unclear designated goods/services

- Identify unclear goods/services from the data provided by the JPO, and investigate them using technical documents and data lent by the JPO in terms of the characteristics of the goods/services and the concept of the goods/services.

Application for trademark registration

[Document name] Application for trademark registration
[Trademark applied for registration]



[Designated goods or services]

Category 7 Mechanical instrument for cutting rolled plastic packaging film, foam, or cushioning into sheets of a desired size

[Applicant] Hanako Shohyo

In this project...

Since the scope of the right is established based on the goods/services, it is necessary to identify the characteristics and the concept of the goods/services having unclear expression.

Investigate the unclear designated goods/services

Identify the case to be examined

Use the materials, lists, and internet

Investigate from a similar viewpoint as the examiner!



3. JPO's initiatives for speeding up the examination process-3

C) Use of searchers

Use of searchers

- Staff (searchers) that assist examinations conducted by trademark examiners are used in order to promptly and appropriately process examinations.
- Persons who have knowledge of the trademark system and trademark examinations are recruited from the public as searchers.

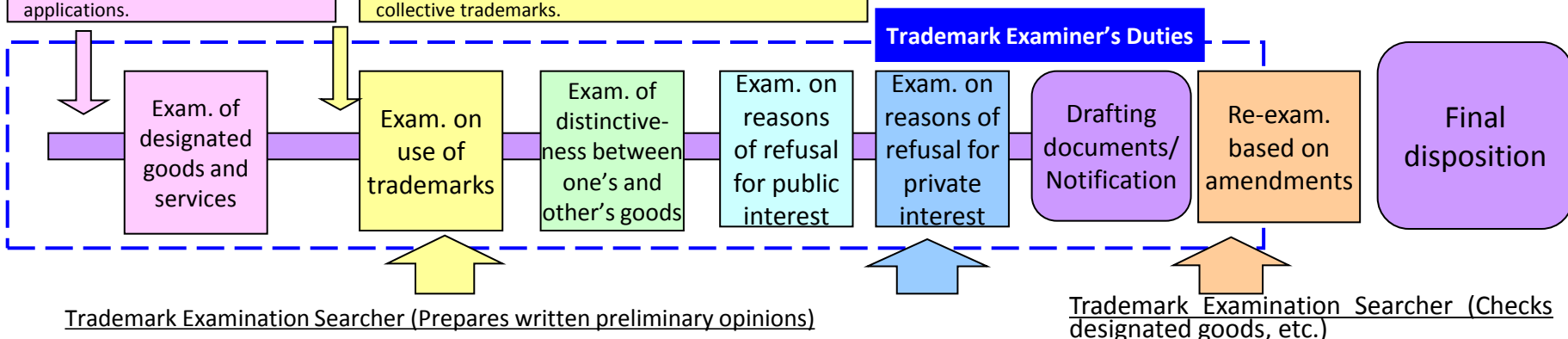
Searchers' tasks

- Searchers collect/analyze information on the Internet, newspaper articles, etc., and search the presence of prior trademarks regarding goods/services and trademarks used by applicants that are unclear.

Data Sorting Searcher

- Collecting /sorting materials on newspapers, magazines, the Internet, etc. regarding unclear goods and services related to regular and int. trademark reg. applications.

- Collecting/sorting materials on the Internet, etc. related to the use of applicants' trademarks.
- Collecting/sorting materials on newspapers, magazines, the Internet, etc. regarding public awareness of applications for registering regional collective trademarks.



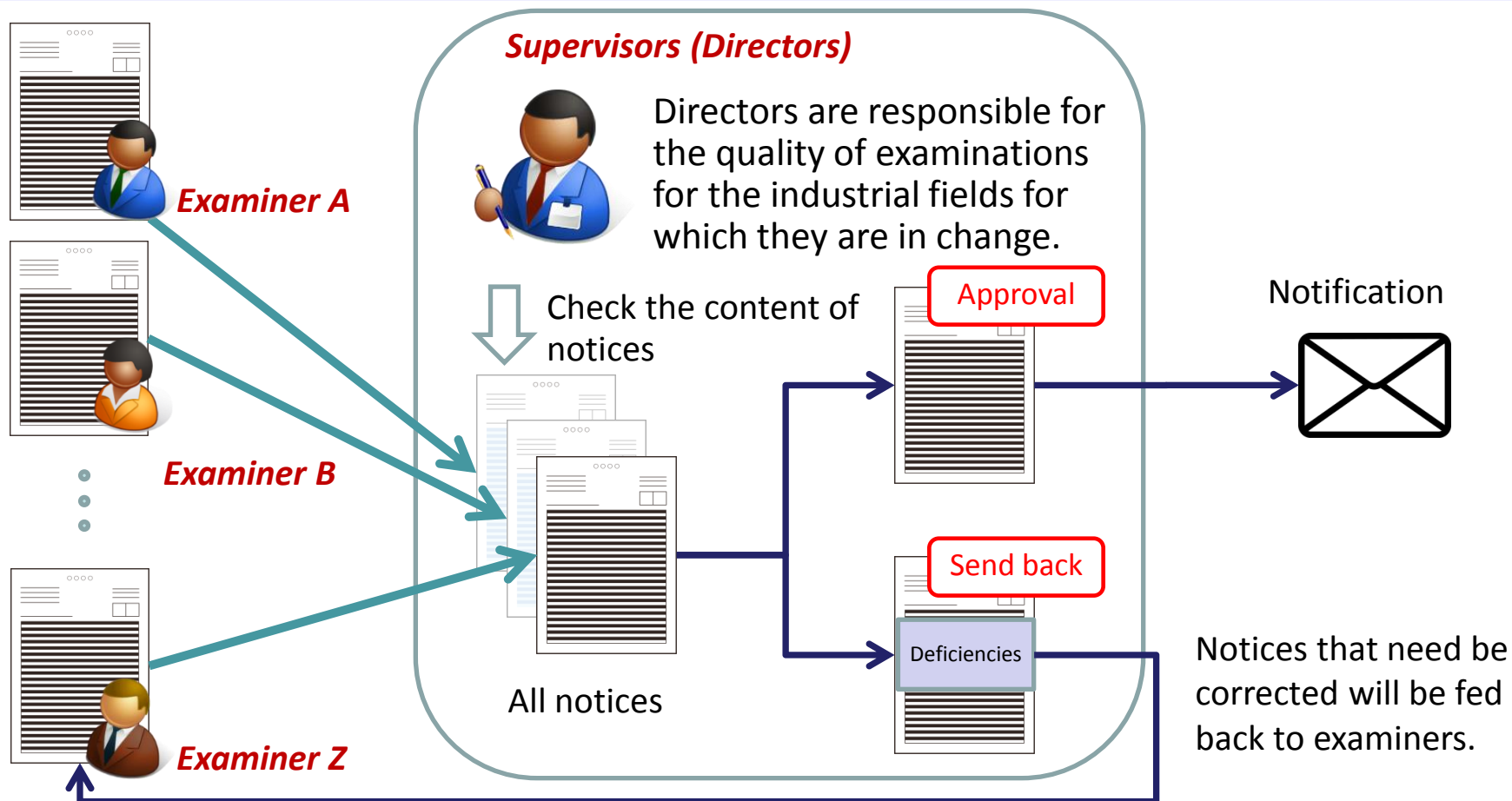
- Analyzes information regarding use of applicants' trademarks on the Internet etc. collected and sorted by Data Sorting Searchers.
- Conducts preliminary search on the presence of reasons of refusal

- Conducts search on presence of identical or similar prior trademarks
- Conducts search on rights regarding prior trademarks
- Prepares prior trademark search reports

- Checks content of submitted amendments
- Checks the presence of goods for which reasons of refusal are applicable regarding indication of designated goods/services after applications have been amended
- Prepares preliminary check reports

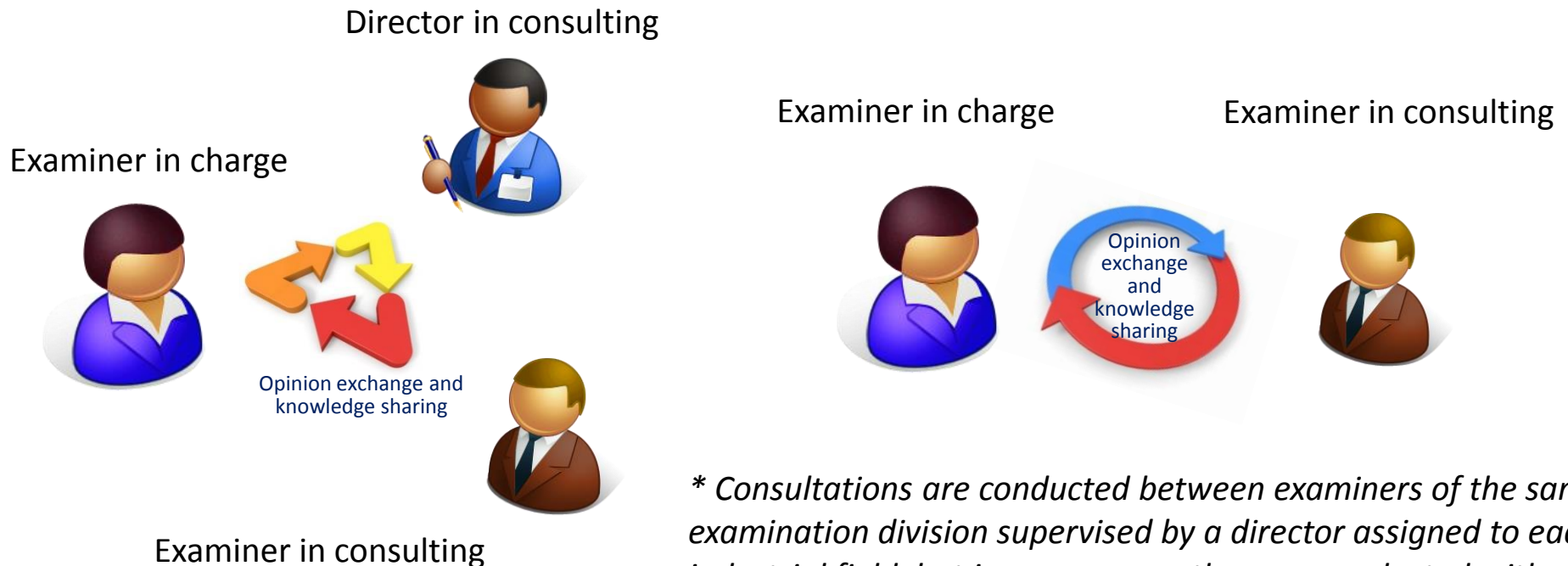
4. JPO's initiatives for managing the quality of examinations- Quality checks and approvals by directors

- Substantive and formality checks on examinations by Directors by checking all notices prepared by examiners



4. JPO's initiatives for managing the quality of examinations-9 Consultations between examiners

- Examiners exchange opinions and share information with each other to share their expertise, such as examination practices and methods as well as knowledge, by bringing together the knowledge and experiences of all examiners.
- They do this in order to reduce disparities in terms of examination decisions and conduct prompt and appropriate examinations.



** Consultations are conducted between examiners of the same examination division supervised by a director assigned to each industrial field, but in some cases, they are conducted with a director or/and an examiner of another examination division.*

■ **The Check Sheet for Examiners**

- consolidating typical problem cases revealed through various measures of the Quality Management
- points that examiners should check in the process of examination

■ **Conducting examination according to the Check Sheet for Examiners**

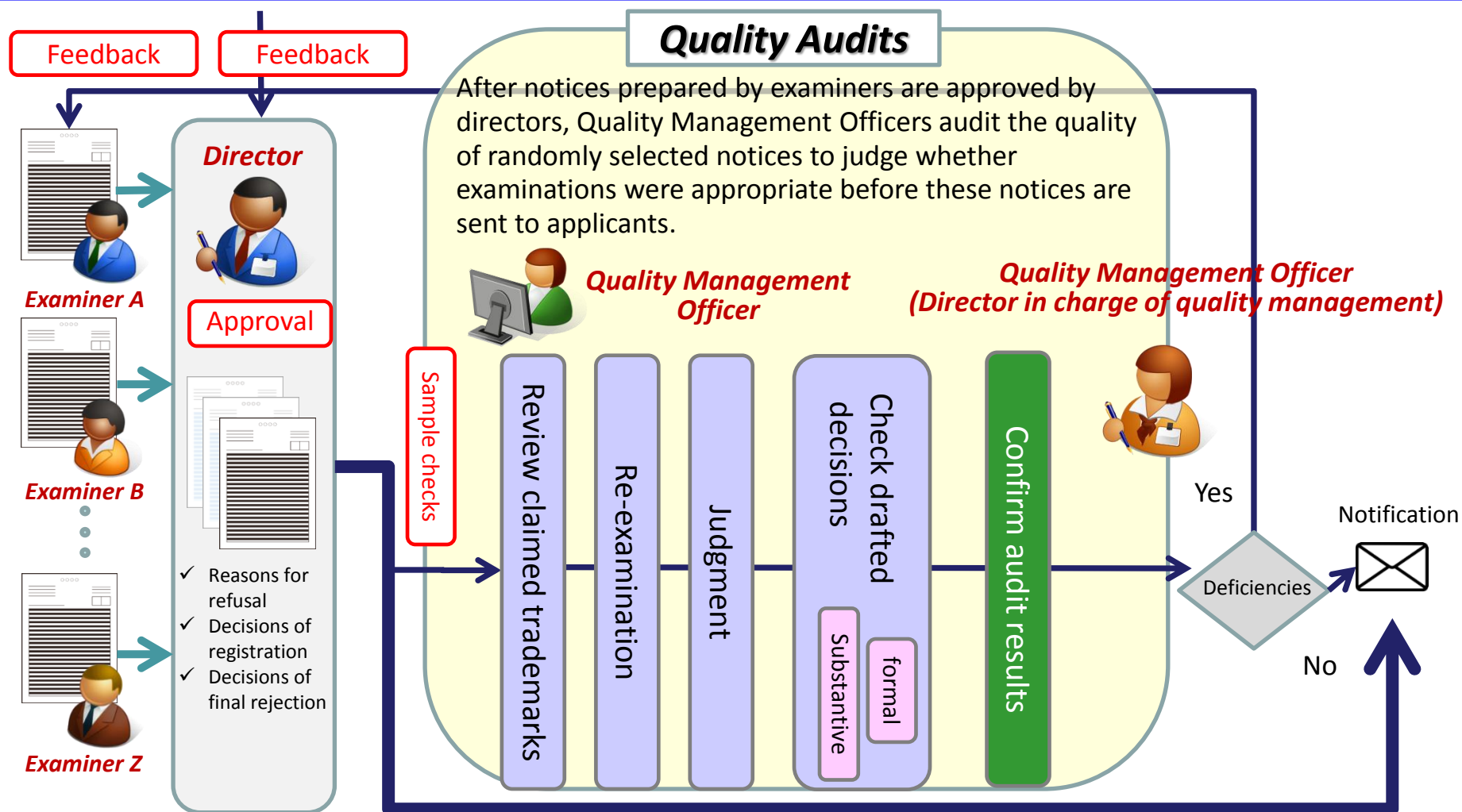
■ **Submission this sheet with drafted documents to the approver**

- examiners can avoid typical careless mistakes that could be made in the examination
- approver can easily check the examination done through the proper process

- The items of the Check Sheet for Examiners are **upgraded** for more appropriate ones, based on the results of various measures for the Quality Management.

Quality Audits

- Review the quality of examinations based on sample checks (to verify the quality of the entire examination process)



User satisfaction survey

Results of the User Satisfaction Survey (2014-2015)

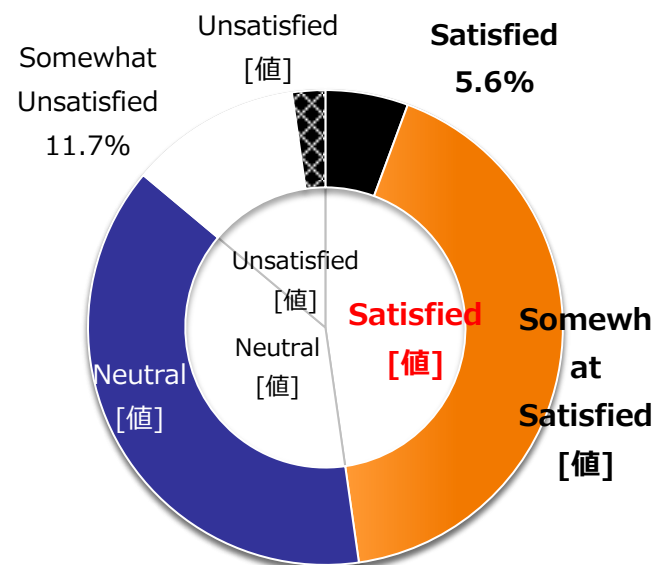
- The percentage of "Average" or higher was 86%.
The combined percentage for "Satisfied" and "Somewhat Satisfied" reached 47.7%.

Comparison with the Previous Year

- ✓ The number of target users for the survey was doubled. (200 → 400)
- ✓ The method of total evaluation was changed from Four-Grade Evaluation to Five-Grade Evaluation.

Total Evaluation

Five-Grade Evaluation	No. of Responses	Percentage (FY2015)	Percentage (FY2014)
Satisfied	15	5.6%	19.1%
Somewhat Satisfied	112	42.1%	58.9%
Neutral	102	38.3%	-
Somewhat unsatisfied	31	11.7%	19.1%
Unsatisfied	6	2.3%	2.8%
Total	266	100%	100%



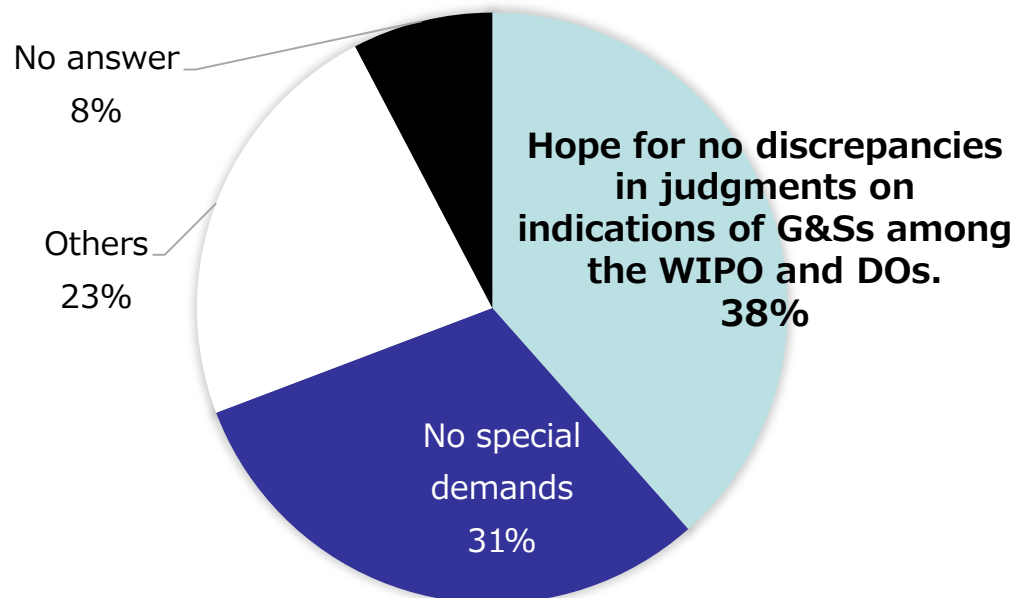
Note: Above table and chart show the aggregated results using Five-Grade Evaluation for the overall impression of the degree of appropriateness of examiners' decisions, the content of notices, communication with the examiners, etc. for trademark examination in general.

5. JPO's initiatives for international harmonization of trademark examinations on goods and services -1

Issues to be solved for examination practices on goods and services

	Article 6 (1) (Examination of designated G&Ss)	Article 4 (1)(xi)	Principal Paragraph of Article 3(1)	Others
Reasons for refusal (FA)	47%	22%	24%	7%
Reasons for refusal(final decision)	37%	31%	21%	11%

User opinions about examinations on goods and services being conducted by offices of designated contracting parties (DOs)



Source: "Results of JPO's Study from the Perspective of Promoting Wider Use of the International Registration System" under the JPO's activities of comparative studies on industrial property rights systems around the world in fiscal year 2015

International Initiatives of Japan for harmonization of G&Ss

- The differences of acceptable indications and classifications of G&Ss among countries impose the burden both on applicants and IP Offices.
- Japan has promoted international initiatives in the frameworks of WIPO, TM5 and bilateral cooperation.
- For the purpose of reducing the procedural burden for Japanese applicants and the examination burden for overseas IP Offices.

International Initiatives of Japan for harmonization of G&Ss

■ **Nice International Classification**

- Participation in the Expert Committee.
- Propose new G&Ss based on requests from Japanese industry.

■ **Madrid G&S Manager (MGS)**

- Providing Japanese translation, acceptability and Similar Group Codes of G&Ss in Japan.

■ **ID List Project (TM5: Japan, USA, EUIPO, Korea, China)**

- This project started in 2002.
- Each offices cooperate for making a list of G&Ss which are acceptable each other.

■ **Bilateral Cooperation**

- Exchange corresponding table of G&Ss with Similar Group Codes between JPO and KIPO.

Similarity of G&Ss in JPO

Examination Guidelines for Similar G&Ss

Goods/Services
Producers/Providers, Market Places,
Function, Purposes, Main Materials, Consumers,
Finished products/parts,
Business categories, etc.

- Organizing and Grouping related G&Ss
- Provide 5-digit Codes to each Groups (Similar Group Code)

The G&Ss with the same Similar Group Code are assumed to be Similar in Examinations in JPO

Advantages of Similar Group Codes

The G&Ss with the same Similar Group Code are assumed to be Similar in Examinations

(For Applicants/Representatives)

- Efficient Prior trademark searches with the Similar Group Code before filing an application
- Improve predictability of the results of Examination
- Easy amendments to G&Ss to avoid conflict with prior trademarks

(For JPO)

- Ensure uniformity in examination of G&Ss
- Fast & Efficient searches of conflicting prior trademarks
- Not effected by any revision of the Nice Classification

Example of Similar Group Codes in the same Class

Class 18

Suitcases

21C01

Wallets

21C01

Folding umbrellas

22B01

Rucksacks

21C01

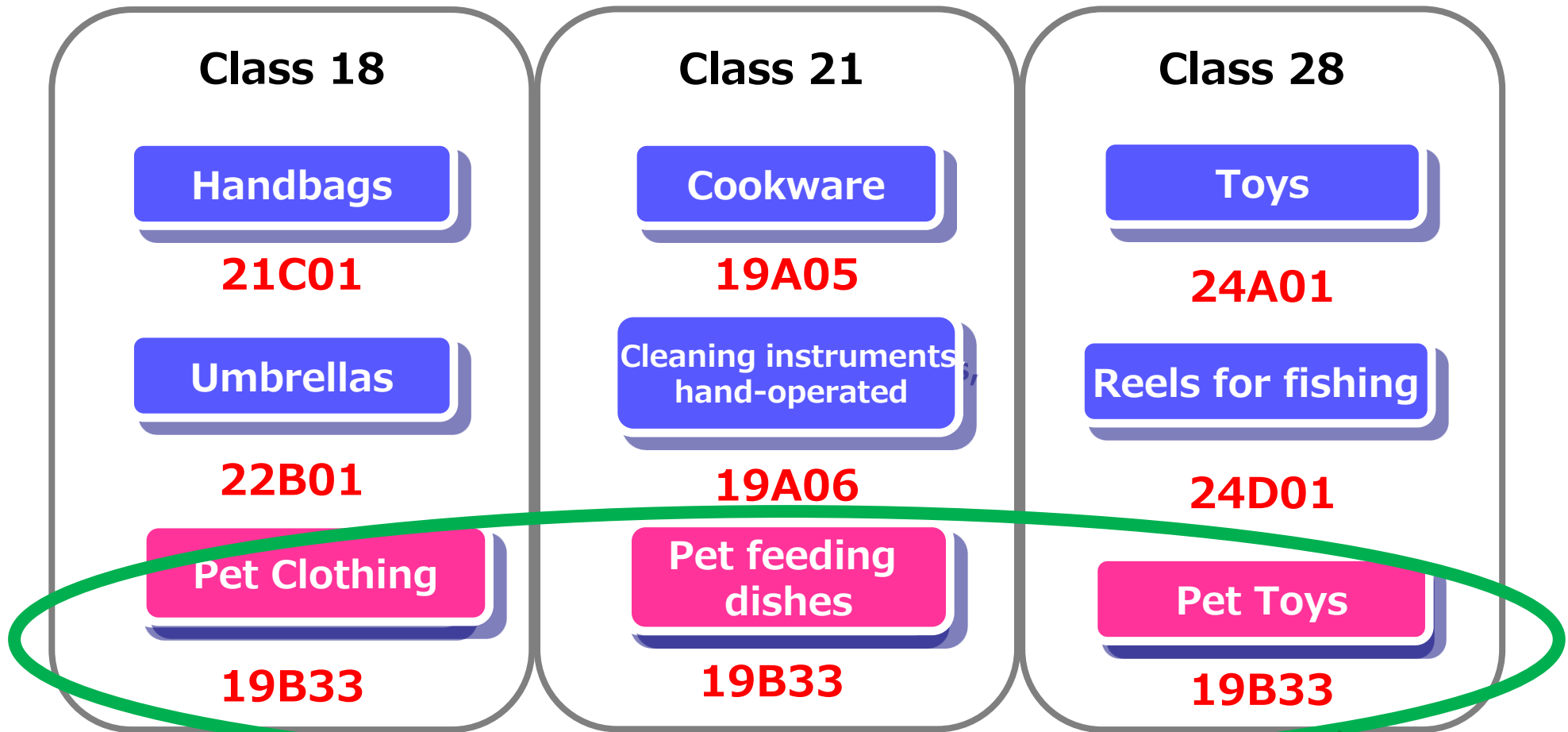
Walking sticks

22C01

Parasols

22B01

Example of Similar Group Codes among several Classes



Assumed to be Similar goods

Cooperative Activities for ASEAN and SAARC Countries

- **The JPO's Recent Activities for the ASEAN and SAARC countries in examinations on goods and services**
- Conducting training programs by inviting trainees (in 2015 and 2016):
Brunei, Cambodia, Philippines, India, Indonesia, Malaysia, Myanmar, Singapore, Thailand, Viet Nam, and Laos
- Sending experts (from 2014 to 2016)
Sending experts: Cambodia and Laos
Holding workshops (under the support of the Japan Funds-in-Trust at the WIPO):
Cambodia (Topic: Madrid Protocol system and trademark application)
Brunei (Topic: Classification of goods and services as well as trademark examination practices)

- **The JPO is providing information on and sharing the JPO's examination practices and methods using its similar-group codes, and supporting each country to make examination guidelines for similar goods and services.**

THANK YOU!
ありがとうございました