44.02

The Method of Conducting the "Lottery" prescribed in Article 8(5) of the Trademark Act where the Competitive Relationship is Complicated

[Examination case 1] Although a directive for consultation has been notified for the following five applications set forth in the following table, the competitive relationship could not be resolved and none of the applicant reported the results of the consultation, and thus the "lottery" prescribed in Article 8(5) was conducted in the following manner.

Application number	A X-100158	B X-101238	C X-183699	D X-194659	E X-207135
Trademark	☎とっきょ	●JPO●	JPO／☆	☎jpo	あ　JPO
Designated services	42P01 42P02 42Q01 to 03 42V02 42V03	42P01 42Q01, 42V02 42V03 42X11	42P02	42Q01 42V02 42V03	42P01 42P02 42X11
Other party to the directive for consultation	D	D E	E	A B	B C

* A and B are the same applicant. Regarding the trademarks, A and D were found similar in terms of the figure part while B, C, D and E were found similar in terms of the character part.

[Method of conducting the lottery]

After deciding the comparative ranking by one lottery conducted for the five applications, the one applicant among the competing applications will be decided in order.

[Reason]

(1) Even if a lottery is implemented with each of the other parties to the directive for consultation (the following (i) to (v) cases), a state which is generally called a "tie" may occur, and thus it is necessary to decide the comparative ranking for the five applications as a whole.

    (i) AD

    (ii) BDE   Example: As a result of the lottery for case (iii), C

    (iii) CE   becomes first, but as a result of the lottery for case (v), E

    (iv) DAB   becomes first, and then C and E are in a state of "tie."

    (v) EBC

(2) Advantage of arranging by one lottery

- No "tie"
- Prompt process
- Relief of burden of paperwork or appearance of the applicant

(3) Fairness

When the "lottery only with the competitor" and the "one lottery" in which persons other than the competitors participate are compared, a specific person's application would not be advantageous or disadvantageous even in the case of "one lottery," since the probability of becoming first in relation to the competitive application is the same.

(Established in January 2017)

Model case

In the case where a competitive relationship is found between A and B and B and C with respect to the three applications filed by A, B and C, A's probability of becoming first in relation to the competing party (=B) will be compared.

- When lottery is implemented between the two, A and B
  The lottery will result in two permutations: (i) AB and (ii) BA, and thus, A becomes first in case (i) and the probability is one half.

- When the lottery is implemented between the three, A, B and C
  The lottery will result in six permutations: (i) ABC; (ii) ACB; (iii) BAC; (iv) BCA; (v) CAB; and (vi) CBA, and thus, A becomes first in cases (i), (ii) and (v), and A's probability of becoming is three sixths, i.e. one half.

[Examination case 2] Although a notification for a directive for consultation was sent for the four applications set forth in the following table, an agreement was reached in some of the consultations but the competitive relationship could not be resolved and thus the "lottery" prescribed in Article 8(5) was conducted in the following manner.

Application number	A O-194836	B O-202127	C O-215122	D O-216730
Trademark	JPO	●JPO●	JPO／☆	ジェーピーオー
Designated services	36A01 36B01 ~~36C01~~ 36D01 36F01 36H01	36C01	36A01 36B01 36C01	36A01 36B01 36C01 36D01

* An agreement was reached in the consultation between A and B (A deleted 36A01)

[Method of conducting the lottery]

One lottery was implemented collectively for A, B, C and D, and the first to fourth ranking were decided comparatively. As a result of the lottery, D became first and its trademark was registered and other applications were refused.

"Form of document to be attached to the written notification to conduct a lottery in the case where a state of tie may occur"

In conducting a lottery

MMM/DDD/YYY

Trademark Division, Design and Administrative Affairs Department, Trademark, Japan Patent Office

The lottery planned to be conducted on MMM/DDD/YYY will be conducted for the following applications for trademark registration with respect to which the applicants were directed to conduct consultation pursuant to the provisions of Article 8(4) of the Trademark Act but none of the applicants reported the results of the consultation. Since the competitive relationships are complicated in these applications, when a "lottery" is implemented between the respective parties to the consultations, one applicant may not be decided. Therefore, the overall ranking will be decided by one "lottery" for all the applications in a competitive relationship and thereby the ranking of the one applicant among the competing applications will be decided.

The probability of becoming first in relation to the competing party is the same even if this method is taken (see the "Model case" in the Annex)

Description

End

[Example]

(i):	Trademark application 200 -	Competing applications → (ii), (iii)
(ii):	Trademark application 200 -	Competing applications
(iii):	Trademark application 200 -	Competing applications
(iv):	Trademark application 200 -	Competing applications

(Established in January 2017)

Model case

[When there is a competitive relationship between A and B and B and C with respect to three applications (A and C are not competing)]

> A: Competing application it notified→B
> B: Competing application it notified→A and C
> C: Competing application it notified→B

The probability of the applicant becoming first in the competitive relationship as a result of the lottery.

> (1) When a lottery is conducted between A and B, the lottery will result in the following two permutations, and thus A becomes first in the case mentioned in (i) and the probability is one half: (i) First-A, Second-B; and (ii) First-B, Second-A.

> (2) When the lottery is implemented between the three, A, B and C
> The lottery will result in six permutations: (i) ABC; (ii) ACB; (iii) BAC; (iv) BCA; (v) CAB; and (vi) CBA and thus, A becomes first in cases (i), (ii) and (v), and the probability is three sixths, i.e. one half.

> Accordingly, the probability of becoming first in relation to the competing party as a result of the lottery would be the same no matter how many persons that are not in a competitive relationship join the lottery.

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

(Established in January 2017)