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Proceedings of Opposition to Registration of Trademark

1. Consolidation or Separation of Proceedings

(1) Relevant Provisions

The Trademark Act Article 43-10 (Consolidation or separation of oppositions)

Where two or more oppositions to registration are filed in relation to the same trademark right, unless special circumstances exist, the proceedings thereof shall be consolidated.

(2) Proceedings consolidated in accordance with the preceding paragraph may later be divided.

(Explanation)

Consolidation of proceedings

A The system of pre-grant opposition to registration of trademark is that, where multiple oppositions to registration are filed, a decision has to be made for each and every one of such oppositions to registration in principle, causing the following problems: (a) where multiple oppositions to registration are filed, it delays the registration of the trademark, and (b) a reply has to be made for each opposition to registration, placing a heavy burden on the holder of the trademark right.

B Under these circumstances, in order to promptly and effectively conduct the proceedings for the opposition to registration in line with the transition to the post-grant opposition to registration of trademark, where multiple oppositions to registration are filed, proceedings shall be consolidated on these oppositions in principle, and a single decision shall be given for revocation or maintenance of the registration.

(2) Consolidation of Proceedings

A Consolidation of proceedings in principle

Where multiple oppositions to registration are filed for the same registration, since the proceedings should be consolidated for legitimate oppositions, the proceedings for these oppositions shall be consolidated unless there are special circumstances, regardless of

whether the designated goods or designated services for the oppositions, or the reasons for the oppositions or the evidences thereof, are the same or different.

B Special circumstances

"Special circumstances" means cases where it is deemed that the consolidation of proceedings make the proceedings procedures rather complicated, thus making the progress difficult.

An example of such cases is when the written opposition for one of the multiple oppositions to registration is dismissed, and an action is filed against the said decision.

C Effect of consolidation of proceedings

(A) Procedures after the consolidation of proceedings

Where proceedings are consolidated, the subsequent procedures, such as notice of reasons for revocation, submission of a written opinion, and a decision making on an opposition to registration, etc. are taken collectively.

(B) Use of submitted documents, means of proof, etc.

Where proceedings are consolidated, the means of proof, etc. having been presented or submitted in the respective opposition to registration may be used in the proceedings on all the oppositions to registration having been consolidated.

D Procedures for the consolidation of proceedings

(A) Where multiple oppositions to registration are filed, their proceedings shall be consolidated in principle; thus, no notice shall be made to the effect that the proceedings will be consolidated.

(B) Procedures where proceedings are not consolidated

Where multiple oppositions to registration are lawfully filed, and if the proceedings are to be conducted without consolidating a part of the oppositions to registration, notice stating thereof shall be made to the holder of trademark right, the opponent, and the intervenor.

(3) Separation of Proceedings

A Preconditions for separating proceedings

Proceedings may be separated only where the proceedings have already been consolidated.

B Where proceedings are separated

Proceedings are separated where proceedings have been consolidated for multiple oppositions to registration, and it is determined that continuing to do so would complicate the proceedings procedures and make the progress of the procedures difficult.

C Effect of separation of proceedings

Where proceedings are separated, they are conducted and decisions are rendered through separate procedures. Materials including documents having been submitted before the separation of proceedings, etc. shall have common effect over both procedures.

D Procedures for separation of proceedings

Where proceedings are to be separated, notice stating thereof shall be made to the holder of trademark right, the opponent, and the intervenor.

2. Documentary Proceedings and Oral Proceedings

(1) Relevant Provisions

The Trademark Act Article 43-6 (1) (Proceedings, etc.)

The proceedings of the opposition to registration shall be conducted by documentary proceedings; provided, however, that upon motion filed by the holder of trademark right, the opponent, an intervenor, or ex officio, the chief administrative judge may decide to conduct oral proceedings.

The Trademark Act Article 43-6 (2) and Article 56 (1) → the Patent Act Article 145 (3)
(Procedure of proceedings)

3 Where a trial is conducted by oral proceedings under paragraph (1) or the proviso to the preceding paragraph, the chief administrative judge shall designate the date and place thereof and summon the parties and the intervenor on the designated date.

(2) Documentary Proceedings in Principle

The opposition to registration system is based on the notice of reasons for revocation by the Patent Office and the submission of a written opinion, etc. in response to the notice; thus, it is prescribed in the Trademark Act that the documentary proceedings shall be conducted in

principle, and in cases of exception, oral proceedings shall be conducted (the Trademark Act Article 43-6 (1)). Where the chief administrative judge decides to conduct the oral proceedings, upon motion filed by the holder of trademark right, the opponent, an intervenor, or ex officio, notice stating thereof shall be made to the holder of trademark right, the opponent, and the intervenor.

(the Trademark Act Article 43-6 (2) and Article 56 (1) → the Patent Act Article 145 (3))

(Revised Feb. 2015)