

Chapter XVI: Articles 2, 3, 4, 6, 11, 12 and 24 of Supplementary Provisions
(Reclassification)

Supplementary Provisions

Article 2

(1) The owner of a trademark right resulting from a trademark application filed before April 1, 1992 shall have a re-classification of its designated goods registered in accordance with the classification of goods and services designated by Article 6(2) of Cabinet Order effective at the time of filing of an application as prescribed in Article 3(1) of the Supplementary Provisions (hereinafter called the “registration of a reclassification”).

(2) Commissioner of the Patent Office shall, with consideration to the status of filing of applications for the registration of a re-classification and their examination, designate the scope of trademark rights with respect to which a re-classification of designated goods shall be registered and a date starting to accept such applications (called the “acceptance starting date” in Article 3(2) of the Supplementary Provisions.)

Article 3

(1) A person applying for the registration of a re-classification shall submit a request describing the following matters to the Commissioner of the Patent Office, together with necessary explanations.

- (i) the name and the domicile or residence of the applicant;
- (ii) the registration number of the registered trademark; and
- (iii) the designated goods seeking a re-classification and their classes of goods and services as prescribed in Article 2.

(2) An application for the registration of a re-classification shall be made within a period from six months before the expiration of the term of a registered trademark right (hereinafter referred to as the “expiration date”) which arrives first after six months counting from the acceptance starting date to one year after the expiration date.

(3) Where a person required to apply for the registration of a re-classification has been unable to make an application for the registration of a re-classification within the time limit prescribed in the preceding paragraph due to reasons outside his control, he may make such application within 14 days (where he is a resident abroad, two months) from the date on which the reasons ceased to be applicable but

not later than six months following the expiration of the said time limit.

Article 4

(1) An application for the registration of a re-classification shall be made in accordance with the classification of goods and services as prescribed in Article 2(1) of the Supplementary Provisions and not substantially in excess of the scope of designated goods of a registered trademark right with respect to which it is filed.

(2) In case where there is a person as prescribed in Article 97(1) of the Patent Law (Waiver of Patent Right, Etc.) applied mutatis mutandis in Article 35 of the Trademark Act, a person filing an application for the registration of a reclassification shall obtain the consent of such person.

Article 6

In case where an application for the registration of a re-classification falls under either of the following, the examiner shall render a decision that the application is to be refused.

(i) the application fails to satisfy the requirements prescribed in Article 4(1) of the Supplementary Provisions; or

(ii) the applicant is not the owner of the trademark.

Article 11

In case where a person required to apply for the registration of a re-classification fails to file an application for the registration of a re-classification within the time limits prescribed in Article 3(2) or (3) of the Supplementary Provisions, an examiner's decision or a trial ruling that an application for the registration of a re-classification is to be refused has become final and conclusive, where a trial ruling that the registration of a re-classification is to be invalidated has become final and conclusive in a trial under Article 14(1) of the Supplementary Provisions or an application for the registration of a re-classification is dismissed under the provision of Article 18(1) or Article 18bis(1) of the Patent Law applied mutatis mutandis in the Supplementary Provisions, the trademark right shall be extinguished upon the expiration of the term which arrives after the expiration date.

Article 12

(1) A re-classification shall take its effects upon its registration.

(2) In case where an examiner's decision is made under Article 8 of the Supplementary Provisions, a re-classification of the designated goods of a registered trademark right shall be registered.

(3) In the case prescribed in the preceding paragraph, a trademark right with respect to designated goods which are not indicated in an application for the registration of a re-classification shall be extinguished upon the registration of that re-classification.

(4) A registration is made under Paragraph 2, the following matters shall be published in the Trademark Gazette:

(i) the name and the domicile or residence of the applicant;

(ii) the registration number of the registered trademark;

(iii) the classes of the designated goods before the registration of their reclassification;

(iv) the classes of the designated goods and services after the registration of a reclassification;

(v) the date of the registration of the trademark;

(vi) the date of the registration of a re-classification; and

(vii) necessary matters other than those listed above.

Article 24

A person who has filed an application for the registration of a re-classification and taken other procedures concerning the registration of a re-classification shall be allowed to make an amendment during the pendency of the case in examination, trial or retrial.

1. Item 1 of Article 6 of the Supplementary Provisions is interpreted to apply as follows:

(1) An application for the registration of a re-classification designating goods not only exceeding the scope of the designated of a trademark right with respect to which the application is filed but failing to follow the classification of goods and services is judged as "failing to satisfy the requirements prescribed in Article 4(1) of the Supplementary Provisions."

(2) The above-described classification of goods and services is a classification of goods and services effective at the time of filing of an application.

(3) In case where it is fully convincing that goods designated in an application for the registration of a re-classification did not exist at the time of a trademark

application from which a trademark right concerned has resulted, the application is refused on the ground that they substantially exceed the scope of the designated goods of the trademark right.

(4) Notwithstanding the provision of (3), goods considered substantially the same kind as that of originally designated goods as judged from their quality, shapes, intended purpose, functions, etc. based on a common sense of goods and trade practice is dealt with as goods belonging to the originally designated goods.

However, this interpretation does not apply to such an extent that a “metal-made desk” is included in goods specified as “wooden desks.”

2. An amendment is allowed to alter or expand goods described in an application for the registration of a re-classification (including goods already amended by an earlier amendment).

However, an application for the registration of a re-classification with goods amended to substantially exceed the scope of the designated goods of a registered trademark right concerned is refused on the ground that it falls under the provision of Item 1 of Article 6 of the Supplementary Provisions.

3. If the right of a trademark in pending application for a re-classification lapses (for example, if its term is not renewed and thus expires because a request for renewal of term was not filed or because a request for renewal has been refused, or if all of the designated goods of such trademark right have been abandoned, invalidated or cancelled), such application for reclassification shall be dismissed.

4. In case where part of the designated goods of a trademark right with an application of a re-classification pending is abandoned, invalidated or cancelled, if the goods described in an application for the registration of a re-classification are identical with those or include in those, the application for the registration of a reclassification is refused as they substantially exceed the scope of the designated goods.