

Part XVIII: Others

1. When "the trial decision [...] has become final and conclusive" in Article 11(4) and Article 12 (2) (Change to the application)

The time when "the trial decision [...] has become final and conclusive" is the time when the copy of the registration decision is served.

2. When the same person files an application for the same trademark or mark designating the same goods or services

(1) When the same person makes a duplicating application for the same trademark (including those different in size) designating the same goods or services, except for cases corresponding to the provisions of Article 68-10, in principle, after the trademark in respect of the prior application is registered, the later application will be refused under the reasons that it is "against the purpose of Article 3 of the Trademark Act".

(2) This is also true when the holder of the trademark right applies for a trademark registration for the same trademark (including those different in size) designating the same goods and services.

(3) When the holder of the trademark right is found to have filed an application for registration of a defensive mark for which all of the designated goods or service are the same based on the same registered trademark, the later application will be refused for reasons that it is "against the purpose of Article 64(1) and (2) of the Trademark Act," in principle.

(4) The same applies when the person who holds rights based on a defensive trademark registration has filed an application for registration of renewal of a defensive mark for which all of the designated goods or services are the same with respect to the same registered defensive mark during the period when the application of the renewal registration of the defensive trademark can be made.

3. Application for trademark registration with priority claim under the Paris Convention

(1) Priority claim

When the requirements set forth in (a) to (c) below are satisfied, the priority claim is judged to be appropriate.

(a) the applicant of the application for trademark registration with a priority claim is the same person or the successor of the applicant indicated in the certificate, etc. submitted pursuant to Article 43(2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 13(1) of the Trademark Act (hereinafter referred to as "priority certificate, etc.") (Article 4A(1) of the Paris Convention);

(b) the trademark stated in the application for trademark registration with a priority claim is the

same as that stated in the priority certificate, etc;

(c) all or part of the designated goods or designated services of the application for trademark registration with a priority claim is included in the designated goods or designated services presented in the priority certificate, etc.

(2) Effect of the application for trademark registration with a priority claim

When the priority claim is found to be appropriate, the relevant application for trademark registration is handled as being filed at the time of the first foreign application (hereinafter the date of this first foreign application is referred to as the "priority date") with respect to the application of the following provisions

(a) Article 4(1)(xi) (another person's registered trademark of an earlier application)

(b) Article 8 (earlier application)

In addition, "the time of the application for trademark registration" as referred to in Article 4(3) is judged based on the priority date.

(a) Article 4(1)(viii) (name of others)

(b) Article 4(1)(x) (another person's well-known trademark)

(c) Article 4(1)(xv) (confusion as to the source of goods or services)

(d) Article 4(1)(xvii) (indication of the place of production of wines or spirits)

(e) Article 4(1)(xix) (trademark identical with or similar to another person's well-known trademarks that is used for unfair purposes)