

## 66-01 T

### Procedures for Opposition to Registration of Trademark

#### 1. Relevant Provisions

The Trademark Act Article 43-2 (Opposition to registration of trademark)

Any person may file with the Commissioner of the Patent Office an opposition to registration within two months from the date of publication of the gazette containing the trademark, on the grounds that registration of trademark falls under any of the following items; in this case, an opposition to registration may be filed for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or designated services:

- (i) where registration of trademark has been made in violation of the Trademark Act Article 3, 4(1), 7-2(1), 8(1), 8(2), 8(5), or 51(2) (including its mutatis mutandis application under the Trademark Act Article 52-2(2)), 53(2) or the Patent Act Article 25 as applied mutatis mutandis under the Trademark Act Article 77(3);
- (ii) where registration of trademark has been made in violation of a treaty;
- (iii) where registration of trademark has been made for an application for registration of trademark which does not satisfy the requirements prescribed in the Trademark Act Article 5 (5).

#### 2. Opposition to Registration

(1) Any person may file an opposition to registration on the grounds that the registration of trademark falls under any of the items of the Trademark Act Article 43-2;

Provided, however, that after the extinguishment of the trademark right (including the abandonment of trademark right), it is understood that an opposition to registration may not be filed.

(2) An opposition to registration of trademark may be filed for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or designated services.

While some of the registrations concerning applications filed on and after April 1, 1997 may cover multiple classes of designated goods or designated services, an opposition to registration may be filed for each of designated goods or designated services irrespective of the class even where the registration covers multiple classes.

### **3. Reasons for Opposition to Registration**

Reasons for opposition to registration are limited to those prescribed in the Trademark Act Article 43-2 (including its mutatis mutandis application under Article 68 (4)), and no opposition to registration may be filed based on any other reasons.

#### **(1) Reasons for Opposition as Prescribed in the Trademark Act Article 43-2 Are As Follows.**

##### **A Relevance to item (i)**

Violation of requirements for registration of trademark (the Trademark Act Article 3)

Violation based on reasons for non-registrability (the Trademark Act Article 4 (1))

Requirements for registration of a regional collective trademark (the Trademark Act Article 7-2)

Violation of a prior application (the Trademark Act Article 8 (1), (2), and (5))

Prohibition of re-registration in the event of rescission of registration of trademark (the Trademark Act Article 51 (2) [including its mutatis mutandis application under the Trademark Act Article 52-2 (2)] and Article 53 (2))

Violation of enjoyment of rights by foreign nationals (the Trademark Act Article 77 (3) → the Patent Act Article 25)

##### **B Relevance to item (ii) violation of a treaty**

##### **C Relevance to defensive mark registration (the Trademark Act Article 68 (4))**

Violation of requirements for defensive mark registration (the Trademark Act Article 64)

Violation of enjoyment of rights by foreign nationals (the Trademark Act Article 77 (3) → the Patent Act Article 25)

#### **(2) Relevance to Reasons for Refusal**

In relation to the reasons for refusal as prescribed in the Trademark Act Article 15, cases where the trademark fails to satisfy the requirements prescribed in the Trademark Act Article 6 (Single

trademark on each application) including the cases where the designated goods or designated services, under which the trademark is registered, do not belong to the appropriate classes of goods and services, etc., do not constitute reasons for opposition to registration.

### **(3) Relevance to Reasons for Invalidation**

In relation to the reasons for invalidation as prescribed in the Trademark Act Article 46 (1), the case of a usurped application (the Trademark Act Article 46 (1) (iii)), the case where, after registration of trademark, enjoyment of rights by foreign nationals is no longer possible, the case of violation of a treaty (the Trademark Act Article 46 (1) (iv)), and the case of falling under reasons for non-registrability related to public interests (the Trademark Act Article 46 (1) (v)), do not constitute reasons for opposition to registration.

### **(4) Relevance to a Trial for Rescission As Prescribed in the Trademark Act Article 53-2**

While the reasons for opposition to registration include violation of a treaty, an opposition to registration may not be filed based on the reason that the agent or representative of a person who is the proprietor of a trademark in one of the countries of the Union to the Paris Convention, etc. filed an application for registration of, and was granted the right for, the trademark concerned under its own name without such proprietor's authorization (the Paris Convention Article 6-7 (1), the WTO/TRIPS Agreement Article 2 (1), the Trademark Law Treaty Article 15). In such a case, only the trial for rescission as prescribed in the Trademark Act Article 53-2 will be requested.

(Explanation)

Under the Trademark Act, implementation of the Paris Convention Article 6-septies after the registration of establishment of a trademark right is applicable only in a trial for rescission (the Trademark Act Article 53-2) (a trial for invalidation under the Trademark Act Article 46 may not be requested).

While the Paris Convention Article 6-septies provides that "the proprietor of the mark shall ... be entitled to oppose the use of his mark," it is understood that the "opposition to registration" as referred to therein means "pre-grant opposition" and does not include "post-grant opposition."

#### 4. Timing During Which an Opposition to Registration May Be Filed

(1) An opposition to registration may be filed within two months from the date of publication of the gazette containing the trademark (the Trademark Act Article 43-2).

(2) An amendment of the written opposition to registration of a trademark shall not change the gist thereof. However, provided that such amendment is made no later than 30 days from the expiration of time limit for filing an opposition to registration, an amendment to change the gist of the opposition with respect to the reasons for opposition to registration and the indication of supporting evidence (Refer to 66-03, 1. (3) "Reasons for Opposition to Registration of Trademark and Indication of Supporting Evidence" shall be allowed. In addition, for a person in a remote area or an area with transportation difficulties, the time limit may be extended further (the Trademark Act Article 43-4 (3)).

<Extension of Time Limit>

- ◆ Overseas resident ...Extension of 60 days
- ◆ A person domiciled or resident in Japan and in a remote area or an area with transportation difficulties (refer to the table below) or a representative thereof ...Extension of 15 days

Tokyo	The Izu Islands, The Ogasawara Islands
Ishikawa Prefecture	Wajima-shi Ama-machi (Hegurajima)
Kagoshima Prefecture	The Nansei Islands
Okinawa Prefecture	Neighboring islands other than Okinawa mainland
Hokkaido	Neighboring islands of Hokkaido

#### 5. Withdrawal of Opposition to Registration

(Relevant provisions)

The Trademark Act Article 43-11 (Withdrawal of opposition)

(1) An opposition to registration, once filed, may not be withdrawn after the notice under Article 43-12 (Note 1) is served.

(2) The Patent Act Article 155 (3) as applied mutatis mutandis under Article 56 (2) of this Act (Note 2) shall apply mutatis mutandis to the withdrawal of an opposition to registration.

(Note 1) Notice of reasons for revocation of registration of trademark

(Note 2) Withdrawal of request for trial

(Reference)

The Patent Act Article 155 (3)

(3) When a request for a trial for patent invalidation has been filed with regard to two or more claims covered by a patent that has two or more claims, the request may be withdrawn for any of the claims.

An opposition to registration may be withdrawn until the Patent Office issues a notice of reasons for revocation of registration of trademark (the Trademark Act Article 43-12), and an opposition may be withdrawn for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or designated services.

## **6. Making Application Documents, etc. Available for Public Inspection**

(Relevant provisions)

The Trademark Act Article 18 (Registration of establishment of trademark right)

(4) The Commissioner of the Patent Office shall make application documents and their annexed articles available for public inspection at the Patent Office for two months from the date of issuance of the trademark gazette containing matters listed in each item of the preceding paragraph (hereinafter referred to as "gazette containing the trademark") pursuant to the provisions of the preceding paragraph.

Upon registration of establishment of a trademark right, application documents and their annexed articles shall be made available for public inspection at the Patent Office for two months from the date of issuance of the trademark gazette containing matters such as the registration number, the

trademark stated in the application (registered trademark), and the designated goods or designated services, ("gazette containing the trademark") (the Trademark Act Articles 18 (3), (4)).

**[Reference] Comparison of Reasons for Opposition to Registration of Trademark, Reasons for Invalidation, and Reasons for Refusal under the Trademark Act**

Reasons for opposition	Reasons for invalidation	Reasons for refusal
Requirements for registration of registration the Trademark Act Article 3	Same as left	Same as left
Reasons for unregistrability the Trademark Act Article 4 (1)	Same as left	Same as left
Requirements for registration of regional collective trademarks the Trademark Act Article 7-2 (1)	Same as left	Same as left
Prior application the Trademark Act Article 8 (1), (2), (5)	Prior application the Trademark Act Article 8 (1), (2), (5)	Prior application the Trademark Act Article 8 (2), (5)
Prohibition of re-registration of a trademark whose registration is prohibited the Trademark Act Article 51 (2), Article 52-2 (2), Article 53 (2)	Same as left	Same as left
Enjoyment of rights by foreign nationals the Trademark Act Article 77 (3) → the Patent Act Article 25	Same as left	Same as left
Violation of a treaty Trademark Act Article 43-2 (1) (ii)	Same as left	Same as left
Requirements under Article 5, paragraph 5 Trademark Act Article 43-2 (1) (iii)	Same as left	Same as left
		Single trademark on each application Trademark Act Article 6 (1), (2)
	Registration of a person who is not a patentee Trademark Act Article 46 (1) (iv)	
	Reason occurring after the grant Trademark Act Article 46 (1) (v) - (vii)	

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