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**RESEARCH THEME:**

**THE STUDY OF THE APPEAL BOARD SYSTEM OF JAPAN FOR THE  
FUTURE DEVELOPMENT OF APPEAL BOARD SYSTEM IN CAMBODIA**

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## Abstract

After the positive development of IP system in Cambodia and recent accession to international treaties especially the Madrid Protocol, there foreseen the positive trends for the using and paying more attention on the IP rights as well as promoting and protecting the IP rights as the branding tool for diversification their business. As the result, among other things, inherently the conflict over the IP rights exist and increase and there needed to be addressed and paid more attention on.

The long-term research study organized and sponsored by the Japan Patent Office (JPO) provides the best platform for the study of the IP dispute resolution system in Japan being regarded as one of the most trustworthy system among other developed countries in the world. The main theme of this research is to study about the Appeal Board System of Japan for the future development of the Appeal Board System in Cambodia. Due to the time constrain and different IP administration in Cambodia, the study research will be covered only the Appeal Board System for trademark cases and will be looked into detail the operation system of JPO appeal board and its procedures and proceedings for handling the disputes over the trademark rights.

This report has been compiled from different sources of updated data both from primary and secondary data. The lists of interview questions to JPO Appeal Board members in charge of trademark cases have been tailored in according with submain points of the research theme and the meeting and discussion with the relevant stakeholders have been held to get the fresh and useful information, comments and advices for the inputs of the report.

The collected data has been analyzed by using the comparison method between the two systems. The comparison is looked into detail each of the procedures and proceeding of appeals and trials as well as the operation system adopted by the Trial and Appeal Department of JPO and the Department of Intellectual Property. The differences and similarities of both systems have been identified. Upon the analysis and identification of the differences and similarities between both systems, some proper and feasible recommendations have been identified and proposed based on the experiences and best practices of Japan trials and appeals system for the future development of Appeal Board system in Cambodia.

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## 1. Introduction

Intellectual Property System in Cambodia has been dramatically developed since 1990. From day to day, Cambodia IP system and knowledge become stronger and stronger and has been well develop. Recognizing the important of IP for the national economic growth and poverty reduction, the Royal Government of Cambodia pays more focus on IP development and awareness and sets the IP matter in its agenda and strategic plan. To achieve the goals, competent Ministries in particular Ministry of Commerce, Ministry of Industry and Handicraft, and Ministry of Culture, and Fine Arts work very hard on these matters. As the witness of these efforts, IP awareness and knowledge have been positively increased and developed.

IP system in Cambodia is not an one-window office. IP matters are under the authority of three different Ministries such as Ministry of Commerce, Ministry of Industry and Handicraft and Ministry of Culture and Fine Arts. Each Ministry plays a vital role in the main branches of IP. The Ministry of Commerce, the Department of Intellectual Property (DIP) is responsible for trademarks, GIs, trade secret and act of unfair competition. The Ministry of Industry and Handicraft, the Department of Industrial Property has the authority over the patent, utility model, industrial design and plant variety. The Ministry of Culture and Fine Art, the Department of Copyright and Related rights oversees the copyright and related rights matters.

IP assets as the driven economic grow in this modern and technology era have become the focus and priceless intangible assets for the individual, entities and society as a whole. Therefore, it is necessary needed a strong legal framework and institutions to effectively protect and enforce the exclusiveness of IP rights.

Cambodia is not distingue from other developing countries as the IP has been gradually and well developed from day to day, IP matters and concerns inherently emerge. Many counterfeited, pirated products and infringement IP rights have been occurred everyday especially in the city and our main provinces. Some cases have been positively resolved and some other cases have not. These somehow are due to the lack of IP awareness of both right owners and infringers, enforcement authority, specific IP resolution procedures and the belief in competent authority.

Cambodia does not have a specific court or ADR for IP cases 'settlement. There are only general courts that are handled all civil and criminal cases. Courts compose of Courts of First Instance, Court of Appeal and Supreme Court. Every court case including IP matters are lodged to the Court of First Instance in province its base. It is very time consuming and cost to handle the case through these three level courts. Many right owners reluctant to bring their action against the infringement due to imbalance cost and benefit they gain from the court settlement.

Beside the court system, in DIP, there is also a Litigation Division. It is responsible for trademark disputes, facilitation, negotiation and non-binding resolution. There are not many cases handed in the Division every year despite many infringed cases on the market. It is covered trademark cases and neither of other Departments of other two Ministries have specific divisions for the IP cases settlement.

Despite many main IP laws and regulations have been enacted such as Law Concerning Marks, Trade Names and Acts of Unfair Competition; Law on Geographical Indications; Law on Patent and Industrial Design; Law on Plant Variety and Breeder's Right and Law on Copyright and Related Rights but there is still not have specific regulations and procedures for IP dispute resolution.

Due to the above mention matter, to my point of view, there is a requirement to establish the IP Appeal Board. In line with this establishment, there also shall have a clear procedure for the IP disputes settlement.

In order to establish this Appeal Board, some main factors as following are to be taken into considerations:

1. How is Appeal Board established? Regarding to this, the following points shall be focused:

- Its organizational and management structure,
- Its functions and compositions, and
- Its operating system.

2. What are the ways to work the Appeal Board effectively and efficiently? As it is not so hard to establish something but the really hard and complicated is to work its effectively and efficiently. This will look into detail the following point:

- The strategies for the Appeal Board work effectively and efficiency in handling the cases,
- The capacity building scheme for the members of Appeal Board, and
- The encouragements for the better performance of the members of Appeal Board.

3. How are its procedures and proceedings to handle IP disputes including the hearing procedures? These will be focused on:

- General procedures for the appeal against examiner decision of refusal, opposition, invalidation, cancellation and infringement,
- Documentation proceeding
- Hearing proceeding
- How to examine the cases,
- Appeal decision.

Through this research study, it is hopefully expected that all the above matters have been handled well. Knowledge, experiences, practices; challenges, major concerns and good role model and sample of Japan Appeal Board System have been learnt and possibly played as a model step for establish IP Appeal Board in Cambodia.

## 2. Basic Information and Previous Studies

### 2.1. Overview of IP System of Cambodia

#### 2.1.1. IP Administration of Cambodia

After becoming the member of the World Intellectual Property Organization (WIPO) in 1995 and the World Trade Organization (WTO) in 2004, Intellectual Property System in Cambodia gradually well develop and has a positive trend for the protect and using Intellectual Property Rights as the vital tool for the national economic growth and poverty deduction in line with the Government Rectangular Strategy. In order to comply with international standard and reduce the development gap within the region and international, many main IP Laws and regulation and IP international treaties and conventions have been enacted and acceded to, respectively. In addition, international cooperation in the IP fields has been broaden and strengthen with the countries in the region especially with the international organizations such as WIPO, JPO, SIPO, etc., that contribute a lot to the development of IP in Cambodia.

In Cambodia, IP matters have been governed by three different government agencies and each responsible ministry has the authority and obligations to protect and promote the development of each respective IP field.

Besides these three IP Offices, there is also a National Committee for Intellectual Property (NCIPR) that was established in 2008 by the Royal Government of Cambodia

The main purposes of establishing the committee are to:

- Stimulate and assure a single national policy on intellectual property,
- Enhance a smooth cooperation between ministries and institutions,
- Prepare, disseminate, and enforce laws and regulations of intellectual property rights,
- Receive and utilizing effectively technical assistances,
- Cooperate with competent authorities and courts to prevent and eradicate infringement IPR, and
- Research and study of international agreements and conventions related to IPR for membership of Cambodia.

The committee comprises of 14 ministries as the members as the following.

1- Minister of Commerce	: Chairman
◦Department of Intellectual Property Rights (DIP)	: Secretariat
2- Secretary of State of MIH	: Vice Chairman
3- Secretary of State of MCFA	: Vice Chairman
4- Office of Prime Minister	: Member
5- Ministry of Interior	: Member
6- Ministry of Economics and Finance	: Member
7- Ministry of Information	: Member
8- Ministry of Telecommunication	: Member
9- Ministry of Health	: Member
10- Ministry of Agriculture	: Member



11- Ministry of Environment	: Member
12- Ministry of Justice	: Member
13- Ministry of Education	: Member
14- Ministry of Tourism	: Member

### **Department of Copyright and Related Rights, the Ministry of Culture and Fine Arts (MCFA)**

The matter related to copyright and related rights are under the exclusive authority of the Department of Copyright and Related Rights of the Ministry of Culture and Fine Arts.

The Department of Copyright and Related Rights comprises of five divisions as the following:

- Administrative Division,
- Registry Division,
- Research and Development Division,
- Education and Dissemination Division, and
- Collective Management Organization Division.

The Department is governed by one director with the assistance of many deputy directors. Each Division is led by one chief Division and many deputy chief and officials as the assistances.

According the ministerial declaration on the establishment and functioning of the Department of Copyright and Related Rights, the infringement rights of copyright and related rights cases will be administered and handled by the Administration Division.

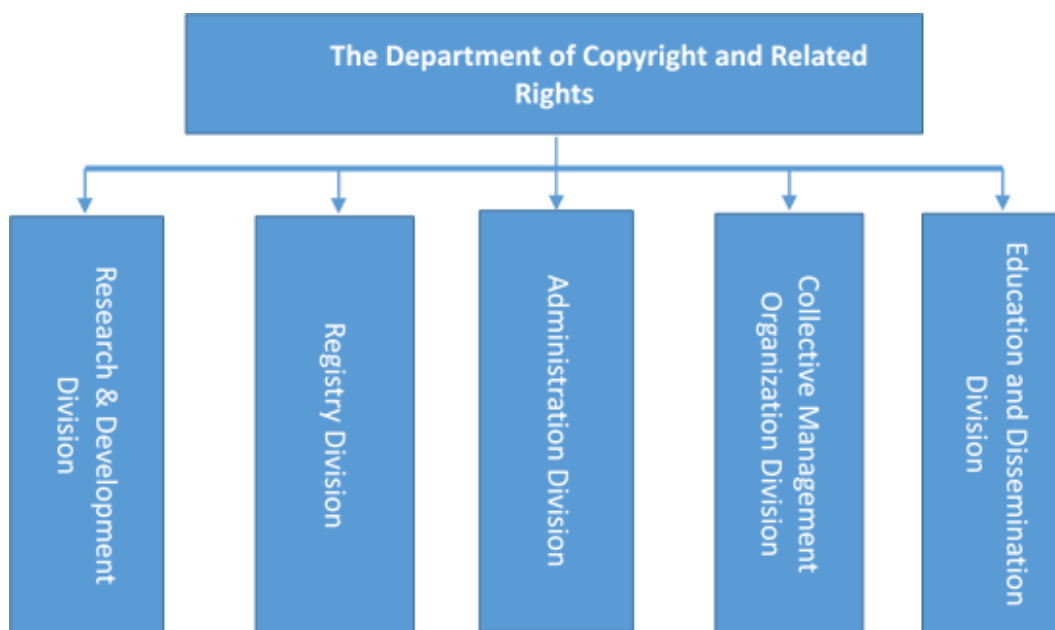


Figure 1. Organizational structure of the Department of Copyright and Related Rights

## The Department of Industrial Property, the Ministry of Industry and Handicraft

The Department of Industrial Property is the administrative authority governed the matters related to patent, utility model, industrial design, and plant variety. The Department is administered by one director with the assistance of many deputy directors.

The Department comprises of five following divisions and an innovation and creativity center:

- Administrative Division,
- Patent Division,
- Industrial Division,
- Breeder's Rights Division, and
- Dispute Settlement and Cooperation Division.

Each division is led by one chief division with the assistance of many deputy chiefs and officials.

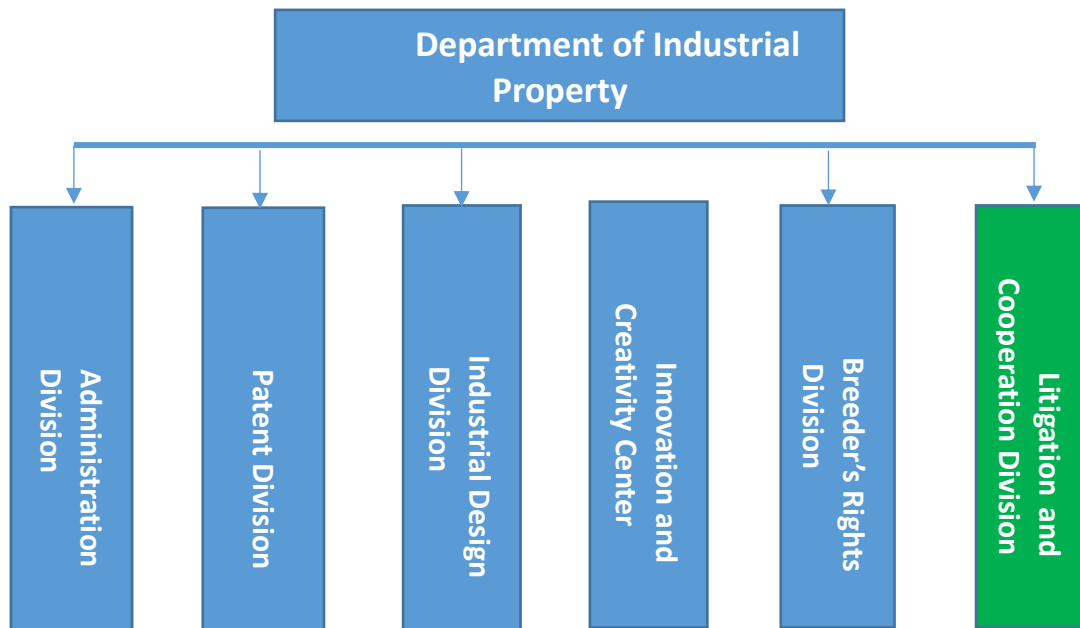


Figure 2. Organizational structure of Department of Industrial Property

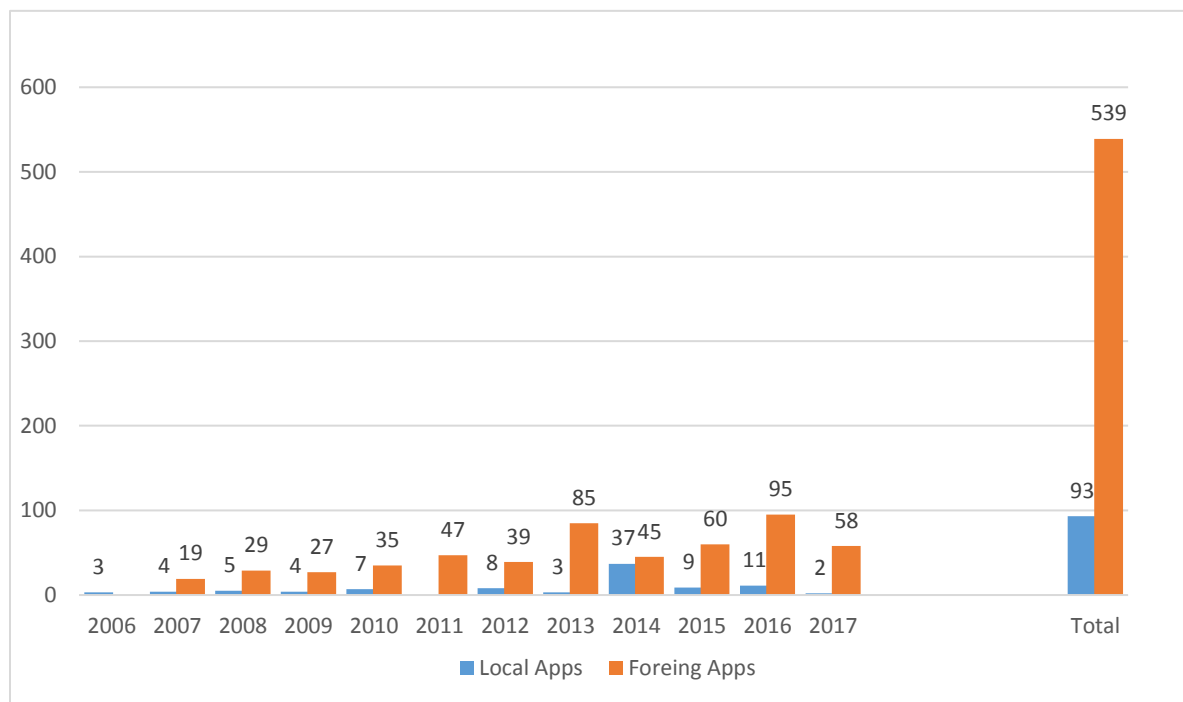


Figure 3. Industrial Design Application Data

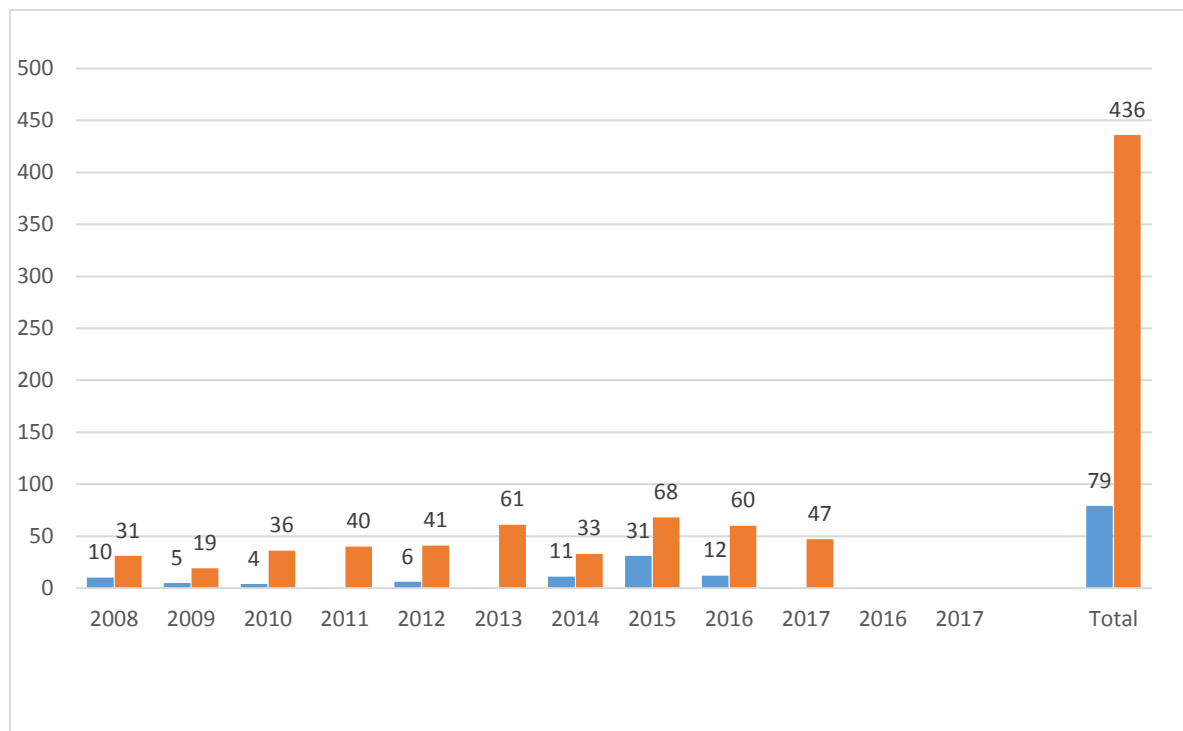


Figure 4. Registered Industrial Design Data

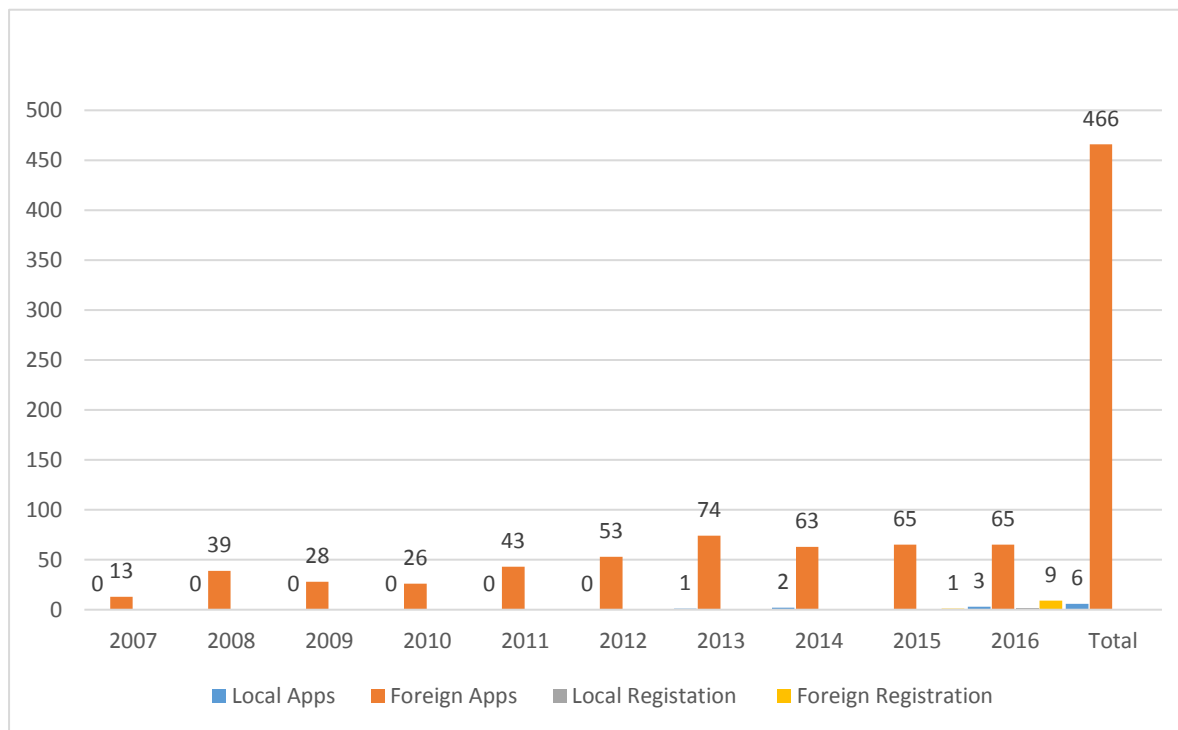


Figure 5. Patent Application and Registration Data

#### Department of Intellectual Property (DIP), the Ministry of Commerce (MoC)

DIP is an affiliate of the Ministry of Commerce, which is responsible for trademarks, collective marks, certification marks, geographical indications (GIs), and trade secret. DIP is governed by one director and many deputy directors as the assistances. DIP has nine specific divisions including:

- Administration Division,
- Mark Registrations Division,
- Post Mark Registrations Division,
- International Mark Registrations Division,
- GIs and Trade Secret Division,
- Information and Technology Division,
- Education and Public Awareness Division,
- Cooperation and Legal Affairs Division, and
- Litigation Division.

Each Division is administered by one chief division and up to four deputy chiefs as the assistances.

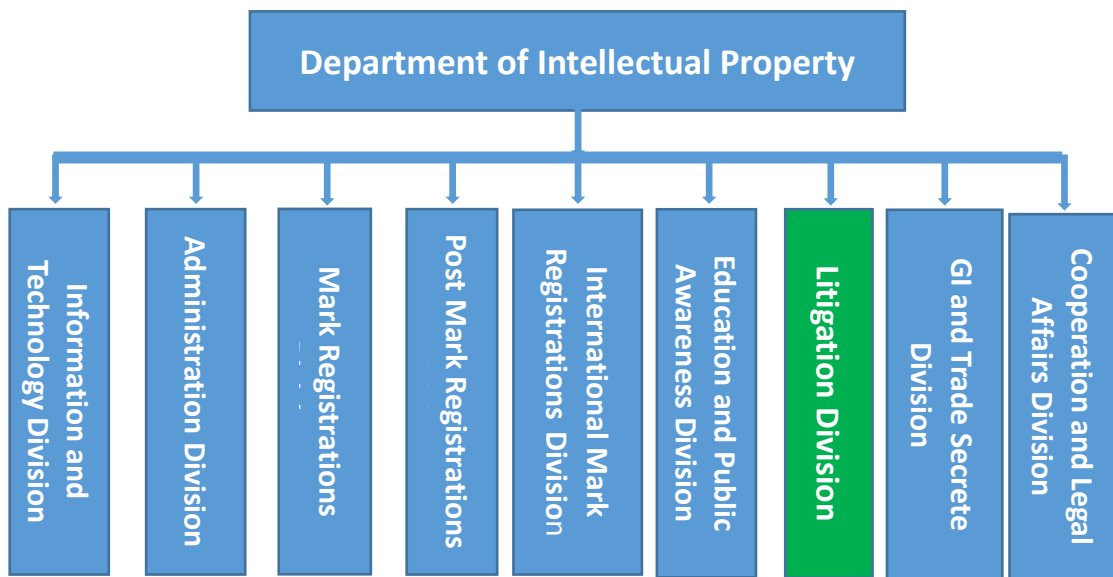


Figure 6. Organizational structure of the Department of Intellectual Property

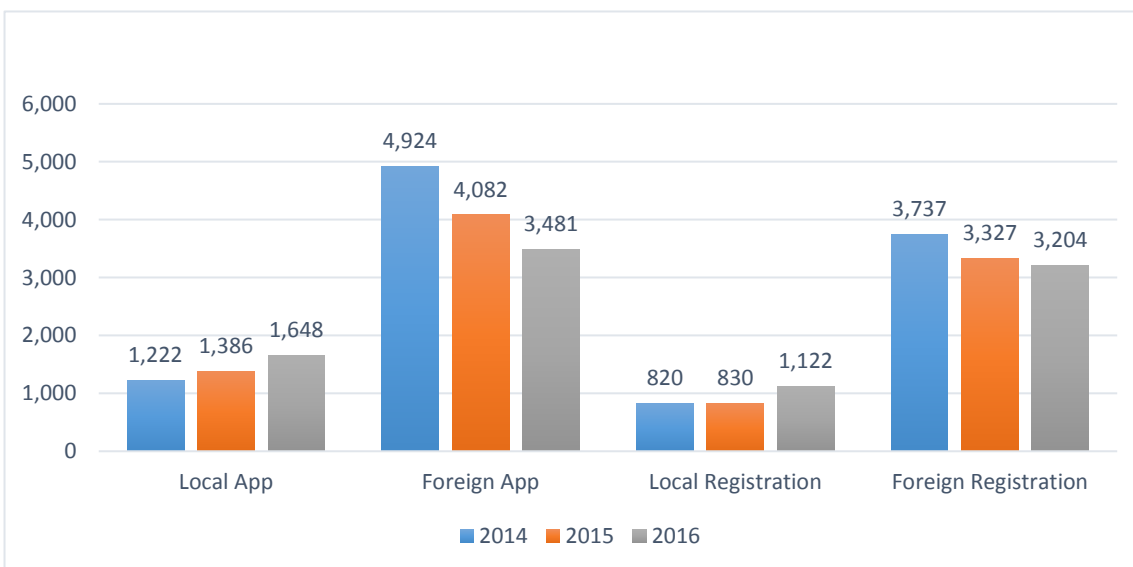


Figure 7. Statistic data of Trademark Application and Registration

### 2.1.2. IP Dispute Resolution in Cambodia

As the IP matters are administered by the three different ministries, the conflicts over the IP rights will be handled by the responsible departments in the respective ministries.

The conflicts over the Patent, Industrial, utility model and plant variety rights and their validity will be settled by the Department of Industrial Property of the Ministry of Industry and Handicraft.

In the Department, there is a Litigation and Cooperation Division, which is responsible over the conflicts of patents, industrial designs, utility models and plant variety. Seemed as the patent field in Cambodia is not so well developed and there still needed the great effort for the development for both the public and private sectors especially in the field of human resource development. Since the development of this field is still limited, there are not many applications and most of the applications are the foreign ones. It is also noted that currently the Department of Industrial Property of the Ministry of Industry and Handicrafts only do the formality examination and the substantive examination will be done by the cooperated partners who have the authority on it. For the cases over patent, there seems no case exist yet but there are a few for industrial designs.

For the disputes over the copyrights and related rights will be gone to and handled by the Department of Copyright and Related Rights of the Ministry of Culture and Fine Art. There is also not many cases related to these, but there are still some concerns over the piracy of the copyrighted and related righted products in the market place. With the purpose of the promotion, effective protection and contribution the reduction of the piracy of copy right and related rights, the Collective Management Organization (CMO) system has been established by the Ministry of Culture and Fine Arts in 2016. But there is still not any CMO established yet. With the efforts of the Ministry and cooperation with other stakeholders in the field, there is a positive trend for the establishment of CMO in the near future.

As the study research study is scoped only on trademark cases, there will be not looked into detail of the patents and copyrights cases.

Trademark field in Cambodia can be regarded as the most developed one by comparing the other IP fields such patent and copyright. The Department of Intellectual Property of the Ministry of Commerce plays very vital role in this field in term of the enforcing trademark Law, handling and acting as the mediator to settle the conflicts over the trademark right matters.

Trademark applications have been increased year by year as indicated in the above diagram. Especially after accession to Madrid Protocol in 2015, the international applications also have been increased year by year as designated Cambodia for the trademark protection. As the number of applications gradually increase, apparently the number of refusal decisions of examiner, oppositions, cancellations and invalidations also increase.

In current practice, the appeal against refusal decisions of examiner will be solved by the Mark Registration Division and the cases will be assigned and handled again by the same examiner who issued the decision of such refusal and the reexamination based mainly on the provided supporting documents by the party. Article 18 paragraph 2 of the Sub-decree on the Implementation of the Law Concerning Marks Trade Names and Acts of Unfair Competition (Trademark Law) states that the applicant is entitled to appeal against the Registrar's decision to refuse the application to the Appeal Board of the Ministry of Commerce or to the competent court within three (03) months counting from the Decision date.

Regarding the opposition, cancellation and invalidation of the trademark registrations, there will be handle by the Litigation Division that has the following main functions:

- Preparing and drafting the procedures and regulations related to IP disputed settlements,
- Proposing and implementing any projects for the improvement of IP dispute settlement system,
- Examining and handling the opposition, invalidation, cancellation cases including any disputes arising from the record of exclusive rights,

- Examining and evaluating the infringement cases upon the request from the parties, competent authorities or courts,
- Handling IP infringement related cases through the mediation process,
- Cooperating with Provincial Departments and other competent authorities to prevent and eradicate the counterfeit products on the market,
- Cooperating with other competent authorities in handling other IP infringement cases related to folklores, traditional knowledge and genetic resources,
- Hearing the IP cases as necessary or with the request from the parties,
- Participating in the Court hearing on IP cases, if there is any requested,
- Promoting the awareness of IP infringements to the public and other assigned takes.

Article 24 paragraph 7 of the Trademark law provides the possibility to the party who does not satisfy with decision of invalidation or cancellation of trademark registration to appeal against such decisions to the Appeal Board of the Ministry of Commerce or competent court within three (03) months starting from the date of the decision.

Currently, the Appeal Board have not been established yet. As a result, there is only one way to appeal against all such above cases by the dissatisfied party is to the competent courts. In addition, there is no any IP court or special court dealing with IP cases yet and also the judge human resources in IP field is still limited. There is only general courts therefore any take action to the court will go through the general courts. The presentation of the Appeal Board in the future is

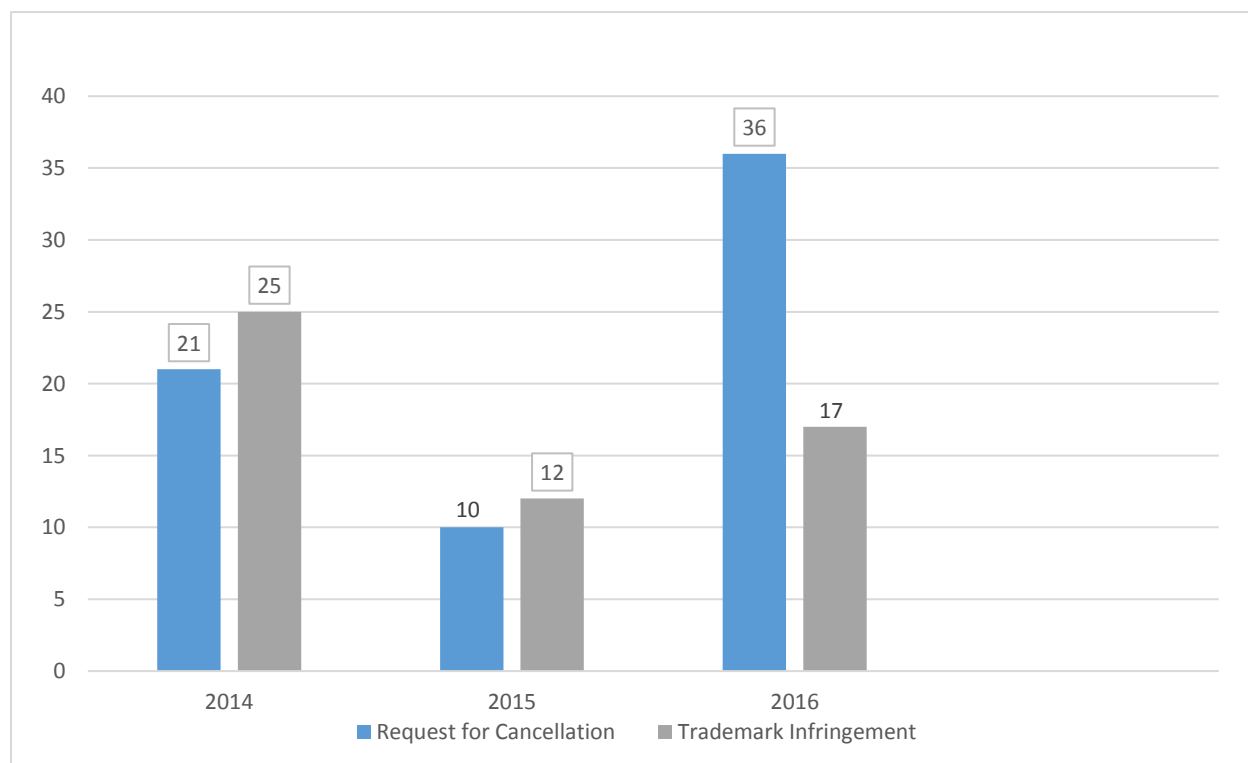


Figure 8. Trademarks Cancellation and Infringement Data

needed and it is also in line with the plan of the Department to establish the Appeal Board. The establishment of Appeal Board is also clearly stated in the Sub-decree of the Trademark Law in Article 18 (2) (3) and Article 24 (7) (8) (9) .

The establishment of Appeal Board will provide best choice and possibility for the party to appeal against the decisions of such above-mentioned cases before proceeding to the court actions as the court proceedings are frequently slow, is time consuming and costing. Due to these, many parties reluctant to hear their cases at court. The existent of the Appeal Board will play a great role in handling all the IP disputes in the most timing and cost effective and efficiency way.

### 2.1.3. Cambodia Court system

According to Article 62 of the Trademark Law, any decision taken by the Ministry of Commerce may be the subject of an appeal by any interested party before the Courts and such appeal shall be filed within three months of the date of the decision. As have been mentioned above, Cambodia does not have any IP or special court for dealing with IP cases. All the cases will be gone through the general competent courts. The general court shall be classified as the Court of First Instance, Court of Appeal and Supreme Court. The judgement of the Court of the First Instance will be subject to be appealed by the dissatisfied party to the Appeal Court and if any party does not satisfy with the appeal decision will appeal to the Supreme Court.

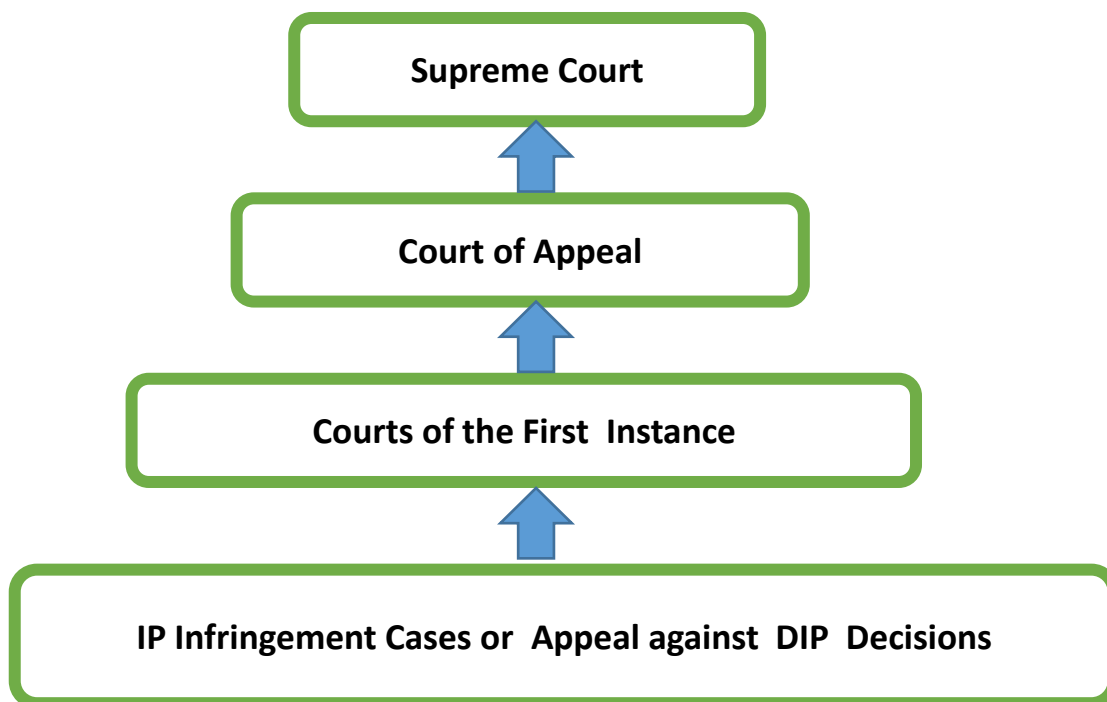


Figure 9. Cambodia Court system



## 2.2 Overview of IP System of Japan

### 2.2.1. Overview of Japanese Trademark System

Japanese Trademark Act began with the modernization of the nation since Meiji restoration in 1868. At that time, six Roppo codes had been compiled by the government in order to reform the society and to introduced the new capitalistic economy. These compiled codes were based primarily on German and French Law. The Roppo consisted of Civil Code, Civil Procedure Code, Criminal Code, Criminal Procedure Code, Commercial Code and Constitution.

The first Trademark Act took effect in 1884 in one of the modernized statutes. The Act introduced the first trademark rights and provided guideline for the registration procedures, substance of a mark and remedies against the infringement. Since the first enactment in 1884, there were completely revised the Trademark Act in 1888, 1899, 1909 and 1922 due to the economic needs and evolvement at the time [Suzuki, 2001].

The current Trademark Act was promulgated on April 13, 1959 and enacted on April 1, 1960 base on the Trademark Ordinance on 1888, the Trademark Act on 1899, the Trademark Act on 1909 and the Trademark Act on 1922 [JPO, 2017]. . The current Trademark Act has been partially revised several times to cope with changing national and international matters.

Table 1 indicates the major revisions to the current Trademark Act [Hayahi, 2017].

Table 1. Major revisions to the current Trademark Act in Japan

Year	Main points of recent revisions
<b>1991</b>	<ul style="list-style-type: none"> <li>- Introduction of registration system for service marks</li> <li>- Revision of relevant regulations along with Japan's adoption of the international classification system (Nice Agreement).</li> </ul>
<b>1994</b>	<ul style="list-style-type: none"> <li>- Revision of relevant regulations resulting from the accession to the Marrakesh Agreement establishing the World Intellectual Property (WIPO)</li> </ul>
<b>1996</b>	<ul style="list-style-type: none"> <li>- Revision of relevant regulations as a result of accession to the Trademark Law Treaty</li> <li>- Adoption of three-dimensional (3D) trademark system</li> <li>- Introduction of collective trademark system</li> <li>- Introduction of the post registration opposition system</li> </ul>
<b>1999</b>	<ul style="list-style-type: none"> <li>- Revision of relevant regulations as result of accession to the Protocol Relating to the Madrid Agreement Concerning International Registration of Marks</li> </ul>
<b>2005</b>	<ul style="list-style-type: none"> <li>- Introduction of the regional collective trademark system</li> </ul>
<b>2006</b>	<ul style="list-style-type: none"> <li>- Introduction of the registration system for retail and or wholesale services</li> </ul>
<b>2014</b>	<ul style="list-style-type: none"> <li>- Introduction of the registration system for non-traditional trademarks (sounds, colors, movement, position and hologram trademark).</li> </ul>

## Japan IP Administration

IP administration of Japan is under the authority of two different Ministries. The industrial property rights are governed by the Japan Patent Office (JPO) of the Ministry of Economy, Trade and Industry (METI) and Copyright and Related Rights are under the responsibility of the Japan Copyright Office (JCO) of the Agency for Cultural Affairs (ACA), which is a part of the Ministry of Education, Culture, Sports, Science and Technology (MEXT).

### Japan Patent Office (JPO) [JPO, 2017]

JPO is an affiliated agency of the Ministry of Economy, Trade and Industry (METI). The main roles and functions of JPO are 1) appropriate granting of industrial property rights, 2) drafting of industrial property-related measures, 3) promotion of international harmonization and assistance to developing nations, 4) reviews of the industrial property rights system, 5) implementation of support measures designed for SMEs and universities, and 6) improvement in industrial property-related information services. The organizational structure of JPO is shown in Figure 10.

### Japan Copyright Office (JCO)

The protection of copyright and related rights are administered by JCO. The JCO plays a vital role in protecting, promoting and developing the copyright and related rights fields of Japan. JCO also is the authority in charge of planning and carrying out the copyright policies such as drafting the copyright and related rights laws and regulations, improving the right clearance systems, setting up new policies to cope with the development of digitization and network, supervising over the collective societies, promoting and providing educational activities for experts and the general public, participating in international norm-setting, cooperation programs for developing countries, countermeasures against piracy, etc. Figure 11 is the diagram of the structure of the governmental organizations related to copyright.

## 2.2.2 IP Dispute Resolution in Japan

IP dispute resolution in Japan, currently, uses a two-track system, with the Board of Appeals of the Japan Patent Office (JPO) dealing with the appeals, opposition, trial for invalidation and cancellation and special IP court system dealing with infringements and appeal against the JPO decisions.

In dealing with conflict over the IP rights and the validity of IP rights, JPO vests its power to deal with these issues to its special department, so called the Trial and Appeal Department. The Depart acts as the upper level authority to oversee and review the decisions of the examination in case there are any appeal demanded by any party and play a vital role in redetermine the validity of any IP rights. The JPO Appeal Board is an administrative authority that has a special characteristic as a quasi-judicial<sup>3</sup>. Its decision is equal to the decision of the First Instance Court; any appeal against its decision will go directly to IP High Court.

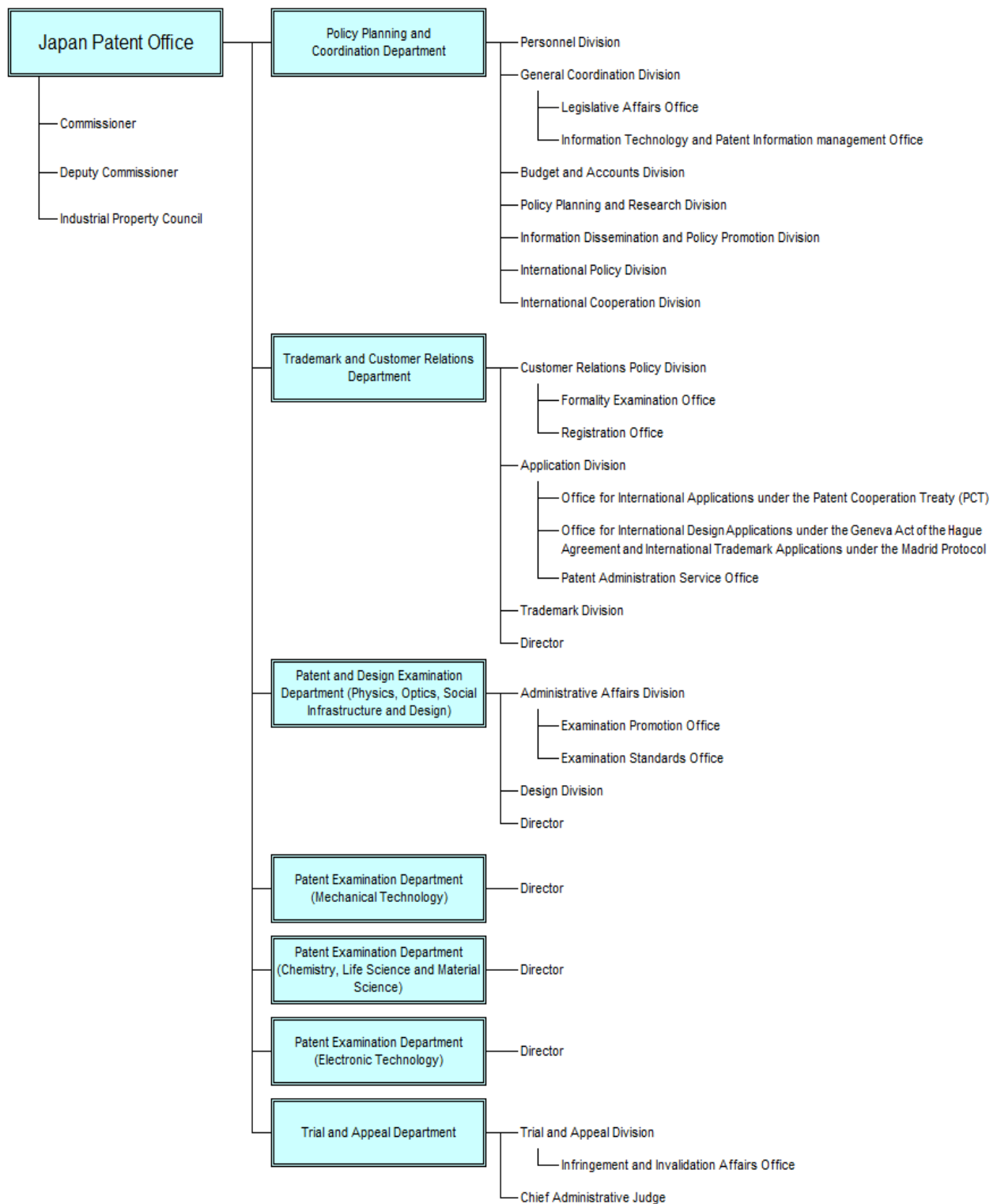


Figure 10. The Organizational structure of JPO

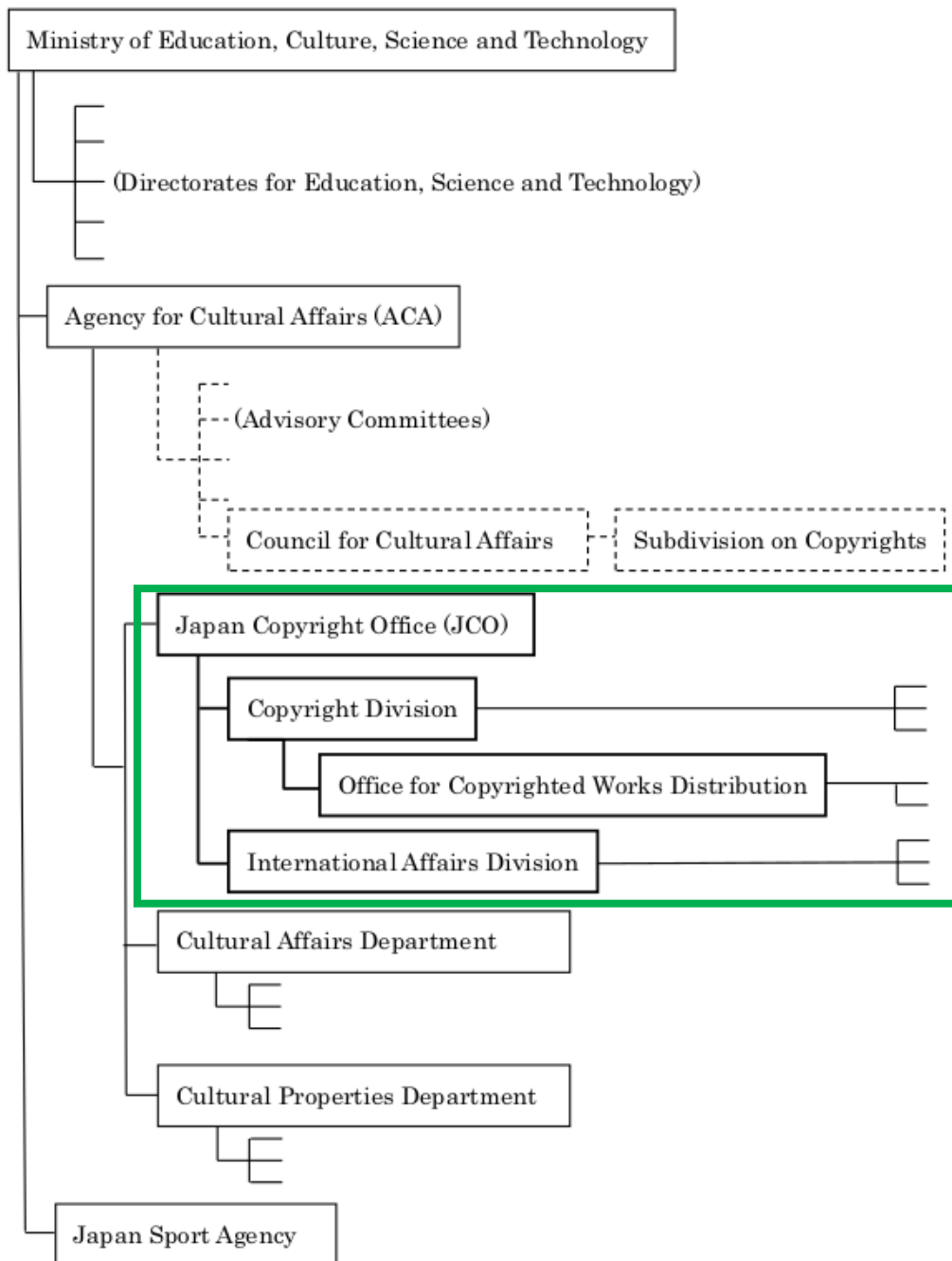


Figure 11. The structure of the governmental organizations related to copyright

### 2.2.2.1 The Trial and Appeal Department

The Trial and Appeal Department is an affiliated organization of the Japanese Patent Office (JPO) consisting of 38 trial and appeal boards, a trial and appeal division, and a litigation affairs office. The Department is governed by a Director General and there is one executive chief administrative judge in charge of supervising all boards, especially those dealing in litigation. Director of the Trial and Appeal Board is designated among chief administrative judge. In addition, each board consists of one director and a plurality of administrative judges.

#### Trial and Appeal Boards

There are a total of 38 trial and appeal boards, which categorized according to the specialization in the patent, industrial design and trademark field. There are 33 boards for patent including boards for physics, optics, and social infrastructures (1st to 8th boards), boards for machinery (9th to 16th boards), boards for chemistry (17th to 25th boards), boards for electronics (26th to 33rd boards), one board for Design (34th board) and 4 boards for trademark (35th to 38th boards). The detail outline of JPO Appeals Department field outline of the section is attached in the appendix.

Each board handle each specific designated case in according with their respective specialization.

#### Trial and Appeal Division

The Trial and Appeal Division conducts the following main duties:

- Handling the communication arrangement tasks concerning the appeal against industrial property rights and the opposition to registration of a trademarks;
- In charge of tasks concerning the appeal and opposition cases;
- A designated agent of the Commissioner of JPO dealing with the litigations related with a cancellation of an appeal decision on the industrial property right and a cancellation decision of the trademark registration.

In addition, under this division, there are two specific offices namely Trial and Appeal Planning Office and Infringement and Invalidation Affairs Office. The Trial and Appeal Planning Office main responsibly is dealing with conducting researches and plans on the basic matters concerning the operation and processing the trial and appeal system. On the other hand, Infringement and Invalidation Affairs Office is in charge of conducting the proceedings for an invalidation, cancellation appeal against the industrial property rights, and a correction.

Litigation Affair Division only deals with the litigation to the court in the cases where the JPO is the defendant in the court action. In cases where the appellant is dissatisfied with the JPO decisions in the ex parte cases, appellant will take action against such decisions to the IP High Court. Such a case, JPO will be the defendant of the appellant action to the court. In such this procedure, litigation affair office is responsible for confronting and taking part in the court procedure for such dispute. For further action against the decision of IP High Court, there still under responsibility of the office and the office also can take further appeal action to the Supreme Court against the decision of the IP High Court [Meeting with the ASEAN India Committee of Intellectual Property Japan].

The main roles of trials and appeals system are as the following [JPO, 2017].

- The upper instance of examination: review the decision of examiner (appeal against examiner's decision of refusal or refusal of amendments) and improve the reliability of rights (opposition to registered trademark), and
- Accelerated the resolution of disputes: determination the validity of rights (trial for invalidation and cancellation) and expert opinion of the scope of the rights (Hantei).

JPO Appeal Board does not deal with the infringement actions. The infringement actions is under the exclusive authority of the court that have jurisdiction over the cases. But during the infringement court procedure, there might be parallelly the invalidation or cancellation trial to JPO over the validity of IP rights over the cases. But at the end, JPO must follow the decision of the court even though there is diverse between their decisions.

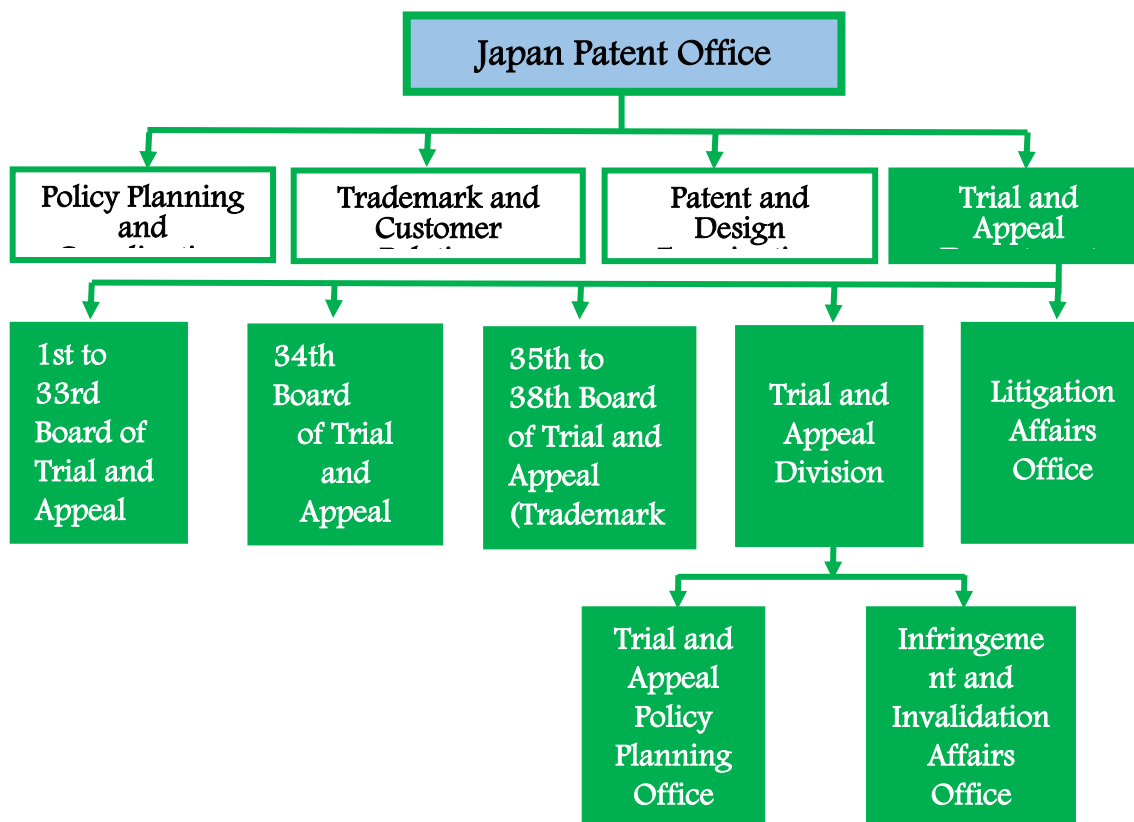


Figure 10. Organizational structure for the Trial and Appeal system in Japan

#### 2.2.2.2 Intellectual Property High Court (IP High Court)

In Japan, the whole judicial power is vested in the Supreme Court and in such inferior courts as are established by the law [Article 76, 1947]. The judicial system in Japan divided into the Supreme Court, High Courts and District Courts. The Supreme Court is the highest court in Japan. The High Courts are the second high-level courts that located in eight major cities in Japan: Tokyo, Osaka, Nagoya, Hiroshima, Fukuoka, Sendai, Sapporo, and Takamatsu. Each High Court composes of one president and several judges. In general, the high courts have jurisdiction over appeals against judgments by the district courts, family courts, and summary courts. The District Courts are the first instance courts that located in 50 cities—one in every prefecture except for Hokkaido, which is divided into four districts—and there are 203 branches throughout the country. District Courts are normally the courts of first instance for both civil and criminal cases [Supreme Court of Japan, 2017].

Intellectual Property High Court (IP High Court) which is a special brand of Tokyo High Court, was established on April 1, 2005 in accordance with the Law for the Establishment of the IP High Court (enacted on June 18, 2004) as a specialized court dealing with IP related litigations such as infringement litigation related to IP rights, IP-related lawsuits over the violation of the Unfair Competition Prevention Act, and suits against appeal/trial decisions made by the Japan Patent Office.

IP related litigation can be divided into IP related civil cases and suits against appeal/trial decisions made by the JPO.

IP related civil cases cover the cases claimed for damages or an injunction against an act of infringement of the IP rights; or a breeder's rights specified in the Plant Variety Protection and Seed Act; or of business interests as a result of unfair competition specified in the Unfair Competition Prevention Act. In general, the first instances of IP related civil cases are handle by district courts. The Japan court system is the three-tiered system that allow either party who is dissatisfied the judgement of the lower courts to appeal a lawsuit such judgement to the higher courts.

IP related civil cases related to technology of the patent, utility model rights, layout design exploitation rights for semiconductor integrated circuits, or the author's rights for a computer program works are under the exclusive jurisdiction of the Tokyo District Court or Osaka District Court, both of which have specialized divisions for IP related civil cases. Any appeal against such actions would be handle by the Intellectual Property High Court.

However, IP related civil cases related to non-technology matters such as design rights, trademark rights, author rights (excluding the author rights for computer program work), publication rights, neighboring rights, breeder's rights, or infringement of business interests caused by unfair competition, are under the jurisdiction of fifty district courts located throughout Japan including Tokyo District Court and Osaka District Court. Any appeal against such actions will be under the jurisdiction of one of the eight high courts located throughout Japan that corresponds to the district courts in charge of the first instance.

Regarding the suits against appeal/trial decisions made by the JPO, any person who is dissatisfied with the JPO decision of refusal of IP rights registrations, amendment of IP rights; opposition; invalidation trials; and cancellation trials may appeal against such decisions to the Tokyo High Court (Article 178 (1) of the Patent Act). These suits would be settled by the

Intellectual Property High Court. Any person who is dissatisfied with a judgement of Intellectual Property High Court may file a final appeal with the Supreme Court.

The Intellectual Property High Court comprises of the Litigation Department which consists of four ordinary divisions and the Special Division (Grand Panel), and the IP High Court Secretariat, which is in charge of administrative affairs.

The composition of IP High Court includes chief judge, other judges, and judicial research officials dealing with IP cases, court clerks, and court secretaries. Technical advisors may also be involved in IP cases as part time officials on a case-by-case basis.

In principle, IP High Court handles cases through a panel of three judges. In cases any appeal against actions of technology related actions and suit against an appeal/trial decision made by the JPO with regard to a patent or utility model are conducted by a panel of five judges (Grand Panel) which comprise of the four presiding judges from each of the four ordinary divisions as members of the panel in principle [Intellectual Property High Court, 2017].





### 3. Methodology of the Research Study

The theme of this research study is focus on the study of the JPO Appeal Board system for the development of Appeal Board system of Cambodia in the future. As the IP matters in Cambodia are governed by different government agencies, the study is only covered and addressed on the Appeal Board dealing with the trademarks cases. To focus on the above theme research, the following research areas shall be addressed:

1. The organizational structure of Appeal Board, its compositions and operational system,
2. The procedures and proceeding for handling the IP cases of the Appeal Board including the hearing proceeding.

As mentioned above, the research study mainly focus only the Appeal Board System of Japan especially Appeal Board for trademark cases. The data collection of the research study is used both the primary and secondary data. The collected data will be analyzed using the analytical and comparative approaches.

The secondary data are collected from various reliable sources of data, to name a few such as Japan Patent Office's website (<https://www.jpo.go.jp>), IP High Court, their reports, related previous studies, Japanese IP Laws and regulations, Manual for Trial and Appeal Proceedings (16th edition) etc., and other library based sources were also used to support the development of this research study.

The primary data are obtained from the interviews, study visit in the JPO Trial Court, attend the JPO trainings, and the consult with supervisor and advisors. For the interview, two question lists of interview with JPO Appeal Board members have been designed and tailored corresponding to the main areas of research study. The first list of interview is focus on the organizational structure of the Appeal Board of JPO, its compositions and operational system. The second list is addressed on the procedures and proceeding for handling the IP cases of the Appeal Board including the hearing proceeding. For the detail, the two question lists have been incorporated in the following:

#### JPO Interview Questions-Part 1 (Structure and operation system)

1. Could you briefly descript the history of establishment of Appeal Board and is there any challenges that JPO faced during the first introduction of Appeal Board?
2. There are 38 Boards of Appeal and Trials (4 Boards of Appeal and Trial for Trademark), Trial and Appeal Division and Infringement and Invalidation Office. What are the factors that shall be taking into account in structuring the organizational structure of the Appeal Board?
3. In addition to above question, what are the functions of Trial and Appeal Division and Infringement and Invalidation Office?
4. What are the most appropriate composition of Appeal Board especially in the situation that the IP human resource is limited? In connection with this, what are the basic required qualification for the Board members?

5. Up to now, how many total members are there in the Appeal Board and in each Board? Besides handling the assigned cases, is there any other responsibilities for Appeal Board members?
6. In JPO, what are the required qualifications and criteria to be appointed as the Appeal Board member and administrative judge?
7. After receiving the cases, how to assign the cases and appoint the appeal board members to specific cases?
8. In settling the cases, there will be solved by the collegial body that comprise of 3 or 5 administrative judges presided over by a chief administrative judge, What are the roles of chief and each administrative judge in the Panel?
9. Is there any limited term period or rotation for each administrative judge in each Board?
10. In the future, will there be any further trademark Board be established?
11. What are the source of budget for the operation of the board?
12. Is there any strategy for the Board to handling, managing and operating cases effectively and efficiency?
13. Are there any capacity building and encouragement schemes for the members of the board?

#### JPO Interview Questions-Part 2 (Cases handling procedures)

1. Most of the cases, Appeal Board proceeds with the documentary proceeding and in what circumstances, does Appeal Board conduct the hearing proceeding? What are the procedures for conducting hearing proceeding?
2. In some instance the hearing procedures have been requested or made ex officio, between the documentary proceeding and the combination of hearing and documentary proceeding which one is the best procedure in term of accuracy, effectiveness and time saving for handling the cases? Why?
3. In case there is a request for invalidation and cancellation of the registered trademark at the same time from different applicants, how will JPO handle the case in this situation?
4. During the opposition period and after JPO decision to maintain the registered trademark upon the opposition proceeding, the opponent cannot take further action against the decision, but then it will be able to request for invalidation or cancellation proceeding. In this case, would it be possible for the opponent to directly request for invalidation or cancellation proceeding without opposition?

5. For the invalidation and cancellation cases, does JPO have the ex officio action on these cases without the request from interested parties?
6. In designated an adequate time limit for the parties to submit their statement of arguments in each proceeding, how long should it be and what factors shall be taking into consideration in designated an adequate time limit for each proceeding?
7. How does the Appeal Board examine the evidences and make the decision?
8. In deciding the cases, the well-known and famous of the trademarks will be taken into consideration. What are the differences between the well-known and famous trademarks? What are the criteria to judge the well-known and famous degree of the trademarks?
9. How long does it take to handle a case with the Appeal Board?
10. After the invalidation or cancellation procedures reached an end and the decision to invalidate or cancel registered trademark have been issued, is there any action taken by JPO concerning the products bearing the registered trademark in the market?
11. The statistical data of Appeal cases and court cases
  - i) The total statistical data of the appeal, opposition and trial cases from 2016 to August 2017
  - ii) The total trademark statistical data of the appeal, opposition and trial cases from 2016 to August 2017 by specified its accepted, not accepted and dismissed, and withdraw/abandon
  - iii) The statistical data of Court cases against the Board decisions from 2014 to August 2017
12. During the infringement proceeding to the court, is there any role or participation of JPO in the court proceeding?

The answers of the above question lists are attached to the report in the Appendix.

After the collected data both from the primary and secondary sources have been studied and analyzed, some proper and suitable recommendations based on the Japan system will be visualized and suggested to DIP of Cambodia for the future development of its Appeal Board system.

There shall be noted that not every single practice, system, procedures and proceeding adopted by JPO Trial and Appeal System including the suggested recommendations will be followed or applied by the DIP. This is due to the differences of legal system, level of development, socio economic policies, cultural and human resources of each respective country. Thus, this paper will only suggest for the information, lesson learns and best practices that might be learnt or applied to some extend in DIP for the development of its Appeal Board system.

Please also noted that the ideas expressed herein the paper do not reflect of those of the Cambodia IP Offices. They are based solely on the personal thought and analysis of the writer only.

## 4. Results and Analysis

### 4.1 Types of Trial and Appeal of JPO

#### 4.1.1 Appeal against examiner's decision of refusal and trial against ruling to decline amendments

After trademark applications have been filed, the examiner will examine the applications. Through the examination process, if the examiner finds no reason to refuse the trademark application, the decision to register the trademark application will be rendered and notified the application for the payment of registration fee. But, in case the examiner finds that the applied trademarks do not comply with any requirements set out by the Trademark Law, before rendering the decision examiner will notify the applicant the reasons for refusal and give applicant an opportunity to submit a statement of argument, designating an adequate time limit. Within this time limit, if the applicant cannot overcome the reasons for refusal of examiner or amend the application to comply with the requirements, the examiner will rule to reject application or decline the amendment in writing and state the reasons thereof.

According to Art. 44(1) of Trademark Law states that a person who has received the examiner's decision that his application is to be refused and is dissatisfied may appeal against such decision to the Appeal Board within the period of three months from the date on which he received the examiner's decision.

If, due to some reasons outside his control, a person is unable to demand the trial within above limited period, the demand can be made within 14 days (2 months in case resident abroad) from the date when the reason ceased to be applicable but no later than 6 months from the expiration of above time limited. Reasons beyond his control are not only limited to the inability of the party due to acts of God or other unavoidable situations, but also include the inability due to any subjective or personal reason such as illness or other reasons that cause them unable to take action within the time limited, even though they took appropriate care [Ono, 1999].

The main reasons for the refusal of examiners includes the followings [Toyosaki, 2017].

- The goods of the applied trademark cannot be distinguished from those of other companies,
- The applied trademark is similar to the prior trademarks,
- The description of designated goods or services is not explicit,
- The applied trademarks falls under any other ground of unregistrability.

Moreover, Art. 45 (1) states that a person who has received a ruling to decline an amendment and is not satisfied may demand a trial thereon within three months for the transmittal of the ruling.

When there is a demand for trial against a ruling to decline an amendment, the examination process of the application will be suspend until the trial decision has become final and exclusive (Art 16-2(4)).

The suspension is because the content of the trademark or designated goods or services to be examined would be vary, depending on whether the demand for trial is accepted or dismissed.

## Appeal Process (1)

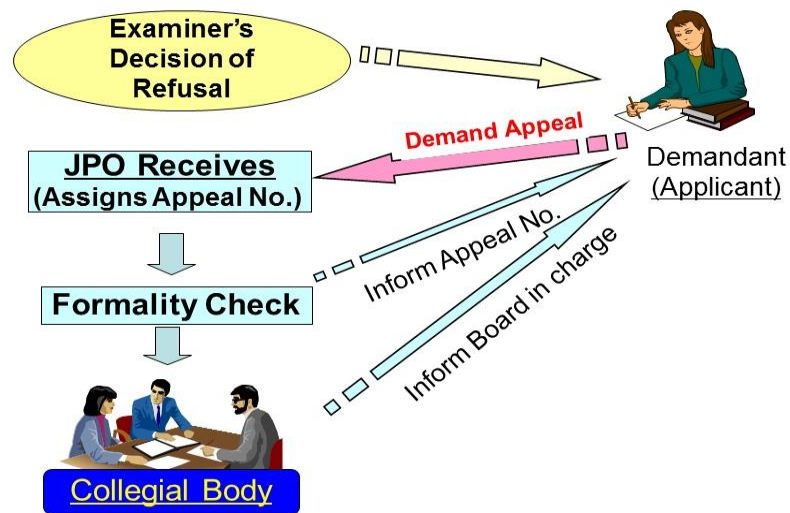


Figure 12. Flow chart of Appeal against decision of refusal of the examiner  
[Trial and Appeal Division, JPO, 2017]

## Appeal Process (2)

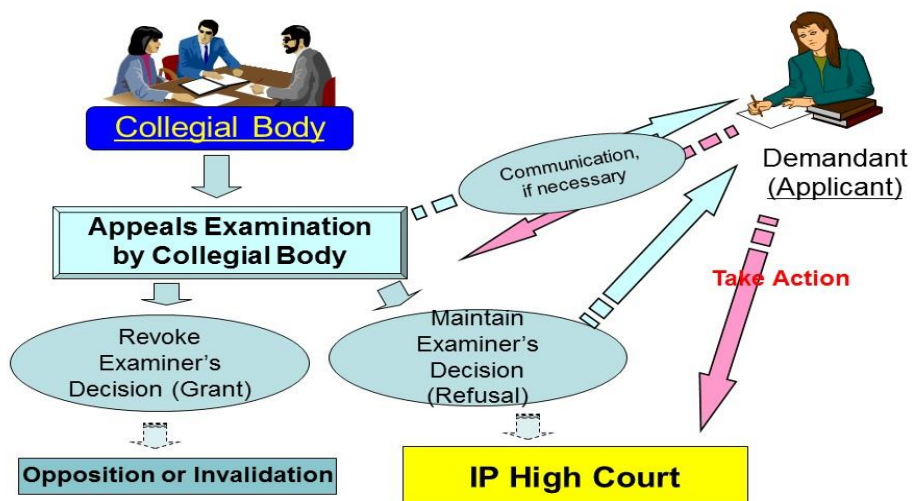


Figure 13. Flow chart of Appeal against decision of refusal of the examiner  
[Trial and Appeal Division, JPO, 2017]

#### 4.1.2. Trial for opposition

Before 1997, Japan adopted the pre-registration opposition system for the purpose of granting stable IP rights. Due to the shortening life cycles of products, stronger demand for the speed up granting of trademark registration and only percent of the JPO decisions were reversed on the ground of opposition which lead to the revision of Japanese Trademark Law in 1996 changing from the pre-registration opposition to post-registration system [WIPO, 2017].

The post registration system allows the opposition to be filed after the registration of trademark right and speeds up the registration process of trademarks as well as provides the opportunities for the third parties to file a request for rescission of trademark registration within the certain period of time after the publication of registered trademark rights in the official gazette.

As the nature of the opposition system is not to resolve the conflicts between the parties over the establishment of IP rights, the system does not restrict to only interested persons but widely available for any persons.

Post-opposition system allows any persons to file with the Commissioner of JPO an opposition to registration of trademark within 2 months from the publication of the registered trademark in the Gazette. If there are two or more items of designated goods or services are covered by the registered trademark, the opposition may be filed with respect to each such designated goods or services [Article 43-2, Trademark Act of Japan]. Some trademark registrations associated with applications filed on and after April 01, 2007 relate to designated goods or services for more than one category. In this case, the opposition may also be filed for each of designated goods or services regardless of their multi categories.

The opposition shall be filed in the written form to the JPO stating the following.

- The names and address of the opponent and or his representative;
- The identification of trademark registration concerned in the opposition;
- The grounds for opposition and indication of supporting documents.

Upon the written opposition was filed, the opponent shall not allow to change the gist of opposition but the grounds for the opposition can be amended before the lapse of 30 days after the expiration of opposition time limited ( 2 months from the publication in the Gazette). This period may be extended for further 60 days for resident abroad and 15 days for the resident living in the remote areas of Japan with the transportation difficulties by the Commissioner of JPO upon the request or ex officio.

The grounds of opposition to registration are restricted to those stated in the Article 43-2 of the Trademark Law as the following:

- Violation of registrability requirements of trademark;
- Violation of the unregistrability conditions of the trademark;
- Violation of requirements for registration of regional collective trademark;
- Violation of the prior rights of trademarks;
- Violation the first to file system;
- Violation the provisions of prohibiting re-registration of canceled trademarks. Any cancelled trademarks by the trial for cancellation of the registered trademark due to illegal used cannot

be re-registered until the lapse of five years from the date of the decision of trial become final and exclusive;

- Violation of the enjoyment of trademark rights by foreign nationals (national treatment);
- Violation of the provisions of relevant treaties;
- Violation of the requirements and condition for registration of defensive marks.

The opposition request may not be withdrawn after the notification of reasons for revocation of trademark registration of the trial examiner-in-chief. In addition, the withdrawal may be made in respect of designated goods or services if the opposition has been filed for more than one designated goods or services.

The main purpose of the post opposition system is to guarantee the appropriateness of the examination of trademark. Therefore the examination will be done by an examination body consisting of trial examiners in order to make sure that the examination is sufficient, fair, independent and accurately operated.

The examination of the opposition cases shall be conducted by a collegial body consisting of three or five administrative judges. The decision shall be made by the majority vote of the collegial members.

The examination shall be conducted by the documentary examination. Upon the request from the trademark right owner, opponent or intervenor, or ex officio, however, the trial examiner in chief may decide to conduct trial by oral trial [Article 43 (6), Trademark Law]. The date and place of the trial will be fixed by the trial in chief and summoned to the parties [Article 145 (3), Patent Law].

In the process of examination of the opposition to registration, all the grounds pleaded and the evidences submitted shall be considered and examined. Moreover, the trial examiners also have the right to make ex officio examination of any other grounds that are not pleaded.

Only the challenged designated goods or services raised by the opponent shall be examined.

In cases the opposition has been withdrawn with respect to only in part of the designated goods or services, the examination will be conducted only with rest of the designated goods or services.

After the examination, where the trial examiner in chief intends to render the decision of rescission of registration, he will notify the right owner of the trademark and intervenor the reasons for the rescission and gives the said persons the opportunity to submit a written opinion in a designated adequate time limit.

In the opposition process, the only action of the right holder of the trademark is to wait for the notification of reasons for rescission and to submit a written opinion responding to the notification. The right holder is not required to submit a written reply to the opposition of registration.

In general, there are two types of decision of opposition of the Appeal Board. If the trial examiner finds that the trademark registration under the opposition falls under any grounds of Article 43(2) of the Trademark Law, the trial examiner will render a decision to rescind the trademark registration (rescission decision). On the other hand, if trial examiner finds that the trademark registration under the opposition does not fall under any ground stated in the Article 43(2) of the Trademark Law, the trial examiner will render the decision to maintain the registered trademark. The decision of the opposition shall be rendered in writing and stating the following matters:

- The opposition number of the case,
- Names and address of trademark right holder, opponent, intervenor and their representative



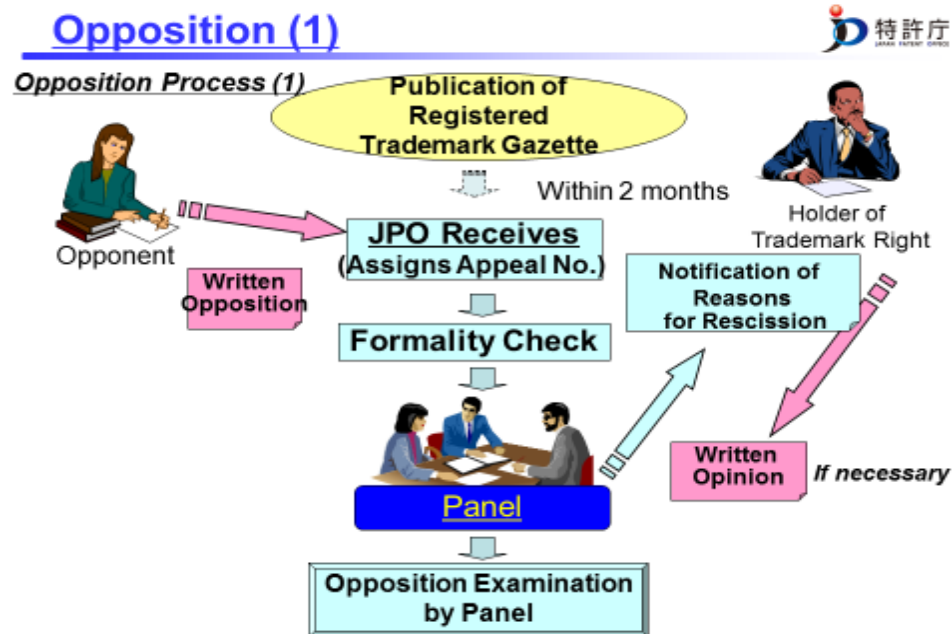


Figure 14. Flowchart of Opposition (1)  
[Trial and Appeal Division, JPO, 2017]

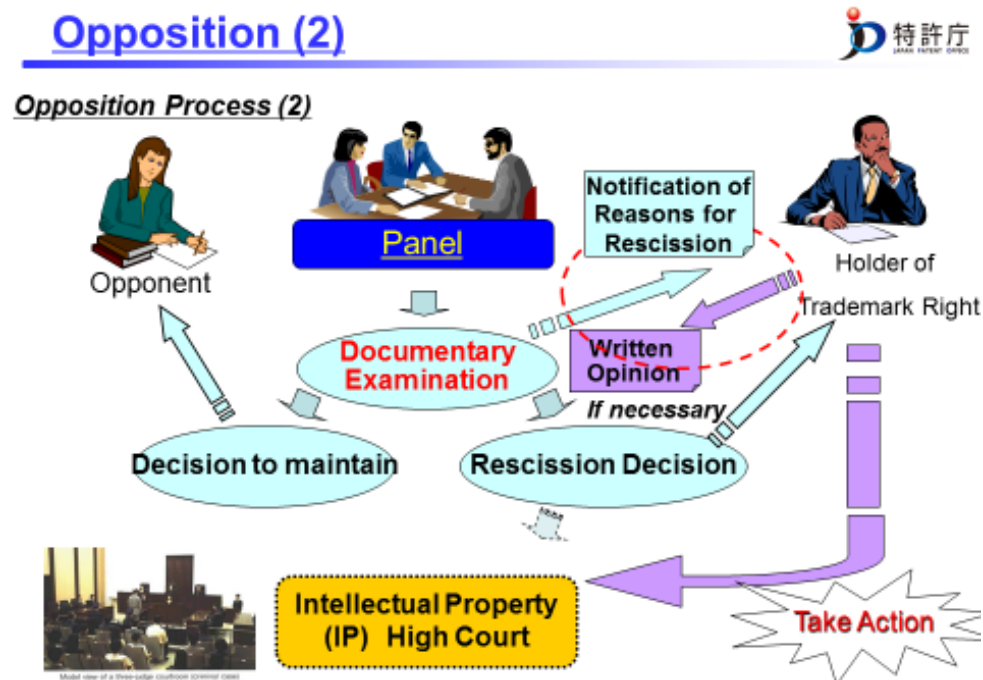


Figure 15. Flowchart of Opposition (2)  
[Trial and Appeal Division, JPO, 2017]

- The indication of the trademark registration in the question,
- The conclusion of and reasons for the decision, and
- The date of the decision.

In case there are more than one opposition to registration have been filed, in principle, the examination is conducted jointly as the result the content of decision to rescind or maintain the registration shall be in one written ruling.

The copy of the decision will be transmitted to the right holder, opponent, intervenor and the persons whose request for intervention in the opposition have been refused.

The period of the opposition cases is on average 8.3 months after the filing but the time may be vary by case.

The decision on the opposition to the registration shall become final and binding upon the expiration of the appeal period in the case of the decision to rescind the registration and upon the serving of a transcript of the decision in the case of the decision to maintain the registration.

When the decision to rescind the registration becomes final and binding, the right of the trademark shall be deemed to never to have existed [Article 43-3 (3), Trademark Law]. In addition, if the decision to rescind the registration becomes final and binding only with respect to some designated goods or services, only these designated goods or services shall be deemed never to have existed.

There is no appeal available for the decision to maintain the registration of trademark. The further possibility to appeal against such decision is to request for invalidation or cancellation. On the other hand, the right owner of the trademark may take action against the decision to rescind the registration to the Tokyo High Court.

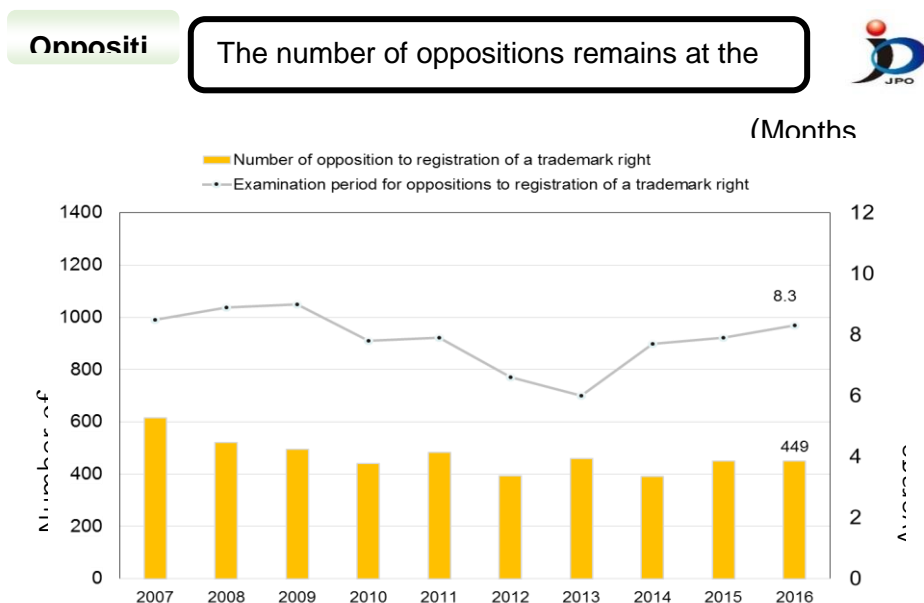


Figure 16. The number of oppositions and the average examination period in JPO [Trial and Appeal Division, JPO, 2017]

#### 4.1.3. Trial for cancellation of registered trademark

Any person can file the request for cancellation of the registered trademark to the JPO on the following grounds:

- i. Non-use,
- ii. Illegitimate used by a trademark owner,
- iii. The confusingly use the transferred registered trademark after separation or division with the intention to violate the rules of fair competition,
- iv. Illegitimate used by the exclusive or non-exclusive rights owner,
- v. The registration of trademark in a foreign country by the trademark owner's agent or representative without the legitimate reason or the authorization of the owner.

##### 4.1.3.1. Trial for cancellation of registered trademark based on non use

Even though the trademark system does not require the actual use or use while applying the application for registration of trademark, but it is required the owner of the registered trademark to use it in specific period after the granting of right. Without complying with this substantial

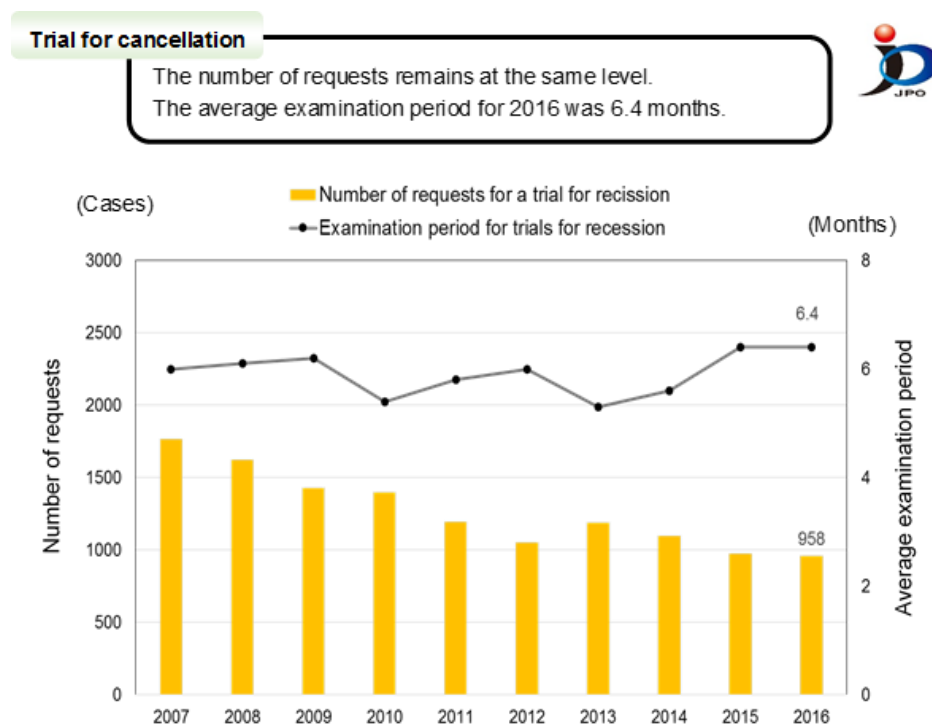


Figure 17. The number of request and the average examination period of trial for cancellation in JPO

[Trial and Appeal Division, JPO, 2017]

requirement, the right will be able to be demanded for cancellation from any person due to the non-use. This non-use will causes the damage to the general interest and also narrow down the scope of the selection of trademarks of the third parties. Therefore, the Trademark Law allows the system of cancellation based on the non-use of registered trademark within the specific period of time.

Trial for cancellation of registered trademark may be demanded by any person when the trademark has not been continuously using in respecting the designed goods or services in Japan for 3 years or more without any legitimate reasons by either the trademark owner or exclusive right or non-exclusive right owner.

In this case, the defendant has the obligation to prove the use of the trademark either by himself or exclusive right or non-exclusive right owner with regard to the designated goods or services. If there is any evidences proving the use of the trademark by any above mentioned parties, the trademark shall not be able to be cancelled. The Trademark Law also provide the possibility for the trademark owner to counter against such non-use ground by providing the legitimate reasons for the failure to use the trademark in respected of the designated goods or services in that period.

## Trial for Cancellation Based on Non-use

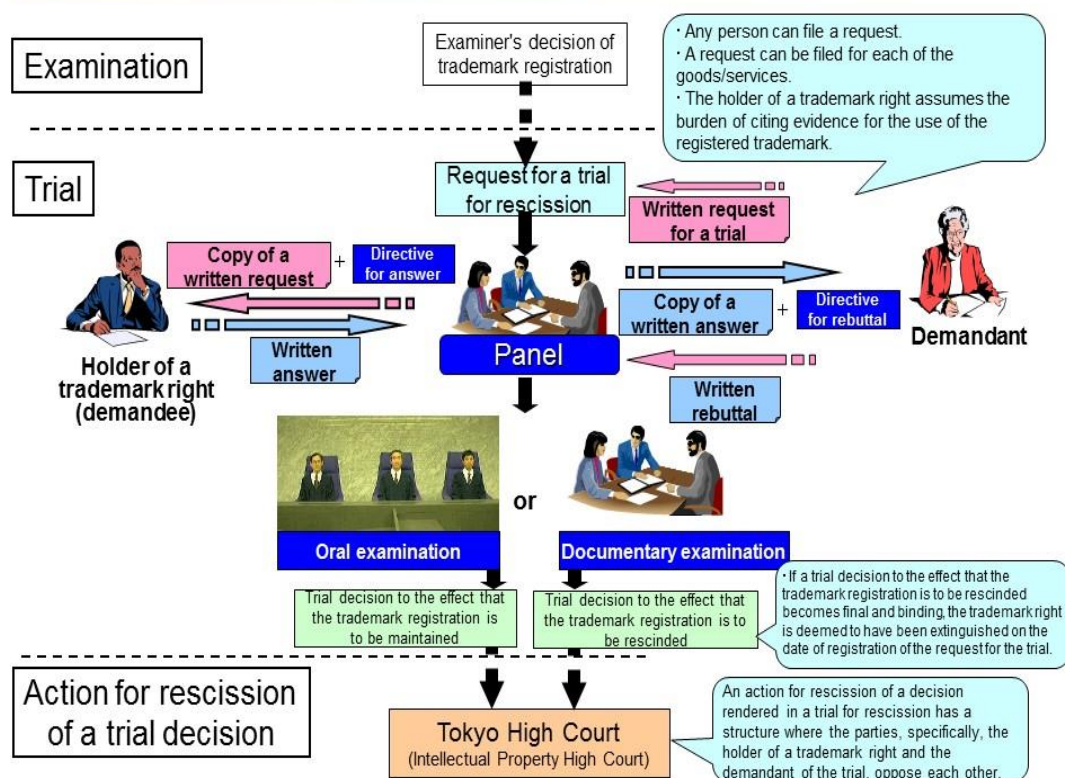


Figure 18. Flowchart of Trial for cancellation based on non-use [Trial and Appeal Division, JPO, 2017]

In order to prevent the sudden use of the trademark by the owner to avert the trial for cancellation based on non-use after sensing the possibility of the demand for cancellation, the Trademark Law prohibits last minute use as the ground against non-use [Article 50, Trademark Law]. Last minute use is the use of the trademark within the period of three months before the demand for cancellation till the date of registration of the demand.

When the trial decision ordering cancellation of registered trademark has become final and conclusive, the trademark right shall be deemed to have extinguished on the date of registration of the demand for trial.

#### 4.1.3.2. Illegitimate used by a trademark owner or owner of use rights

Any person may demand the trial for cancellation of the registered trademark when the trademark owner:

- i. Intentionally uses the trademark similar to the registered trademark in respect of designated goods or services, or
- ii. Intentionally uses registered trademark or similar trademark in respect of goods or services similar to the designated goods or services in the way that may be misleading as to the quality of the goods or services or which may cause the confusion with goods or services connecting with other's person business.

In addition, the demand also can be initiated by any person if the owner of exclusive use or non-exclusive use of the trademark uses the registered trademark or similar trademark in respect of designated goods or services or goods or services similar thereto in a way which may be misleading as to the quality of the goods or services or which may cause confusion with goods or services connected with other persons' business. The above provisions shall not apply when the trademark owner was both unaware of the fact and taking appropriate care.

When the trademark registration has been cancelled under the above paragraph, the former owner of the trademark right may not obtain the registration of the same or similar trademark for the designated goods or services covered by the registered trademark or for goods or services similar thereto, within five years from the date of the trial decision of cancellation becomes final and conclusive [Article 51, Trademark Law].

The trial under the preceding paragraph may not be demanded after the expiration of five years counting from the date of cease to exist the illegal use [Article 52, Trademark Law].

#### 4.1.3.3. Cause confusion after separate transfer of the trademark

The revised Trademark Law allowing the trademark can be divided and separated transfer each divided trademark right. This revision led to the abolishment of the associated trademark system and there need to be transferred separately divided trademark rights. Due to this, there were possibilities of the confusion. Therefore, such trial has been established to prevent such confusion.

Article 52-2 states that where, as the result of the transfer of a trademark right, a trademark right that is similar or identical to a registered trademark and is used for identical goods or services or similar goods or services comes to belong to a different owners, and where the use of one registered trademark by its owner is used with an intention of violating the rule of fair competition of the registered trademark for its designated goods or services connected with the business of the

owner of other registered trademark or owner of its exclusive or non-exclusive use, any person can demand for cancellation of the registration.

#### 4.1.3.4. Illegitimate registration by the agent

Where a registered trademark is the trademark of a person who has the rights to the trademark in a country party to the Paris Convention or a member of the WTO or a contract party to the Trademark Law Treaty (but only where such right is equivalent to the trademark right) or is similar to such a trademark, and goods or services relating to such right or similar goods or services have been made the designated goods or services and moreover the trademark application concerned was made, without a legitimate reason and without the authorization of the person who has the right to the trademark by his agent or representative or by the former agent or representative, the person who has the right to the trademark may demand a trial for cancellation of its registration [Article 53, Trademark Law].

The above demand shall not be initiated after 5 years from the registration of the establishment of trademark right. As after this period, the reputation of the trademark maybe built up and would be inappropriate to ruin such reputation provided that the owner is taking appropriate cares.

When the trial decision ordering cancellation of registered trademark has become final and conclusive, the trademark right shall from that moment become extinguished.

The decision will be notified to the trademark owner and other related persons who have interest in the trademark registration.

#### 4.1.4. Trial for invalidation of trademark registration

Base on the following grounds, any interested person may demand the trial for invalidation of trademark registration:

- Contrary to Article 3-Registrability of trademark,
- Contrary to Article 4(1)-Unregistrability of trademark,
- Contrary to Article 7-2(1)-Special collective trademark or GIs,
- Contrary to Article 8 (1) (2) or (5)-First to file rule,
- Contrary to Article 51 (2)-Prohibition of re-registration period after cancellation (including its application under Article 52-2(2) or 53 (2),
- Contrary to the provisions of treaty,
- Where the registration has been effected in respect of a trademark application filed by a person who has not succeeded to the right deriving from trademark application,
- Where, after registration, the owner of trademark has become a person who can no longer enjoy such right under Article 25 of the patent law as applied under Article 77(3) of the Law or the registration no longer complies with a treaty,
- Where, after the registration, the registered trademark has become a trademark falling under Art 4(1) (i) to (iii), (v),(vii) or (xvi).

The demand shall be made with respect to each designated goods or services.

When a trial decision of invalidation has become final and conclusive, the trademark right shall be deemed never to have existed.



When a trial decision under the ground of Article 46(1)(v) to (vii) become final and conclusive, the trademark right shall be deemed not to have existed from the time when the trademark registration failed under such condition.

In case, where the time at which the registered trademark fall under 46(1)(v) to (vii) cannot be determined, the trademark right shall be deemed not to have existed from the date of registration of the demand for a trial for invalidation.

However, the trial for invalidation may not be demanded after 5 years from the establishment of the trademark registration right base on the grounds of contrary to Article 3, 4(1)(viii) or (xi) to (xiv) or 8(1) (2) or (5), 4(1)(x) or (xvii)(except where registration was obtained with the intention of violation the rules of fair competition) or contrary to Article 4(1)(xv) (except where the registration was obtained for unfair intention) or where a trademark registration falls under Article 46(1)(iv).

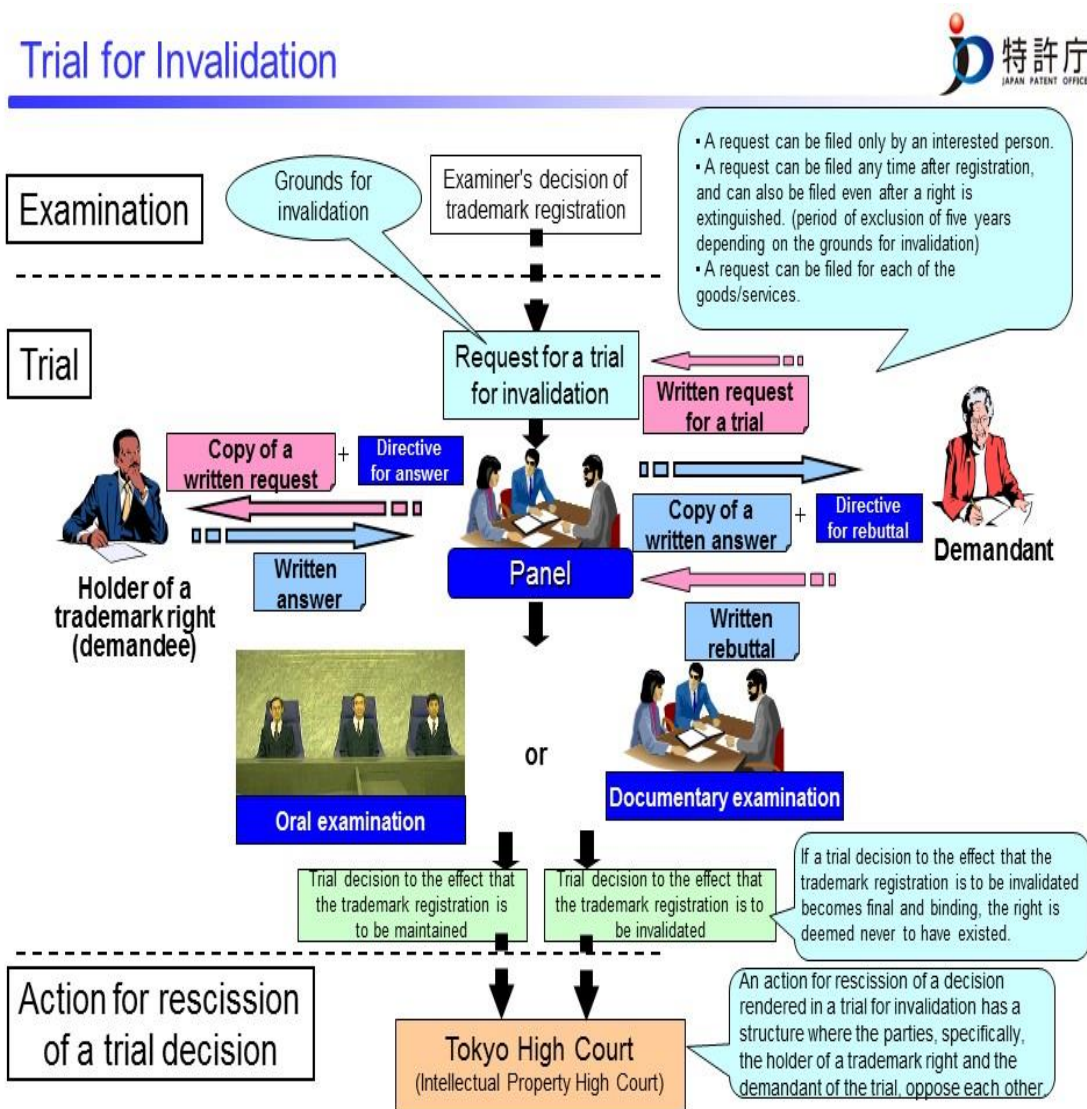


Figure 19. Flowchart of Trial for Invalidation  
[Trial and Appeal Division, JPO, 2017]

#### Trial for invalidation

The number of requests has stayed at around 100 in recent years.  
The average examination period for 2016 was 11.3 months.

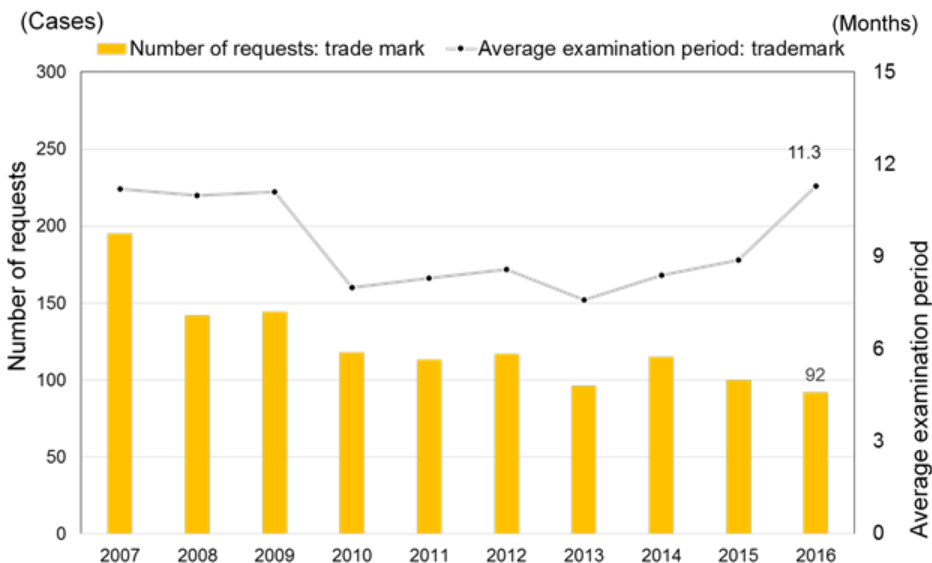


Figure 20. The number of requests and the average examination period in JPO [Trial and Appeal Division, JPO, 2017]

#### 4.2. Collegial Body of the Appeal Board

The trials or appeals shall be conducted by the collegial body consisting of 3 or 5 trial examiners (Grand panel). The grand panel is established only for the important cases that will probably lead to a new interpretation of the law or a change in its operation, such as cases that are appealed to the Supreme Court but returned to the JPO. The collegial body will preside over by one trial examiner in chief designated among the trial examiners.

For the qualification to be a trial examiner are provided by law by virtue of Article 4 Paragraph 2 of the Trademark Act Enforcement Order. Basically, three main requirements will be taken into consideration in appointing an trial examiner:

- The rank of Salary – Grade 3 or higher (up to Grade 8) in the Wage Table for Specialized Administrative Professions,
- Working Experiences – at least 5 years in the substantive examination. Sometimes officers with less than 5 years of working experience may be nominated by their respective superior,
- Designated Training – Required to complete the designated training course. The course is held once a year and usually takes 1.5 months. It is comprised of 10-15 subjects and need to be attended in full-time. At the end of training, report(s) need to be submitted.



There is a total of 38 trial and appeal boards, which categorized according to the specialization in the patent, industrial design and trademark field as follow:

- Board of Trial and Appeal 1 to 33 for patents,
- Board of Trial and Appeal 34 for Designs, and
- Board of Trial and Appeal 35-38 for Trademarks:
  - Board 35th deals chemicals and foodstuffs,
  - Board 36th deals with machinery and electric appliances,
  - Board 37th deals with textiles and general merchandise,
  - Board 38th deals with industrial services and general services.

The detail of each board specification is attached in the appendix.

The trial examiners are assigned to the respective board based on their specialization in the fields, and the cases will be allocated to specific board in according with the nature of the cases in the fields.

There is a total of 42 qualified trial examiners for the trademark. However, only 27 officers are actively in charge of the appeal trials. The rest of the officers are in charge of various other matters such as in administrative and policy making related matters.

The number of trial examiners in each board of the trademark field are as follow:

- Board 35th: 6 trial examiners,
- Board 36th: 6 trial examiners,
- Board 37th: 6 trial examiners,
- Board 38th: 9 trial examiners.

The collegial body will be formed among the trial examiners of each board. Once in few years, the trial examiners in the 4 boards will be reshuffled.

As principle, the collegial body for each case is designated by the Commissioner of the JPO. Practically, the trial examiner in chief will ensure a balance arrangement and assignment of cases among the trial examiner.

Usually, the collegial body will have 2-3 sessions in a week where the 1st session is allocated to discuss the cases and on the subsequent session decision will be drafted and so on.

Whenever a case is appealed, a collegial body will be formed where trial examiner in chief and responsible primary trial examiner (person-in-charge) will be appointed. After the discussion of a case, the primary trial examiner will draft the written judgment in which it will be presented to the trial examiner in chief and the rest of the collegial panel at the subsequent session. Upon consent, the grounds of judgment will be finalized.

For each trial, the Commissioner of JPO shall designate the trial examiners constituting the collegial body. In case the designated trial examiners are unable to participate in the trial, the Commissioner will designate another trial examiner in replace of the former ones.

The trial examiner in chief will also be designated by the Commissioner among the members of the collegial body. The trial examiner in chief will preside over the matter related to trial.

Table 2. The number of JPO staffs

Fiscal Year		2011	2012	2013	2014	2015	2016
Total number of Staff		2,895	2,880	2,852	2,837	2,821	2,040
Examiners and Administrative Judge		2,297	2,298	2,285	2,280	2,275	2,275
	Examiners	1,910	1,911	1,898	1,893	1,888	1,887
	Patents	1,711	1,713	1,701	1,702	1,702	1,702
	Designs	51	51	51	49	48	48
	Trademarks	148	147	146	142	138	137
	Administrative Judges	387	387	387	387	387	383
Clerical Staff		598	582	567	557	546	534

When the trial examiners has been designated, the names of trial examiners will be notified to trademark right owner, opponent and intervenor. In case there is any change regarding the designated trial examiners, such change will also be notified to the trademark right owner, opponent and intervenor.

#### The exclusion of trial examiners

The trial examiners shall be excluded from the trial proceeding on the ground of any of the following cases:

- i. The trial examiner or his spouse or former spouse is or was a party, an intervenor or an opponent in the case;
- ii. The Trial examiner is or was a relative by blood within the fourth degree, a relative by affinity within the third degree or a relative cohabiting with a party, an intervenor, or an opponent in the case;
- iii. The trial examiner is a guardian, a supervisor of the guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party, an intervenor, or an opponent in the case;
- iv. The trial examiner has become the witness or an expert witness in the case;
- v. The trial examiner is or was a representative of a party, an intervenor, or an opponent in the case;
- vi. The trial examiner participated as an examiner in the examiner's decision which is challenged in the case; ( items 3 to 7 are omitted, Appeal and Trial manual).
- vii. The trial examiner has a direct interest in the case.

The demand for the exclusion of the trial examiner under above mentioned grounds shall be filed by the party or intervenor.

The party or intervenor may also challenge the trial examiners in the circumstances preventing the fair trial due some part from the trial examiner. A party or intervenor may not challenge the trial examiner after he has made a written or oral statement to a trial examiner with regard to the case. However, this shall not apply where the party or intervenor did not know there were grounds for challenges or where the grounds for challenges arose subsequently.

The party or intervenor who request for the exclusion or challenge shall submit the grounded documents to the Commissioner of JPO. The grounds for exclusion or challenge shall be submitted within three days from the date of requesting for exclusion or challenge. This procedure also can be carried out orally in the oral trial examination.

The ruling on the motion of exclusion or challenge shall be rendered by the trial examiners other than trial examiner concerned in the motion through a trial. There is also providing the chance for the trial examiner concerned in the motion to state his opinion. The ruling shall be in writing and stated the reasons thereof.

#### 4.3. Intervention

Any person who has the interest in the case can intervene in the examination in order to assist the parties in the cases. The person demanding for intervention shall submit the request to the trial examiner in chief then the trial examiner in chief will transmit the request to the parties and intervenors and give them the opportunities to express their opinions within adequate time limit. The ruling of the intervention shall be made in writing and stated the reasons thereof.

#### 4.4. Trial Procedures

The demand for appeals/trials shall be submitted in writing to the commissioner of JPO. After receipt the demands, the formality examination will be conducted to check whether they are comply with the formality requirements or not. If the demands do not comply with any formality requirements, the trial examiner in chief shall invite the demandant to amend the demand. In case there is not provided the amendment within designated time period, the demand will be dismissed by written ruling with the reasons and notified the demandant.

After complying with the formality examination, the trial examiner in chief shall transmit a copy of written demand to demandee and give him an opportunity to submit written reply within adequate time limit.

Upon receipt the written reply from the demandee, the trial examiner in chief shall transmit a copy of written reply to demandant.

As a rule, inter parte trial is conducted orally while ex-parte trial is conducted by documents. In practice, trial examinations are mostly conducted by documentary proceedings.

As mentioned above, inter parte trial examinations shall be conducted by oral proceeding but trial examiner in chief may decide to conduct the trial by documentary examination upon the request of a party or an intervenor or ex officio.

Similarly, in the ex-parte trial examination, the trial examiner in chief may decide to conduct the trial by oral proceeding on the motion by a party or ex officio.

When a trial is conducted by oral proceeding, the trial examiner in chief shall fix the date and place then submit the written notification thereof to parties and interveners.

The oral proceeding shall be conducted in public to assure the fairness.

Where the trial is demanded by more one person or more than one demanding parties concerning the same trademark right, the trial will be conducted jointly.

#### 4.5. Oral Proceeding

Trials may be conducted by documentary proceedings and oral proceedings. In general, invalidation trials shall be proceeded by oral proceedings. Oral proceedings will help the collegiate body accurately understand the points of dispute between the parties in the case through questioning by the chief administrative judge to draw claims from the parties that they may not completely express in writing. The proceedings will allow the parties to clarify technical details in question for accurate understanding.

For the parties, the proceedings will give an opportunity to claim enough to eliminate further need to submit a second written reply, written refutation, or other documentation, which, as an advantage, may lead to the trial being examined faster than by documentary proceedings.

Another advantage is that constructive guidance for trial examination will be provided so that the parties may claim only on necessary points of dispute, skipping the process of claiming and proving on those other than the points of dispute.

Depending on the case, various means may be devised to bring the case to an optimum settlement.

Trials at the JPO may be examined either orally or in writing. Even when a trial is conducted by oral proceedings, all written submissions shall be deemed to have been stated validly in the trial.

At oral proceedings, the chief administrative judge questions the parties and organizes the points of dispute well enough to enable the parties to claim and prove appropriately.

In principle, the oral proceeding will be conducted at the Trial Court (16th floor, JPO building), the First Trial Court (1st floor, METI annex) or the Second Trial Court (1st floor, METI annex). In case the oral proceedings without examination of evidence, the oral proceeding will be held at the Second Trial Court and such oral proceedings may be held in a meeting or interview room if their openness is secured.

The Trial Court or the First Trial Court is used for oral proceedings with examination of evidence. For information, the Trial Court is equipped with IT infrastructure that allows technical explanation with moving images, for example, and inspection of the actual article and the object using a document camera.

In addition, the collegiate body may visit locations across Japan to conduct circuit trial examinations with oral proceedings.

Before oral proceedings, the chief administrative judge and other administrative judges in the collegiate body, and the trial court clerk, consult in advance—including briefing the overview of the case—regarding how to conduct oral proceedings, main issues in dispute, points to be recorded, etc.

## Trial Court



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Figure 21. Visual description of the trial court in JPO  
[JPO, 2017]

To ensure that proceedings proceed smoothly and fruitfully, the collegiate body notifies the parties in the case in advance of matters planned to be examined on the date of the trial, by giving written notice of proceeding matters or by other form of notification, to urge the parties to make preparations based on the notification including drafting up an oral proceedings statement brief. A written notice of proceeding matters is sent to the parties, in principle, after the date of trial is determined. Even before determination of the date, however, the parties will receive by fax the information contained in the notice to be mailed later.

The collegiate body will be assisted by a trial court clerk designated by the JPO Commissioner. The trial clerk is in charge of preparing records and their transmittal as well as other office works under the direction of the trial examiner in chief with respect to trial. Trial clerk also posts a monthly schedule of trial sessions in the lobby of the JPO building. The clerk also posts the schedule on the JPO's website and places a notice on the bulletin board in front of each court in the morning of the day to inform the cases going on trial on the day.

### 4.6. Analysis

Based on the findings, the comparison between the appeals and trials of JPO and DIP have been summarized in the following tables.

## 4.6.1. Comparison of Appeal against examiner's decision of refusal between JPO and DIP

Table 3. Comparison of Appeal against examiner's decision of refusal between JPO and DIP

	<b>Appeal Against Examiner's Decision of Refusal at JPO</b>	<b>Appeal Against Examiner's Decision of Refusal at DIP</b>
<b>Parties</b>	Dissatisfied person vs JPO	Dissatisfied person vs DIP
<b>Purpose</b>	<ul style="list-style-type: none"> <li>● To review the examiner's decision</li> </ul>	<ul style="list-style-type: none"> <li>● To review and reconsideration of trademark application</li> </ul>
<b>Period</b>	<ul style="list-style-type: none"> <li>● 3 months from the transmittal of the examiner's decision.</li> </ul>	<ul style="list-style-type: none"> <li>● 3 months from the decision date.</li> </ul>
<b>Type of Hearing</b>	<ul style="list-style-type: none"> <li>● Documentary proceeding</li> </ul>	<ul style="list-style-type: none"> <li>● Documentary and hearing proceeding.</li> </ul>
<b>Handling Person</b>	<ul style="list-style-type: none"> <li>● Collegial Body consist of 3 or 5 trial examiners,</li> <li>● Grand panel (5 trial examiners) in cases that appeal until Supreme Court or deal with the new interpretation of the Law.</li> </ul>	<ul style="list-style-type: none"> <li>● Individual responsible officer</li> </ul>
<b>Procedure</b>	<ul style="list-style-type: none"> <li>● Refer to the flowchart of appeal against examiner's decision of refusal.</li> </ul>	<ul style="list-style-type: none"> <li>● Refer to the flowchart in the appendix.</li> </ul>
<b>Grounds</b>	<ul style="list-style-type: none"> <li>● The goods of the applied trademark cannot be distinguished from those of other companies,</li> <li>● The applied trademark is similar to the prior trademarks,</li> <li>● The description of designated goods or services is not explicit,</li> <li>● The applied trademarks falls under any other ground of unregistrability</li> </ul>	<ul style="list-style-type: none"> <li>● Do not comply with Article 8(a) and (b) of the Trademark Law: formality and substantive requirements.</li> </ul>
<b>Appeal</b>	<ul style="list-style-type: none"> <li>● Appeal to IP High Court and Supreme Court</li> </ul>	<ul style="list-style-type: none"> <li>● Appeal to Appeal Board or competent court within 3 months from the decision date.</li> </ul>

## 4.6.2. Comparison of opposition between JPO and DIP

Table 4. Comparison of opposition between JPO and DIP

	<b>Opposition at JPO</b>	<b>Opposition at DIP</b>
<b>Parties</b>	Any person vs JPO	Any person relevant to the trademark registration vs trademark owner
<b>Purpose</b>	<ul style="list-style-type: none"> <li>• Increase the reliability of the registered trademarks</li> </ul>	<ul style="list-style-type: none"> <li>• To solve the conflict over the trademark registration</li> </ul>
<b>Period</b>	<ul style="list-style-type: none"> <li>• Post- Registration Opposition,</li> <li>• Within 2 months from the publication of the registered trademark in the Gazette</li> </ul>	<ul style="list-style-type: none"> <li>• Post-Registration Opposition,</li> <li>• Within 90 days from the date of publication.</li> </ul>
<b>Type of Hearing</b>	<ul style="list-style-type: none"> <li>• In principle, documentary proceeding</li> </ul>	<ul style="list-style-type: none"> <li>• Documentary proceeding and oral proceeding, if either or both wish to be heard.</li> </ul>
<b>Handling Person</b>	<ul style="list-style-type: none"> <li>• Collegial Body consist of 3 trial examiners, in general,</li> <li>• Grand panel (5 trial examiners) in cases that appeal until Supreme Court or deal with the new interpretation of the Law.</li> </ul>	<ul style="list-style-type: none"> <li>• Individual responsible officer</li> </ul>
<b>Procedure</b>	<ul style="list-style-type: none"> <li>• Refer the flowchart of opposition,</li> <li>• Opposition for each designated goods or services</li> </ul>	<ul style="list-style-type: none"> <li>• Refer to the flowchart in the appendix.</li> </ul>
<b>Grounds</b>	<p>The grounds of opposition to registration are restricted to those stated in the Article 43-2 of the Trademark Act such as the following:</p> <ul style="list-style-type: none"> <li>• Violation of registrability requirements of trademark;</li> <li>• Violation of the unregistrability conditions of the trademark;</li> <li>• Violation of requirements for registration of regional collective trademark;</li> <li>• Violation of the prior rights of trademarks;</li> <li>• Violation the first to file system;</li> <li>• Violation the provisions of prohibiting re-registration of canceled trademarks. Any cancelled trademarks by the trial for cancellation of the registered trademark due to illegal</li> </ul>	<ul style="list-style-type: none"> <li>• On the ground of Articles 2.(a), 4 and 5 of the Trademark Law:</li> <li>• Art 2(a): "mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise.</li> <li>• Art. 4: Unregistrability of trademark:               <ul style="list-style-type: none"> <li>(a)-if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;</li> <li>(b)-if it is contrary to public order or morality or good custom;</li> </ul> </li> </ul>

	<p>used cannot be re-registered until the lapse of five years from the date of the decision of trial become final and exclusive;</p> <ul style="list-style-type: none"> <li>• Violation of the enjoyment of trademark rights by foreign nationals (national treatment);</li> <li>• Violation of the provisions of relevant treaties;</li> <li>• Violation of the requirements and condition for registration of defensive marks.</li> </ul>	<p>(c)-if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;</p> <p>(d)-if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of , or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorized by the competent authority of that State or organization;</p> <p>(e)-if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in the Kingdom of Cambodia for identical or similar goods or services of another enterprise;</p> <p>(f)-if it is identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well-known and registered in the Kingdom of Cambodia for goods or services which are not identical or similar to those in respect of which registration is applied for , provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark that the interests of the owner of the well-known mark are likely to be damaged by such use; or</p> <p>(g)-if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.</p>
<b>Appeal</b>	Appeal to IP High Court and Supreme Court	Appeal to Appeal Board or competent court within 3 months from the decision date.



## 4.6.3. Comparison of trial for invalidation between JPO and DIP

Table 5. Comparison of trial for invalidation between JPO and DIP

	<b>Invalidation at JPO</b>	<b>Invalidation at DIP</b>
<b>Parties</b>	Interested party	Any interested party
<b>Purpose</b>	<ul style="list-style-type: none"> <li>• Early settlement of dispute over the validity of the rights</li> </ul>	<ul style="list-style-type: none"> <li>• Settlement over the dispute of validity of trademark rights</li> </ul>
<b>Period</b>	<ul style="list-style-type: none"> <li>• Any time after the registration</li> </ul>	<ul style="list-style-type: none"> <li>• Any time after the registration</li> </ul>
<b>Type of Hearing</b>	<ul style="list-style-type: none"> <li>• Oral proceeding, in principle,</li> </ul>	<ul style="list-style-type: none"> <li>• Documentary proceeding and oral proceeding if necessary</li> </ul>
<b>Handling Person</b>	<ul style="list-style-type: none"> <li>• Collegial Body consist of 3 trial examiners, in general,</li> <li>• Grand panel (5 trial examiners) in cases that appeal until Supreme Court or deal with the new interpretation of the Law.</li> </ul>	<ul style="list-style-type: none"> <li>• Individual responsible official</li> </ul>
<b>Procedure</b>	<ul style="list-style-type: none"> <li>• Refer to the flowchart of trial for invalidation.</li> <li>• The demand shall be made with respect to each designated goods or services.</li> </ul>	<ul style="list-style-type: none"> <li>• Refer to the flowchart in the appendix.</li> </ul>
<b>Grounds</b>	<p>Base on the following grounds, any interested person may demand the trial for invalidation of trademark registration:</p> <ul style="list-style-type: none"> <li>• Contrary to Article 3-Registrability of trademark,</li> <li>• Contrary to Article 4(1)-Unregistrability of trademark,</li> <li>• Contrary to Article 7-2(1)-Special collective trademark or GIs,</li> <li>• Contrary to Article 8 (1) (2) or (5)-First to file rule,</li> <li>• Contrary to Article 51 (2)-Prohibition of re-registration period after cancellation (including its application under Article 52-2(2) or 53 (2),</li> <li>• Contrary to the provisions of treaty,</li> <li>• Where the registration has been effected in respect of a trademark application filed by a person who has not succeeded to the right deriving from trademark application,</li> </ul>	<ul style="list-style-type: none"> <li>• Any of the requirements of Articles 2 (a) and 4 is not fulfilled.</li> </ul>

	<ul style="list-style-type: none"> <li>• Where, after registration, the owner of trademark has become a person who can no longer enjoy such right under Article 25 of the patent law as applied under Article 77(3) of the Law or the registration no longer complies with a treaty,</li> <li>• Where, after the registration, the registered trademark has become a trademark falling under Art 4(1)(i) to (iii), (v),(vii) or (xvi).</li> </ul>	
<b>Effect of Invalidation</b>	<ul style="list-style-type: none"> <li>• Trademark right shall be deemed never to have existed.</li> </ul>	<ul style="list-style-type: none"> <li>• The registration of a mark shall be deemed not to have been effective as of the date of registration.</li> </ul>
<b>Appeal</b>	<ul style="list-style-type: none"> <li>• Appeal to IP High Court and Supreme Court</li> </ul>	<ul style="list-style-type: none"> <li>• Appeal to Appeal Board or competent court within 3 months from the decision date.</li> </ul>

## 4.6.4. Comparison of trial for cancellation between JPO and DIP

Table 6. Comparison of trial for cancellation between JPO and DIP

	Cancellation at JPO	Cancellation at DIP
<b>Parties</b>	<ul style="list-style-type: none"> <li>Interested party</li> </ul>	<ul style="list-style-type: none"> <li>Any interested party</li> </ul>
<b>Purpose</b>	<ul style="list-style-type: none"> <li>Determination concerning non-use and use for unfair purposes</li> </ul>	<ul style="list-style-type: none"> <li>Settlement the disputes and review the validity of the registered trademark rights</li> </ul>
<b>Period</b>	<ul style="list-style-type: none"> <li>Any time after the registration</li> </ul>	<ul style="list-style-type: none"> <li>Any time after registration</li> </ul>
<b>Type of Hearing</b>	<ul style="list-style-type: none"> <li>Oral proceeding, in principle</li> </ul>	<ul style="list-style-type: none"> <li>Documentary and oral proceeding</li> </ul>
<b>Handling Person</b>	<ul style="list-style-type: none"> <li>Collegial Body consist of 3 trial examiners, in general,</li> <li>Grand panel (5 trial examiners) in cases that appeal until Supreme Court or deal with the new interpretation of the Law.</li> </ul>	<ul style="list-style-type: none"> <li>Individual responsible official</li> </ul>
<b>Procedure</b>	<ul style="list-style-type: none"> <li>Refer to the flowchart of trial for cancellation.</li> </ul>	<ul style="list-style-type: none"> <li>Refer to the flowchart in the appendix.</li> </ul>
<b>Grounds</b>	<p>Any person can file the request for cancellation of the registered trademark to the JPO on the following grounds:</p> <ul style="list-style-type: none"> <li>Non-use,</li> <li>Illegitimate used by a trademark owner,</li> <li>The confusingly use the transferred registered trademark after separation or division with the intention to violate the rules of fair competition,</li> <li>Illegitimate used by the exclusive or non-exclusive rights owner,</li> <li>The registration of trademark in a foreign country by the trademark owner's agent or representative without the legitimate reason or the authorization of the owner.</li> </ul>	<p><b>Article 14</b> of the Trademark Law states that the Ministry of Commerce has the right to order the cancellation to the registered mark where:</p> <ul style="list-style-type: none"> <li>The applicant does not apply for renewal of the registered mark within the period prescribed under Article 12.(b) and (d).</li> <li>The owner of the registered mark requests the removal.</li> <li>The owner of the registered mark has not complied, within 90 days, with the conditions or restrictions prescribed under Article 8.</li> <li>The owner of the registered mark ceases to have an address for service in the Kingdom of Cambodia.</li> <li>It is convinced upon evidence that the owner of the registered mark is not the legitimate owner.</li> <li>It is convinced that the registered mark is similar or identical to a well known mark owned by third party.</li> </ul>

		Article 15: Any interested person may request the Ministry of Commerce to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of five years, provided that a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.
<b>Effect of Cancellation</b>	<ul style="list-style-type: none"> <li>The trademark right shall become extinguished from the trial decision ordering cancellation become final and conclusive.</li> </ul>	<ul style="list-style-type: none"> <li>The trademark right shall become extinguished from the date of decision of cancellation.</li> </ul>
<b>Appeal</b>	<ul style="list-style-type: none"> <li>Appeal to IP High Court and Supreme Court</li> </ul>	<ul style="list-style-type: none"> <li>Appeal to Appeal Board or competent court within 3 months from the date of decision.</li> </ul>

Based on the finding and comparison above, there are some differences and similarities between the trademark disputes resolution of the Japan Patent Office and the Department of Intellectual Property.

The main differences between these 2 systems include the following points.

- Trial and Appeal Board Department of JPO has the exclusive authority over the four main types of trials and appeals such as appeal against examiner's decision of refusal, appeal against the dismissal amendment of examiner, opposition, trial for invalidation, and trial for invalidation while Litigation Division of DIP governs only the opposition, trial for invalidation and trial for invalidation.
- Trial and Appeal Department does not get involve in the infringement cases as well as provide the alternative dispute resolutions (ADR) for the parties over the IP disputes, but DIP does. DIP plays a vital role in providing the mediation service for the parties to solve their disputes. DIP does not have any authority in deciding the cases. As the general rule, infringement cases are under the authority of the Courts. DIP only acts as the mediator for the parties and provides the expert opinion and some legal consequent of the cases. There reaching the agreement is based on the parties. But through the experiences, this is an effective practice in Cambodia.
- In JPO, the cases will be handled by the collegial body consisting of 3 or 5 trial examiners depending the nature of the cases. In contrast, in DIP, the cases will be handled by individual assigned official with the review from his or her head authority within the Department.
- The trial examiners in JPO are selected from and required the long term experiences and specialization in the examination and completion of required trainings. On the other hand, DIP is still limited in term of human resource in this field.
- Appeal Boards in JPO is a special administrative agency that is provided special authority over IP cases by the Law. The decisions of JPO is equal to the decisions of the First Instance Courts. Any action against such decisions will be appealed to the High Court not to the Court of the First Instance. In Japan, there is also specialize IP Court so called Intellectual Property High Court or IP High Court. IP High Court has authority over IP cases and some specific cases are under the exclusive authority of the IP High Court. However, DIP is a normal administrative agency in dealing with the IP cases and its decisions may be taken further action before the competent court (the First Instance Courts) and there is not yet existed the special court for IP. Therefore, the cases will be heard by the general court.
- In JPO, there is a specific and detail manual both for examination and appeals and trials procedures. This leads to the consistency and accuracy in term of the decisions and speed up the pendency period of the IP dispute resolutions. In Cambodia, currently, there has not yet have the specific guideline for the IP dispute resolution beside the Law and regulations. There needed this type of manual in order to guarantee the consistency and accuracy of the decisions.
- One of the most interesting technique to continuously improve and enhance trials and appeals examination of JPO is conducting the trial and appeal practitioner study group meeting every year. The study group has been established since 2006, which comprise

of industrial practitioners, patent attorneys, lawyers and trial examiners. In addition, there is also the participation of the judges of IP High Court and the Tokyo District Court as the observers. The studies were made on the judgements of JPO and IP High Court based on the cases of trial/appeal decisions and court decisions, and were divided into specific groups such as patents, industrial designs and trademarks. Each study group will look into detail and review the assigned cases of the previous JPO and court decisions. The outcome and analysis of the study group will be widely disseminated and it has contributed a lot and plays a very crucial role to provide feedbacks from various perspectives for the future improvement and enhancement of the trial and appeal examination of JPO as well as shares the understanding of the examination practices with the users of the trial and appeal systems.

## 5. Implications and Recommendations

Based on the study and analysis of the collected data, comments from the members of IPAJ and members of JPO Appeal Board, the appeal board system of Japan is seemed mature everything in term of human resources, expertise, specialization, and institutions especially IP special court. To some extent, the system would not applicable and appropriated for the first start up and limited development country in IP fields. Some important facts should be taken into consideration in the structuring appeal board include the scope, roles and responsibility of the appeal board. Especially, the human resources in the field and the trends of request for the trials and appeals shall be totally paid attention on.

In comply with the current situation, practices in Cambodia by taking into account the study and recommendations from Japan, to my point of view, there are two feasibility proposals to be proposed concerning the future establishment of Appeal Board System in Cambodia. The first proposal is to upgrade the Litigation Division of the Department of Intellectual Property to be functioned as the Appeal Board. The second proposal is to establish the new system of Appeal Board that is acted as the upper level authority to review and in charge of appeals against any decision made by the Department of Intellectual Property.

### 5.1. Upgrade the Litigation Division of DIP to be functioned as the Appeal Board

The Litigation Division of DIP takes, to some extent, the same functions of the Appeal Board of JPO such as oppositions, trial for invalidations and trial for cancellations, except the appeal against examiner's decision of refusal that is out of scope of the function of the Division. To take fully functions as appeal board system of not only as Japan and also other countries, the appeal against examiner's decision of refusal function shall be covered in the functions of the Litigation Division. Also as above mentioned, the two systems are totally different in term of dealing with the infringement cases. The new upgraded Division will still play the vital role in providing mediation services over the IP infringement cases.

There other main important things shall be taken into account involving the upgrade process. These shall be included the followings:

- Shall there be needed to restructure the existing one?
- The requirement for strengthening, capacity building and improving the specialization of the existing hearing officials to deal with the new, increase and complicated workload in the upgraded one.
- There shall be needed more hearing official to deal with the cases, as currently there are still limited in the numbers of the officers.

As the solution to above problems might need more time and effort, there cannot be tackled at once. Due to everything is still limited, the most important thing is to make the most use of the existing resources.

In the initial stage, it is recommended that the new upgraded Division will be functioned as the normal one, but concurrently the upgraded processes also do step by step.

### 5.2. Establishment the new Appeal Board

The second proposal is to establish the new Appeal Board that acts as the upper authority to review the decisions made by the Department of Intellectual Property. The new Board will have the authorities over the following things:

- The appeal against examiner's decision of refusal,
- The appeal against the decisions made by the Department in term of oppositions, trial for invalidation and cancellations,
- Further mediation process, if requested from parties.

As already indicated above, the requirement for the establishment of Appeal Board is clearly provided in the provisions of the Sub-decree on the Implementation of the Trademark Law. The above functions also are comply with the Sub-decree. There is not required any amendment the sub decree and regulation regarding this establishment. This is the most positive point to take into consideration as the amendment of Sub-decree require time and also the long process. It might take some reasonable long period of time.

As the initial stage, the members of the Appeal Board shall be proposed 3members but it is not limited to that numbers. The compositions shall be as following:

- |                                                           |                 |
|-----------------------------------------------------------|-----------------|
| - Appointed Person (Long term experiences in IP)          | : Chairman      |
| - Director of DIP                                         | : Vice Chairman |
| - Deputy Director of DIP (in charge of Mark Registration) | : Member        |
| - Chief Division of Litigation                            | : Trial Clerk   |

The Collegial Body will be formed only upon there is an appeal case. Beside this, the members will handle their routine works in their respective responsibility. The specific responsibilities, functions and other conditions will be stated into detail in the Ministerial Declaration on the Establishment of the Appeal Board.

The possible four steps process in order to achieve the above recommended proposals are as the followings and shown in Figure 24.

Step 1: The meetings within the Department will be held to discuss about the proposals. The most proper proposal will be selected by taking into account all the concerns raised during the meeting.

Step 2: The other meetings will be held to discuss about the proposed composition of the Board. The relevant stakeholders will be invited for the meeting.

Step 3: After step 1 and 2 have been done, the DIP will draft the Ministerial Declaration on its establishment. There will be many meeting held to discuss about the draft of the Ministerial Declaration.

Step 4: The last step, the final draft will be submit to the Minister for signature.



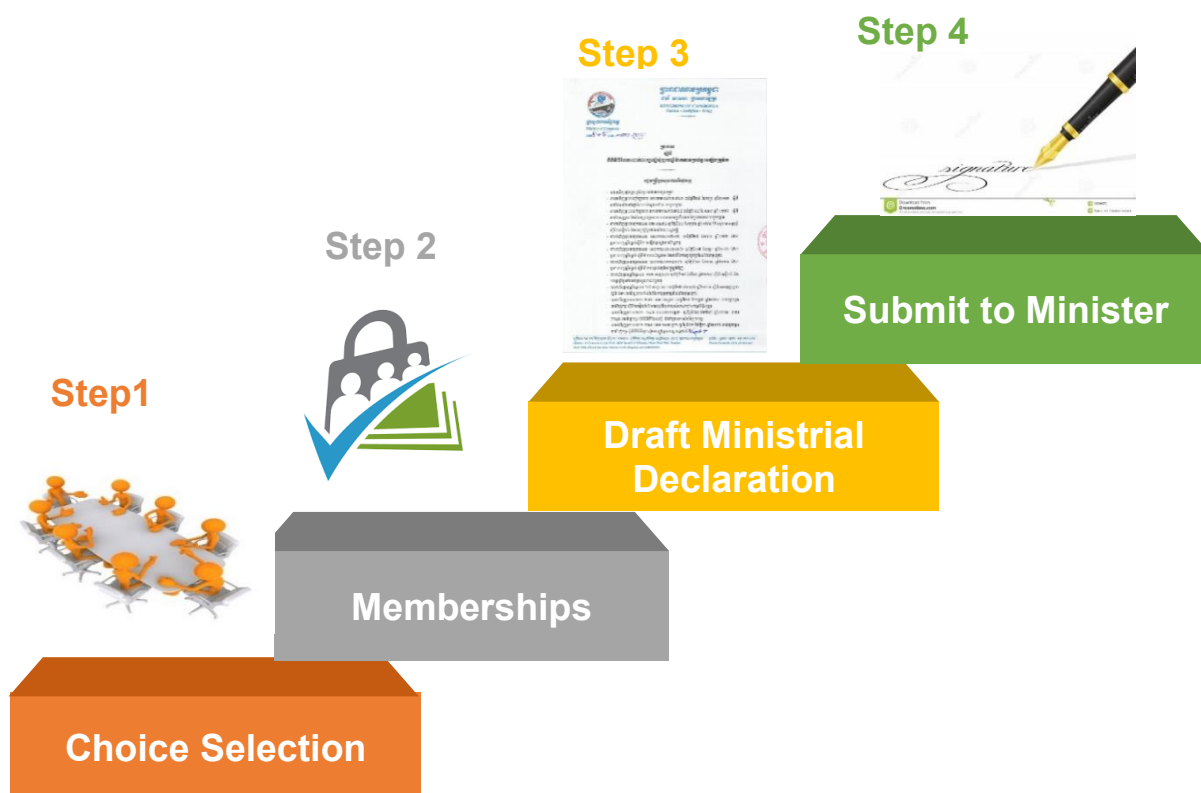


Figure 22. The possible four steps in order to achieve the proposals.

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## References

- Department of Intellectual Property, Ministry of Commerce. (2017, September). *Kingdom of Cambodia, Secretariat of National Committee, Kingdom of Cambodia*. Retrieved from <http://www.cambodiaip.gov.kh/default.aspx?lang=en>
- Hayahi, J. (2017). *Outline of the Japanese Trademark System and Trademark Act (2)*.
- Intellectual Property High Court. (2017). *Guidebook of the IP High Court*. Retrieved from Intellectual Property High Court.
- JPO. (2017, September). *Outline of the Trademark System*. Retrieved from Japan Patent Office: [https://www.jpo.go.jp/seido\\_e/s\\_shouhyou\\_e/outline\\_trademark.htm](https://www.jpo.go.jp/seido_e/s_shouhyou_e/outline_trademark.htm)
- JPO. (2017). *The Role of the Japan Patent Office*. Retrieved from Japan Patent Office.
- JPO. (2017). *Trial and Appeal System*.
- Ono, S. (1999). *Overview of Japanese Trademark Law 2nd ed. Ch. 13*. Retrieved from Institute of Intellectual Property: <http://www.iip.or.jp/translation/ono/ch13.pdf>
- Supreme Court of Japan. (2017). *Court System of Japan*. Retrieved from Supreme Court of Japan: [http://www.courts.go.jp/english/judicial\\_sys/Court\\_System\\_of\\_Japan/index.html#01](http://www.courts.go.jp/english/judicial_sys/Court_System_of_Japan/index.html#01)
- Suzuki, M. (2001). *The trademark registration system in Japan: A firsthand review and exposition*. JPO.
- Trial and Appeal Division, JPO. (2017). *Trial System (Trademark), Focused on Opposition*.
- WIPO. (2017). *Japanese Opposition System*. Retrieved from World Intellectual Property Organization: [http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/jp\\_2.pdf](http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/jp_2.pdf)
- Laws:
- Article 145 (3), Patent Act (1959)  
<http://www.japaneselawtranslation.go.jp/law/detail/?id=42&vm=04&re=01>
- Article 43 (6), 43-2, 43-3 (3), 50, 51, 52, 53, Trademark Act (1959)  
[http://www.japaneselawtranslation.go.jp/law/detail\\_main?re=&vm=4&id=45](http://www.japaneselawtranslation.go.jp/law/detail_main?re=&vm=4&id=45)
- Article 76, The constitution of Japan (1947)  
[https://japan.kantei.go.jp/constitution\\_and\\_government\\_of\\_japan/constitution\\_e.html](https://japan.kantei.go.jp/constitution_and_government_of_japan/constitution_e.html)
- Information from the Advisor:
- Toyosaki, R. *Trademark Appeal Procedure*.

Textbook of APIC-JIPII Training courses:

Hayashi (2017) *Outline of the Japanese Trademark System and Trademark Act (2)*.

JPO (2017) *The Role of the Japan Patent Office. Japan Patent Office*.

JPO (2017) *Trial and Appeal System*.

Trial and Appeal Division, JPO (2017) *Trial System (Trademark), Focused on Opposition*.

## Appendixes

### Appendix I: Answers from JPO to Questions Part 1. Structure and operation system

Date: Answers by written document were received on 19 September 2017

Respondent: Trial and Appeal Division, Trial and Appeal Department, JPO

*Question 1: Could you briefly describe the history of establishment of Appeal Board and is there any challenges that JPO faced during the first introduction of Appeal Board?*

Since the Patent Office was established in 1887, it has had the Trial and Appeal Department. Nonetheless, it is not clear that what kind of challenges the Office faced on this matter.

*Question 2: There are 38 Boards of Appeal and Trials (4 Boards of Appeal and Trial for Trademark), Trial and Appeal Division and Infringement and Invalidity Office. What are the factors that shall be taken into account in structuring the organizational structure of the Appeal Board?*

In order to establish the best possible organization of the Trial and Appeal Department, the JPO believes that it is essential to consider appropriate chain of command among administrative judges (trial examiners), trial clerks, and administrative officials. Also, when allocating human resources, it is also important to check the trends in the number of requests for trials and trial examination period\* in each technical field.

Note\*: The average time of the first action (FA) pendency for trial examinations, i.e., the waiting period between the time appeals or trials are requested until the time notices of trial decisions or notices of reasons for refusal are sent to plaintiffs.

*Question 3. In addition to above question, what are the functions of Trial and Appeal Division and Infringement and Invalidity Office?*

At the JPO, the Trial and Appeal Division is working on the following works:

1. Coordinate administrative works for appeals and trials involving industrial property rights, oppositions to granted patents, and oppositions to trademark registrations;
2. Conduct administrative works for appeals and trials involving industrial property rights, oppositions to granted patents, and oppositions to trademark registrations, (which include trials for requests for advisory opinions and judgments that provide opinions on the technical scope of rights that are given proper protection; the same shall apply hereinafter); and
3. Conduct administrative works for trial decisions on industrial property rights and designated representatives of the JPO Commissioner, who are involved with lawsuits rescinding trial decisions on the cancellation of granted patents and trademark registrations.

In the Infringement and Invalidity Affairs Office of the Trial and Appeal Division, trial clerks are conducting formality checks on written documents involving trials for patent invalidations and trials for cancellation of trademark registrations; and are

working to ensure proper coordination among demandants of trials, demandees, and administrative judges (trial examiners).

*Question 4. What are the most appropriate composition of Appeal Board especially in the situation that the IP human resource is limited? In connection with this, what are the basic required qualification for the Board members?*

With regard to basic qualifications of members of the Trial and Appeal Department at the JPO, please refer to VI. stated below. In our understanding, when there are only a limited number of human resources that can be assigned at the trial and appeal department, one idea might be to establish a framework in which examiners conduct re-examinations as a step before administrative judges conduct trial examinations.

*Question 5. Up to now, how many total members are there in the Appeal Board and in each Board? Besides handling the assigned cases, is there any other responsibilities for Appeal Board members?*

In general, in the Trial and Appeal Department, there are 280 chief administrative judges and administrative judges (around 5-15 judges per each Board), who conduct trial examinations on trial cases involving industrial property rights and are engaged in related works. Also, around 80 chief administrative judges and administrative judges are working at other departments concurrently, such as the Policy Planning and Coordination Department (the General Coordination Division, the Policy Planning and Research Division, the International Policy Division, the International Cooperation Division, and the Information Technology and Patent Information Management Office) and the Trial and Appeal Division. They are engaged in planning, developing, and coordinating various policies by making effective use of their professional expertise.

Also, in the Trial and Appeal Department, there are around 30 trial clerks and around 20 administrative officials.

Note: Due to changes in personnel, the total number of members who have belonged to the Trial and Appeal Department is unclear.

*Question 6. In JPO, what are the required qualifications and criteria to be appointed as the Appeal Board member and administrative judge?*

In order for individuals to work as full-time, regular employees at the JPO, they need to pass the national civil service examination (career-track position (technology-based) / regular service position (public administration)) and to be hired as technical officials or administrative officials by the JPO. In the Trial and Appeal Department, JPO officials are assigned as chief administrative judges, administrative judges, trial clerks, administrative officials, based on the individual experiences and qualifications. Also, in general, the JPO reassigns them to work in different divisions or departments in several years.

In Japan, Article 5 of the Enforcement Regulations of the Patent Act stipulates that persons qualified to be administrative judges need to (1) have certain job ranks; (2) have conducted examinations as examiners at the JPO for five years or more; and (3) have completed the statutory training courses required by law at the National Center for

Industrial Property Information and Training (INPIT). When assigning administrative judges, the JPO evaluates their personal and performance evaluations.

Note: Currently, JPO officials can be promoted to administrative judges after having worked 16 to 20 years at the JPO.

*Question 7. After receiving the cases, how to assign the cases and appoint the appeal board members to specific cases?*

In the Trial and Appeal Department, there are 38 Boards of Trial and Appeal (4 for trademarks, 1 for designs, 33 for patents/utility models). The Boards for patents and trademarks are divided according to specific fields in charge. Filed trials and appeals are allocated in accordance with technical fields of these trial cases. In each of the Boards, Director of the Board designates three administrative judges to conduct trial examinations as a panel.

*Question 8. In settling the cases, there will be solved by the collegial body that comprise of 3 or 5 administrative judges presided over by a chief administrative judge, What are the roles of chief and each administrative judge in the Panel?*

Chief administrative judges preside over matters relating to trials (under Article 138 of the Patent Act). In fact, chief administrative judges play significant roles in trial proceedings. Also, one of the other three administrative judges in a panel is designated as principal administrative judge to prepare draft trial decisions based on the discussion results in a panel. Other administrative judges are taking part in a panel to check draft trial decisions.

*Question 9. Is there any limited term period or rotation for each administrative judge in each Board?*

The JPO does not set any fixed timeline for the career development of its administrative judges. Nonetheless, in general, after JPO examiners are promoted to administrative judges, they work at the Trial and Appeal Department for 1-2 years to handle trial examinations. Then, they are transferred to the Examination Divisions to conduct examinations as senior examiners. After they are promoted to managers/directors in the Examination Divisions (from Associate Managing Examiner, Managing Examiner, to Director), they are reassigned to the Trial and Appeal Department to involve in trial proceeding as Associate Principal Administrative Judge or Chief Administrative Judge.

*Question 10. In the future, will there be any further trademark Board be established?*

Currently, the JPO doesn't plan to add the Board for trademarks. However, in the future, if the number of trials and appeals involving trademarks increases, the number of the Boards for trademarks may also increase.

*Question 11. What are the source of budget for the operation of the board?*

In Japan, the industrial property system is financed under the Patent Special Account budget. Under the framework of this Patent Special Account, fees being collected from

applicants, such as filing fees, examination request fees, and patent fees, cover expenditures that are needed to conduct examinations and trials on patents, utility models, designs, and trademarks, as well as to register these rights.

*Question 12. Is there any strategy for the Board to handling, managing and operating cases effectively and efficiency?*

One example is that the JPO prepares certain tools for directors and administrative judges to check when trial periods expire and the status of trial proceedings. Also, the JPO uploads useful information in the intranet to support administrative judges, in order for them to apply appropriate laws and make effective use of its systems.

*Question 13. Are there any capacity building and encouragement schemes for the members of the board?*

The JPO conducts the following training courses/programs for officials working in the Trial and Appeal Department to enhance their professional knowledge and practical capabilities involving on laws and technologies:

- Training courses for new chief administrative judges and administrative judges about the overall practices for appeal and trial examinations;
- Technical training program: Lectures on cutting-edge technologies; visit to companies and factories; and participation in academic conferences, exhibitions, and seminars)
- Legal training course: Training on inter-parties trials; training on litigation and actual application thereof; and legal training course for administrative judges (training program for new administrative judges to gain knowledge about laws, mainly about the Code of Civil Procedure)
- Foreign language training program: English, Germany, French, Chinese, Korean, etc.

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## Appendix II: Answers from JPO to Questions Part 2. Cases handling procedures

Date: Answers by written document were received on 21 September 2017

Respondent: Trial and Appeal Division, Trial and Appeal Department, JPO

*Question 1. Most of the cases, Appeal Board proceeds with the documentary proceeding and in what circumstances, does Appeal Board conduct the hearing proceeding? What are the procedures for conducting hearing proceeding? In some instance the hearing procedures have been requested or made ex officio, between the documentary proceeding and the combination of hearing and documentary proceeding which one is the best procedure in term of accuracy, effectiveness and time saving for handling the cases? Why?*

In trials to invalidate patent rights, utility model rights, and design registrations, all trial examinations should be conducted in principle based on oral proceedings (hearing proceedings), excluding cases in which all concerned parties request documentary proceedings. Among trial cases for cancellation of trademark registrations, when both written answers and written refutations have been submitted, all trial examinations should be conducted in principle based on oral proceedings, excluding cases in which all concerned parties request documentary proceedings.

Since both of the oral proceeding and documentary proceedings have their own advantages, it is not easy to answer which is better.

In inter parties trials, such as trials for invalidation and trials for cancellation, the JPO is actively conducting oral proceedings, aimed at determining facts and organizing/clarifying issues under dispute, as well as at achieving the overall satisfaction of both concerned parties. Meanwhile, in ex parte trials, such as appeals against examiners' decisions of refusal, all trial examinations should be conducted in principle based on documentary proceedings, taking into account the burden on concerned parties.

*Question 2. In case there is a request for invalidation and cancellation of the registered trademark at the same time from different applicants, how will JPO handle the case in this situation?*

In Japan, when one or both concerned parties to two or more trials are identical, the proceedings for them may be consolidated (under the 30-03 session of the Manual of Appeal and Trial Proceedings on Patents, Utility Models, Designs and Trademarks). Based on this, when two or more parties request trials for invalidation, or trials for cancellation, against one trademark registration, the proceedings for them will be consolidated. However, two or more trials that can be consolidated should be the same type. Therefore, when trials for invalidation and trials for cancellation are filed simultaneously against one trademark registration, the proceedings for them will not be consolidated, even if concerned parties for them are identical.

*Question 3. During the opposition period and after JPO decision to maintain the registered trademark upon the opposition proceeding, the opponent cannot take further action against the decision, but then it will be able to request for invalidation or cancellation proceeding. In this case, would it be possible for the opponent to directly request for invalidation or cancellation proceeding without opposition?*

In Japan, users can request trials to invalidate/cancel trademark registrations, without filing oppositions to them.

*Question 4. For the invalidation and cancellation cases, does JPO have the ex officio action on these cases without the request from interested parties?*

At the JPO, even if there are no requests for invalidation trials from demandants or interested parties, examiners may conduct ex-officio examinations on reasons for invalidating trademark registrations under Article 56 of the Trademark Act that applies mutatis mutandis Article 153 of the Patent Act. Among trials for cancellation of trademark registrations, if trials for cancellation for non-use are requested, and when the demandees, i.e. rights holders, do not submit any written answers proving that they actually used their registered trademarks for either designated good or service connected to requests for cancelling, or documents stating some justifiable reasons why their registered trademarks have not been used, JPO examiners cannot conduct ex-officio examinations as to whether or not the registered trademarks have actually been used under Article 50 (2) of the Trademark Act.

*Question 5. In designated an adequate time limit for the parties to submit their statement of arguments in each proceeding, how long should it be and what factors shall be taking into consideration in designated an adequate time limit for each proceeding?*

The 25 session of the Manual of Appeal and Trial Proceedings states the deadlines for submitting all written documents to the JPO in trial proceedings. The length of the procedural periods vary depending on various conditions, such as whether or not concerned parties are domiciled in Japan, how long the JPO needs to deal with proceedings for them, and the appropriate length of the periods needed to conduct more prompt trial examinations.

*Question 6. How does the Appeal Board examine the evidences and make the decision?*

In Japan, the Patent Act applies mutatis mutandis Articles of the Code of Civil Procedure for examination of evidence, and based on these, examiners conduct examinations of evidences. Also, the detailed outline of examination of evidence is stated in the section 35 of the Manual of Appeal and Trial Proceedings.

*Question 7. In deciding the cases, the well-known and famous of the trademarks will be taken into consideration. What are the differences between the well-known and famous trademarks? What are the criteria to judge the well knownness and famousness of the trademarks?*

Both well-known trademarks and famous trademarks are trademarks that have become well known among consumers. Well-known trademarks include trademarks that are well known not only among end-use consumers but also among traders; and trademarks that are well known in a specific region. Meanwhile, famous trademarks include trademarks that well known all over the country; and famous foreign trademarks.

*Question 8. How long does it take to handle a case with the Appeal Board?*

The average length of a trial examination for one appeal or trial being conducted at the JPO in 2016 as follows:

Appeals against examiners' decisions of refusal: 13.1 months for patents and utility models; 6.8 months for designs; and 7.2 months for trademarks

Trials for invalidation: 10.5 months for patents and utility models; 15.5 months for designs; 11.3 months for trademarks

Oppositions: 5.8 months for granted patents and 8.3 months for trademark registrations

Trial for cancellation: 6.4 months for trademark registrations

*Question 9. After the invalidation or cancellation procedures reached an end and the decision to invalidate or cancel registered trademark have been issued, is there any action taken by JPO concerning the products bearing the registered trademark in the market?*

In such cases, the JPO does not take any action.

*Question 10. The statistical data of Appeal cases and court cases*

- The total statistical data of the appeal, opposition and trial cases from 2016 to August 2017

Number of Final Decisions Made in Appeals/Trials at the JPO * (From January 2016 to August 2017)	
Appeals against examiners' decisions	19,392
Oppositions	2,350
Trials for invalidation	577
Trials for cancellation	1,652

- The total trademark statistical data of the appeal, opposition and trial cases from 2016 to August 2017 by specified its accepted, not accepted and dismissed, and withdraw/abandon

Decisions Made on Requests Filed for Appeals and Trials for Trademark Registrations at the JPO (From January 2016 to August 2017)				
	Validity/ Partial validity	Invalidity	Dismissal	Withdraw al
Appeals against examiners' decisions	720	302	25	15
Oppositions	115	530	82	82
Trials for invalidation	64	79	1	13
Trials for cancellation	1,305	155	24	169
(There is no data for "abandonment")				

- The statistical data of Court cases against the Board decisions from 2014 to August 2017.

Number of Appeals to the Intellectual Property (IP) High Courts, i.e. Lawsuits rescinding trial decisions (From January 2014 to August 2017)	1,260
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*Question 11. During the infringement proceeding to the court, is there any role or participation of JPO in the court proceeding?*

The JPO is not involved with trial proceedings at the IP High Courts as concerned parties. Nonetheless, under Article 71-2 of the Patent Act, when the JPO is commissioned by courts to provide its expert opinions on the technical scope of patented inventions, the JPO may appoint a panel of administrative judges to provide its expert opinions on this matter.

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### Appendix III: Answers from JPO to further questions

Date: Answers by written document were received on 4th October 2017

Respondent: Trial and Appeal Division, Trial and Appeal Department, JPO

*Question 1. In each Board, there are around 5 to 15 trial examiners and the cases will be assigned to each specific responsible Board according the nature of the cases. In this connection, how are the cases assigned to the members in the Board? In the random, order or rotation manner?*

When appointing a panel of administrative judges (trial examiners at the JPO), Director of the Board takes into consideration certain conditions, such as the details of individual cases and the ongoing progress in conducting trial proceedings.

*Question 2. How many cases does each trial examiner handle per month?*

The number of trial cases examined by administrative judges varies depending on specific technical fields and judges' experiences. Nonetheless, when considering the number of final dispositions on appeals against examiners' decisions of refusal for patents in 2016 (11,562 cases) and the number of administrative judges for patents (about 240 persons), the estimated average number of trial cases for which each administrative judge made final dispositions is 4 per month.

Note: Administrative judges at the JPO are working on other operations, such as activities of a "panel" for other than final dispositions and "first actions.")

*Question 3. Will JPO select the new trial examiners every year? If so, how many per year?*

In order to maintain and improve the quality of administrative judges for patents by appropriately developing human resources, the JPO believes that it would be desirable to ensure certain number of new administrative judges regularly, for example, each year.

The JPO does not fix how many JPO officials should be promoted to administrative judges for patents per year. That is because, in Japan, Article 5 of the Enforcement Regulations of the Patent Act stipulates persons qualified to be administrative judges for patents, and the number of persons who completed the statutory training courses required by law is different depending on the year.

*Question 4. How many levels of administrative judge are there in the Appeals and Trial Department?*

There seven levels as follows.

- Senior Director of the Board of Trial and Appeal
- Director of the Board of Trial and Appeal
- Chief of Administrative Judge
- Principle Administrative Judge
- Associate Principle Administrative Judge
- Senior Administrative Judge
- Administrative Judge

*Question 5. The JPO conducts the training courses/programs for officials working in the Trial and Appeal Department to enhance their professional knowledge and practical capabilities involving on laws and technologies, are the trainings conducted every year?*

Yes.

*Questions 6. The proceeding can be consolidated in case the types of trials and objectives of the trials are identical. However, in the circumstance that different types of trial have been concurrently requested against the same trademark registration, which trial will be put in priority by JPO in the following cases:*

- i)- Opposition and Invalidation,*
- ii)- Opposition and cancellation,*
- iii)- Invalidation and cancellation.*

In your question, for cases in which trials for oppositions and trials for invalidation are pending at the same time (Case i), and for cases in which trials for opposition and trials for cancellation are pending at the same time (Case ii), the 66-07 session of the Manual of Appeal and Trial Proceedings on Patents, Utility Models, Designs and Trademarks states how to conduct trial proceedings. (Provisional English translation of this session is attached)

Also, for cases in which trials for invalidation and trials for cancellation are pending at the same time (Case iii), there are no rules for which trials the JPO gives higher priority to. Nonetheless, a panel of administrative judges will determine the priority by considering the efficiency and necessity.

*Question 7. Could you briefly describe the following processes with indication of the timeline:*

- The process of assign the case to specific board after receipt of appeal or trial request,*
- The formality examination process,*
- The trial examination process,*
- The reply and refutation between parties,*
- Trial decision, and the notification of the decision.*

At the JPO, trial cases are assigned to each of the Boards of Trial and Appeal according to their specific technical fields. When appointing a panel of administrative judges, Director of the Board takes into consideration certain conditions, such as the details of individual cases and the ongoing progress in conducting trial proceedings. The flowcharts of procedures for appeals against examiners' decisions of refusal, trials for invalidation, and trials for oppositions are as attached. For more details, please refer to the following sessions of the Manual of Appeal and Trial Proceedings (Nonetheless, they are available in Japanese only.): 51-03 (Trial for Invalidation Flow Charts by IP Type); 61-00.1 (Basic Flow of Appeal against Examiner's Decision of Refusal); and 67-00 (Opposition to Grant of Patent).

*Question 8. In case the action against the decisions of the Appeal Board to the IP High Court, is there any time limited for that actions?*

Interested parties can file lawsuits in courts within 30 days from the date on which certified copies of the examiners' trial decisions have been sent. Nonetheless, in some cases, the deadline can be extended.

*Questions 9. There are 38 trial and appeal boards and separation division and office in the organizational structure of Trial and Appeal Department of JPO. Is each board responsible both for appeal against examiner's decision of refusal, trial for invalidation and trial for cancellation? Or is there any separation responsibility over the case for the board, division and office?*

Each board is responsible for both.

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