Handling a Case in which, after Comparing the Applicant of Reclassification and the Register, the Applicant was Found to be Different from the Trademark Right Owner

1. When, after comparing the requester of reclassification with the register, the requester is found to be different from the owner of the trademark right, the examiner sends a notice of rejection pursuant to Section 6(1)(ii) of the Supplementary Provisions of the Act.

2. When a statement is made to the effect that an “application for registration of a transfer” or an “application for registration of a change (renewal) in indication of the registered title holder” was submitted at the time of requesting reclassification, the examiner does not immediately send a notice of rejection. This is so even if the requester of reclassification is found to be different from the owner of the trademark right after comparing the request with the register. Instead, the examiner compares them again after a certain period of time (the period required for processing transfer of registration, etc.) and handles the matter as below.

(1) If the requester of reclassification is still different from the owner of the trademark right even after transfer of registration, etc. has been complete (or if the transfer of registration, etc. has not been implemented due to dismissal of the application for transfer of registration, etc.), the examiner sends the notice of rejection referred to in Item 1 above.

(2) If the requester of reclassification is found to coincide with the owner of the trademark right after transfer of registration, etc., the examiner does not send the notice of rejection referred to in Item 1 above.

3. When the registration is transferred after the request for reclassification, the examiner notifies the requester that the reclassification requesting procedure will proceed by recognizing the owner of the trademark right (after the transfer) to be the requester. Subsequently, the examiner records data in a computer file for the JPO’s internal use. Then, the examiner proceeds with the examination, considering the owner of the trademark right to be the requester. (The examiner does not send the notice of rejection referred to in Item 1 above.)

4. When a divisional transfer or a divisional application is registered after a “request for reclassification”, the “request for reclassification” of the trademark right (before registration of divisional transfer or divisional application) is also effective on the new trademark right (after
registration of divisional transfer or divisional application). Since the “request for reclassification” is considered to be filed for the new trademark right, the examiner shall continue examining the owner of the new trademark right as the “requester of reclassification” of the respective trademark right. After reporting, the examiner shall continue the procedures regarding the trademark right owner of the new right as the “requester of reclassification” of the respective trademark right and make a record in a computer file for the JPO’s internal use. (The examiner does not send the notice of rejection referred to in Item 1 above.)

5. When a change (renewal) in indication of the registered title holder is registered after the request for reclassification, the examiner considers the domicile or residence and name of the applicant to have been changed to the indication after the registration of a change (renewal), and conducts subsequent procedures. (The examiner does not send the notice of rejection referred to in Item 1 above.)

6. The above Items from 1 through 3 and 5 are applicable to a request for reclassification of rights based on a defensive mark registration.

(Note) Click below to see the Examination Guidelines for Trademarks
Examination Guidelines for Trademarks:
Articles 2, 3, 4, 6, 11, 12 and 24 of Supplementary Provisions (Reclassification)