

Part VIII: Article 8 (Prior application)

Article 8 (1) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on different dates, only the applicant who filed the application for trademark registration on the earlier date shall be entitled to register the trademark in question. However, if the applicant who filed the application for trademark registration on the later date (hereinafter referred to as the "subsequent applicant" in this paragraph) has obtained the consent of the applicant who filed the application for trademark registration on the earlier date to register the trademark (if there is more than one applicant for trademark registration, the multiple applicants for trademark registration, hereinafter referred to as the "prior applicant" in this paragraph and paragraph (6)), and there is no likelihood of confusion between the goods and services for which the subsequent applicant uses the trademark and those for which the prior applicant uses the trademark (in case of registered trademark, the goods and services pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the application for registration), the subsequent applicant shall also be entitled to register the trademark in question.

(2) Where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods or services have been filed on the same date, only one applicant who is to be determined by consultations among the applicants who filed such applications shall be entitled to register the trademark in question. However, if all applicants mutually have consented to register the trademark, and there is no likelihood of confusion between the goods and services for which the respective trademarks are used, all applicants shall be entitled to register the respective trademarks in question.

(3) Where an application for trademark registration is abandoned, withdrawn or dismissed, or an examiner's decision or a trial decision on an application for trademark registration becomes final and binding, such application shall, for the purposes of the application of the preceding two paragraphs, be deemed never to have been filed.

(4) In the case of the main clause of paragraph (2), the Commissioner of the Patent Office shall require the applicants for trademark registration to arrange consultations among the applicants as set forth in the main clause of the said paragraph and to report the result thereof, designating a reasonable time limit for such purpose.

(5) Where no agreement is reached in the consultations held pursuant to the main clause of

paragraph (2) or no report is submitted within the designated time limit set forth in the preceding paragraph (except in the cases specified in the proviso to paragraph (2)), only the applicant who is first in the order selected by a lottery in a fair and just manner conducted by the Commissioner of the Patent Office, shall be entitled to register the trademark in question. However, if the applicant who is subsequent in the order selected by the lottery (hereinafter referred to as the "subsequent order applicant" in this paragraph) has obtained the consent of the applicant who is prior in the order to register the trademark (if there is more than one applicant for trademark registration, the multiple applicants for trademark registration, hereinafter referred to as the "prior order applicant" in this paragraph and the next paragraph), and there is no likelihood of confusion between the goods and services for which the subsequent order applicant uses the trademark and those for which the prior order applicant uses the trademark (in case of registered trademark, the goods and services pertaining to the business of the holder of the trademark right, exclusive right to use or non-exclusive right to use of the registered trademark), the subsequent order applicant shall also be entitled to register the trademark in question.

(6) In the cases of the proviso to paragraph (1) or the proviso to the preceding paragraph, if the trademark of the prior applicant or the prior order applicant has been registered and the trademark right pertaining to the registered trademark has been transferred, these provisions shall apply by deeming the holder of the trademark right pertaining to the registered trademark to be the prior applicant or the prior order applicant.

1. Regarding "identical or similar trademarks which are to be used in connection with identical or similar goods or services"

Part III, Chapter 10 (Article 4(1)(xi)) of the Guidelines applies *mutatis mutandis* to the judgment on similarity under this item.

2. Consultation order under Article 8(4) (hereinafter referred to as the "consultation order") and the notice of reasons for refusal under Article 8(2) and (5)

Where more than one application for trademark registration is filed on the same date for a mutually identical or similar trademark, the consultation order and notice of the reasons of refusal provided in Article 8(2) and (5) will be given simultaneously.

However, when a written statement indicating whether an agreement has been reached or not under consultation provided for in Article 8(2) has already been submitted prior to the

abovementioned consultation order and notice of reasons for refusal being given, the following measures will be taken.

(1) When a written statement indicating that an agreement has been reached under consultation, a notice of reasons for refusal under Article 8(2) is given with respect to the application for trademark registration other than the application belonging to the single applicant specified by the consultation.

(2) When a written statement indicating that an agreement has not been reached under consultation, a notice of reasons for refusal under Article 8(5) is given to all of the applications for trademark registration.

3. Case of a written statement indicating that an agreement has been reached under consultation

When a written statement indicating that an agreement has been reached through consultation has been submitted from the applicant within the designated time ordered by the Commissioner of the Patent Office, a decision of refusal will be made under Article 8(2) with respect to other applications after the trademark is registered for the single applicant specified by the consultation.

4. Case where a written statement indicating that the consultation has failed or where either written statement indicating that an agreement has been reached or not through consultation has not been submitted.

When the applicant submits a written statement indicating that the consultation has failed or a written statement indicating that an agreement has been reached or not through such consultation within the designated time ordered by the Commissioner of the Patent Office, a lottery in a fair and just manner conducted by the Commissioner of the Patent Office as prescribed in Article 8(5) will be carried out, and after the trademark is registered for the single applicant specified by the lottery, a decision of refusal will be made under Article 8(5) with respect to other applications.

5. Case where the decision of refusal of application of "one applicant" becomes final and binding

When a decision of refusal rendered for an application of "one applicant specified by the consultation of applicants" or "one applicant specified by the lottery in a fair and just manner conducted by the Commissioner of the Patent " becomes final and binding or is withdrawn or abandoned, the application of another applicant will be entitled to receive a trademark registration.

6. Regarding the proviso to Article 8 (1), (2) and (5)

In determining whether or not there is "consent" and "no likelihood of confusion," Part III, Chapter 19 (Article 4(4)) 2. and 4. of this guideline shall apply *mutatis mutandis*.