

40.04

Notice of Reasons for Refusal Citing a Trademark of which Duration of the Trademark Right Has Been Expired

1. In notice of reasons for refusal pertaining to Article 4(1)(xi) of the Trademark Act, citing a trademark of which duration of the trademark right has been expired, shall be handled as follows:

- (1) Where the duration of the trademark right (except for the trademark right based on international registration) of a cited trademark is within one year after the expiration, even if a request for registration of renewal of the duration is not filed, the reasons for refusal citing the said trademark of Article 4(1)(xi) of the Trademark Act shall be noticed.
- (2) Where registration fee of the trademark right of the said cited trademark is paid by installments but the registration fee to be paid until five years prior to the expiration of the duration (hereinafter, referred to as the later installment of the registration fee) and the registration surcharge are not paid, if within one year from the last day five years prior to the expiration of the duration, the reasons for refusal citing the said trademark of Article 4(1)(xi) of the Trademark Act shall be noticed.
- (3) Where the trademark right of the cited trademark is based on international registration and the duration of the trademark right has been expired, as long as the register is effective by the international register of trademarks pertaining to the trademark right of the cited trademark, the reasons for refusal citing the said trademark of Article 4(1)(xi) of the Trademark Act shall be noticed.

2. In rendering decision by citing the trademarks of the preceding paragraphs 1., the cited trademark shall be handled as follows:

- (1) Where, in rendering decision of refusal by citing the trademarks of the preceding paragraphs 1. (1) and (3), the decision of refusal shall be rendered after having confirmed the fact that the duration of the trademark right of the cited trademark has been renewed.
- (2) Where, in rendering decision of refusal by citing the trademarks of the preceding paragraphs 1. (2), the decision of refusal shall be rendered after having confirmed the fact that the payment of the later installment of the registration fee and the registration surcharge has been made.

However, (i) where it is confirmed that the renewal registration is not filed after a period of one year had elapsed after the expiration of the duration of the trademark right of the cited trademark, (ii) where it is confirmed that the later installment of the registration fee and the registration surcharge pertaining to the cited trademark has not been paid within one year from the last day five years prior to the expiration of the duration, and (iii) where it is confirmed that the international register of trademarks pertaining to the trademark right of the cited trademark has been closed, the reasons of

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refusal shall be treated as those that have been not falling under Article 4(1)(xi) of the Trademark Act citing the said trademark.

Furthermore, (iv) where the holder of trademark right of the cited trademark had submitted a written document making a manifestation of intention not to file an application for registration of renewal, if six months have elapsed after the expiration of the duration, and it is confirmed that the application for registration of renewal pursuant to Article 20(3) is not filed, and (v) where registration fee of the trademark right of the cited trademark was paid by installments and the holder of trademark right of the said cited trademark had submitted a written document making a manifestation of intention not to pay the later installment of the registration fee, if six months have elapsed after the day five years prior to the expiration of the duration, and it is confirmed that the payment of the later installment of the registration fee and the registration surcharge pursuant to Article 41(2)(vi) is not made, the reasons for refusal shall be treated as those that have not been falling under Article 4(1)(xi) of the Trademark Act citing the said trademark.

(Explanations)

1. Filing an application for registration of renewal of the duration of trademark right

The holder of trademark right may file the said application within six months even after the expiration of the said time limit (Article 20(3)). Where the holder of trademark right fails to file an application for registration of renewal within the time limit for such request pursuant to the provision of the preceding paragraph, the trademark right shall be deemed to have been extinguished retroactively from the time of the expiration of its duration (Article 20(4)).

Furthermore, where the original holder of a trademark right which was deemed to have been extinguished pursuant to the provision of the preceding paragraph is not found to have intentionally failed to file an application for registration of renewal within the time limit, the original holder of the trademark right may file the said application for registration of renewal of the duration of trademark right within two months from the date on which the holder becomes available to file the request for registration of renewal but not later than six months after the expiration of the said time limit (Article 21(1)).

2. Payment of the later installment of the registration fee when registration fee has been paid by installments

In payment of registration fee by installments, delayed payment of the later installment of the registration fee may be made within six months even after the expiration of the time limit (Article 41-2(5) of the Trademark Act), but, if the later installment of the registration fee and the registration surcharge are not paid within six months after the expiration of the time limit, the said trademark is deemed to have been extinguished retroactively as of the last day five years prior to the expiration of the duration (Article 41-2(6) of the Trademark Act).

Furthermore, where the original holder of a trademark right which was deemed to have been extinguished pursuant to the provision of the preceding paragraph is not found to have intentionally failed to pay the later installment of the registration fee and the registration surcharge within the time limit capable to pay the later installment of the registration fee, the original holder of the trademark right may pay the later installment of the registration fee and the registration surcharge within two months from the date on which the holder becomes available to pay the fees but not later than six months after

the expiration of the said time limit (Article 41-3).

3. Renewal of the expiration of the duration of trademark right based on the international registration

Although the duration of a trademark right based on international registration, may be renewed based on the renewal of the duration of the international registration (Article 68-21(2) of the Trademark Act), for renewal procedure of international registration, moratorium of six months after the expiration of the duration is admitted (Article 7(4) of the Madrid Agreement). If the duration of the international registration is not renewed, the trademark right based on the international registration shall be deemed to have been extinguished retroactively from the time of the expiration of its duration (Article 68-21(4) of the Trademark Act), but, in practice, whether renewal of the duration is made shall be confirmed from the international register of trademarks. (WIPO International Bureau notifies Japan that the duration relating to the trademark right of the international registration has not been renewed (note 1), then necessary procedures, such as, registering extinguishment of the trademark right on the register of trademarks will be taken.)

(Note 1) Refer to Rule 31(4) of Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement.