

40.03

Notification of Reasons for Refusal within the Time Limit Prescribed by Cabinet Order

1. An application for trademark registration cannot be refused unless the examiner finds a reason for refusal within the "time limit provided by Cabinet Order" that is provided in Article 16 of the Trademark Act (Article 2(1) or (2) of the Enforcement Order of the Trademark Act). Whether or not the examiner has found a reason to refuse an application for trademark registration within the "time limit provided by Cabinet Order" should be determined based on the date on which the JPO dispatched the notification of reasons for refusal for said application, by taking into consideration the objectivity of the facts.

Accordingly, if the dispatch date of the notification of reasons for refusal is within the time limit prescribed in Article 2(1) or (2) of that Order, the application can be refused based on the reasons unless the reasons described in the notification have been dissolved.

2. When the examiner finds a reason for refusing an international application for trademark registration, he/she shall prepare a document to report the provisional refusal which describes the reasons for refusal, and send it to the International Bureau.

This dispatch of a document to the International Bureau to report the provisional refusal is a procedure under the Madrid Protocol, and the document is not sent directly to the applicant from the JPO. However, since the document describes the reasons for refusal and is sent from the International Bureau to the applicant, etc., it shall be handled as including the effect as a notification of reasons for refusal based on Article 15-2 or 15-3 of the Trademark Act. Thus, a separate notification of reasons for refusal shall not be sent to the applicant.

3. Even if the notification of reasons for refusal were sent back without reaching the applicant, etc. due to reasons such as a change in the applicant's name, address, etc. and the notification were re-dispatched, it is a fact that the examiner would have found a reason for refusing said application and would have dispatched a notification disclosing the reasons. Therefore, the date on which the notification of reasons for refusal was first dispatched falls under the time when the examiner found reasons for refusal within the "time limit provided by Cabinet Order" referred to in 1. above.

4. Article 16 of the Trademark Act provides that, the examiner must render a decision that a trademark is to be registered when he/she has not found any reasons for refusal within the time limit provided by Cabinet Order; and since the period to provide

notification of reasons for refusal is limited, if the examiner finds two or more reasons for refusal in the course of examination, he/she shall, in principle, make a notification of all of the reasons for refusal at the same time.

However, after the examiner sends a notification of reasons for refusal pursuant to Article 6(1) or (2) of the Trademark Act due to reasons such as the lack of clarity of the designated goods or designated services, and the applicant responds to the notification of reasons for refusal by submitting a written opinion or a written submission of materials that substantially explains only the goods and services, if the examiner then finds another reason for refusal, he/she shall notify the applicant of said other reason either without or with instruction for the submission of a written amendment that would dissolve the previous reason(s) for refusal.

The "time limit provided by Cabinet Order" provided in Article 16 of the Trademark Act:

- i) The period for notifying reasons for refusal of a national application is one-year and six-months from the filing date. However, when reasons for refusal have been notified pursuant to Article 6(1) or (2) of the Trademark Act and a written amendment dissolving the reasons for refusal has been submitted, the period for notifying the reasons for refusing the application (one-year and six-months) shall be reckoned from the date of submission of the written amendment (Article 2(1) of the Enforcement Order of the Trademark Act).
- ii) The period during which a provisional refusal may be reported for an international application for trademark registration is limited to one-year and six-months from the date on which the request for territorial extension was reported based on an international registration (Article 2(2) of the Enforcement Order of the Trademark Act).

The provisional refusal shall be reported to the International Bureau within one-year and six-months from the date of the report based on the request for territorial extension based on an international registration.

[Note] This handling applies to applications filed on or after March 14, 2000.

(Note) Click below to see the Examination Guidelines for Trademarks
Examination Guidelines for Trademarks: Article 16 (Examiner's decision of trademark registration)