

40.01

Notification of Reasons for Refusal Based on Unregistered Prior Trademarks

There are several instances of multiple applications for trademark registration being filed for identical or similar trademarks simultaneously or within a short time period, reflecting the social situation at the time. For such applications, until the procedures for the first application have been completed, other applications for trademark registration must wait for these procedures to be applied, which delays the entire trademark registration procedure.

If the applicant were aware of an unregistered prior trademark at an early stage, the applicant could amend the designated goods or service at an early stage, or, adopt a different trademark and file an application for trademark registration, or respond in many other ways. In the event that the existence of an unregistered prior trademark was unknown to other applicants until the final decision was reached with respect to the application for trademark registration, there is a realistic concern that the situation could hinder the development of business.

Taking this situation into consideration, in the 1996 amendment of the Trademark Act, a new provision was added regarding the notification of reasons for refusal based on unregistered prior trademarks: which until then had been handled according to the discretion of each examiner, in order to clarify the legal grounds and to facilitate the examination procedures.

1. Notification of reasons for refusal

When a trademark claimed in an application for trademark registration is identical or similar to a prior trademark of a third party, the trademark is to be used for designated goods or designated services identical or similar to those for which the prior trademark is used, and the first-mentioned trademark will fall under the provisions of Article 15(1) of the Trademark Act when the prior trademark is registered, the examiner will notify the applicant of the fact in advance (notification of reasons for refusal) and designate a reasonable time limit so that the applicant has the opportunity to submit a written opinion (Article 15-3(1) of the Trademark Act).

When the notification of reasons for refusal has already been sent, and when the trademark of the third party has been registered, the examiner will not be required to send another notification of reasons for refusal (Article 15(2) of the Trademark Act).

2. Content of the notification of reasons for refusal

When the examiner sends a notification of reasons for refusal that is based on a prior unregistered trademark, the examiner must state the application number of the prior

unregistered trademark (cited trademark) notification of reasons for refusal. (When the prior unregistered trademark [cited trademark] is an international application for trademark registration, the international registration number should be included; in the case of subsequent designation, the description should be "International Registration No. OOOOOOO for which subsequent designation has been recorded on mm, dd, yyyy.")

Even where the designated goods or designated services of the unregistered prior trademark that has been cited as the reasons for refusal have been amended, or where the application number has been added or changed due to division of applications or any other reason, the examiner is not required to send another notification of reasons for refusal.

3. Decision of refusal

When the examiner sends a notification of reasons for refusal based on the unregistered prior trademark, and when the examiner makes a final decision regarding the refusal based on the pertinent reasons for refusal pursuant to Article 15(1) of the Trademark Act, after the registration of the prior trademark that has been cited as the reasons for refusal, the examiner must clearly indicate the registration number of the trademark that is related to the pertinent citation in the content in the notification of reasons for refusal.

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

[Examination Guidelines for Trademarks: Article 15-3 \(Unregistered prior trademark\)](#)