

20.04

Suspension of Examination Procedure

1. Stipulation of Trademark Law

In the examination of trademarks, the cases where the examination procedure could be suspended by other trial and appeal or lawsuits are stipulated as follows.

- (1) When it is admitted necessary during the examination, the procedure could have been suspended until the decision on opposition or appeal/trial decision has become irrevocable or the lawsuit procedure has completed (the Patent Act Article 54(1) applied mutatis mutandis pursuant to the Trademark Act Article 17).
- (2) When the applicant requested the appeal against examiner's decision to dismiss amendment, the examiner shall have suspended the examination until the decision of the trial and appeal has become irrevocable (the Trademark Act Article 16-2(4)).

2. Suspension of the procedure when it is admitted necessary during the examination

- (1) Application for Trademark Registration subject to the Suspension of the procedure

The application for trademark registration which is determined to have an effect on the reason for refusal based on the results of the trial and appeal or the like, relating to the trademark registration or application for trademark registration by another person or the person (applicant) who is pending opposition, trial and appeal, or judgment (hereinafter referred to as "trial and appeal, etc.") is subject to the suspension of the procedure.

- (2) Procedure for Suspension

I. Notification of Suspension

Regarding the application for trademark registration which has been determined that it is necessary to suspend the examination procedure based on the Trademark Act Article 17 in above 1 (1), the examiner notifies the applicant that the procedure of the application for trademark registration will be suspended along with the information that can identify the target trial and appeal or the like, such as the trademark registration number or the number of the application for trademark registration that serve as a basis for suspending the procedure.

II. Notification of Release of Suspension

Relating to the trademark registration or application for trademark

registration that serves as the basis for suspending, when the decision on opposition or appeal/trial decision become irrevocable or the lawsuit procedure has completed, the examiner notifies the applicant that the suspension of the procedure has been released.

3. Suspension of Procedure associated with Request for Appeal against Examiner's Decision to Dismiss Amendment

(1) Application for Trademark Registration subject to the Suspension of Procedure.

The application for trademark registration which was requested an appeal against examiner's decision with respect to the decision of dismissal of amendment after determined is subject to the Suspension of Procedure.

(2) Procedure for Suspension

I. Notification of Suspension

No notification of the suspension of the procedure will be issued. when the applicant requested an appeal against examiner's decision to dismiss amendment with respect to the application for trademark registration that was decided to dismiss amendment by examiner, as the law stipulates that the examination of the application for trademark registration shall have been suspended until the decision of the trial and appeal become irrevocable, the procedure would be definitely suspended. Thus, it is deemed unnecessary to issue a notification.

II. Notification of Release of Suspension

No notification of the release of the suspension of the procedure will also be issued. As the law stipulates that the examination of the application for trademark registration shall have been suspended until the decision of the trial and appeal become irrevocable, if the decision of the trial and appeal become irrevocable, the suspension of the procedure would be definitely released. Thus, it is deemed unnecessary to issue a notification.

4. Validity of Suspension

(1) Stop and Start of Progress of the Term

If the procedure is suspended, the term will stop to progress. When the procedure restarts to due to releasing of the suspension, the whole term will start to progress from the beginning of the rest¹ (the Civil Procedure Law Article 132(2) applied mutatis mutandis pursuant to the Patent Act Article 24 applied mutatis mutandis pursuant to the Trademark Law Article 77(2)).

(2) Procedures Performed during Suspension

The validity of procedures relating to the substantive judgment in the

¹ The term specified by the cabinet order of the Trademark Law Article 16 will progress as a new term (18 months).

examination performed by the examiner during the suspension of the procedure is not admitted.

5. Others

This processing does not apply to the international trademark application.