

5. Trial for Rescission of Trademark Registration

Q1: A request for a trial for rescission of my trademark registration in connection with multiple classes of designated goods and designated services due to nonuse has been filed. In the Written Reply, I intend to prove the use of the trademark by submitting catalogs, etc. In doing so, is it necessary to prove that this registered trademark has been used in connection with all of the designated goods and designated services, which is subject to the trial examination?

A1: As for the use of a registered trademark in connection with designated goods and designated services that is subject to a trial examination, if the right holder is able to prove its use in connection with some of the designated goods and designated services, the registered trademark will not be rescinded even if it has not been used in connection with all of the designated goods, etc.

Q2:
<Background to the case>
(1) Party A has filed a request for a trial for rescission of the registered trademark C owned by Party B due to nonuse.
(2) Party A and Party B held negotiations regarding the assignment of the registered trademark C and reached an agreement.
(3) Accordingly, Party A intends to file a request for transfer of registration of the registered trademark C and to withdraw the trial for rescission of the unused registered trademark C.
<Questions>
In order to avoid all possible risks, Party A wishes to withdraw the trial for rescission of the unused trademark registration C once its transfer is registered in the Trademark Registry. However, this will lead to the demandant and the demandee in the trial for rescission of the unused registered trademark merging into a single party. In this case, will the request for the trial be dismissed? In addition, is it possible for Party A, the demandant, to withdraw the trial?

A2: It is possible for a merged party to withdraw a request for a trial. Therefore, when the demandant and demandee have become merged, the JPO does not dismiss the request for trial, but rather asks the merged person to withdraw the request for trial.

Q3: When there is no reply from the right holder in a trial for rescission of trademark registration due to nonuse, how long will it take for the trial decision to be rendered?

A3: On average, the trial decision will be rendered about 4 to 6 months after the request is made.

Q4: When a demandee in a trial for rescission of trademark registration intends to prove that the holder of rights of non-exclusive use is using the trademark in question, is it required that the rights of non-exclusive use be registered?

A4: Since the registration of rights of non-exclusive use is merely a requirement to duly assert against third parties, it is not required. However, in order to prove the status of the holder of rights of non-exclusive use, certifying documents such as a license contract concluded between the holder of rights of non-exclusive use and the holder of the trademark right must be submitted.

<<Requirements for rescission in a trial for rescission of trademark registration due to nonuse>>

Q5: Can a registered trademark that was not used in Japan for three consecutive years or longer be rescinded through a trial?

A5: Even if the trademark was not used for three consecutive years or longer, if there is the fact that it was used subsequently, and if the demandee (right holder, etc.) can prove the fact that it was used within three years prior to the registration of the request for a trial, the trademark is not subject to rescission due to nonuse (Trademark Act §50 (2)).

<<Burden of proof on the demandee in a trial for rescission of trademark registration due to nonuse>>

Q6: When a request for a trial for rescission of trademark registration due to nonuse is filed, the burden of proof is on the demandee, and if the demandee fails to prove the fact that the trademark was used within three years prior to the registration of the request for a trial, this can be grounds for rescission of the trademark. Assuming that the right of the trademark has been transferred within three years prior to the registration of the request for a trial and the current right holder is unable to obtain documents certifying the fact of use by the previous right holder, will the trademark registration be rescinded?

A6: In a trial for rescission due to nonuse, the demandee (the right holder, etc.) is required to prove the fact of use, including facts related to the previous right holder, within three years prior to the registration of the request for a trial (Trademark Act §50 (2)). Even if the rights are transferred to the demandee, the fact of use prior to the transfer does not itself disappear. As such, the demandee must prove the fact of use within three consecutive years prior to registration of the request, including the period of use by the previous right holder.

Accordingly, if the demandee can prove that neither the previous right holder nor the demandee's used the trademark within the three consecutive years prior to registration of the request, the trademark registration will be rescinded.

<<Last-minute use in a trial for rescission of trademark registration due to nonuse>>

Q7: When a holder of a trademark right has learned that a request for a trial for rescission of his/her trademark registration due to nonuse will be filed, and therefore, has used the registered trademark prior to registration of the request for trial in order to avoid rescission, can the right holder avoid rescission of the registered trademark?

A7: If the use of a registered trademark by the trademark right holder, etc. (1) occurs during the period between three months prior to the filing of the request for a trial and the date of registration of the request for a trial, and (2) occurs after the trademark right holder learns that the request for a trial was or will be filed, then this use will be deemed "last-minute use," and the right holder will not be able to avoid rescission on the grounds of nonuse (Trademark Act §50 (3)).

Please note that the burden of proof for (1) and (2) falls on the demandant of the trial.

Q8: When filing a request for a trial for rescission of trademark registration in connection with some of the designated goods or the designated services, is it possible to use the description "___ and goods (or services) similar to it" as the "gist of the request" to specify the designated goods (or services) of the trademark that will be subject to a trial examination?

A8: It is necessary to describe the "gist of the request" in a trial for rescission accurately in order to clearly note the subject of a trial examination and the scope of rights after the final and binding decision on rescission. Descriptions such as "___ and goods (or services) similar to it" and "goods (or services) similar to ___" leave the content and scope of the goods (or services) unclear. As such, the "gist of the request" using these descriptions is not recognized as accurately described.

Accordingly, when the description "___ and goods similar to it", etc. is written in the "Gist of the Request" column of the request form, the JPO may request, via an invitation for amendment or a hearing, that the description be made clear (within the scope that does not change the gist), or that the description be deleted if unneeded, or that the objective clarity of the written "gist of the request" be explained.

Please note that requests for trials for invalidation are handled in the same way.