

41.01

Regarding the operation of the examination in the case of violation of the purport of Article 3 of the Trademark Act

Examination Guidelines for Trademarks: Part XVIII Others

2. When the same person files an application for the same trademark or mark designating the same goods or services
- (1) When the same person makes a duplicating application for the same trademark (including those differing in size) designating the same goods or services, except for cases corresponding to the provisions of Article 68-10, in principle, after the trademark in respect of the prior application is registered, the later application will be refused under the reasons that it is "against the purpose of Article 3 of the Trademark Act".
- (2) This is also true when the holder of the trademark right applies for a trademark registration for the same trademark (including those differing in size) designating the same goods and services.

The determination of whether or not the designated goods or designated services of the filed trademark are "identical" with the designated goods or designated services of the unregistered prior trademark or registered prior trademark to be cited in the abovementioned guidelines shall be made as follows (the Alphabetic capital characters show general indication while the small letters show individual indications (indications to be included in those represented by capital letters)).

1. Case where the examiner determines that the designated goods or designated services in question are "identical"

If the indication of the designated goods or designated services are identical, the examiner will make the determination by presuming that they are "identical."

(1) Case where all of the designated goods or designated services of the application concerned are identical with the designated goods or designated services of the unregistered prior trademark or registered trademark that have been cited.

Designated goods or designated services of the application concerned	Designated goods or designated services of the cited trademark
A, B, C	A, B, C
A, b, c	A, b, c
a, b	a, b

(2) Case where the designated goods or designated services of the application concerned are included in the designated goods or designated services of the unregistered or registered prior trademarks that have been cited (excluding the case where they are included in a conceptual sense).

Designated goods or designated services of the application concerned	Designated goods or designated services of the cited trademark
A, B	A, B, C
A, b	A, b, c
c	a, b, c

(Explanation)

The case mentioned in (2) above is one where the applicant has newly filed an application by designating some of the goods or services designated for the unregistered or registered prior trademark. In this case, even if the applicant does not file a later application, since the same result is obtained if the applicant disclaims unnecessary designated goods or designated services from the goods or services designated for the unregistered or registered prior trademarks, the relevant designated goods or designated services will be considered to be "identical".

2. Case where the designated goods or designated services of the application concerned will not be determined to be "identical" with those of the unregistered or registered prior trademarks

Designated goods or designated services of the application concerned	Designated goods or designated services of the cited trademark
A, B	B, C
a, b	b, c
a	A
A	a
A, B, C	A, B
a, b	b

(Explanation)

When some of the designated goods or designated services of the application concerned are identical with the designated goods or designated services of the unregistered or registered prior trademarks that have been cited, if the designated goods or designated services of the unregistered or registered prior trademarks are indicated using general indications and the designated goods or designated services of the application concerned are indicated using individual indications that are included in the former indications, they will not be determined to be "identical."

3. Case where the examiner can determine that the designated goods or designated services are substantially different

Even when the case mentioned in 1. above is applicable, if the applicant claims that the content of the goods or services are substantially different due to reasons such as the difference in the edition of international classification between the designated goods or designated services of the application concerned and those of the unregistered or registered prior trademarks and such fact is admitted, the relevant reasons for refusal are dissolved since the examiner can determine that the presumption of finding the relevant designated goods or designated services to be identical has been reversed.