

Chapter XII: Article 16-2 and 17-2
(Dismissal of amendment)

Article 16-2

(1) Where an amendment made to the designated goods or designated services, or to the trademark for which registration is sought as stated in the application, is considered to cause any change of the gist thereof, the examiner shall dismiss the amendment by a ruling.

(2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state reasons therefore.

(3) Where a ruling dismissing an amendment under paragraph (1) is rendered, the examiner shall not render any decision on the said application for trademark registration before the expiration of a period of three months from the date of service of a transcript of the ruling.

(4) Where an applicant for trademark registration files a request for a trial under Article 45 (1) against the ruling dismissing an amendment under paragraph (1) the examiner shall suspend the examination of the application for trademark registration until the trial decision becomes final and binding.

Article 17-2

(1) The provision of Article 17-3 (New Application for Designs as Amended) of the Design Act (Act No. 125 of 1959) shall apply mutatis mutandis to the case where an amendment is dismissed by a ruling pursuant to Article 16-2 (1) of this Act.

(2) The provision of Article 17-4 of the Design Act shall apply mutatis mutandis to the case of an extension of the time limit provided in Article 17-3 (1) of the Design Act as applied mutatis mutandis to the preceding paragraph or Article 55-2 (3) (including its mutatis mutandis application under Article 60-2 (2))of this Act.

Design Law 17-3

(1) Where an applicant for a design registration has filed a new design application for the design as amended within 3 months from the transmittal of a ruling to decline an amendment under Article 17-2(1), the design application shall be deemed to have been filed at the time of submission of that amendment.

(2) Where a new design application referred to in the preceding SubArticle has been filed, the original design application shall be deemed withdrawn.

(3) The two preceding SubArticles shall be applicable only where the applicant has

submitted, at the same time as the new design application, a statement to the Commissioner of the Patent Office indicating his desire for the application of Subsection (1) to the new design application referred to in that Subsection.

1. A judgment on a change in the gist of an application needs to be made based on the following criteria.

(1) With Respect to Designated goods or designated services

(a) A modification or broadening of the scope of designated goods or designated services is a change in the gist of an application not only in a case where a modification or a broadening is made to cover dissimilar goods or services but in a case where a modification or a broadening is made to cover other similar goods or services.

(b) A restriction of the scope of designated goods or designated services, correction of errors, and changes in order to clarify unclear descriptions are not deemed as a change in the gist of an application.

(c) Amendments in respect of retail services will be handled as follows.

(i) Amendments where “retail services or wholesale services for a variety of goods in each of the fields of clothing, foods and beverages, and livingware, and taking all goods together” (hereinafter referred to as “general retail services”) are changed to other retail services (hereinafter referred to as “specific retail services”) shall be deemed as a change in the gist of an application. The same will apply in the reverse case where specific retail services are changed to general retail services.

(ii) While a restriction of the scope of goods connected with specific retail services is not deemed as a change in the gist of an application, a modification or broadening of the scope is deemed as such.

(iii) Amendments where retail services are changed to goods are deemed as a change in the gist of an application. The same will apply in the reverse case.

(2) With Respect to Trademark

(a) A deletion of any letters used in a trademark merely in an appendant portion, such as “JIS,” “JAS,” “特許” (patent), “実用新案” (utility model registration), “意匠” (design registration), etc. or letters indicating the place of production and sale of goods or the provision of services is not a change in the gist of an application, in principle.

(b) An alteration, addition or deletion of a common name, characters indicating the quality of goods or services, characters indicating raw materials, figures,

symbols or three-dimensional shapes is a change in the gist of an application.

(Examples)

- (i) Where with respect to a trademark “桜羊かん” [SAKURAYOKAN], characters “羊かん” [YOKAN] are deleted or altered,
 - (ii) where with respect to a trademark “桜” [SAKURA], characters “羊かん” [YOKAN] are added,
 - (iii) where with respect to a trademark “椿銀行” [TSUBAKIGINKO], characters “銀行” [GINKO] are deleted or altered, and
 - (iv) where with respect to a trademark “椿” [TSUBAKI], characters “銀行” [GINKO] are added, the gist of a trademark application is deemed changed.
- (c) A post-application alteration of the colors of a trademark is a change in the gist of an application.
- (d) A post-application alteration of a plain trademark to a “three-dimensional trademark” as prescribed in Article 5(2) by adding its description in the request to that effect or an alteration of a three-dimensional trademark to a plain trademark by deleting its description in the request under Article 5(2) is a change in the gist of an application.
- (e) A post-application alteration of a trademark composed of “standard characters” as prescribed in Article 5(3) by adding or deleting its description in the request through an amendment is deemed to be a change in the gist of an application, in principle.
- (f) A post-application addition of a color to a trademark under the proviso to Article 5(4) is a change in the gist of the application.

2. In accordance with Article 68-18, Article 17-3 of the Design Law, as applied under Article 17-2(1) of the Trademark Act shall not apply to the applications for international trademark registration.