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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. The indication of "similar goods", etc. is not permitted in principle, because the scope of designated goods/services covered by the registered trademark becomes ambiguous when the case becomes final and binding with a partial rescission or a partial invalidation.

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

(Note) A description "similar goods", etc. includes "similar services". The same applies hereinafter.

2. Handling of the Case

(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 in violation of 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. within the range that does not change 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 give any response to an order for amendment, a chief administrative judge may dismiss a written demand for trial by decision under the provision 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 make substantive determination on clarity of “Purport of demand”.

B. A panel asks a demandant for an explanation on 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. (2007 (Gyo-Ke) 10084) Judgement of the IP High Court, June 27, 2007
2. (2007 (Gyo-Ke) 10158) Judgement of the IP High Court, October 31,

2007

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

(Revised Feb 2015)