

Part XV: Article 65-2, 3, and 4 (Duration of right based on defensive mark registration)

Article 65-2 (1) The duration of a right based on defensive mark registration shall expire after ten years from the date of registration of the establishment of such right.

(2) The duration of a right based on defensive mark registration may be renewed by filing an application for registration of renewal; provided, however, that this shall not apply to the case where the registered defensive mark becomes unregistrable as a defensive mark pursuant to Article 64.

Article 65-3 (1) A person filing an application for registration of renewal of the duration of a right based on defensive mark registration shall submit to the Commissioner of the Patent Office an application stating the following matters:

(i) the name and the domicile or residence of the applicant;

(ii) the registration number of the defensive mark registration; and

(iii) in addition to those listed in the preceding two items, the matters provided by Ordinance of the Ministry of Economy, Trade and Industry.

(2) An application for registration of renewal shall be filed during the period from six months prior to the expiration of the duration of the right based on defensive mark registration to the date of expiration thereof.

(3) Where a person who files an application for registration of renewal of the duration of a right based on defensive mark registration has been unable to file the application for registration of renewal within the time limit for such application pursuant to the preceding paragraph, the person may file such application only within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that this does not apply to cases where the person has intentionally failed to file the application for registration of renewal within the time limit for such application pursuant to the preceding paragraph.

(4) Where an application for registration of renewal of the duration of a right based on defensive mark registration is filed, the duration shall be deemed to have been renewed upon expiration of the duration (where an application is filed under the preceding paragraph, upon filing of the application); provided, however, that this shall not apply to the case where the examiner's decision or appeal/trial decision to the effect that the application is to be refused becomes final and binding or the renewal of the duration of a right based on defensive mark registration is registered.

Article 65-4 (1) Where an application for registration of renewal of the duration of a right based on defensive mark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused:

(i) the registered defensive mark pertaining to application is filed becomes unregistrable as a defensive mark pursuant to Article 64; and

(ii) the applicant is not a person who has the right based on the defensive mark registration.

(2) Where no reasons for refusal are found in connection with an application for registration of renewal of the duration of a right based on defensive mark registration, the examiner shall render a decision to the effect that the renewal is to be registered.

1. Identity of the applicant and the right holder

In case where the name and the domicile or residence of an applicant for the registration of a renewal of a right based on a registered defensive mark are different from those of its right holder registered in the Trademark Register, the right holder and the applicant are deemed not to be the same person (for example, in a case where one indication is "○○○株式会社" [KABUSHIKI KAISHA] and the other indication is "○○○カンパニー" [COMPANY]).

2. Description in the application for the registration of a renewal of a right based on a registered defensive mark

A mark or designated goods or designated services mistakenly described in the application for the registration of a renewal of a right based on a registered defensive mark are deemed not to have been described.

3. Criteria for judgment

A judgment on whether a defensive mark for with respect to which an application for the registration of a renewal of a right based on a registered defensive mark is filed has become not registrable under Article 64 is subject to the application mutatis mutandis of Part XIV, Items 1, 3 and 4 (Article 64) of the Guidelines. In such a case, full consideration needs to be given to the state of the use of a original registered trademark.