

**61-12 T****Handling of Appeal Against Examiner's Decision Cases  
When the Cited Trademarks are Pending in either a Trial for  
Trademark Invalidation or a Trial for Rescission of Trademark  
Registration**

In an appeal against examiner's decision of refusal for the Trademark Act Article 4(1)(xi) (in this section, 61-12, hereinafter referred to as "later appeal"), when a trial decision of an invalidation trial or a rescission trial with respect to the registered trademark cited in the appeal (in this section, 61-12, hereinafter referred to as a "first trial") is not finalized, the later appeal is handled as follows.

1. When a demand for the first trial is not successful, even before a decision of the first trial has been finalized, it is possible to make an appeal decision to refuse a trademark of the later appeal due to the fact that the registered trademark of the first trial is as a cited trademark.
2. When a demand for the first trial is successful (invalidation, rescission), the decision of the later appeal is pending until the decision of the first trial becomes final and binding.

Reasons are as follows.

The Trademark Act Article 4(1)(xi) provides that no trademark may be registered if the trademark is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of that trademark.

Then, the “final and binding” trial decision is required to invalidate or rescind the trademark registration under an invalidation trial or a rescission trial.

In a case where the first trial decision is a decision of invalidation or rescission, the trademark right exists until the trial decision becomes final and binding, and since the “registered trademark” exists in real, if the later appeal decision of registration is made before the trial decision becomes final and binding, a situation of an overlapped registration is occurred for the registered trademark with respect to the former trial and the trademark with respect to the later appeal.

In the Trademark Act eliminates an overlapped registration as provided in Trademark Act Article 4(1)(xi) (Identical with or similar to a registered trademark of others) and Article 8 (Prior application).

Therefore, it is not desirable to make a trial decision knowing that it may occur an overlapped registration situation.

When the decision of the former trial is unsuccessful, on the other hand, as the prior trademark is a “registered trademark”, the trademark of the later appeal falls under the Trademark Act Article 4(1)(xi), it may make a trial decision of refusal before a decision of the former trial becomes final and binding. In this case, the problem of overlapped registration will be never occurred.

(Revised Oct 2015)