



How to register a trademark in Japan:

 **5 Steps for Trademark Applications** 





INDEX

▣ 3 Key Points!	P.02
------------------------	------

▣ Pre-filing Checklist	P.03
-------------------------------	------

▣ 5 Steps for Trademark Applications	P.04
---------------------------------------------	------

Step 1 Appointment of a Representative	P.05
-----------------------------------------------------	------

Step 2 Verification of the Logo and Naming (Trademarks)	P.06
----------------------------------------------------------------------	------

Step 3 Designation of Goods / Services	P.07
-----------------------------------------------------	------

Step 4 Searching for Similar Registered Trademarks.....	P.12
----------------------------------------------------------------	------

Step 5 Payment of Fees	P.15
-------------------------------------	------

▣ Flow after Filing an Application	P.17
-------------------------------------------	------

▣ References	P.18
---------------------	------



3 Key Points!

If you are thinking of filing a trademark application in Japan, we hope this explanation will help enhance your understanding of the Japanese trademark system!

Point 1

Registration Principle

Trademark rights are acquired after you have completed the registration of your trademark with the Japan Patent Office (JPO). Under this trademark right, you can secure the exclusive use of the trademark, file an injunction or claim for damages against infringers.

Point 2

First-to-file Principle

In Japan, trademarks may be registered only by the first applicant. If someone else has registered a trademark similar* to your own, you may not be able to register it in Japan, even if you were using it first.

* JPO normally uses the words "identical" and "similar" in different ways; but in this booklet we have included the meaning of "identical" within the word "similar" in order to avoid redundant expressions.

Point 3

Examination Principle

Every trademark application is examined by a JPO examiner. The filed trademark will be examined with regard to both the following aspects:

- 1 Absolute grounds for refusal arising from the trademark itself, such as whether it is distinguishable
- 2 Relative grounds for refusal, which relate to questions of applicability in relation to the rights of others

Pre-filing Checklist



Before filing a trademark application,
let's check the list below:

	YES	NO
Do you have a representative?	<input type="checkbox"/>	If you wish to file an application, you need to appoint a representative. Let's check Step 1: Appointment of a Representative.
Does the trademark have "distinctiveness"?	<input type="checkbox"/>	Trademarks that are not distinctive cannot be registered. Let's check Step 2: Verification of the Logo and Naming (Trademarks).
Is the indication of the goods / services to be designated concise and clear?	<input type="checkbox"/>	Some indications, that can be accepted in other countries, may not be accepted in Japan. Let's check Step 3: Designation of Goods / Services.
Do you currently conduct the business connected to the designated goods / services, or plan to do ?	<input type="checkbox"/>	When a broad range of goods / services are described, verification of actual or planned use of the trademark may be required. Let's check Step 3: Designation of Goods / Services.
Have you checked whether similar trademarks have been registered?	<input type="checkbox"/>	If you find a trademark similar to the one you want to register, your trademark may not be registered. Let's check Step 4: Searching for Similar Registered Trademarks.



5 Steps for Trademark Applications

Step
1



Appointment of a Representative

If you wish to file an application directly in Japan, you must appoint a representative who is domiciled in Japan. You can find a patent attorney in Japan by using the "Patent Attorney Navi" .

Click! ➔



Patent Attorney Navi (Japan Patent Attorneys Association)

▶ P.05

Step
2



Verification of the Logo and Naming (Trademarks)

Characters that merely represent the content or characteristics of goods / services cannot be registered as trademarks. If you are unsure, consult your representative.

▶ P.06

Step
3



Designation of Goods / Services

When you apply for a trademark, you must designate not only the trademark itself, but also the goods / services for which you will use it. Once a trademark is registered, you are the only one who can use it; and it must be used exclusively to do business within the scope of the designated goods / services. This designation is important, because it determines the scope of your trademark rights.

▶ P.07

Step
4



Searching for Similar Registered Trademarks

You will not be able to register a trademark if someone else has registered a similar trademark in the range of similar goods / services before you. Searching for such other people's registered trademarks before filing an application, therefore, will reduce the risks of not being able to register the trademark, or unknowingly infringing the rights of others.

▶ P.12

Step
5



Payment of Fees

Having decided on the details of your application, it is time to apply! Make sure to first pay the application fee.

Once an application is filed, it will be examined. If the examiner determines that the trademark can be registered, you will receive the "Decision for Registration".

If you pay the registration fee within 30 days after the decision is sent out, your trademark registration is complete!

▶ P.15

Step 1

Appointment of a Representative

Overseas residents may not submit documents directly to JPO by themselves!


CAUTION!

Q I want to apply to Japan! Can I apply directly from overseas in English?

A When applying directly to Japan, all procedures must be conducted in Japanese through a representative.

In addition, there is another method of filing an application in English: filing an international trademark application using the Madrid system. You can choose the method that best suits your situation and brand strategy.

For more information on the Madrid system, please refer to the WIPO website.

Click!  [Madrid System – The International Trademark System \(WIPO\)](#)

✿ Pros and Cons of filing methods ✿

	Pros	Cons
Direct Application	<ul style="list-style-type: none"> Basic application or registration is not required No risk of cancellation due to central attack* 	<ul style="list-style-type: none"> Impossible to file a batch application to multiple countries
International Trademark Application	<ul style="list-style-type: none"> Possible to file a batch application to multiple countries Application documents can be prepared in English Easy management after registration 	<ul style="list-style-type: none"> Basic application or registration is required There is a risk of cancellation due to central attack*

* Cancellation of international registration due to revocation of basic application or registration.
If the international registration is canceled, the protection in the designated country will also be canceled.

Check

1



Selecting the appropriate filing method and representative.

Step 2

Verification of the Logo and Naming (Trademarks)

Q Any tips when coming up with trademarks?

When including characteristics of goods / services in a trademark, the key is to make it full of originality (i.e., distinctiveness), while also conveying its characteristics clearly.

A

Learn more... What is "Distinctiveness"?

Distinctiveness is the power to have one's goods / services recognized as distinct from those of others with respect to a certain logo or naming (trademark). The existence of distinctiveness is judged in relation to the goods / services for which the trademark is used.



Ex. The following trademarks do not have "distinctiveness"



Tokyo High Court, 1999 (Gyo-ke) No.82

An indication of the quality of goods :

Designated goods : Alcoholic beverages

The term "ORGANIC" merely indicates the quality of the goods: "made from organic agricultural products".



Intellectual Property High Court, 2015 (Gyo-ke) No. 10019

An indication consisting only of a very simple and common mark :

Designated services : Providing financial information, etc.

It is very simple and consists only of a common mark.

Learn more... Can the mark be registered if it is combined with a distinguishing letter or logo?

Even non-distinctive characters can be registered as long as they are combined with distinctive characters or logos (figures, etc.). However, this does not mean that the non-distinctive character part can be monopolized.



Q Can I change my trademark after filing?

No. You need to apply for a new trademark.

A

Check

2

Making the trademark "distinctive".

Step3

Designation of Goods / Services

“Unclear description of goods / services” is the most common reason for refusal.



Be sure to designate goods / services by referring a list of goods / services on J-PlatPat.

Click! ➔  Goods / Service Name Search (J-PlatPat)

Ex. Examples of goods / services

Be sure to designate the goods / services that you currently conduct or plan to conduct, the business connected to in the future.

For “Apparel manufacturers” ...?

[**Class 25**]
Clothing



A

“Clothing” includes a wide range of items, such as “coats”, “sweaters”, “underwear”, “socks”, “hats”, etc.
By describing such a term that encompasses a variety of goods, a right can be granted to include goods of that sub-concept as well.

For “App production companies” ...?

[**Class 42**]
Computer software design



A

Be sure to also consider Class 9 “Application Software”, for example, if you sell apps that can be downloaded on the web.

For "Esthetic salons" ...?

[**Class 44**]
Beauty salon services

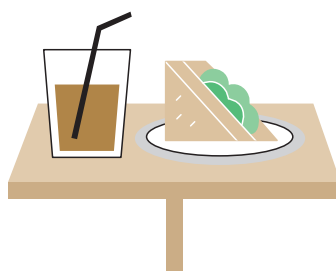


A

Be sure to also consider Class 3 "Cosmetics", for example, if you are manufacturing and selling original cosmetics.

For "Cafes" ...?

[**Class 43**]
Providing
food and drink



A

Be sure to also consider Class 30 "Sandwiches", for example, if you are considering take-out.

* "Class XX" refers to a category of goods / services.

The application fee and registration fee vary depending on the number of classes designated.

* Since the procedural language is Japanese, the English translations of the goods / services are for reference only.

Q

Are there any other things to keep in mind?

Be sure to avoid overly detailed descriptions of goods / services. Concise expressions are recommended to avoid rejection. In addition, if you list goods / services for which you do not plan to conduct related business, you may not be able to register them. Or, even if they have been registered, these may be canceled.

A

Check
3



It is recommended that the indications of goods / services be those listed on J-PlatPat.

Learn more...**Can the trademark be accepted in Japan by choosing the indication on the Nice Classification (NCL)?**

Some indications in the NCL are judged to be unclear in Japan.

For example, the class headings in the NCL cannot be accepted in Japan because the wording is ambiguous.

The following are some examples.

Class	Unacceptable indications of the class headings of NCL12-2023
7	Machines, machine tools, power-operated tools;
9	Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments;
12	Vehicles;
12	Apparatus for locomotion by land, air or water;
17	Packing, stopping and insulating materials;
31	Raw and unprocessed agricultural, aquacultural, horticultural and forestry products;
33	Alcoholic preparations for making beverages;
36	Financial, monetary and banking services;
37	Installation and repair services;
40	Treatment of materials;
41	Sporting and cultural activities;
42	Scientific and technological services and research and design relating thereto;
42	Quality control and authentication services;
45	Funerary services;

If you change these indications to others, they could be accepted.
For more information, please visit our website.

Click! ➔



Indications of goods / services appearing in the class headings of LIST OF CLASSES OF GOODS AND SERVICES WITH EXPLANATORY NOTES under the NICE Agreement (JPO)

A

Learn more...

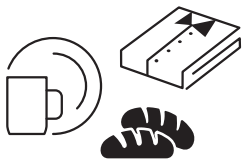
How should retail services be designated?

Q

Our main service is retailing goods.
What type of service indications are eligible for registration?

A

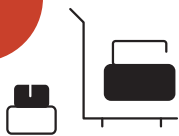
Since the JPO organizes retail services according to the goods which are dealt with, it is necessary to clarify this information. Please consult your representative for details.

Case
1

General Retailing

When the retail service includes a variety of goods such as clothing, foods, beverages, daily necessities, etc. in department stores or supermarkets, etc.

“Retail services or wholesale services for a variety of goods in each field of clothing, foods and beverages, and livingware, carrying all goods together”

Case
2

Specified Retailing

When the retail service is for specific products

“Retail services or wholesale services for [XX(specified goods)]”

* If you are mainly planning to provide goods online, be sure to consider indicating “Online retail services or wholesale services for [XX (specified goods)]” .

A

However, please note that even in [Case 1] and [Case 2], if the range of goods dealt with in the retail services is extensive, the examiner may check the actual or planned use of the trademark.

▶ P.11

Learn more...

Can't a trademark be registered if a wide range of goods / services are designated for it?

In principle, trademarks that can be registered are limited to goods / services for which an applicant actually conducts business, or plans to conduct business in the future.

Therefore, in the following cases, the examiner sends the applicant a “Notice of Reasons for Refusal” to confirm whether the applicant really plans to conduct business connected to the goods / services.

- 1 The applicant selects a wide range of goods / services within 1 class
- 2 The applicant selects multiple retail services in Class 35

The number of Similar Group Codes (SGC) is used to determine whether a wide range of goods / services have been selected.

Details of SGC ▶ P.14

1 When a wide range of goods / services are selected (23 or more Similar Group Codes (SGC) within 1 class)

If there are 23 or more SGC in 1 class, the examiner will consider that a wide range of goods / services have been selected and will issue a "Notice of Reasons for Refusal".

Example

	goods	SGC	accumulated number of codes counted
Class 29	Baked apple	30A01	1
	Sesame oil	31C01	2
	Milk products	31D01	3
	Milk	31D01	—
	Meat	32A01	4

Since they are in the same SGC, counted as "1".

"4" SGC within a class

No "Notice of Reasons for Refusal"

2 When multiple retail services are selected

SGC for retail services are indicated as "35 K XX." A single selection of the code for retail services can cover a wide range of goods / services as shown in Example 1 below. Therefore, if there are 2 or more types of "35 K XX" designated as shown in Example 2 below, the examiner will consider that a wide range of services is designated and will notify the reason for refusal.

Example 1

	services	SGC	accumulated number of codes counted
Class 35	Retail services for confectionery, bread and buns	35K03	1
	Retail services for tea and coffee	35K03	—

Since they are in the same SGC, counted as "1".

No "Notice of Reasons for Refusal"

Example 2

	services	SGC	accumulated number of codes counted
Class 35	Retail services for confectionery, bread and buns	35K03	1
	Retail services for cosmetics	35K10	2

There are 2 or more types of "35 K XX" designated.

"Notice of Reasons for Refusal"

Check 4



If you do not plan to use the trademark for all the range designated, be sure to narrow down the range of goods / services.

Step 4

Searching for Similar Registered Trademarks

Once a trademark and goods / services have been determined, it is important to check whether there have been similar registered trademarks in the past before filing an application. In addition to asking your representative to search, you can also conduct a Trademark Search via J-PlatPat.

Click!  Trademark Search (J-PlatPat)

Q

How can I determine whether trademarks are similar?

A

Examination involves a comprehensive evaluation of the trademark's appearance, sound (pronunciation), and concept (meaning) in order to determine whether the trademarks are similar.

Ex. Examples of trademarks found to be similar



Intellectual Property High Court, 2008 (Gyo-ke) No. 10285

→ They are similar in appearance and share the same sound of "CIS".



Intellectual Property High Court, 2013 (Gyo-ke) No. 10008

→ The composition that combines a skull and two bone fragments is common. Differences remain within a fine range.

Q

Are there cases where trademarks that do not appear similar at first glance have been found to be similar?

A

Yes. A trademark that combines multiple characters or contains a figure is called a "composite trademark," and in this case, the examiner may separate the important part of the entire trademark (called the "primary part") to determine whether the trademarks are similar.

Learn more...**Examples of Composite Trademarks**

Comparing the primary parts "EMPIRE", the appearances are confusing, and the sound (pronunciation) "Empire" and the concept of "Empire" are identical.

Intellectual Property High Court, 2019 (Gyo-ke) No. 10104



trademark as applied



EMPIRE

another person's registered trademark

The court found that in the industry that provides the service designated by the trademark applied for, "Providing food and drink in restaurants", the names and signboards of shops generally include a figure of a cow or the letters "STEAK HOUSE", and therefore these are weak parts to distinguish the applicant's services from those of others.

Then, by excluding what was determined to be the "weak parts" of the entire applied-for trademark, the court considered the word "EMPIRE" as the "primary part" of the applied-for trademark, and determined that the primary part was similar to that of another person's registered trademark "EMPIRE".

Check**5**

Checking whether similar trademarks have been registered.



I found a similar trademark. In that case, do I have to give up registering my trademark?



Even if the trademarks are similar, they can be registered if the goods / services are not similar. The following is a good way to think about this:



In the example below, both can be registered because the trademarks are similar, but the goods are not.



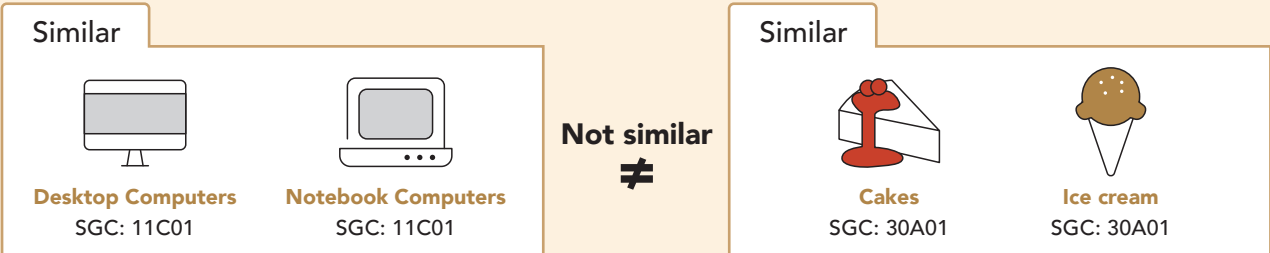
How do I determine whether goods / services are similar?



The JPO assigns a five-digit alphanumeric code to goods / services called a "Similar Group Code" (SGC). Similar goods / services have the same SGC, so please check this.

Learn more... What is SGC?

SGC is a grouping of goods / services that have commonalities in terms of the companies dealing them, as well as their content and other matters.



Click! ➔



Similar Group Code (JPO)

Step5

Payment of Fees

As of April 2023

Once you have decided on the trademark and the designated goods / services, let's apply to the JPO for trademark registration. You must pay fees at the time of filing and registration.

The information on this page is current as of April 2023. Please be sure to check the JPO and WIPO websites for the latest fee information before filing an application.

Direct Application

Click!



Schedule of fees (JPO)

International Trademark Application

Click!



Fees and Payments – Madrid System (WIPO)

Q

How much does it cost to get a trademark in Japan?

A

For example, if you file an online application designating 2 classes, you must pay the following fees.

- **Application Fee : ¥20,600**
- **Registration Fee (Lump sum payment for 10 years) : ¥65,800**

In addition, if the application is filed from abroad, payment of fees for a representative is also required.

Direct Application

Application Fee	JPY 3,400 + (number of classes x JPY 8,600)	
Digitization Fee (for paper procedures only)*	JPY 2,400 + (1 sheet x JPY 800)	
Registration Fee	Lump sum payment for 10 years	number of classes x JPY 32,900
	Payment in installments for 5 years	number of classes x JPY 17,200
Renewal Fee	Lump sum payment for 10 years	number of classes x JPY 43,600
	Payment in installments for 5 years	number of classes x JPY 22,800

* Digitization fees will be charged not only for the application form, but also for arguments, amendments, renewal registration applications and so on.

Q

Is the fee the same for obtaining trademark rights in Japan using an international trademark application?

No. For international trademark applications, a basic fee and individual fees must be paid.

A

International Trademark Applications

Below are the amounts when only Japan is designated. For details on fees related to the Madrid Protocol, please check the website of the International Bureau (WIPO).

Application

Basic Fee	If the mark is not colored	CHF 653
	If the mark is colored	CHF 903
Individual Fee (amount to be determined by each Contracting Party)	Amount equivalent to the Registration Fee in Direct Application (number of classes x JPY 32,900)*	

* Please check the website of the International Bureau (WIPO) for specific amounts.

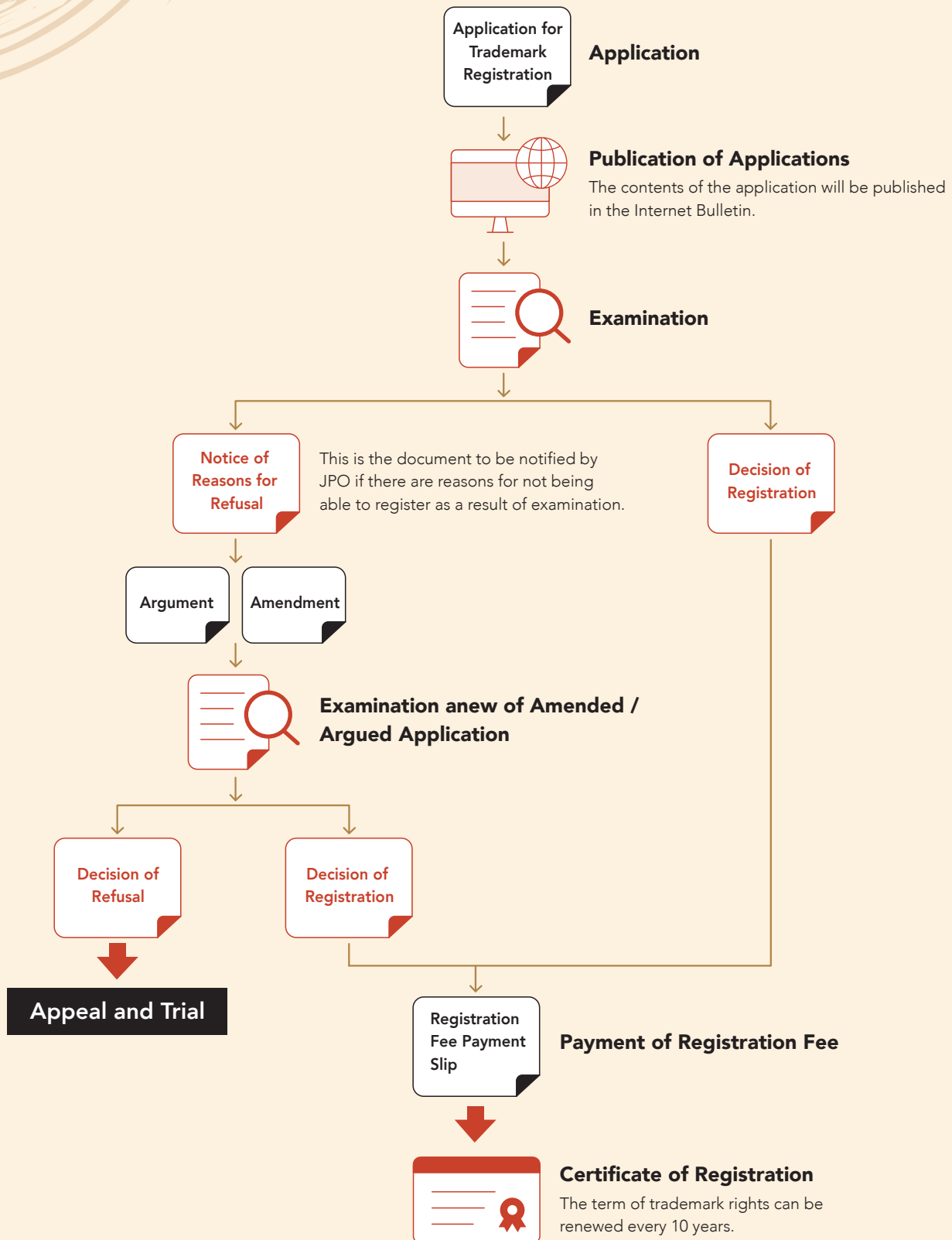
Renewal

Basic Fee	If renewal procedures are performed before the expiration of the duration	CHF 653
	If the payment is processed during the grace period of 6 months	CHF 326.5 (Surcharge)
Individual Fee (amount to be determined by each Contracting Party)	Amount equivalent to the Renewal Fee in Direct Application (number of classes x JPY 43,600)*	

* Please check the website of the International Bureau (WIPO) for specific amounts.

Flow after Filing an Application

Understanding the application process is very important in order to proceed smoothly with your application.



Click! ➔



Madrid System – The Process (WIPO)

References

■ Trademark



Trademark Search (J-PlatPat)

■ Goods / Services



Goods / Service Name Search
(J-PlatPat)



Similar Group Code (JPO)

■ Examination



Examination Guidelines for
Trademarks (JPO)



The Trademark Examination Manual
(JPO)

■ International Trademark Applications



Madrid System (WIPO)



Process of Filing International
Trademark Applications (WIPO)



Fee (WIPO)



Information for users designating
Japan under the Madrid Protocol
(JPO)

■ Others



Patent Attorney Navi
(Japan Patent Attorneys Association)



Direct Application Fee (JPO)



JPO Initiatives and Information (JPO)

