

## 44.01

### **Handling of the Lottery Provided in Article 8(2), (4) and (5) of the Trademark Act**

With respect to the lottery provided in Article 8(5) of the Trademark Act, the administrative procedures will be proceeded in the following manner.

1. (1) The JPO decides on the date and place for the lottery, and sends a notification concerning the implementation of the lottery to the applicants for co-pending applications filed on the same date by two weeks before the date of the lottery.

(2) Matters concerning the lottery mentioned in the preceding paragraph and the conducting of a public lottery shall be posted in the JPO by two weeks before the date of the lottery.

2. (1) The Director of the Trademark Division shall conduct the lottery. However, when circumstances prevent the Director of the Trademark Division from conducting the lottery, the Senior Director shall conduct it instead.

(2) Two or more witnesses must be present at the lottery.

(3) The applicants concerned in the lottery can serve as witnesses. However, even if all or a number of the applicants concerned in the lottery are absent, the person in charge of conducting the lottery can designate other persons as witnesses in order to carry out the lottery.

(4) The lottery must be conducted publicly.

3. The lottery is conducted using a lottery machine.

4. When the lottery is finished and one applicant has been decided, the person in charge shall create one copy of a record describing the result of the lottery and attach it to the filing document of the chosen trademark applicant. In this case, for other applications, the person shall create copies of the record and attach them to the filing documents of other applications.

5. The above procedures and any other affairs related to the lottery shall be handled by the Trademark Division of the Trademark, Design and Administrative Affairs Department.

[Reference] Background that led to the practice of sending the notification of reasons for refusal pursuant to Article 8(2) and (5) of the Trademark Act and the notification for a directive for a consultation based on Article 8(4) of the Trademark Act at the same

time

(1) Under the previous procedures, when identical or similar applications for trademark registration filed by different applicants on the same date competed with each other, the JPO would first direct the applicants to hold a mutual consultation under the name of the JPO Commissioner, and then render a decision to register an application for trademark registration of one applicant: which has been decided through consultation, and also notify other applicants of the reasons for refusal pursuant to Article 8(2) of the Act.

However, in the past, when the applicants did not reach an agreement through the consultation, or when the applicants did not report the consultation result within the time limit specified in a written directive for consultation, the JPO would send a notification to conduct a lottery under the name of the JPO Commissioner and would then conduct the lottery. Then, the JPO would render a decision to register an application for trademark registration of one applicant as decided by the lottery, and would notify the other applicants of the reasons for refusal pursuant to Article 8(5) of the Act.

In accordance with Article 2 of the Enforcement Order of the Trademark Act revised in 1999, the notification period for the reasons for refusal is one-year and six-months from the filing date, in principle; therefore, it is difficult, based on the previous procedures, to provide notification of reasons for refusal pursuant to Article 8(2) or (5) of the Act within the period.

Accordingly, the previous procedures have been revised, and when an application competes with a similar application filed by another applicant on the same date, the JPO shall send the following two notifications at the same time:

- (i) A reason for refusal under Article 8(2) of the Trademark Act on the grounds that the applicant is not the one decided in the consultation between the applicants of competing applications (notification for a directive for consultation pursuant to Article 8(4) of the Trademark Act shall be made at the same time); and
- (ii) A reason for refusal stating that the application for trademark registration falls under Article 8(5) of the Trademark Act and cannot be registered, in the event that the applicant is not the one decided by the lottery conducted under the name of the JPO Commissioner when the applicant has not been the one decided in consultation or when the result of the consultation has not been reported within the period designated in a directive for consultation.

Incidentally, the examiner must clearly describe the reasons for refusal and the conditions of refusal and make statements that leave no room for misunderstanding in the notification of reasons for refusal.

In this case, a notification of reasons for refusal under Article 8(5) of the Act is

conditional; however, the conditions of refusal are clearly described in the notification of reasons for refusal, and such notification of reasons for refusal is not considered to cause a disadvantage to the applicant.

(2) When a document stating that the applicants reached an agreement in the consultation is submitted in response to a directive for consultation provided under Article 8(4) of the Trademark Act, the JPO shall render a decision to register the application for trademark registration decided in the consultation. After the registration of the application for trademark registration, the JPO shall render a decision to refuse the applications of the other applicants based on the previously-notified reason for refusal under Article 8(2) of the Act.

In addition, when the applicants have submitted a document reporting that they could not reach an agreement in the consultation, or when the applicants have not submitted a document to report that they have reached an agreement within the designated period, the JPO shall, as usual, go forward with the procedures for a lottery conducted under the name of the JPO Commissioner (see the form for documents stating that an agreement was reached or not in the consultation).

(3) Since the applicable provisions and the notification period for the reasons for refusal are the same for an international application for trademark registration as for a national application for trademark registration, the JPO shall send a notification of reasons for refusal stating that the trademark falls under Article 8(2) and (5) of the Trademark Act and a directive for consultation pursuant to Article 8(4) of the Act at the same time, in the same way as for a national application for trademark registration. (The JPO shall report the provisional refusal containing the reasons for refusal and the directive for consultation.)

\* When some of the applicants subject to consultation are overseas residents, the designated period for sending a notification for a directive for consultation and a notification for reasons for refusal will be changed to "within three months."

(Note) Click below to see the Examination Guidelines for Trademarks Examination Guidelines for Trademarks: Article 8 (Prior application)



**Example of documents proving that an agreement was reached in the consultation**

<p>Consultation Certificate</p> <p style="text-align: right;">MMM/DDD/YYYY</p> <p>Numbers of the Applications for Trademark Registration Subject to Consultation and the Applicants</p> <p>(1) Number of the application for trademark registration</p> <p style="padding-left: 40px;">Trademark application No. (International registration No.                    )</p> <p style="padding-left: 40px;">Applicant for trademark registration Domicile (residence) Name (Representative)</p> <p>(2) Number of the application for trademark registration</p> <p style="padding-left: 40px;">Trademark application No. (International registration No.                    )</p> <p style="padding-left: 40px;">Applicant for trademark registration Domicile (residence) Name (Representative)</p> <p>As a result of a consultation conducted based on Article 8(2) of the Trademark Act between the abovementioned applicants, the following applicant has been decided to be the person who may receive the trademark registration for the trademark.</p> <p style="text-align: center;">Description</p> <p>Number of the one application for trademark registration and applicant decided by consultation</p> <p style="padding-left: 40px;">Trademark application No. (International registration No.                    )</p> <p style="padding-left: 40px;">Applicant for trademark registration</p>
---

Domicile (residence) Name
------------------------------

\* For the item "[Application number]," state the number given to the application such as "Trademark application No.," "International registration No." or "International registration No. for which a subsequent designation was recorded on MM/DD/YY."