

16.01

Handling of Claims for Application of the Special Provisions Concerning the Time of Filing of an Application

1. The exhibitions subject to the provisions of Article 9(1) of the Trademark Act are as follows:

- (1) An exhibition held by the national or local government (hereinafter referred to as the "Government, etc.");
- (2) An exhibition held by those who are not the Government, etc. that complies with the standards specified by the Commissioner of the Patent Office;
- (3) An international exhibition held by a country that is a contracting party to the Paris Convention for the Protection of Industrial Property ("Paris Convention"), a member of the World Trade Organization or a contracting party to the Trademark Law Treaty (an international exhibition held by the Government, etc. or by those authorized thereby to hold such an exhibition); and
- (4) An international exhibition held by a country which does not fall under the category prescribed in paragraph (3) above but complies with the standards specified by the Commissioner of the Patent Office (hereinafter referred to as the "Standards") (an international exhibition held by the Government, etc. or by those authorized thereby to hold such an exhibition).

2. On claiming the application of the special provisions concerning the time of filing of an application pursuant to Article 9(1) of the Trademark Act, an applicant must prove the date when goods or services were exhibited at an exhibition and the fact that such goods or services were exhibited at the exhibition (Article 9(2) of the Trademark Act, and Article 6-2 of the Regulation for Enforcement of the Trademark Act).

For example, the fact of exhibition of such goods or services shall be proved by the following means of proof:

- (1) Certificate issued by an exhibition-organizer, proving that such goods or services were exhibited by the applicant; and
- (2) Pamphlet showing that such goods or services were exhibited by the applicant.

3. Where the exhibition falls under the categories prescribed in the preceding paragraphs 1(2) and 1(4), the applicant, in addition to proving the fact that such goods or services were exhibited at the exhibition as prescribed in 2. above, must prove that the exhibition complies with "the standards specified by the Commissioner of the Patent Office" based on Article 9(1) of the Trademark Act.

Whether the exhibition complies with the Standards, shall be proved by means of

proof, such as, a pamphlet or a program of the exhibition created to be publicly distributed, where, for example, (i) the name of the exhibition, (ii) the name of the organizer, (iii) the presence of support by Government, etc. and the like are clearly described.

(Explanations)

1. The provisions of Article 9 of the Trademark Act prescribe special provisions concerning the time of filing of an application, and provide that where an application for trademark registration is filed in connection with a trademark used for goods or services exhibited at an exhibition held by the Government, etc., by the exhibitor of such goods or services bearing the trademark within six months from the date of exhibition of such goods or services, the application shall be deemed to have been filed at the time of exhibition of such goods or services.

2. The purpose of this Article is to protect an exhibitor in a case where an application for trademark registration of a trademark used for goods or services exhibited at an exhibition by the exhibitor is filed first by a person other than the exhibitor who should be the correct applicant for trademark registration.

Furthermore, this Article is also a provision for securing the duties prescribed in Article 11 of the Paris Convention.

3. Where an application is decided to fall under the reasons for refusal prescribed in Article 4(1)(xi) or other relevant provisions of the Trademark Act, for reasons such that it does not comply with the Standards and the filing date is not retroactive, the applicant can make a counterargument against the decision that the exhibition relating to the special provisions concerning the time of filing of an application does not comply with the Standards, through a written opinion against the notification of reasons for refusal or a request for appeal against an examiner's decision of refusal.

On the other hand, where an application is decided not to fall under the reasons for refusal prescribed in Article 4(1)(xi) or other relevant provisions of the Trademark Act, and the trademark is registered, i.e. the trademark complies with the Standards and the filing date is retroactive, a third party can make a counterargument against the decision that the exhibition relating to the special provisions concerning the time of filing of an application complies with the Standards, through an opposition to registration or a request for an invalidation trial.

(Reference)

1. In the Trademark Act before being partially amended in 2011, there were special provisions (Article 9(1)) providing that only with respect to an exhibition, etc., held by those who are not the Government, etc. that is an exhibition designated by the

Commissioner of the Patent Offices shall an application for trademark registration filed for the trademark used for the goods or services exhibited at the exhibition be deemed to have been filed at the time of exhibition of such goods or services.

In the amended law, for the purpose of improving the convenience of applicants and reducing the burden of the exhibition-organizers, the system was changed to one where applicants can claim the application of the special provisions concerning the time of filing of an application in relation to an exhibition complying with certain standards even if such exhibition has not been designated by the Commissioner of the Patent Office.

2. "The standards specified by the Commissioner of the Patent Office" based on Article 9(1) of the Trademark Act after the amendment are substantially the same as the designation standards of exhibitions based on Article 9(1) of the Trademark Act before the amendment.

See part 16.04 of the Trademark Examination Manual for "The standards specified by the Commissioner of the Patent Office."

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

Article 4(1)(ix) (Prize awarded at an exhibition)

Article 4(1) (xi) (Another person's registered trademark applied for prior to the filing date of the trademark application concerned)

Article 9 (Special provisions concerning the time of filing of applications)