

Part XIII: Article 16-2 and 17-2 (Dismissal of amendment)

Article 16-2 (1) Where an amendment made to the designated goods or designated services, or to the trademark for which registration is sought as stated in the application, is considered to cause any change of the gist thereof, the examiner shall dismiss the amendment by a ruling.

(2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state reasons therefor.

(3) Where a ruling dismissing an amendment under paragraph (1) is rendered, the examiner shall not render any decision on the said application for trademark registration before the expiration of a three month period from the date of service of a transcript of the ruling.

(4) Where an applicant for trademark registration files a request for a trial under Article 45 (1) against the ruling dismissing an amendment under paragraph (1), the examiner shall suspend the examination of the application for trademark registration until the trial decision becomes final and binding.

Article 17-2 (1) The provision of Article 17-3 (New Application for Designs as Amended) of the Design Act (Act No. 125 of 1959) shall apply mutatis mutandis to the case where an amendment is dismissed by a ruling pursuant to Article 16-2 (1) of this Act.

(2) The provision of Article 17-4 of the Design Act shall apply mutatis mutandis to the case of an extension of the time limit provided in Article 17-3 (1) of the Design Act as applied mutatis mutandis to the preceding paragraph or Article 55-2 (3) (including its mutatis mutandis application under Article 60-2 (2)) of this Act.

Design Act Article 17-3 (1) Where an applicant for design registration files, within three months from the date on which a certified copy of the ruling dismissing an amendment under paragraph 1 of the preceding Article has been served, a new application for design registration for the amended design, the new application shall be deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted.

(2) Where a new application for design registration is filed under the preceding paragraph, the original application for design registration shall be deemed to have been withdrawn.

(3) The preceding two paragraphs shall apply only when the applicant for design registration has submitted to the Commissioner of the Patent Office, at the time of the filing of a new application, a document stating a request for the application of paragraph (1) to the new application for design registration under paragraph (1).

1. A judgment on a change in the gist of an application will be made based on the following criteria.

(1) Designated goods or designated services provided for in Article 5(1)(iii) (hereinafter referred to as the "designated goods or designated services")

(a) A modification or broadening of the scope of designated goods or designated services is a change in the gist of an application not only in a case where a modification or a broadening is made to cover dissimilar goods or services but in a case where a modification or a broadening is made to cover other similar goods or services.

(Example 1) Case of change in the gist

(i) Modification of scope

Amendment from Class 32 "beer" to Class 33 "western liquors"

(ii) Broadening of scope

Amendment from Class 12 "trucks" to Class 12 "automobiles"

However, for example, when the designated goods or designated services are indicated in a comprehensive manner as shown below, changing each designated good or designated service contained in such indication made in a comprehensive manner is not a change in the gist.

(Example 2) Case which is not a change of gist

Designated goods: Amendment from "tableware" to "drinking cups, Japanese rice bowls (chawan)" in Class 21

Designated service: Amendment from "providing amusement facilities" to "providing kara-oke facilities, providing other amusement facilities" in Class 41

(b) A restriction of the scope of designated goods or designated services, correction of errors, and changes in order to clarify unclear descriptions are not deemed as a change in the gist of an application.

(c) Amendments in respect of retail services will be handled as follows.

(i) Amendments where "retail services or wholesale services for a variety of goods in each of the fields of clothing, foods and beverages, and livingware, and taking all goods together" (hereinafter referred to as "general retail services") are changed to other retail services (hereinafter referred to as "specific retail services") are deemed as a change in the gist of an application. The same will apply in the reverse case where specific retail services are changed to general retail services.

(ii) While a restriction of the scope of goods connected with specific retail services is not deemed

as a change in the gist of an application, a modification or broadening of the scope is deemed as such.

(iii) Amendments where retail services are changed to goods are deemed as a change in the gist of an application. The same will apply in the reverse case.

(2) Statements in the column in which the trademark for which registration is sought under Article 5(1)(ii) is to be stated (hereinafter referred to as the "trademark stated in the application")

(a) Amendment of the trademark stated in the application is, in principle, a change in the gist.

(Example)

(i) To alter or delete the characters, figures, symbols or three-dimensional shapes of a trademark;

(ii) To add characters, figures, symbols or three-dimensional shapes to a trademark; and

(iii) To change the color of a trademark.

(b) A deletion of any characters used in a trademark merely in an appendant portion (for example, the trademark has other parts that function to distinguish its own goods or services from those of others and the relevant part is not united in composition with such part having the function to distinguish its own goods from those of others), such as "JIS," "JAS," "特許" (patent), "実用新案" (utility model registration), "意匠" (design registration), etc. or characters indicating the place of production and sale of goods or the provision of services is not a change in the gist of an application, in principle.

(c) Amendment to add or delete a statement that the trademark as applied is a "three-dimensional trademark" as prescribed in Article 5(2) after the filing of an application for trademark registration is, in principle, a change in the gist.

However, an amendment to add a statement that the trademark as applied is a three-dimensional trademark in the case where the trademark stated in the application can only be recognized as a three-dimensional trademark or an amendment to delete a statement that the trademark as applied is a three-dimensional trademark in the case where the trademark stated in the application can only be recognized to be a plane trademark is not a change in the gist.

(d) An amendment to add or delete a statement that a trademark is composed of "standard characters" as prescribed in Article 5(3) after the filing of the application for trademark registration is deemed to be a change in the gist of an application, in principle.

However, an amendment to add a statement that a trademark is composed of standard characters in the case where the trademark stated in the application is found identical with that

indicated by being replaced with standard characters is not a change in the gist.

(e) Filing an application to receive the application of colors under the provisions of the proviso to Article 5(6) after the filing of an application for trademark registration is a change in the gist.

2. In accordance with Article 68-18, the provisions of Article 17-3 of the Design Act (New Application for Amended design) as applied mutatis mutandis pursuant to Article 17-2(1) of the Trademark Act do not apply to the international applications for trademark registration.

3. Motion, hologram, color, sound and position marks

(1) Amendments to descriptions stating as motion, hologram, color, sound and position marks

(a) Principle

Amendments to add or delete descriptions stating as motion, hologram, color, sound and position marks provided for in Article 5(2) are changes in the gist, in principle.

(b) Exception

However, if a trademark can only be recognized as either a motion, hologram, color, sound or position mark based on a description provided in its application, and a detailed description of the trademark (hereinafter referred to as the "detailed description of the trademark") or an material to be provided for by an Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as the "article") provided for in Article 5(4), and if an amendment is done to add a description that it is such a trademark or to delete a description that it is such a trademark, the amendment is not regarded as a change in the gist.

(2) Amendment to trademark described in application

(a) Principle

An amendment to a trademark described in an application is a change in the gist, in principle.

(b) Exception

However, in the case of sound marks, if the trademark stated in the application contains a description of an element other than linguistic elements or sounds that constitute the sound mark such as the music name or composer's name, the amendment to delete them is not regarded as a change in the gist.

(3) Amendment to detailed description of trademark or article

If a trademark for which registration is sought is not specified, in order to decide whether an

amendment to a detailed description of the trademark or a material is a change in the gist, it is examined whether the detailed description of the trademark or the material as amended falls under the scope of composition and manner of the trademark stated in the application.

If a trademark for which registration is sought is specified, in order to decide whether an amendment to a detailed description of the trademark or a material is a change in the gist, it is examined whether the detailed description of the trademark or the material as amended falls under the scope of composition and manner of the trademark stated in the application. For example, for a sound mark, because the detailed description of the trademark (limited to a case when it is required to identify a trademark described in an application) and the material can be used to identify an item which is not described in a trademark stated in an application (such as the sound tones of an instrument played or the range of voice, but excluding lyrics and other linguistic elements), it is decided based on whether the detailed description of the trademark (limited to a case when it is required to identify a trademark described in an application) and the material as amended are contained within the scope.

(a) Motion marks

For example, cases which are not changes in the gist are as follows.

[a] When a mark is described in a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the mark to the detailed description of the trademark.

[b] When the change of a mark with respect to time is described in a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the change of the mark with respect to time to the detailed description of the trademark.

(b) Hologram marks

For example, cases which are not changes in the gist are as follows.

[a] When a trademark described in an application but is not described in a detailed description of the trademark, an amendment is made to add the mark to the detailed description of the trademark.

[b] For a hologram mark which has a visual effect to let it display different display surfaces depending on different viewing angles, when an explanation about a display surface is described in a trademark stated in an application but is not described in a detailed description of the trademark, an amendment is made to add the explanation of the display surface to the detailed description of the trademark.

(c) Color marks

For example, cases which are not changes in the gist are as follows.

[a] When the color of a trademark stated in an application is red while that of the trademark described in a detailed description of the trademark is blue, an amendment is made to change the color of the trademark described in the detailed description of the trademark to red.

[b] When a trademark stated in an application consists of 3 colors while the trademark described in a detailed description of the trademark consists of 4 colors, an amendment is made to change the trademark described in the detailed description of the trademark into one consisting of 3 colors.

[c] When a trademark described in an application consists of 4 colors which are arranged from the bottom to the top with their ratios of 25% each while the trademark described in a detailed description of the trademark consists of 4 colors which are arranged from the bottom to the top with their ratios of 30%, 30%, 20% and 20%, an amendment is made to change the trademark described in the detailed description of the trademark into one consisting of 4 colors with their ratios of 25% each.

(d) Sound marks

(i) For example, cases which are not changes in the gist are as follows.

[a] When a trademark stated in an application is a staff notation with a piano as an instrument played while its material is a sound file which is recognized as recording sounds generated by a guitar, an amendment is made to change the material into a sound file which is recognized as recording sounds generated by a piano.

(ii) For example, cases which are changes in the gist are as follows.

[a] When a trademark stated in an application is a staff notation which describes no lyrics while its material is a sound file which records no voices singing a lyric, an amendment is made to change the material into a sound file which records voices singing a lyric.

[b] When a trademark stated in an application is a staff notation which describes no instrument played while its article is a sound file which is recognized as recording sounds generated by a guitar, an amendment is made to change the material into a sound file which is recognized as recording sounds generated by a piano.

(e) Position marks

(i) For example, cases which are not changes of gist are as follows.

[a] When a trademark described in an application is a pair of eyeglasses which have a mark attached to their temple while its detailed description of the trademark describes that a mark is attached to the lens frames of a pair of eyeglasses, an amendment is made to change the detailed

description of the trademark into a statement which describes that a mark is attached to a temple of a pair of eyeglasses.

4. Item 3(1) and (2) above do not apply to an international application for trademark registration.