

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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March 12, 2021

Mr. Vuttikrai Leewiraphan  
Director General  
Department of Intellectual Property  
Ministry of Commerce  
563 Nonthaburi Road, Bangkrasor Muang  
Nonthaburi 11000

Dear Mr. Leewiraphan,

**Re: JIPA Comments on Draft Trademark Registration Consideration Manual**

We, the Japan Intellectual Property Association “JIPA”, are a private user organization with about 970 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems.

Having learned the Draft Trademark Registration Consideration Manual on your website, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,

Koji SAITO  
Managing Director  
Japan Intellectual Property Association

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Public Opinion Survey Form on  
A Draft Manual for Trademark Filing and Procedure B.E. ....

Chapter 1 General

1. Flowchart on Procedure
2. Definition of Trademark
3. Registrable Trademark

Opinion .....

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Chapter 2 Examination and consideration of trademark application

Part 1 Examination of request form and items on the list

1. Consideration of application for registration (Request Form)

Opinion .....

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2. Consideration of the list of products and services

Opinion .....

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Please send the file, Public Opinion Survey Form, via e-mail to [trademark.guideline@gmail.com](mailto:trademark.guideline@gmail.com)

by March 10, 2021

**3. Consideration of pronunciation and translation**

Opinion .....

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**4. Consideration of mark**

Opinion .....

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**5. Consideration of Rights under Section 28 and Section 28 Bis**

Opinion .....

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**6. Consideration of amendments to the list in the application**

Opinion .....

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**Part 2 Consideration of characteristics that can be registered**

**1. Consideration of a trademark with distinctiveness**

**Opinion:**

To clarify the rule regarding the distinctiveness of trademarks is welcomed and such rule will help to make a consistent judgement regarding distinctiveness of trademarks. We would like to have

specific reasons why the applied trademark is not distinctive in the examination stage. Furthermore, if the notice of refusal stating the lack of distinctiveness or the similarity of prior marks is issued, we would like to have the opportunity to submit to the Examiner a counter-argument against such refusal firstly before filing it with the Appeal Board from international harmonization standpoint. It will enable us to overcome such refusal much sooner.

## 2. Consideration of a trademark containing prohibited characteristics

Opinion .....

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## 3. Consideration of similarity of trademark

Opinion .....

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## Chapter 3 Consideration of service mark

Opinion .....

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## Chapter 4 Consideration of certification mark

Opinion .....

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## Chapter 5 Consideration of collective mark

Opinion .....

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Chapter 6 Publication of trademark registration

Opinion .....  
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Chapter 7 Opposition of trademark registration

Opinion .....  
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Chapter 8 Important provisions relating to orders of the Registrar

Opinion .....  
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Annex

Opinion .....  
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Others

Regarding the non-use cancellation as defined in the Article 63 of the Trademark Act, the burden of proof on the non-use lies with the applicant. However, it is very difficult for the applicant to prove the non-use. So, we would like to amend this Article to be read that the burden of proof on the use of registered trademark lies with the registrant. If the registrant cannot prove the use of registered trademark, such trademark shall be cancelled.

Regarding the trademark license as defined in the Article 68 of the Trademark Act, the trademark license agreement shall become effective upon the registration with the Office. We would like to amend this Article to be read that the trademark license agreement shall not be used against a bona fide third party without the registration.