

18.01

Handling of Re-filings after Central Attack

1. Examination of re-filings after central attack

Where an international registration relating to a trademark that was the subject of an “international registration designating Japan” is rescinded pursuant to the provisions (central attack) of Article 6(4) of the Protocol in respect of all or some of the goods or services designated in the international registration, the person who was the holder of the international registration may file an application for trademark registration for all or some of the goods or services within three months from the date on which the international registration was rescinded (Article 68-32(1) of the Trademark Act; hereinafter referred to as "re-filing").

Article 68-34 of the Trademark Act stipulates special provisions on the reasons for refusal of re-filings, and a re-filing will be rejected if the re-filing falls under any of the items of Article 15 of the Trademark Act or does not comply with the requirements provided in Article 68-32(1) or (2) of the Trademark Act.

However, with regard to Article 15 of the Trademark Act, in respect of an international registration rescinded by central attack, if protection has become final as a trademark right based on the international registration through substantive examination in Japan, no re-examination on the substantive reasons for refusal (reasons for refusal other than Articles 5(5) and 6 of the Trademark Act) shall be conducted.

Specifically, the examination will be conducted as follows.

(1) Regarding a re-filing concerning a trademark right pertaining to an international registration, only the following examinations as to (i) to (iv) and the examinations as to Articles 5(5), 6(1) and (2) of the Trademark Act will be conducted (Article 68-34(2) of the Trademark Act).

(2) Regarding a re-filing concerning an international application for trademark registration, the following examinations (i) to (iv) and regular examinations (Articles 3, 4, 6, etc. of the Trademark Act) will be conducted (Article 68-34(1) of the Trademark Act).

(i) The applicant of the re-filing is the same person as the holder of the international registration rescinded by central attack.

(ii) The re-filing is made within three months from the date on which the international registration was rescinded by central attack.

(iii) The trademark stated on the application of the re-filing and the trademark pertaining to the international registration rescinded by central attack are identical.

(iv) The designated goods or designated services pertaining to the re-filing are included in the scope of goods or services pertaining to the international registration rescinded by central attack.

2. Concerning the identicalness of applicant of re-filing made after central attack and the holder of international registration rescinded by central attack (Requirement (i))

Regarding the applicant stated in the application for a re-filing and the person who was the holder of the international registration rescinded by central attack, if the name and the domicile or residence do not match or are unknown, the reasons for refusal will be notified, and a request will be made for submission of a document proving that the applicant is the same person as the person who was the holder of the international registration rescinded by central attack.

If it can be confirmed from the submitted document that the applicant and the holder are the same person, the applicant stated in the application for the re-filing shall be determined to be the person who was the holder of the international registration rescinded by central attack.

If the requirement is satisfied at the time of filing, the requirement will be satisfied even if there is a change of name during a pending examination.

3. The re-filing is filed within three months from the date on which the international registration was rescinded by central attack (Requirement (ii))

The date on which the international registration was partially or wholly rescinded by central attack will be confirmed by the "Cancellations" sent from the International Bureau.

If the re-filing is not filed within three months from the date on which the international registration was rescinded, it is confirmed whether the re-filing has been made within 14 days (two months for overseas residents) from the date on which the reasons not attributable to the applicant ceased to be applicable but not later than 6 months after the expiration of the period (Article 68-32(6) of the Trademark Act).

If the application is not filed within these periods, the reasons for refusal will be notified.

4. Concerning the identicalness of the trademark stated in the re-filing application and the trademark pertaining to the international registration rescinded by central attack (Requirement (iii))

The determination of whether or not the trademarks are identical shall be strictly interpreted, and the two trademarks must be identical in structure and form (including those which differ only in scale).

If the two trademarks cannot be found to be identical, the reasons for refusal will be notified.

Re-filing is a means of remedy when a trademark right based on an international registration in Japan or an international application for trademark registration is rescinded. In view of such objective, it may be considered too harsh for the applicant to determine that there are reasons for refusal even for a trademark¹ where

¹ For example, if there was declaration to the effect that the trademark pertaining to the international application rescinded by central attack is "standard characters", it can be said that a remark indicating "standard characters" in the application for the re-filing was made with the intension of making the trademarks identical.

the applicant intends to file the same trademark as a trademark for which the international registration was rescinded by central attack, even if there is a formal doubt as to the identicalness of the trademarks. Therefore, taking into account the differences between the Japanese system and the international trademark registration system and the applicant's reasonable intentions that can be seen from the descriptions in the application, it is determined whether an amendment (limited to amendments to replace with the trademark pertaining to the international registration) to the trademark stated in the application for the re-filing constitutes a change in the outline.

5. The designated goods or designated services pertaining to the re-filing are included in the scope of the goods or services pertaining to the international registration rescinded by central attack (Requirement (iv))

If the designated goods or designated services pertaining to the re-filing are found to be substantially identical to the goods or services pertaining to the international registration rescinded by central attack or substantially included in such goods or services, the designated goods or designated services shall be deemed to be included in the scope of the goods or services. If it cannot be found that the designated goods or designated services pertaining to the re-filing are included in the scope of the goods or services pertaining to the international registration rescinded by central attack, the reasons for refusal will be notified.

For re-filings, since the date of international registration (date of subsequent designation) is deemed to be the filing date, the version of the international classification corresponding to the date of international registration (date of subsequent designation) will be applied.

Specifically, the designated goods or designated services pertaining to the re-filing will be compared with the following designated goods or designated services.

- (1) For a re-filing concerning a trademark right pertaining to an international registration, the designated goods or designated services registered in the trademark registry pertaining to the trademark right that have been rescinded by central attack
- (2) For a re-filing concerning an international application for trademark registration, the designated goods or designated services described in the application (or, if any amendments or limitations were made at the time of rescinding by central attack, the designated goods or designated services after such amendments or limitations)

Where Requirement (iv) is not satisfied and the reasons for refusal are notified, if, as a result of amendment to the designated goods or designated services pertaining to the re-filing, the designated goods or designated services came to be included in the scope of the goods or services pertaining to the international registration rescinded by central attack, the reasons for refusal will be resolved.

6. Retroactive date for re-filing after central attack

If the re-filing satisfies the requirements, the re-filing shall be deemed to have been made on the date of international registration (in the case of subsequent

designation, on the date of subsequent designation).

In addition, if the priority under Article 4 of the Paris Convention has been recognized for the international application for trademark registration pertaining to the re-filing, the priority will be recognized for the application for trademark registration under the same paragraph (Article 68-32(3) of the Trademark Act).

7. Examination of application for trademark registration after denunciation of the Protocol

An application for trademark registration based on Article 68-33 of the Trademark Act (special provisions concerning applications for trademark registration after denunciation of the Protocol) will be examined in the same manner as for a re-filing.