

15.01

With regard to Examination of Effect of Priority Claim on Application for Trademark Registration Claiming Priority

1. Examination of the effect of a priority claim

(1) Cases in which the effect of a priority claim needs to be determined

It is sufficient for an examiner to determine whether or not the effect of a priority claim is recognized only in the following cases: (i) a case in which the examiner finds a cited trademark that could fall under Article 4(1)(xi) of the Trademark Act during the period between the filing date in the first foreign country (country with which a basic application for claim of priority was filed) (hereinafter referred to as the “priority date”) and the filing date of the application for trademark registration claiming priority; (ii) a case in which the examiner finds a trademark which, as of the priority date, could serve as the basis of Article 8(2) or (5) of the Trademark Act; and (iii) a case in which the reasons for refusal provided in Article 4(3) of the Trademark Act apply (the provisions set forth in Part XVIII: Others, 3 (2) of the Examination Guidelines for Trademarks, i.e. Article 4(1)(viii), (x), (xv), (xvii), and (xix) of the Trademark Act).

(Explanations)

This is because the examination results change according to whether or not the effect of the right of priority under the Paris Convention (Paris Convention Article 4 A(1)) is recognized only in cases where a fact that serves as the basis for any of these grounds for refusal is found during the period between the priority date and the filing date of the application for trademark registration claiming priority. The same applies to the priority claim governed by the Paris Convention (Articles 9-2 and 9-3 of the Trademark Act and Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of the Trademark Act).

(2) Requirements for recognizing the effect of a priority claim

In order for the effect of a priority claim to be recognized, the following requirements (i) to (iii) need to be satisfied.

When the requirements are not satisfied, the application is treated as an application for trademark registration for which the effect of a priority claim is not recognized.

- (i) The applicant of an application for trademark registration claiming priority is the same person as the applicant or the successor thereof shown in the certificate, etc. submitted pursuant to Article 43(2) of the Patent Act as applied mutatis mutandis pursuant to Article 13(1) of the Trademark Act (hereinafter referred to as “priority

certificate, etc.”) (Paris Convention Article 4 A(1)).

- (ii) The trademark described in the request of an application for trademark registration claiming priority is identical with the trademark described in the priority certificate, etc.
- (iii) All or part of the designated goods or designated services pertaining to an application for trademark registration claiming priority are included in the designated goods or designated services shown in the priority certificate, etc.

2. Identity between the applicant of an application for trademark registration claiming priority and the applicant shown in the priority certificate, etc. (requirement (i))

When the name of the applicant entered in the request of an application for trademark registration claiming priority and that of the applicant entered in the priority certificate, etc. do not match or their identity is unclear, a notice is given to the applicant or agent to require submission of a document that proves that the applicant in the request and the applicant in the priority certificate, etc. are the same person or the successor thereof.

This notice does not necessarily have to be given as an independent notice, and the contents of the notice may be additionally stated when giving another notice, such as when the first notification of reasons for refusal is issued.

If the document proving the identity of the applicant or the successor thereof is not submitted within a reasonable period, the effect of the priority claim is not recognized, and a notice to that effect is given to the applicant or agent. This notice is given by additionally stating the contents of the notice when giving an examiner's decision of trademark registration or decision of refusal.

(Explanations)

The fact that the applicant of the application for trademark registration claiming priority is the same person as the applicant shown in the priority certificate, etc. or the successor thereof is one of the requirements for the effect of the priority claim to be recognized. However, some countries issue a priority certificate, etc. with no statement of the domicile or residence of the applicant, so there are cases where it cannot be confirmed whether the domicile or residence of the applicant entered in the request and that of the applicant entered in the priority certificate, etc. are the same based on information in the priority certificate, etc. alone. In addition, there are also frequent cases where the applicant's domicile or residence is changed within the same country, and there is no reasonable ground for requiring submission of a material showing the basis for the difference in the domicile or residence in spite of the name of the applicant being the same. Accordingly, in examining the effect of a priority claim, the applicant of the application for trademark registration claiming priority and the applicant shown in the priority certificate, etc. are determined to be the same person if their names are the same.

3. Identity between the trademark described in the request of an application for trademark registration claiming priority, and the trademark shown in the priority certificate, etc. (requirement (ii)).

In the case that a trademark described in the request of an application for trademark registration claiming priority and the trademark shown in the priority certificate, etc. are clearly different, such as where the capital letters and small letters of alphabetical characters differ between them, the trademarks cannot be recognized to be identical.

If the trademarks are not identical, a notice is given to the applicant or agent of the fact that the effect of the priority claim is not recognized and the reason therefor. This notice does not necessarily have to be given as an independent notice, and the contents of the notice may be additionally stated when giving another notice, such as when giving the first notification of reasons for refusal or the examiner's decision of trademark registration.

On the other hand, if the difference is recognized to be derived from a difference in the system and operation or from a difference in information system operation in the first foreign country according to the explanation by the applicant or agent after comprehensive examination of the contents of the description of the whole priority certificate, etc., the trademarks are treated as being substantially the same and recognized to be identical, even if they are not strictly identical.

When both of the trademarks fall under the following items, they are treated as being substantially the same trademarks.

(1) Case of difference in the system and operation

(i) Application for a “series of trademarks” in the United Kingdom, etc.

When an application in the first foreign country is an application for a series of trademarks, and a plurality of trademarks are shown in the priority certificate, etc. and a trademark contained in the request is recognized to be identical to one of those trademarks concerned, both of them are treated as being substantially the same trademarks.

(Explanations)

A series of trademarks is a specific system adopted in the United Kingdom, etc. In this system, it is possible to file an application for a plurality of trademarks through a single procedure, and it is deemed that the application has been filed for each one of those trademarks independently instead of for one trademark as a whole.

Therefore, if it is possible to confirm that an application in the first foreign country is an application for a series of trademarks from the description of the priority certificate, etc., one trademark of the series of trademarks of the application in the first foreign country is compared with the trademark described in the request to judge whether they are identical to each other.

Incidentally, when an application for registration of a plurality of trademarks shown in the priority certificate, etc. is filed with the JPO as one trademark, the practice to treat the trademark shown in the priority certificate, etc. and the trademark described in the request as being substantially the same trademarks is not applied.

(Case example where the trademarks were recognized as being substantially the same trademarks)

- The trademark shown in the request of an application for trademark registration claiming priority (Trademark Application No. 2000-2024)



- The trademarks shown in the priority certificate, etc. and a statement indicating that they are a series of trademarks



Date Filed:	16.07.1999
Date Progress Stopped:	
(Earliest) Priority Date:	
Priority Country Code:	
Number in Series:	002

(ii) An application for a three-dimensional trademark in the USA

When fine lines or shading for representing shadow are applied to a three-dimensional trademark contained in the priority certificate, etc., but fine lines or shading for representing shadow are not applied to the three-dimensional trademark contained in the request, and their only difference is the presence or absence of the fine lines or the shading, both of them are treated as being substantially the same trademarks.

(Explanations)

In the USA, it is acceptable to apply dotted lines or fine lines or shading for representing shadow to a trademark specimen. However, Notes in Form 2 of the Regulation for Enforcement of the Trademark Act of Japan provide that “fine lines or shading representing shadow, indication lines, signs or characters for explaining the contents, and other lines, signs, figures or characters not constituting the trademark must not be stated or depicted unless otherwise provided for.”¹

In this case, although the shadow is applied to the three-dimensional trademark shown in the priority certificate, etc., the applicant for trademark registration needs to delete the shadow concerned from the trademark specimen of the three-dimensional trademark relating to the application. In this case, the trademarks will not strictly match.

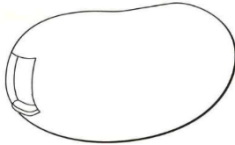
However, the difference in the presence or absence of the shadow concerned results from a difference in the method of describing a trademark between the USA and Japan, and it is harsh on the applicant for trademark registration to be denied of the identity of the trademarks only based on the difference in the presence or absence of the shadow

¹ USPTO Examination Guide 1-05 <http://www.uspto.gov/trademarks/resources/exam/examguide1-05.jsp>

concerned. Therefore, both trademarks are treated as being substantially the same trademarks unless there are special circumstances.

(Example where both trademarks are assumed to be substantially the same trademarks)

- The trademark contained in the request for an application for trademark registration claiming priority (three-dimensional trademark)



- The trademark shown in the priority certificate, etc. and an explanation about the trademark



[Description about the trademark]²

The mark consists of the product packaging for candy, namely a three dimensional configuration of a unique container in the shape of a jelly bean. The lining shown in the drawing is used to indicate the 3-dimensional roundness of the mark and is not a feature of the mark, and does not indicate color.

(2) Case of difference in information system operation

- (i) An application for a trademark composed of standard characters or characters expressed in a font recognized to be a generally used font

In the case where the trademark shown in the priority certificate, etc. is composed of characters expressed in a font recognized to be a generally used font in electronic equipment, and the trademark described in the request is composed of standard characters or characters expressed in a font recognized to be a generally used font in electronic equipment, both are treated as being substantially the same trademarks unless there are special circumstances.

(Explanations)

In issuing a priority certificate, etc., characters with various fonts can be printed due to the recent development and spread of a wide variety of electronic equipment. Accordingly, there is a possibility that the same characters would be displayed in varied fonts according to the information systems of government offices of the respective countries.

In consideration of the circumstances described above, in the case where the font of characters of the trademark shown in the priority certificate, etc. is different from that of characters of the trademark described in the request, both trademarks cannot be said to

² The mark consists of the product packaging for candy, namely a three-dimensional configuration of a unique container in the shape of a jelly bean. The lining shown in the drawing is used to indicate the three-dimensional roundness of the mark and is not a feature of the mark, and does not indicate color.

be strictly identical, but if neither font is recognized to have a feature that affects the distinctiveness of the trademark, and can be recognized to be a common font, the difference in the font concerned is thought to be attributable to the information systems as described above. Therefore, both trademarks are treated as being substantially the same trademarks unless there are special circumstances.

(ii) Difference between double-byte and single-byte characters in an application for a trademark composed of standard characters

In the case where the trademark shown in the priority certificate, etc. is composed of single-byte characters expressed in a font recognized to be a generally used font in electronic equipment, and the trademark described in the request is composed of standard characters (double-byte characters), both are treated as being substantially the same trademarks unless there are special circumstances.

(Explanations)

The characters that can be used for the standard characters prescribed in Article 5(3) of the Trademark Act are only double-byte characters. A trademark composed of single-byte characters cannot be filed in Japan as a trademark composed of standard characters.

(https://www.jpo.go.jp/system/laws/rule/guideline/trademark/binran/document/index/s_hiryou_1_1.pdf)

Therefore, in the case where the trademark shown in the priority certificate, etc. and the trademark described in the request (standard characters) have a difference between double-byte and single-byte characters, the trademarks cannot be said to be strictly identical, but the difference is considered to be attributable to the information systems, so both are treated as being substantially the same trademarks unless there are special circumstances.

(Case example where the trademarks were recognized as being substantially the same trademarks)

○ The trademark described in the request of an application for trademark registration claiming priority (Trademark Application No. 2008-12191)

M a r y L o u ' s W e i g h (standard characters)

○ The trademark shown in the priority certificate, etc.

Mary Lou's Weigh

4. Determination as to whether the designated goods or designated services stated in the request of an application for trademark registration claiming priority are included in the designated goods or designated services shown in the priority certificate, etc. (requirement (iii))

If the designated goods or designated services stated in the request of an application for trademark registration claiming priority are included in the designated goods or designated services shown in the priority certificate, etc., the effect of the priority claim arises for each of the designated goods or designated services thus included.

In other words, there is a case where the effect of a priority claim arises for all designated goods or designated services stated in the request and a case where such effect only arises for part of the designated goods or designated services stated in the request.

In making its determination, the indication of the designated goods or designated services shown in the priority certificate, etc. does not need to be the same as the designated goods or designated services stated in the request; as long as a comprehensive indication that includes the designated goods or designated services stated in the request (such indication may be unclear at times) is shown in the priority certificate, etc., the designated goods or designated services stated in the request are recognized to be included in the designated goods or designated services shown in the priority certificate, etc.

If it is recognized that the designated goods or designated services stated in the request are clearly not included in the designated goods or designated services shown in the priority certificate, etc., a notice is given to the applicant or agent of the fact that the effect of the priority claim is not recognized and the reason therefor. This notice does not necessarily have to be given as an independent notice, and the contents of the notice may be additionally stated when giving another notice, such as when giving the first notification of reasons for refusal or the examiner's decision of trademark registration.