

## 66-03 T

### Method of Filing an Opposition to Registration of Trademark

#### 1. Written Opposition

##### (1) Relevant Provisions

The Trademark Act Article 43-4 (1) (Formality requirements for filing an opposition, etc.)

A person filing an opposition to registration of trademark shall submit to the Commissioner of the Patent Office a written opposition stating the following matters:

(i) the name and the domicile or residence of the opponent to the registration and a representative(s) thereof;

(ii) the indication of registration of trademark pertaining to the opposition to registration;  
and

(iii) the reasons for the opposition to registration and the indication of supporting evidence.

##### (2) Name, etc. of the Opponent to the Registration and the Indication of the Trademark Registration

A Opponent to registration, etc.

A written opposition must state the name and the domicile or residence of the opponent to the registration and a representative(s) thereof.

B Indication of registration of trademark pertaining to the opposition

A written opposition shall state the registration number of the trademark, as well as the classification of goods and services for which the opposition is filed, and the designated goods or designated services.

##### (3) The Reasons for the Opposition to Registration of Trademark and the Indication of Supporting Evidence

A The reasons for the opposition to registration of trademark

A written opposition must state the claim made by the opponent as to why the designated goods or designated services pertaining to the opposition fall under any of the items of the Trademark Act Article 43-2.

As the reasons for the opposition, a written opposition usually states the following:

(A) Background of the registered trademark from the filing of an application to registration;

(B) The registered trademark for which the opposition is filed, and the designated goods (services) thereof, and the indication of the legal basis and supporting evidence based on which the registration should be rescinded;

(C) Specific reasons for revocation of the registration, etc.

#### B The Indication of Supporting Evidence

For the opposition to registration which requires supporting evidence, the evidence for verifying the specific facts to be claimed as the reasons for the opposition must be indicated. Means of proof include written documents, objects to be inspected, the party to the litigation, expert witnesses, and witnesses.

#### **(4) Submission of Duplicates of the Written Opposition to Registration of Trademark**

When submitting a written opposition, the required number of duplicates to be dispatched to the holder(s) of the trademark as well as a duplicate for the examination must be submitted (Regulations under the Trademark Act Article 22 (1) → Regulations under the Patent Act Article 4.

#### **(5) Procedures in the Event of Opposition to Registration**

##### A Dispatch of a duplicate of a written opposition

The chief administrative judge shall dispatch a duplicate of the written opposition to the holder of trademark right (the Trademark Act Article 43-4 (4)). If the holder of the trademark right of the said registration has requested a representative to handle the matters concerning the opposition, a duplicate of the written opposition shall be dispatched to the representative.

A duplicate of the written opposition shall be dispatched after the period for submission of supplementary reasons for opposition to registration has passed, and if multiple oppositions to registration have been filed, they shall be dispatched collectively.

The holder of a trademark is not required to state opinions in response to the duplicate of the written opposition. An opportunity to state opinions will be granted in response to the notice of reasons for revocation of registration (→66-04 3. Notice of reasons for Revocation of Registration).

**B Notice to holders of exclusive right to use, etc.**

Where an opposition to registration is filed, the chief administrative judge shall notify the holder of exclusive right to use in connection with the said trademark right, and other persons who have any registered rights relating to registration of trademark (the Trademark Act Article 43-4 (5) → the Trademark Act Article 46 (3)).

**C Announcement of registration concerning opposition to registration**

In the event of opposition to registration, announcement of the fact is registered in the Trademark Register (the Trademark Registration Order Article 1-2 (ii)).

**D Publication in Trademark Gazette**

In the event of opposition to registration, the fact is published in a trademark gazette after the announcement of registration is made (Patent Office Gazette (the issue containing the trademark)) (the Trademark Act Article 75 (2) (v)).

## **2. Deficiencies in the Procedures for the (Written) Opposition to Registration and the Opposition to Registration Case**

### **(1) Relevant Provisions**

The Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 133(Dismissal by decision in the case of non-compliance with formality requirements)

Where a written request does not comply with the provisions of Article 131, the chief administrative judge shall order the demandant to amend the written request, designating an adequate time limit.

(2) Excluding the case as provided in the preceding paragraph, the chief administrative judge may order the demandant to amend procedures pertaining to the trial and appeal, designating an adequate time limit, in any of the following cases:

(i) where the procedures do not comply with the paragraphs (1) to (3) of Article 7 or Article 9 (Note 1);

(ii) where the procedures do not comply with the formality requirements as provided in this Act or an order thereunder; and

(iii) where the fees for a procedure payable under Article 195 (1) or Article 195 (2) (Note 2) have not been paid for the procedures.

(3) The chief administrative judge may dismiss the procedures by a decision where a person ordered to make an amendment to procedures pertaining to appeal/trial cases to make such amendment within the time limit designated under the preceding two paragraphs or where such amendment is made in violation of Article 131-2 (1)..

(4) The decision under the preceding paragraph shall be made in writing and state the reasons therefor.

(Note 1) the Patent Act Article 7 (1) - (3) (Capacity of minors, adult wards, etc. to undertake procedures), Article 9 (Scope of authority of representation)

(Note 2) In the case of application mutatis mutandis to the Trademark Act Article 43-15, it shall be understood as the Trademark Act Article 76 (1) (ii) (Fees).

the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 135 (Dismissal of inadequate appeal/request for trial by appeal/trial decision)

An unlawful request for a trial, that is not amendable, may be dismissed by appeal/trial decision without giving the demandee an opportunity to submit a written answer.

The Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 133-2 (Dismissal of unlawful procedures)

In the procedures pertaining to appeal/trial case (excluding appeal/request for trial), the chief administrative judge may, by a decision, dismiss procedures that are unlawful and not amendable.

(2) Where the chief administrative judge intends to dismiss a procedure under the preceding paragraph, he/she shall notify the person who undertook the procedures of the reasons therefor, and give the said person an opportunity to submit a statement of explanation, designating an adequate time limit.

(3) The decision under this paragraph (1) shall be in writing and state the reasons therefor.

**(2) Deficiencies in the (Written) Opposition to Registration and Disposition in Such Case**

A Invitation to amend and dismissal of written opposition

Where a written opposition has non-compliance with formalities or deficiency of fees, the chief administrative judge shall issue an invitation to amend.

Where an applicant who received the said invitation to amend fails to amend the application within the designated time limit, the chief administrative judge shall dismiss, by a decision, the written opposition (the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 133 (3)).

B Dismissal of unlawful opposition to registration

Where an opposition to registration is unlawful (lapse of period, etc.), instead of amendment being ordered, the opposition shall be dismissed by a decision made by a panel consisting of administrative judges (the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 135).

**(3) Defect with Procedures for an Opposition to Registration Case Other than a (Written) Opposition to Registration, and Disposition Thereof**

Any procedure concerning an opposition to registration case other than a written opposition (for example, notice of change in domicile/residence of opponent, notice of change/alteration of a representative, etc.; hereinafter referred to as "procedure for matters other than a written opposition"), in the event of defect, the following procedures shall be taken.

A Invitation to amend and dismissal of procedures

Where the case has non-compliance with the formality requirements for the procedures for matters other than a written opposition, or deficiency of fees, the chief administrative judge shall issue an invitation to amend.

Where the applicant fails to make amendment in response to the said invitation to amend within the designated time limit, the chief administrative judge shall dismiss, by decision, the said procedure (the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 133 (1)).

## B Dismissal of unlawful procedures

Where a procedure for matters other than a written opposition is unlawful and not amendable, the chief administrative judge may dismiss the procedure by decision.

Where the chief administrative judge intends to dismiss a procedure for matters other than a written opposition, he/she shall notify the person who undertook the procedures of the reasons therefor, and give the said person an opportunity to submit a statement of explanation, designating an adequate time limit (the Trademark Act Article 43-15, the Trademark Act Article 56 (1)→ the Patent Act Article 133-2 (2)).

### **(4) Appeal against a Decision of Dismissal**

#### A Appeal against a decision to dismiss a written opposition

An action may be instituted in the Tokyo High Court (Intellectual Property High Court) against a decision to dismiss a written opposition according to the above (2) A (the Trademark Act Article 63 (1)).

#### B Appeal against a decision to dismiss an unlawful opposition to registration

An appeal may not be filed against a decision to dismiss an unlawful opposition to registration according to the above (2) B (the Trademark Act Article 43-15 (2), Article 43-3 (5), and Article 56 (1) → the Patent Act Article 135).

#### C Appeal against a decision to dismiss a procedure for an opposition to registration

For an appeal against a decision to dismiss a procedure for matters other than a written opposition according to the above (3), a trial may be requested pursuant to the Administrative Appeal Act (the Trademark Act Article 63-2→ the Patent Act Article 184-2).

## **3. Change of Gist of a Written Opposition**

### **(1) Relevant Provisions**

The Trademark Act Article 43-4 (2), (3)(Formality requirements for filing an opposition, etc.)

2 An amendment of the written opposition submitted under the preceding paragraph (Note 1) shall not change the gist thereof. However, this provision shall not apply to any amendment with respect to the matters provided for in item (iii) of the preceding paragraph (Note 3);

provided that such amendment is made no later than thirty days following the expiration of the time limit provided in Article 43-2 (Note 2).

3 The Commissioner of the Patent Office may, upon request or ex officio, extend the time limit provided in the preceding paragraph for a person in a remote area or an area with transportation difficulties.

(Note 1) The matters stated in a written opposition

(Note 2) Time limit for filing an opposition to registration

(Note 3) Reasons for the opposition to registration and the indication of supporting evidence

## **(2) Amendment Which Changes the Gist of a Written Opposition**

A Amendment to the name, etc. of the opponent or the indication of registration of trademark

(A) Name, etc. of the opponent

Where the amendment is for the name of the opponent and the amendment causes the opponent to lose its identity, the amendment is considered change of the gist.

(B) Amendment to the indication of registration of trademark pertaining to the opposition to registration

Where the amendment is for the registration number or the indication of designated goods or designated services for which the opposition to registration is filed, and the amendment causes the subject of the opposition to lose its identity, the amendment is considered change of the gist.

Deletion of designated goods or designated services for which the opposition to registration is filed does not fall under change of the gist. However, deletion of designated goods or designated services for which the opposition to registration is filed shall be limited to such that is made prior to the notice of reasons for revocation.

B Reasons for the opposition to registration and the indication of supporting evidence

Where the amendment is for the reasons for the opposition to registration or the indication of supporting evidence, an amendment which changes the gist thereof after the expiration of the time limit for supplementing the reasons for the opposition to registration and the indication of supporting evidence shall not be accepted.

Specifically, addition or change with respect to the relevant provisions of the opposition to registration or to the evidence shall not be accepted.

In the above A and B, whether or not such amendment changes the gist of the opposition to registration shall be determined based on the entirety of the written opposition.

(Revised Feb. 2015)