

21—03.3 T**Handling of a Case When Description in the Column "Purport of Demand" is "Similar Goods", etc.
in Trial for Invalidation/Rescission for Trademark****1. Basic concept**

In demanding a trial for rescission or a trial for invalidation for trademark registration, there is a case that "similar goods" etc., is described (Note) in a column "Purport of demand" of a written demand for trial when a trial is demanded for a part of the designated goods/services.

"Purport of demand" in a written demand for trial is described by a demandant. The scope of the subject of proceedings for a demand for trial is determined based on said description. It is not permitted in principle the indication of "similar goods", etc. because the scope of designated goods/services to which the registered trademark is effective becomes ambiguous.

Therefore, a written demand for trial having a description of "similar goods" in a column "Purport of demand" needs to handle as follows.

(Note) A description "similar goods", etc. includes, for example, "similar services", "goods of similarity" or "services of similarity".

2. Countermeasures**(1) Order for written amendment**

A. When there is an indication of "similar goods", etc. in "Purport of demand" in a written demand for trial, an order for amendment shall be issued against the provision of the Patent Act Article 131(1) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1) during a

formality examination.

B. Said order for amendment requires either to clarify an indication “similar goods” etc. in a range without change of the gist, or to delete said indication if not necessary, or to explain about objective clarity of said “Purport of demand”.

C. When a demandant does not respond at all against an order for amendment, a chief administrative judge may dismiss a written demand for trial by decision under provisions of the Patent Act Article 133(3) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1).

(2) Inquiry

A. When there is any response such as amendment or explanation of “Purport of demand” to the order for written amendment in (1), a panel shall judge substantially on clarity of “Purport of demand”.

B. A panel requires a demandant to explain clarity of “Purport of demand” under the inquiry of a chief administrative judge, based on the Patent Act Article 134(4) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1), if necessary.

C. When a panel recognizes “Purport of demand” becomes clear by amendment or explanation, the panel corrects a preliminary registration of a register of the trademark registration, and serves a duplicate of a written demand for trial to a counterparty.

D. When there is no response to the inquiry from a demandant and a panel still recognizes the description of “Purport of demand” is unclear, said written demand for trial shall be dismissed by decision under the Patent Act Article 133(3) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1).

(Reference court cases)

1. Judgement of the IP High Court, June 27, 2007 (2007 (Gyo-ke) 10084)
2. Judgement of the IP High Court, Oct. 31, 2007 (2007 (Gyo-ke) 10158)

3. Judgement of the IP High Court, Nov. 28, 2007 (2007 (Gyo-ke) 10172)

(Revised Feb 2015)