

89.01

Offering Information concerning an Application for Trademark Registration

1. Significance of the System of Offering Information

According to the revision of the Trademark Act in 1996, the pre-grant opposition system was abolished to be transferred to the post-grant opposition system. The role of the pre-grant opposition system as an opportunity to open the opinion to the public against the decision of the examiner was shifted to the post-grant opposition system.

Under the circumstances, taking into the account the fact that a powerful right for the trademark right is established without such opportunity being given to the public, it is important that the trademark examination performed based firmly on the substantive examination principle, is executed with even further accuracy.

Therefore, the JPO decided to systemize the procedures concerning the offerings of information that have been carried out according to practical use to date by newly prescribing them under the Regulation for Enforcement of the Trademark Act and to expand the use of the new system to improve accuracy and speed of examination, thereby preventing in advance possible granting of deficient trademark rights.

Incidentally, the system of offering information is to be positioned as a procedure to facilitate the acquisition of useful information for further improvement of the accuracy and speed of examination.

(See, Article 19 (Offering of information) of the Regulation for Enforcement of the Trademark Act)

2. Specific implementation

(i) Information provider

"Anyone" can offer information.

Incidentally, the description of the name, etc. in the column of "submitter" can be omitted.

In such case, columns of "domicile (residence)" and "name" shall be filled out with the word "omitted."

(ii) Application for trademark registration subject to the offering of information

Only those applications for trademark registration pending before the JPO are subject to the offering of information.

Therefore, information cannot be offered for the applications for trademark registration not pending before the JPO (e.g., applications decided to be refused, applications decided to be registered for trademark right, and withdrawn applications).

When the case concerning the offering of information cannot be specified, the

offering of information shall be dismissed.

(iii) Information that can be offered

Information to the effect that the trademark claimed in the application for trademark registration falls under the provisions prescribed under any of the following articles can be offered.

The trademark claimed in the application for trademark registration cannot be registered pursuant to the provisions of Article 3, Article 4(1)(i), (vi) to (xi) and (xv) to (xix), Article 7-2(1), and Article 8(2) or (5) of the Trademark Act.

In a case where information which does not fall under the provisions of the above listed Articles is offered, the examiner shall not consider such information.

Further, with respect to domestic applications to which the provisions of Article 68-32 (Special Provisions for application for Trademark Registration after Rescission of International Registration) or Article 68-33 (Special Provisions Concerning Applications for Trademark Registration after Denunciation of Protocol) of the Trademark Act are applied, the provisions of Article 15(i) and (ii) of the Trademark Act shall not apply to such domestic applications pursuant to the provisions of Article 68-34(2) of the Trademark Act. Therefore, the examiner shall not take this into consideration.

(iv) Materials that can be submitted

An information provider may submit the information which he/she intends to offer in the form of "documents."

The "documents" that can be submitted include publications or copies thereof, or copies of the written application for trademark registration, etc. as well as evidential materials showing the use of the trademark, e.g., copies of catalogues, brochures, transaction documents.

However, submission of materials which do not fall under the range of "documents", e.g., a video tape, etc. showing the use of the trademark, shall not be allowed.

(v) Handling of submitted documents, etc. such as publications

i) The examiner shall adopt the submitted documents, etc. as reference materials upon examination for determining presence or absence of a reason for refusal only when the submitted documents, etc. includes information that could not be known through the search conducted upon examiner's authority and the examiner may have confidence as to the existence of the facts to be objectively proved by the submitted documents, etc.

ii) The examiner notifies the reason for refusal when he/she could determine that the application for trademark registration contains a reason for refusal as a result of the examination of the submitted documents, etc.

(vi) Opportunity of clarification/interview, etc. with respect to the information provided by the information provider

Since the information provider is not the party related to the examination of the application for trademark registration, in principle, it shall not be allowed for the party to make a contact with the examiner for the purpose of clarification of the offered information and argument, interview, etc. with respect to the registration possibility of the application for trademark registration.

Further, the examiner shall not be allowed to directly ask the information provider who offered information to submit essential documents and other materials which are prescribed in the provisions of Article 194(1) (Submission of Documents) of the Patent Act applied *mutatis mutandis* pursuant to Article 77 of the Trademark Act.

(vii) Feedback to the information provider

Feedback concerning the use of the information will be given in response to the request from the information provider.

The contents are:

- a. Whether or not the offered information has already been cited in the Notification of Reasons for Refusal before the information was offered; and
- b. Whether or not the offered information has already been cited in the Notification of Reasons for Refusal after the information was offered. (It is not necessary to give feedback of the final examination result.)

Incidentally, demand of feedback is stated in the column of "reasons for submission" of the "Written submission (publications, etc.)."

(viii) Notification to the applicant

The fact that the information is provided shall be notified to the applicant.

(ix) Public inspection of the offered information

The offered information shall be subjected to inspection.

(x) Date of implementation

The system for offering information regarding applications for trademark registration was brought into force on April 1, 1997. Incidentally, the system for offering information relating to Article 7-2(1) (Addition) of the Trademark Act was brought into force on April 1, 2006.

(xi) Form for offering of information ("Form for submitting publications, etc.")

For reference sake, see "Form No. 20 (related to Article 19 of the Regulation for Enforcement of the Trademark Act)"

Reference Form No. 20 of the Regulation for Enforcement of the Trademark Act (related to Article 19 of the Regulation for Enforcement of the Trademark Act; extract)

<p>[Document title] Written submission (publication, etc.)</p> <p>[(Date of submission] MM/DD/YYYY)</p> <p>[To] Commissioner of the Patent Office</p> <p>[Indication of the case] [Application number]</p> <p>[Submitter] ([Identification number]) [Domicile or residence] [Name]</p> <p>[Agent] ([Identification number]) [Domicile or residence] [Name]</p> <p>[Publication, etc. to be submitted]</p> <p>[Reason for submission]</p>
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[Notes]

1. For the item "[Application number]" in the column "[Indication of the case]," 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/YYYY." For applications pending in a trial or appeal, establish a column "[Trial or appeal number]" in the column "[Indication of the case]," state the number given to the trial or appeal such as "Appeal Against Examiner's Decision of Refusal XX" and state the number given to the application in the column of "[Application number]."

2. In the case of omitting the description of the domicile or residence or name of the submitter pursuant to the provisions of Article 13-2(3) of the Regulation for Enforcement

of the Patent Act as applied mutatis mutandis pursuant to Article 19(3), state "omitted" in the column "[Domicile or residence]" or "[Name]."

3. When there are two or more persons to be stated in the column "[Submitter]," state them by repeatedly establishing the column as follows.

[Submitter]
([Identification number])
[Domicile or residence]
[Name]
[Submitter]
([Identification number])
[Domicile or residence]
[Name]

4. In the column "[Reasons for submission]," state the reasons why the trademark claimed in the relevant application for trademark registration does not satisfy the requirements for registration based on the relevant publication, etc.

5. Other matters will be handled in the same manner as those mentioned in Notes 1 to 4, 20 to 22, 26, 29 and 40 to 43 of Form No. 2 and Notes 2 and 5 of Form No. 10.