

# Welcome kit

on Trade Marks in Japan  
for EU Businesses

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## Filing a trade mark application in Japan?

This kit helps European SMEs to understand the Japan Patent Office's examination requirements and thus communicate more effectively with Japanese attorneys in order to secure trade mark protection in Japan.

European applicants are encouraged to seek legal advice from their representatives in Japan and to refer to the up-to-date original text of the various guidelines of JPO. These are publicly available on the website: [www.jpo.go.jp/e/system/laws/rule/guideline/trademark/index.html](http://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/index.html)

## Main similarities and differences in examination practice

	Japanese trade mark system	EUTM
<b>Is representation required</b>	<p>A person that is not domiciled or resident (or, for corporations, with their place of business) in Japan is required to appoint a representative that is domiciled or resident in Japan.</p> <p>You can find a patent attorney in Japan by using the 'Patent Attorney Navi.'</p> <p><a href="http://www.benrishi-navi.com/english/english1.php?search=2">www.benrishi-navi.com/english/english1.php?search=2</a></p>	<p>Those without a domicile, principal place of business, or real and effective commercial establishment within the <a href="#">EEA (European Economic Area)</a> should appoint a professional representative.</p>
<b>Date of filing</b>	<p>The filing date is the date on which the application is submitted. However, if the application lacks some required information, the filing date will be moved back to the date the deficiencies were remedied.</p>	<p>The date of filing subject to payment of the application fee within one month of filing the required documents.</p>
<b>Scope of examination <i>ex officio</i></b>	<p>Formalities, Classification, Absolute Grounds, Relative grounds</p>	<p>Formalities, Classification, Absolute Grounds</p>
<b>Grounds for refusal</b>	<p>Substantive examination includes examination based on absolute grounds and examination based on relative grounds.</p> <p><i>*When a broad range of goods or services are described, verification of actual or planned use of the trade mark may be required.</i></p>	<p>Absolute grounds are examined <i>ex officio</i>, third party observations are possible after publication, before registration.</p> <p>Relative grounds for refusal are not examined <i>ex officio</i> but only when an opposition or cancellation is filed.</p>
<b>Identification of earlier rights that could conflict with the application</b>	<p><i>Ex officio</i> examination of existing earlier applications and rights</p>	<p>Search report</p>
<b>Disclaimer</b>	X	X

	Japanese trade mark system	EUTM
<b>Opposition</b>	Can be filed within 2 months from the day of publication of the Trade mark Bulletin.	<p>Can be filed within 3 months from publication date.</p> <p>Scope of grounds: Relative grounds for refusal</p> <p>*The applicant can file a request for proof of use, requiring the opponent to prove that any earlier mark registered for more than 5 years has been genuinely used</p>
<b>Division of Application/Registration</b>	✓	✓
<b>Duration of registration</b>	10 years from the date of registration	10 years from the date of filing of the application
<b>Term of renewal</b>	Within 6 months before expiration of the registration with the renewal fee; within 6 months after expiration upon payment of an additional fee.	Within 6 months before expiration of the registration with the renewal fee; within 6 months after expiration upon payment of an additional fee.
<b>Transfer</b>	<p>Can be transferred by dividing it for each of the designated goods or services.</p> <p>Where trade mark rights are owned jointly, no joint owner may transfer his/her stake or establish a pledge on his/her stake without the consent of all the other joint owners.</p>	<p>An EU trade mark may be transferred separately from any transfer of the undertaking in respect of some or all of the goods or services for which it is registered.</p> <p>An assignment of the EU trade mark should be made in writing and requires the signature of the parties (except when it is a result of a judgment).</p> <p>A transfer cannot affect the unitary character of the EUTM. Therefore, an EUTM cannot be 'partially' transferred for some territories.</p>
<b>Use requirement</b>	Non-use for over 3 consecutive years makes the trade mark registration vulnerable to cancellation.	Non-use for more than 5 years following registration makes the trade mark registration vulnerable to cancellation.
<b>Can you obtain consent from the owner of a conflicting mark to proceed to registration?</b>	<p>Yes, as of April 2024.</p> <p>*Concurrent registration of trade marks will be allowed under the condition that the prior registered trade mark holder consents to the registration, <b>and that it will not cause confusion among consumers.</b></p>	Usually not. If there is a dispute, the courts will decide.

# Key points on the Japanese trade mark system

If you are thinking of filing a trade mark application in Japan, we hope this explanation helps enhance your understanding of the Japanese trade mark system!

There are three Principles to follow!

POINT  
1

## Registration Principle:

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

POINT  
2

## First-to-file principle:

In Japan, trade marks may be registered only by the first applicant. If someone else has registered a trade mark 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 trade mark application is examined by a JPO examiner. The filed trade mark will be examined with regard to both of the following aspects:

- 1 Absolute grounds for refusal arising from the trade mark 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 trade mark application, let's check the list below:

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

# 5 steps for trade mark 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)

STEP  
2



## Verification of the logo and naming (trade marks)

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

STEP  
3



## Designation of goods/services

When you apply for a trade mark, you must designate not only the trade mark itself, but also the goods/services for which you will use it. Once a trade mark 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 trade mark rights.

STEP  
4



## Searching for similar registered trade marks

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

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 trade mark 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 trade mark registration is complete!

STEP  
1

Appointment of a representative



**CAUTION** Overseas residents may not submit documents directly to JPO without a representative!

I want to apply for a trade mark in Japan! Can I apply directly from overseas in English?

When applying for a trade mark in 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 trade mark 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 – the International Trade mark System (WIPO)



Click

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

Pros and Cons of filing methods

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

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

CHECK  
1



Selecting the appropriate filing method and representative.

## STEP 2

### Verification of the Logo and Naming (trade marks)

Any tips when coming up with trade marks?

When incorporating features of products or services into a trademark, it is important to note that this alone may lack distinctiveness. Therefore, adding distinctive words or designs is key to creating an overall composition that possesses distinctiveness.

#### Learn more... What is "Distinctiveness"?

Distinctiveness is achieved where one's goods/services can be recognised as distinct from those of others with respect to a certain logo or name (trade mark). The existence of distinctiveness is judged in relation to the goods/services for which the trade mark is used.



Ex. The following trade marks do not have 'distinctiveness'.

Trade mark

**ORGANIC**

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

**An indication of the quality of the goods:**

**Designated goods: alcoholic beverages.**

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

Trade mark

**i**

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 part can be monopolized.



**Can I change my trade mark after filing?**

No. You need to apply for a new trade mark.

CHECK  
**2**

Making the trade mark "distinctive".

STEP  
3

## Designation of Goods / Services



**CAUTION** '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 produce/provide, or plan to produce/provide in future.

#### For "Apparel manufacturers"…?

[ CLASS 25 ]

**Clothing**

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**

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**



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**



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 translation of the goods/services is for reference only.

## 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 cancelled.

CHECK  
**3**

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

**Learn more...****Can the trade mark 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, signalling, 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 \(JPO\).](#)

**Learn more...****Guidelines for Designated Goods/Services Related to Virtual Environments and NFTs**

The JPO has published a summary of its current approach to examination for designated goods and services related to virtual environments and non-fungible tokens (NFTs).

**Click**

[Guidelines for Designated Goods and Services Related to Virtual Environments and NFTs](#)

## Learn more...

## How should retail services be designated?



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

Since the JPO organises retail services around the goods that are dealt with in carrying out those services, 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 living ware, 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)]’.*

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 trade mark.

> P.15

## Learn more...

## Can a trade mark be registered if a wide range of goods/ services are designated for it?

In principle, trade marks 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 one 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.18

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

If there are 23 or more SGC in one 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** //

	<b>goods</b>	<b>SGC</b>	<b>accumulated number of codes counted</b>
<b>Class 29</b>	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** //

	<b>services</b>	<b>SGC</b>	<b>accumulated number of codes counted</b>
<b>Class 35</b>	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** //

	<b>services</b>	<b>SGC</b>	<b>accumulated number of codes counted</b>
<b>Class 35</b>	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 trade mark for all the range designated, be sure to narrow down the range of goods / services.**

STEP  
4

## Searching for Similar Registered Trade marks

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

Click  [Trade mark Search \(J-PlatPat\)](#)



**How can I determine whether trade marks are similar?**

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



### Ex. Examples of trade marks 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.



**Are there cases where trade marks that do not appear similar at first glance have ultimately been found to be similar?**

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



## Learn more... Examples of Composite Trade marks

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



The court determined that the term "STEAK HOUSE" and the graphic representation of the cow have a weak function as a sign for distinguishing goods and services in relation to the designated service of "providing food and beverages in restaurants."

Then, by excluding what was determined to be the 'weak parts' of the trade mark applied for, the court considered the word 'EMPIRE' as the 'primary part' of the trade mark and determined that the primary part was similar to that of another registered trade mark, 'EMPIRE'.

CHECK  
5

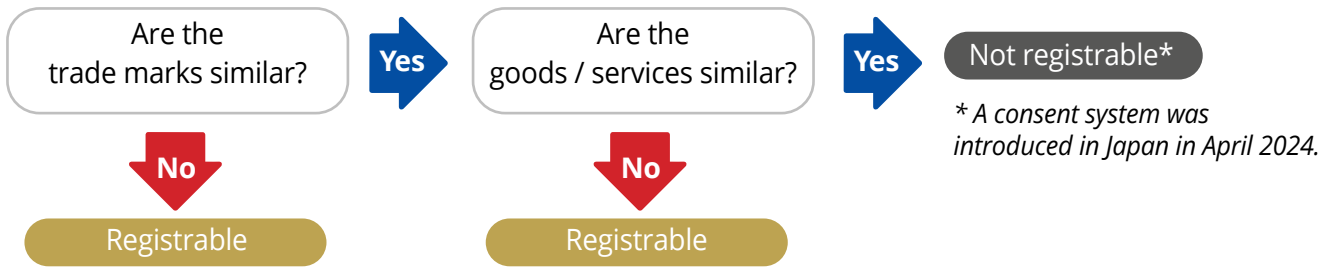
Checking whether similar trade marks have been registered.



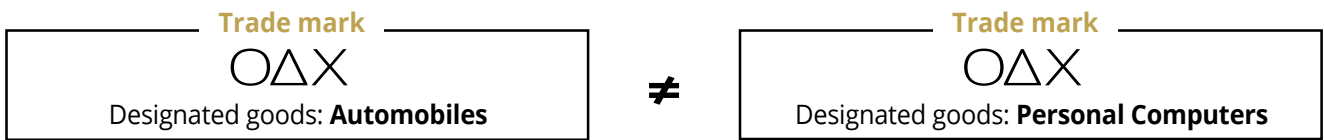
I have found a similar trade mark. Do I just give up registering my trade mark?

Even if the trade marks 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 trade marks are similar, but the goods are not.



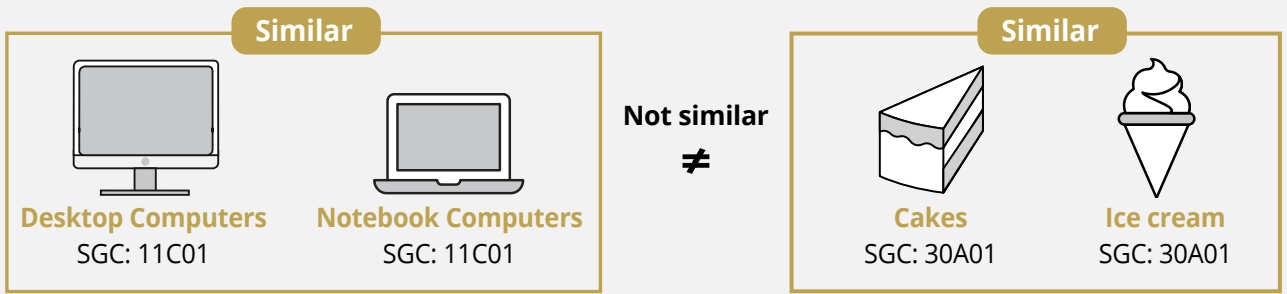
**Q** How do I determine whether goods / services are similar?

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.

**A**

**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 \(JPO\)](#)

**Learn more... Consent System**

From 1 April 2024, the JPO has introduced the consent system to allow concurrent registration of trade marks under the condition that the prior registered trade mark holder consents to the registration, and that it will not cause confusion among consumers

Click  [Examination Guidelines for Trademarks regarding Consent System](#)

**STEP 5**


**Payment of Fees**

As of April 2023

Once you have decided on the trade mark and the designated goods/services, you can apply to register your trade mark with the JPO. You must pay the 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 Trade mark Application**

Click  [Fees and Payments - Madrid System \(WIPO\)](#)

**Q How much does it cost to get a trade mark in Japan?**

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**

<b>Application Fee</b>	JPY 3,400 + (number of classes x JPY 8,600)	
<b>Digitization Fee (for paper procedures only)*</b>	JPY 2,400 + (1 sheet x JPY 800)	
<b>Registration Fee</b>	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
<b>Renewal Fee</b>	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.



**Is the fee the same for obtaining trade mark rights in Japan using an international trade mark application?**

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



////////// **International Trade mark 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**

<b>Basic Fee</b>	If the mark is not colored	CHF 653
	If the mark is colored	CHF 903
<b>Individual Fee (amount to be determined by each Contracting Party)</b>	Amount equivalent to the Registration Fee in Direct Application (2023/12/23 ~ CHF266 for one class + CHF250 for each additional class)*	

**Renewal**

<b>Basic Fee</b>	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)
<b>Individual Fee (amount to be determined by each Contracting Party)</b>	Amount equivalent to the Renewal Fee in Direct Application (2023/12/23 ~ number of classes x CHF 263)*	

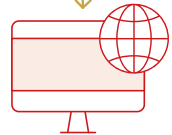
\* Please check the website of the International Bureau (WIPO) for specific amounts.

# Flow after Filing an Application

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

Application for Trademark Registration

## Application



## Publication of Applications

The contents of the application will be published in the Internet Bulletin.



## Examination

Notice of Reasons for Refusal

This is the document to be notified by JPO if there are reasons for not being able to register as a result of examination.

Decision of Registration

Argument    Amendment



## Examination anew of Amended / Argued Application

Decision of Refusal

Decision of Registration

**Appeal and Trial**

Registration Fee Payment Slip

## Payment of Registration Fee



## Certificate of Registration

The term of trademark rights can be renewed every 10 years.

Click



[Madrid System – The Process \(WIPO\)](#)

# References

## ■ Trade mark



[Trade mark Search \(J-PlatPat\)](#)

## ■ Goods / Services



[Goods / Service Name Search \(J-PlatPat\)](#)



[Similar Group Code \(JPO\)](#)

## ■ Examination



[Examination Guidelines for Trade marks \(JPO\)](#)



[The Trade mark Examination Manual \(JPO\)](#)

## ■ International Trade mark Applications



[Madrid System \(WIPO\)](#)



[Process of Filing International Trade mark 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 \(JPO\)](#)





[euipo.europa.eu](http://euipo.europa.eu)



[jpo.go.jp](http://jpo.go.jp)