

Chapter XVIII: Articles 7 and 8 of the Supplementary Provisions of the Act for Amendment of the Design Act (Act No. 55 of 2006)

(Trademark Applications for Retail Services Filed During the Exception Period)

(Special Provisions for Applications for Trademark Registration Filed Within Three Months Following the Enforcement)

Article 7

(1) For the purpose of Article 4(1) of the Trademark Act (limited to the portion relating to Paragraph (xi)) for applications for trademark registration filed within three months following the enforcement of this Act which designate retail services (hereinafter in this Article referred to as “trademark applications for retail services filed during the exception period”), “trademarks which are ...” in Article 4(1)(xi) shall read as “trademarks which are ..., excluding those used in respect of services relating to Article 2(2) where the designated services covered by the trademark registration are relating to Article 2(2).”

(2) For the purpose of Article 4(1) of the Trademark Act (limited to the proportion relating to Paragraph (xiii)) for trademark applications for retail services filed during the exception period, “trademarks which are ...” in Article 4(1)(xiii) shall read as “trademarks which are ..., excluding those used in respect of services relating to Article 2(2) where the designated services covered by the trademark right are relating to Article 2(2).”

(3) For the purpose of Article 8(1) of the Trademark Act for trademark applications for retail services filed during the exception period, “services” in Article 8(1) shall read as “services (excluding those provided for in Article 2(2)).”

(4) For the purpose of 8(2) of the Trademark Act for trademark applications for retail services, the relevant applications filed during the exception period will be deemed as those filed on the same date.

(Application of Special Provisions Based on Use)

Article 8

(1) Where there are two or more applications that are deemed as filed on the same date under Article 7(4) above, the applicant may claim application of the special provisions based on use when his trademark application seeks registration of a trademark which has been used in Japan prior to the enforcement of this Act for retail services connected with his business without an intention of violating the rules of fair competition.

(2) Any Applicant who desires to claim application of the special provisions must submit to the Commissioner of the Patent Office, within the allocated period specified in Article 8(4) of the Trademark Act, a written statement to that effect and documents to prove that the application falls under any of the following paragraphs.

1. The trademark in an application has been used in Japan prior to the enforcement for retail services connected with his business.

2. The designated services in an application are the retail services mentioned in 1 above.

(3) For the purpose of Article 4(1) of the Trademark Act (limited to the proportion relating to Paragraph (x)) for applications claiming application of the special provisions which fall under any of the paragraphs in the preceding sub Article, “which are used” in Article 4(1)(x) shall read as “which are used (excluding trademarks which are well known among consumers as indicating the services connected with his business (limited to the services provided for in Article 2(2)), and which are used in respect of such services ).”

(4) For the purpose of Article 8(5) of the Trademark Act, if any of the two or more applications under Sub Article (1) are those to which the special provisions apply, “one applicant chosen by the drawing of lots conducted in a fair and just manner by the Commissioner of the Patent Office” shall read as “the applicant of a trademark application to which the special provisions based on use apply as stated in Article 8(3) of the Supplementary Provisions of the Act for Amendment of the Design Law (Act No. 55 of 2006) (‘the applicants of trademark applications’ if there are two or more applications to which the special provisions apply)”

(5) Article 24quater and Article 52bis shall apply mutatis mutandis where trademark rights concerning two or more identical or similar registered trademarks which are to be used in identical or similar retail services were established with respect to different trademark holders, and thus registered by the application of Article 8(5) of the Trademark Act under the preceding SubArticle (4).

1. Special provisions concerning examination for earlier and later applications (special provisions related to Article 7 of the Supplementary Provisions)

(1) Examination regarding earlier and later applications for trademark registration in respect of retail services will be handled in the following manner.

(a) Article 4(1)(xi) and (xiii), and Article 8(1) shall not apply to applications for trademark registration filed from April 1, 2007 to June 30, 2007 (hereinafter

referred to as the “exception period”) which designate retail services (hereinafter referred to as “trademark applications for retail services filed during the exception period”) where a trademark used in respect of retail services is cited against the relevant trademark in the notification of reason for refusal.

(b) Where, during the exception period, two or more trademark applications for retail services related to identical or similar trademarks which are to be used in identical or similar retail services are filed, they will be deemed as applications filed on the same date in accordance with Article 7(4) of the Supplementary Provisions of the Law for Amendment. Consequently, the Commissioner of the Patent Office shall order the applicants to hold consultations for an agreement under Article 8(4) of the Trademark Act, and notify the reason for refusal under Article 8(2) and (5).

(c) The first-to-file rule shall apply to applications for retail services (filed during the exception period) against which a trademark used in respect of goods or in respect of services other than retail services is cited in the notification of reason for refusal. Article 4(1) (xi) and (xiii), and Article 8(1) and (2) shall consequently apply thereto.

(2) The first-to-file rule shall apply to trademark applications covering goods or services other than retail services that are filed during the exception period, including those against which a trademark used in respect of retail services is cited in the notification of reason for refusal. Article 4(1) (xi) and (xiii), and Article 8(1) and (2) shall consequently apply thereto.

(3) Regarding trademarks filed during the exception period, the special provisions concerning examination for earlier and later applications (Article 7 and Article 8 of the Supplementary Provisions) shall only apply to trademarks used in respect of retail services. Even if the same application designates, besides retail services, goods or services other than retail services, the special provisions don't apply to the extent of the trademark in respect of goods or services other than retail services.

## 2. Application of special provisions based on use (related to Article 8(1) and (2) of the Supplementary Provisions)

(1) In judgment concerning the application of special provision based on use, a decision as to whether the relevant trademark application for retail services (filed during the exception period) falls under the category 1 and 2 below will be made by examining the documents that were submitted during the allocated period for consultation under Article 8(2) of the Supplementary Provisions.

(i) The trademark in an application has been used in Japan prior to the

enforcement for retail services connected with his business.

(ii) The designated services in an application are the retail services mentioned in 1 above.

(2) The user of the trademark prior to the enforcement mentioned in 1 above must be the applicant in principle.

(3) When examining the use of a trademark in the trademark application for retail services (filed during the exception period), if a trademark is indicated on goods, their packaging, price lists, business documents and advertisements, judgment as to whether or not a trademark is used in respect of retail services shall be made by examining, according to the form of indication, whether the trademark identifies the source of the goods or the source of retail services in connection with the goods.

(4) Even where the documents have been submitted in accordance with Article 8 (2) of the Supplementary Provisions, the special provisions based on use will not apply if the relevant application is recognized as falling under categories 1 and 2 below.

Even if the application accordingly is not considered as registrable under Article 8 (5) of the Trademark Act, the examiner will, instead of notifying drawing of lots or refusal under Article 8(5) of the Trademark Act, notify the applicant that the special provision will not apply because of the reason above, so as to give the applicant an opportunity to file an argument. When the application is still considered as falling under categories 1 and 2 below even after consideration given to the argument submitted by the applicant, the examiner will notify the applicant of drawing of lots or refusal under Article 8(5) of the Trademark Act.

(i) Where, following an examination on the documents submitted under Article 8(2) of the Supplementary Provisions, the application is not recognized as falling under each Paragraph of Article 8(2) of the Supplementary Provisions (1 and 2 of (1) above)

(ii) Where the applicant's use of the trademark in respect of retail services is recognized as one with an intention of violating the rules of fair competition

3. Examinations for trademark applications for retail services (filed during the exception period) to which the special provisions based on use apply (related to Article 8(3) and (4) of the Supplementary Provisions)

(1) Even where a trademark in the trademark application for retail services to which the special provisions based on use apply is identical or similar to another person's well-known trademark (must be identical or similar trademarks which are to be used on identical or similar goods or services), the provision of Article 4 (1)(x) of the Trademark Act will not apply if the relevant trademark is well-known as

indicating retail services connected with the applicant's business.

However, the provision of Article 4(1) (xv) of the Trademark Act will apply where another person's trademark is recognized as more famous than the relevant trademark, because it is liable to cause confusion over the trade source.

(2) Where a directive for consultation under Article 8(4) of the Trademark Act is given to two or more applications for retail services filed during the exception period, as long as no other reasons for refusal are found, trademarks to which the special provisions apply will be given priority for registration. In such an event, if there are two or more such trademarks, all of them may be registered redundantly.

Following the registration of the above-mentioned trademark applications, applications to which the special provisions do not apply will be refused, because they are violating the provision of Article 8(5) of the Trademark Act under Article 8(4) of the Supplementary Provisions.

(Reference)

The acceptability of trademark registration under Article 8(3) and (4) is shown in the table below.

Acceptability of trademark registration

		Applications filed on the same date for a same or similar trademark			
		Famous	Well-known	Used/Not well-known	Not in use
Application subject to examination	Famous	Multiple registrations	○	○	○
	Well-known	×	Multiple registrations	○	○
	Used/Not well-known	×	×	Multiple registrations	○
	Not in use	×	×	×	Multiple registrations

\* ○: single registration    ×: refusal

\* “Multiple registrations” include cases where there are more than two trademark registrations.

4. Article 51(2) of the Trademark Act shall apply where five years have not elapsed since the date of the trial decision that the trademark registration should be cancelled, which was established under Article 52-2(1) of the Trademark Act applied under Article 8(5) of the Supplementary Provisions.

5. Rules 1 to 4 above shall also apply to applications for international trademark registration.