

A8.01

Notification to the International Bureau in a Case in which All or a Part of the Designated Goods or Designated Services Concerning the Basic Registration or Basic Application have Expired

When there are any facts or decisions relevant under the provision of Article 6(3) of the Protocol concerning the basic registration or basic application, the office of origin shall notify this to the International Bureau. (Article 6(4) of the Protocol) (This generates an effect known as a "central attack".)

The fact concerning the basic registration and basic application subject to central attack and the period for notifying it to the International Bureau are as shown in the Annex.

[Explanation]

(1) The Protocol provides in Article 6(4) for the implementation of Article 6(3) that when there are any facts and decisions based on the provisions of paragraph (3), the office of origin shall notify this to the International Bureau.

The notification shall be made on the relevant "number of the international registration", "name of the holder," "the facts and decisions affecting the basic registration or basic application, and the effective date of those facts and decisions", etc. in line with Rule 22(1)(a) of the Common Regulations.

(2) When a trademark is no longer protected in the country of origin, the office of origin shall notify such fact to the International Bureau based on Rule 22(1)(a) of the Common Regulations as indicated below:

- i) The office of origin shall make a notification when all or a part of the designated goods or designated services concerning the basic registration or basic application are deleted and the deletion has become final and binding before the expiry of the five-year period from the international registration date;
- ii) When procedures provided in Article 6(3)(i) through (iii) of the Protocol have begun before the expiry of the five-year period from the international registration date and the final decision has not been reached before the expiry of the five-year period, the office of origin shall conduct notification of the fact when the five-year period has expired;
- iii) When falling under ii) above, and when the final decision has been reached after the expiry of the five-year period, the office of origin shall conduct notification to the effect; and
- iv) When the applicant or holder of trademark right withdraws or waives the basic

registration or basic application subject to the procedures falling under iii) above, the office of origin shall notify it in the same way as iii).

(3) The fact concerning the basic registration and basic application subject to central attack and the period for notifying it to the International Bureau are as shown in the Annex.

* When a request is made from the International Design and Trademark Application Office regarding (2) above, the International Trademark Application Examination Office will agree to hold talks and based on the result thereof, the International Design and Trademark Office will perform this handling.

<Reference>

"Expiration of the basic registration or basic application"

Article 6(3) of the Protocol provides that an international registration cannot be claimed with respect to the scope of the respective expired designated goods or designated services when expiry of the basic application is finalized by refusal, withdrawal, abandonment, etc. before the expiration of the five-year period from the international registration date, or when the expiry of the respective trademark right of the basic registration (including the basic application which has been registered) is finalized by cancellation, decision of invalidation, abandonment, or expiration of the term, etc., of the basic registration.

This provision provides for the dependency of an international registration on the basic registration or basic application: that is to say, the protection by international registration cannot be claimed where a trademark has not been protected in the country of origin; this is the effect of the so-called "central attack".

In addition, according to the same provision, the international registration shall be invalidated when the following procedures, which are the procedures for disputing the effect of the basic application or basic registration before expiry of the five-year period from the international registration date have been started, and when a final decision to lapse the protective effect after the expiry of the five-year period has been made:

- (i) an appeal against a decision refusing the effects of the basic application;
 - (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or the basic registration;
- or
- (iii) an opposition to the basic application.

In addition, where the basic application or basic registration is voluntarily withdrawn or abandoned by the applicant during the procedure of mentioned in (i) through (iii) above, the effect of the international registration shall expire in the same

way.

However, a change in the holder of the international registration does not affect the effect of dependence.

* The procedures set forth in (i) through (iii) above include cases in which the decision is finalized after the expiration of the five-year period, to ensure that the effect of an international registration would not escape being invalidated subordinately if the procedures were prolonged and the effect of protection had still not lapsed after five years. In addition, the cases where the right holder withdraws or abandons the basic registration or basic application shall also be subject to central attack based on the same reason.

[Annex]

Facts on the Basic Registration or Basic Application to be Notified to the International Bureau, and the Notifying Period

Facts to be notified	Period for notifying the International Bureau	
	Notified during the five-year term	Notified after the five-year term
Amendment which restricts the scope of the designated goods or designated services concerning the application * This does not include a restrictive amendment associated with a divisional application or amendment for correcting a clerical mistake or clarifying the description.	○ Notified when the decision of registration (appeal decision of registration) of application concerning the restrictive amendment has become final and binding within five years	
Restrictive amendment in classification unit submitted upon payment of the registration fee	○ Notified when the application has been registered based on the submitted amendment within five years	
Decision of refusal	○ Notified when the decision of refusal has become final and binding within five years.	
Appeal made against examiner's decision of refusal (Article 44 of the Trademark Act)	○ Where a request for appeal or filing of an opposition has been made within five years, (i) when an appeal decision of registration of an application for which a restrictive amendment of the designated goods or designated services have been made, or an appeal decision of refusal of an application or appeal decision of invalidation (cancellation) of a registration has become final and binding within five years, the JPO shall conduct notification; or	○ In case of (ii) on the left, the JPO shall conduct notification when the appeal decision (ruling) against the respective appeal (opposition) has become final and binding. Furthermore, when there is a withdrawal of the respective appeal or withdrawal of the respective application or restrictive amendment of designated goods or designated services or waiver of the respective registration, the content thereof shall be included in the notification.
Request for an invalidation trial (Articles 46 and 68(4) of the Trademark Act, Articles 8 and 9 of the supplementary provisions of 1996)	(ii) when an appeal decision of refusal of application or an appeal decision of invalidation (cancellation) of registration has not become final and binding within five years, the JPO shall immediately conduct notification that a request for an appeal (filing of opposition) has been made.	
Demand for a cancellation trial (Articles 50, 51, 52-2, 53 and 53-2 of the Trademark Act)		
Opposition (Articles 43-2 and 68(4) of the Trademark Act)		
Extinction of the trademark right by the expiration of the term (registration which has not been renewed)	○ The JPO shall conduct notification when the respective trademark right has expired (not been renewed) by extinction of the term within five years. Furthermore, non-renewal is finalized after one year from the expiration of the	

	term (term of double payment + term for the reason unattributable to the applicant), and when the expiration date of the term is within five years, the JPO shall conduct notification after the finalization.	
Trademark right has extinguished due to lack of payment of the registration fee for the latter term when making installment payment	○ The JPO shall conduct notification when the trademark right has extinguished within five years for non-payment of the second half registration fee	
Dismissal of application procedures	○ The JPO shall conduct notification when the dismissal of the application procedures has become final and binding within five years.	
Withdrawal or waiver of application * This excludes deemed withdrawal.	○ The JPO shall conduct notification when the application has been withdrawn or waived within five years	
Application recognized as withdrawn by filing of a new application after a dismissal of an amendment	○ The JPO shall conduct notification when a new application has been accepted after dismissal of amendment, and when the date on which the original application (which has become a basic application) was recognized as withdrawn is within five years.	
Waiver of a trademark right (including a partial waiver.)	○ The JPO shall conduct notification when waiver of a trademark right has been registered on the trademark register within five years.	
Extinction of a defensive mark registration (Article 66 of the Trademark Act)	○ The JPO shall conduct notification when a right based on a defensive mark registration has extinguished within five years.	
Extinction of trademark right by lack of existence of a successor, etc.	○ The JPO shall conduct notification when a trademark right has extinguished for lack of existence of a successor to the trademark right owner within five years.	