

## **53-03 T**

# **Trial for Rescission against Trademark Registration in Bad Faith by Agent or Representative of the Holder of a Mark in a Country of the Union to the Paris Convention**

## **1. Background**

The Trademark Act Article 53-2 reinforces the protection of a holder of trademark right in a country of the Union to the Paris Convention by allowing the holder of trademark right in the other member countries to request for rescission of a trademark registration, for which an application for trademark registration had been filed in bad faith by the agent, representative, etc. of the holder of trademark right. This Article was newly established as a partial revision to the Trademark Act in 1965 (Law No. 81 of 1965) with the purpose of implementing the provisions of the Paris Convention Article 6-septies. Later, in a partial revision to the Trademark Act in 1991 (Law No. 65 of 1991), the trademark registration for services also became the subject of a trial for rescission.

## **2. Time Limit of Exclusion for Request**

A request for trial for rescission of the trademark registration may not be filed after the lapse of five years from the date on which the establishment of the trademark right has been registered (Article 53-3 of the Trademark Act). The purpose of this Article is that once a trademark is registered, even under the name of the agent or representative, a new credibility is built based on the registration. Accordingly, if the registration continues to be subject to rescission forever, the newly-established credibility becomes significantly unstable. As such, taking into account the principal's due care for acts by the agent, etc., and considering the provisions of the Paris Convention Article 6-septies, the time limit for requesting for a trial for rescission came to be limited to five years after the registration of the trademark.

### **3. Justifiable Reasons**

"Justifiable reasons" as used in the Article refers to the cases where a holder of a mark causes its agent or representative to believe that said holder waives its right to the mark or does not have the intention to obtain a right for the mark concerned in the country.

["Chukai Paris Joyaku" (Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967, Japanese Ed.) by Bodenhausen, page 121, published by AIPPI JAPAN in 1968]

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