

Amendments to the “Japanese Examination Guidelines for similar goods and services”

Preface

The eighth edition of “International Classification of Goods and Services for the Purposes of the Registration of Marks based on Nice Agreement” was entered into force on January 1, 2002.

Before the International Classification was first introduced on April 1, 1992, the examination by Japan Patent Office had been based on the Japanese original classification system. Upon shifting to the International Classification, the Office reclassified every goods on the basis of conventional national classification system as well as newly adopted international classification system. Similar goods and services were given the same “similar group code”, and announced officially in “Examination Guidelines for similar goods and services based on the classification of goods and services”. For example, “Chemicals” in class 1 is given the similar group code No. 01A01.

Even though the Japanese trademark law clearly states that, “The classes of goods and services referred to in the preceding subsection shall not be determinative of the scope of similarity of goods or services” (Section 6 (3)), it is the reality that we must rely on the similar group codes assigned in each class to determine the scope of similarity of specific goods or services in the process of application or preliminary research.

To applicants and our colleagues overseas however, the “Japanese Examination Guidelines for similar goods and services”, especially the concept of similar group codes, seems hard to understand. At our end, representatives in Japan find it difficult to explain to the clients and representatives abroad what the similar group codes are, and how they work in various occasions. For example, when we are requested to file a new application from abroad, first work we engage in is to assign the specified goods and services to the similar group codes. Since examiners proceed their examination along with similar group codes of the Examination Guidelines, unnecessary Office Actions can be avoided if we follow the examples made clear in the Guidelines from the very beginning of the application.

When a registered trademark of the third party is cited in the Office Action,

similar group codes are crucial to analyze which goods conflict with each other. Again, this is not the easy part for the applicants and representatives overseas to understand. A similar group code includes ample goods and services, and only a partial conflict would be deemed similar in goods and services as a whole, even if difference does exist in individual goods and services. A cross search could be conducted since some of the code cover goods and services in other classes.

Along with the amendments to the International Classification, several changes have taken place in the “Japanese Examination Guidelines for Similar Goods and Services” as well. By showing some examples, let us introduce several points which may be of interests to applicants and representatives abroad.

1. Main points of amendment

Among several amendments made in “Japanese Examination Guidelines for similar goods and services”, the major amendment was the change in classification of services. Needless to say, such change has taken place in other countries, along with the introduction of 8th edition of International Classification. What is unique to the amendments in Japan is the disappearance of so-called “General Class”.

Since April 1, 1992 when the International Classification was first introduced in Japan, the classification of services had consisted of 8 classes from class 35 to class 42. The amendment this time resulted in the increase of the classification, from class 35 to class 45, totaling 11 classes for services. This is due to the regrouping of the class 42, which used to include broad and various services. In other words, services formally fell under class 42 were subdivided into classes 42 to 45.

1) New classification after revision

Examples:

Class 42: study on pharmaceutical preparations, design of computer programs

Class 43: providing accommodation facilities, providing foods and drinks

Class 44: medical service, beauty culture

Class 45: providing wedding facilities, agencies for housework

Under traditional Classification system, most of the services that do not appear to come under any classes from class 35 to class 41 are considered to belong to class 42. However, under the revised Classification, such miscellaneous services no longer fall automatically into the said class. It is now necessary to carefully examine the appropriate class for a particular service, consulting the examples shown in each

class.

There are also minor changes in classes from 35 to 41, such as the change, deletion, and addition of some services which are previously shown as examples. We strongly recommend consulting your representative in Japan on reviewing the Guidelines, prior to filing an application.

2) Goods and services related to Information Technology

The revised classification made it clear that “electric apparatus and instruments” means “apparatus and instruments used for electric conduction, opening and closing the electronic circuit, transformers and so on” (“electric calculators” has been deleted (09D01)), and that “programs for electronic computers” (similar group code 11C01) and “electronic publications” (26A01, 26D01) are the goods which belong to class 9. “Programs for electronic computers” and “electronic publications” include downloaded as well as recorded forms of such programs and publications.

These days with development of IT industry, enquiries and trademark applications with reference to IT related goods and services have increased both domestically and internationally. However, it has never been made clear whether “computer programs” and “electronic publications” are treated as services or goods. The amendment this time reflects the public demand to clarify the position of “computer programs” and “electronic publications”, to be treated as goods under class 9.

Further, even though “computer programs” and “electronic publications” are treated as goods, they are deemed similar with some services in some cases. For example, “computer programs” in class 9 is considered similar to “providing computer programs” in class 42, and “electronic publications” is treated similar to “providing electronic communications” in class 41. Such a cross search is not positively conducted at the time of examination; however, it becomes crucial at the time of opposition from the third party, if the cited registered trademark covers such cross-searched goods or services. They are presumed similar if they share the same similar group codes. Unless the client disproves such similarity, the latter application could be invalidated.

2. Other amendments

1) Amendments to classification of goods

Other than major amendments to the classification of services, several minor changes took place in classification regarding goods. Several goods were reclassified

from one class to another, and a prospect applicant should be well aware of such changes, as specifying the conventional class would be subject to the rejection of the application.

Goods	New Class	Old Class	Similar Group Code
Eyelash curler tongs	8	21	21F01
Ear plugs Swimming ear plugs, sleeping ear plugs, Soundproof ear plugs	9	10	01C04
Apparatus and instruments for amusement parks, not including video game apparatus for amusement arcade	28	9	09G53
Karuta playing cards	28	16	24A01
Japanese playing cards (Utagaruta), Playing cards, Japanese playing cards (Hanafuda)	28	16	24B01
Insect collecting implements Insect nets with handle, Insect collecting boxes, Insect collecting cases, Insect tape pipes, Poisonous trap pots	28	16	25B02

2) Reclassification of goods for trademark rights

Along with the amendments, “Reclassification Guidelines” has also been revised. Therefore, consideration should be given to the classification of specified goods upon reclassification application. As far as specified services are concerned, the amendments this time do not affect the reclassification, and so far, no plan has been made to amend the “Reclassification Guidelines” in the same manner as the “Japanese Examination Guidelines for similar goods and services”.

3. Conclusion

The amendments in “Japanese Examination Guidelines for similar goods and services” this time reflects the revision of “International classification of goods and services for the purposes of the registration of marks based on Nice Agreement” from 7th edition to 8th edition. For services, the classes for “miscellaneous” services have been made systematic and subdivided, and as a result, become user-friendly. Another outcome of the amendments is that IT related goods are made clear to come under the category of goods, which relieves the confusion of the applicants all over the world. We hope this article should be of help in any way for applicants and our colleagues overseas in researching and filing applications in Japan in the future.

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