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Proceedings on the Opposition to Registration

1. Proceedings Body and Administrative Judges

(1) Proceedings Body

The Trademark Act Article 43-3 (1) (Decision)

Proceedings and decision on an opposition to registration shall be conducted by a panel consisting of three or five administrative judges.

The Trademark Act Article 43-5 and Article 56 (1)→ the Patent Act Article 136 (2) of (Panel system for trial)

A decision of the panel under the preceding paragraph shall be made by a majority vote.

(Explanation)

The post-grant opposition system for trademark rights examines the appropriateness of the decision of registration, and while the procedures must ensure fairness and independence of the proceedings, the appropriateness of the proceedings must also be ensured in the procedures; thus, it was decided that proceedings shall be conducted by a panel consisting of administrative judges.

(2) Designation of Administrative Judges

A Relevant provisions

The Trademark Act Article 43-5 and Article 56 (1) → the Patent Act Article 137(Designation of administrative judges)

The Commissioner of the Patent Office shall designate the administrative judges constituting a panel under Article 136 (1) (Note) for each trial (omitted).

(2) Where any of the administrative judges designated under the preceding paragraph is unable to participate in the trial, the Commissioner of the Patent Office shall terminate the designation and appoint another administrative judges to fill the vacancy.

(Note) Panel system for the trial

B Notice of designation of administrative judges

The Regulations under the Trademark Act Article 22 (5)→ the Regulations under the Patent Act Article 48 (2)

(A) When an administrative judge is designated, the name of the said administrative judge shall be notified to the holder of trademark right, the opponent, and the intervenor.

(B) When an administrative judge is changed, the name of the said administrative judge shall be notified to the holder of trademark right, the opponent, and the intervenor.

(3) Authority of the Chief Administrative Judges

The Trademark Act Article 43-5 and Article 56 (1)→ the Patent Act Article 138(Chief administrative judge)

The Commissioner of the Patent Office shall designate one of the administrative judges designated under Article 137 (1) (Note) as the chief administrative judge.

2 The chief administrative judge shall preside over matters relating to the trial and appeal cases.

(Note) Designation of administrative judges

(4) A Motion Requesting Exclusion or Recusation

A Relevant provisions

The Trademark Act Article 43-5 and Article 56 (1) → the Patent Act Article 139

(Exclusion of administrative judges)

An administrative judge shall be excluded from performing his/her duties in any of the following cases:

(i) where the administrative judge or his/her spouse or former spouse is or was a party in the case, an intervenor in the case, or a patent opponent in the case;

(ii) where the administrative judge is or was a relative by blood within the fourth degree of kinship, a relative by affinity within the third degree of kinship, or a relative living together of a party in the case, an intervenor in the case, or a patent opponent in the case;

(items (iii) through (vii) are omitted)

(Explanation)

The holder of trademark right, the opponent, or the intervenor may file a motion requesting exclusion or recusation of an administrative judge.

The Patent Act Article 137, which is applied mutatis mutandis in the Trademark Act Article 43-5 and the Trademark Act Article 56 (1) provides that, where any of the administrative judges designated is unable to participate in the trial, the Commissioner of the Patent Office shall terminate the designation and appoint another administrative judge to fill the vacancy. The administrative judge who is "unable to participate in the trial" includes a person who is the subject of exclusion or recusation in addition to the cases of illness and the like.

2. Scope of Proceedings

(1) Relevant Provisions

Main paragraph of the Trademark Act Article 43-2 (Opposition to registration)

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:

(The items are omitted)

The Trademark Act Article 43-3 (2), (4) (Decision)

(2) Where the administrative judges find that registration of trademark pertaining to an opposition to registration falls under any of the items of Article 43-2 (Note), the administrative judges shall render a decision to the effect that registration of trademark is to be revoked (hereinafter referred to as "decision to revoke").

(4) Where the administrative judges find that registration of trademark pertaining to an opposition to registration does not fall under any of the items of Article 43-2 (Note), the administrative judges shall render a decision to the effect that registration of trademark is to be maintained.

(Note) Reasons of the opposition to registration

The Trademark Act Article 43-9 (Ex officio proceedings)

In proceedings of an opposition to registration, any reasons not pleaded by the holder of trademark right, the opponent, or the intervenor may be examined.

(2)d In proceedings of an opposition to registration, no proceedings shall be conducted on any designated goods or designated services for which the opposition to registration is not raised.

The Trademark Act Article 43-11 (1) (Withdrawal of opposition)

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

(Note) Notice of reasons for revocation

(2) Designated Goods or Designated Services Which Are the Subject to Proceedings

The scope of the designated goods and designated services which are the subject to proceedings is limited to the designated goods and designated services for which an opposition to registration has been filed.

Where multiple oppositions to registration are filed and the proceedings are conducted jointly, the designated goods and designated services for which the joined oppositions to registration are filed shall all be the subject of proceedings.

(3) Proceedings on an Opposition to Registration

Proceedings on an opposition to registration take place after an opposition is filed following the examiner's examination of applications; thus, in principle, the proceedings are conducted based on the reasons pleaded by the opponent and the evidence presented by the opponent (Example 1).

In addition, in proceedings on an opposition to registration, any reasons not pleaded by the opponent may be examined. Such examples include the adoption of literature which is not submitted when an opposition to registration is filed (Example 3), and the corresponding application of applicable provisions (Example 4).

Example 1 Where proceedings are conducted by adopting, from among the reasons (evidence) pleaded in an opposition to registration, those which may constitute reasons for revocation.

By adopting (adoption of Evidences A and B) the opponent's claim (for submission of Evidences A and B), the notice of reasons for revocation will be served.

Example 2 Where multiple oppositions to registration are filed, and where proceedings are conducted by selecting, from among the reasons pleaded and the evidence submitted in such oppositions to registration, those which may constitute reasons for revocation Since Opponent Party A submits Evidences A and B, and Opponent Party B submits Evidences C and D, the Evidences A and D are adopted from among the above evidences, and the notice of reasons for revocation will be served.

Example 3 Where proceedings are conducted by adopting even the evidence which the opponent did not submit

The reasons for revocation will be notified by using Evidence C, which the examiner discovered, in addition to Evidences A and B which the opponent submitted.

Example 4 Where the applicable provisions, which are not claimed by the opponent, are applied

If the opponent claims, in the reasons for filing an opposition to registration, that the said registration of trademark falls under the Trademark Act Article 3 (1) (iii), however, if the evidence, etc. that has been submitted indicates that the said registration of trademark also falls under the Trademark Act Article 4 (1) (xvi), the notice of reasons for revocation will be served by referring to the Trademark Act Article 3 (1) (iii) and the Trademark Act Article 4 (1) (xvi) as the relevant provisions.

(4) Where an Opposition to Registration Is Withdrawn

An opposition to registration may be withdrawn as long as the notice of reasons for revocation of a registration is not yet served (the Trademark Act Article 43-11).

A Where all oppositions to registration (if there are multiple oppositions, all such oppositions) are withdrawn, the proceedings on the oppositions filed against the said registration of trademark shall be completed, and the notice as to the withdrawal of the oppositions to registration will be served to the holder of trademark right and the intervenor (Regulations under the Trademark Act Article 22 (5) → Regulations under the Patent Act Article 50-5).

B Where the withdrawal of the opposition to registration concerns a part of the designated goods or designated services, the proceedings on the opposition shall continue excluding the designated goods or designated services that have been withdrawn.

C However, once the notice of reasons for revocation is served, an opposition may not be withdrawn, thus, the proceedings shall continue.

3. Notice of Reasons for Revocation of Registration

(1) Relevant Provisions

The Trademark Act Article 43-12 (Notice of reasons for revocation)

Where the chief administrative judge intends to render a revocation decision, the chief administrative judge shall notify the holder of trademark right and the intervenor of the reasons for revocation of registration of trademark and give the said parties an opportunity to submit a written opinion, designating an adequate time limit.

(Explanation)

Taking into account the nature that the opposition to registration of trademark system is to review the registration, and the necessity that the proceedings should be conducted promptly and precisely, the opposition to registration of trademark system is based on the service of the notice of reasons for revocation by the panel, and the submission of a written opinion, etc. in response to the said notice by the holder of trademark right. However, where there is no reason to revoke the trademark, the decision to maintain the trademark shall be rendered (the Trademark Act Article 43-3 (4)).

(2) Procedures for Notice of Reasons for Revocation

Where an opposition to registration is filed, a duplicate of the written opposition shall be dispatched to the holder of the trademark right (→66-03 1. (5) A "dispatch of a duplicate of a written opposition").

Where the chief administrative judge renders a decision to revoke the registration after the above duplicate is dispatched, the reasons for revocation shall be notified to the holder of the trademark right, providing the trademark holder with the opportunity to submit a written opinion.

Accordingly, it is sufficient for the holder of the trademark right to submit a written opinion only after the service of the notice of reasons for revocation, and thus, there is no need to submit a written reply in response to the duplicate of the written opposition.

(3) Drafting of the Notice of Reasons for Revocation

A Proceedings on opposition to registration shall be conducted with respect to all reasons and evidence.

B If, as a result of the proceedings, registration of trademark is considered to not have any reasons to be revoked, the decision to maintain the registration shall be rendered.

C If, as a result of the proceedings, registration of trademark is considered to have some reasons to be revoked, the matter shall be drafted in the notice of reasons for revocation (where there are multiple reasons for revocation, all such reasons shall be indicated respectively in principle).

Where there are reasons for revocation with respect to a part of the designated goods or designated services from among the designated goods or designated goods for which an opposition to registration is filed, the notice of reasons for revocation shall be served by clearly specifying the applicable designated goods or designated services containing the reasons for revocation.

Where the notice of reasons for revocation is served, a single notice shall be made in principle, however, depending on the content, including the situation where the reasons for revocation rang over multiple classes, the applicable provisions is different from each other, etc., multiple notices of reasons for revocation may be made.

D In the above C, if, for example, there are multiple reasons for revocation with respect to the same applicable provisions, the notice for reasons of revocation shall be drafted in an efficient and reasonable manner according to each case, for example, by adopting the appropriate reason as the reason for revocation, etc.

E Points to note upon drafting the notice of reasons for revocation

(A) Since the proceedings are conducted after the registration, the notice of reasons for revocation shall be served with care.

(B) Care should be taken so that notice of reasons for revocation does not have to be served repeatedly in response to written opinions.

(C) Where there are multiple reasons for revocation, and where a decision to revoke registration of trademark is rendered in a revocation action, it should be noted that a decision to revoke the registration will not be rendered once again based on a different reason for revocation.

4. Examination of Evidence and Inquiry

(1) Relevant Provisions

The Trademark Act Article 43-8 (Examination of evidence and preservation of evidence)

The Patent Act Articles 150 and 151 as applied mutatis mutandis under Article 56 (1) of this Act shall apply mutatis mutandis to the examination of evidence and preservation of evidence in the proceedings of the opposition to registration.

The Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 134 (4)

(Mutatis mutandis application of provisions concerning trial/appeal)

4 The chief administrative judge may question the parties and the intervenors with regard to the trial and appeal.

(2) Examination of Evidence

A Examination of evidence

Where the opponent, etc. requests for examination of evidence, and where the panel determines that the examination of evidence is necessary, the examination of evidence shall be conducted.

B Examination of evidence and notice of reasons for revocation

If, as a result of examination of evidence, the panel decides that the registration shall be revoked, the reasons for revocation shall be notified to the holder of trademark right and give the holder of trademark right the opportunity to submit a written opinion.

(3) Inquiry

Where the panel needs to ask for opinions of the holder of trademark right, the opponent, etc., in order to make the decision appropriately, the panel shall make an inquiry.

[Examples of the inquiries]

Example 1 Where it is deemed necessary with respect to the appropriate decision-making on whether there exists any reason for revocation upon proceedings on the opposition to registration, the panel requests the holder of the trademark right for its opinions on the written opposition.

Example 2 Where it is deemed necessary with respect to the appropriate decision-making on whether there exists any reason for revocation over the claims made in a written opinion submitted by the holder of trademark right, the panel gives the opponent an opportunity to state its opinions.

When the opponent is subject to inquiry, and where the panel decides necessary, the panel transmits copies of the written opinion having been submitted by the holder of trademark right and the notice of reasons for revocation.

5. Submission of Written Opinions

(1) Relevant Provisions

The Trademark Act Article 43-12 (Notice of reasons for revocation)

Where the chief administrative judge intends to render a revocation decision, the chief administrative judge shall notify the holder of trademark right and the intervenor of the reasons for revocation of registration of trademark and give the said parties an opportunity to submit a written opinion, designating a reasonable time limit.

(2) Written Opinions

Where the notice of reasons for revocation is served, the holder of trademark right may submit a written opinion within the designated period.

Under the Trademark Act, correction of the trademark for registration, correction by restricting the designated goods or designated services, etc. is not allowed.

(3) Submission of Duplicates of the Written Opinion

When submitting a written opinion, the holder of trademark right must submit the necessary number of duplicates for transmission to the opponents, as well as a duplicate of the written

opinion for the proceedings (Regulations under the Trademark Act Article 22 (5) →
Regulations under the Patent Act Article 50-4)

6. Proceedings after Submission of a Written Opinion

(1) Where it is determined that, even when taking the written opinion into consideration, the registration should still be revoked, the decision to revoke registration of trademark shall be rendered.

(2) Where, depending on the reasons for revocation, the registration should not be revoked, the decision to maintain registration of trademark shall be rendered.

(Revised Feb. 2015)