

## 66-06 T

### Decision on Opposition to Registration of Trademark

#### 1. Relevant Provisions

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

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

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

(Note) Grounds of the opposition to registration

The Trademark Act Article 43-13 (Formal requirements of decision)

The decision on an opposition to registration shall be rendered in writing stating the following matters:

- (i) the case number of the opposition to registration;
- (ii) the name and the domicile or residence of the holder of trademark right, the opponent, the intervenor, and their representative(s);
- (iii) an indication of the trademark registration on which the decision was rendered;
- (iv) the conclusions of and reasons for the decision; and
- (v) the date of the decision.

(2) Where a decision has been rendered, the Commissioner of the Patent Office shall serve a certified copy of the decision to the holder of trademark right, the opponent, the intervenor, and persons whose request for intervention in the proceedings on the opposition to registration has been refused.

## **2. Types of Decisions on Oppositions to Registration**

Decisions on oppositions to registration include the following:

- (1) Dismissal of an unlawful (written) opposition by a "decision on an opposition to registration" (the Trademark Act Article 43-15 → the Trademark Act Article 56 (1) → the Patent Act Article 133-2 and Article 135) (→66-03 2. Deficiencies in the Procedures for the (Written) Opposition to Registration and Opposition to Registration Case); and
- (2) "Decision on an opposition to registration" after the proceedings have been conducted (the Trademark Act Article 43-3 (2), (4)).

(Reference)

The "decision on an opposition to registration" which dismisses a written opposition is based on the Patent Act Article 133 which is applied mutatis mutandis in the Trademark Act Article 43-15 and the Trademark Act Article 56 (1), and the decision dismissing a procedure of an opposition to registration other than a written opposition is based on the Patent Act Article 133-2 which is applied mutatis mutandis in the Trademark Act Article 43-15 and Article 56 (1) (→66-03 2. Deficiencies in the Procedures for the (Written) Opposition to Registration and Opposition to Registration Case).

## **3. Procedures for a Decision on an Opposition to Registration**

### **(1) Where Multiple Oppositions to Registration Are Filed**

A Where multiple oppositions to registration are filed, the decision of whether to revoke the registration or to maintain the registration shall be stated in a single written decision in principle since the proceedings are consolidated.

Furthermore, where an opposition to registration is filed against the designated goods or designated services which cover multiple classes of goods and services, the content of the decision of whether to revoke the registration or to maintain the registration for the designated goods or designated services of these classes respectively shall be stated in a single written decision.

B Where it is acknowledged that there are reasons for revocation only with respect to a part of the designated goods or designated services for which the opposition to registration is filed, a decision to revoke the registration shall be made for those designated goods or designated services, and a decision to maintain the registration shall be stated in a single written decision of the other designated goods or designated services.

**(2) Where There Is an Unlawful Opposition Among Multiple Oppositions to Registration**

Where there is an unlawful opposition among multiple oppositions to registration, the said opposition to registration shall be dismissed at the time when it is determined as being unlawful, separately from a decision on the lawful oppositions to registration.

In this case, the unlawful opposition to registration shall not be subject to the consolidation of proceedings.

**(3) Service of a Transcript of a Decision on an Opposition to Registration**

Where a decision has been rendered, a certified copy of the decision shall be served to the holder of trademark right, the opponent, the intervenor, and persons whose request for intervention in the proceedings on the opposition to registration has been refused.

A notice of conclusion of proceedings shall not be issued.

**4. Items to be Stated on a Written Decision of an Opposition to Registration**

The decision on an opposition to registration shall state the case number of the opposition to registration, the name, etc. of the holder of trademark right, the opponent, the intervenor, and their representative(s), an indication of the trademark registration, the conclusions of and the reasons for the decision, and the date of the decision.

**5. Final and Binding Decision on an Opposition to Registration**

The decision on an opposition to registration shall become final and binding as of the lapse of the time limit for filing an appeal in the case of a decision to revoke the registration, and as of the time when a certified copy of the decision is served in the case of a decision to maintain the registration.

## 6. Effect of the Decision on an Opposition to Registration

Where the decision to revoke becomes final and binding, the relevant trademark right shall be deemed never to have existed (the Trademark Act Article 43-3 (3)).

Where a decision to revoke a part of the designated goods or designated services among the designated goods or designated services for which the trademark is registered becomes final and binding, the relevant trademark right only for the designated goods or designated services shall be deemed never to have existed.

## 7. Filing of an Appeal against a Decision

### (1) Relevant Provisions

The Trademark Act Article 43-3 (5) (Decision)

(5) The decision under the preceding paragraph (Note) shall not be subject to appeal.

(Note) Decision to maintain registration

The Trademark Act Article 43-15 (2) (Mutatis mutandis application of provisions concerning trial)

(2) the Trademark Act Article 43-3(5) shall apply mutatis mutandis to a decision under the Patent Act Article 135 of (Note) as applied mutatis mutandis under the preceding paragraph.

(Note) A decision on unlawful opposition to registration

The Trademark Act Article 63 (Actions against trial/appeal decisions, etc.)

The Tokyo High Court shall have exclusive jurisdiction over any action against a decision to revoke or a trial/appeal decision, ... and an action against a decision to dismiss a written opposition or a written request for trial/appeal or retrial.

The Trademark Act Article 63 (2) → the Patent Act Article 178 (2) -(6) (Actions against trial decisions, etc.)

(2) An action under paragraph (1) may be instituted only by a party in the case, an intervenor, or a person whose application for intervention in the proceedings, in the trial or in the retrial has been refused.

(3) An action under paragraph (1) may not be instituted after the expiration of thirty days from the date on which a certified copy of the trial decision or the decision has been served.

(4) The time limit as provided in the preceding paragraph shall be invariable.

(5) The chief administrative judge may ex officio designate an additional period extending the invariable time limit under the preceding paragraph for a person in a remote area or an area with transportation difficulty.

(6) An action with regard to a matter for which a request for a trial may be made may be instituted only against a trial decision.

## **(2) Decisions against Which Actions May Be Instituted**

A A decision to revoke registration

The holder of trademark right may institute an action against a decision to revoke registration to the Tokyo High Court.

B A decision dismissing a written opposition

The opponent to the registration may institute an action against a decision dismissing a written opposition to the Tokyo High Court (the Trademark Act Article 43-15 (1) → the Trademark Act Article 56 (1) → the Patent Act Article 133 (3)).

No appeal shall be available under the Administrative Appeal Law against the decision or the decision of above A and B (the Trademark Act Article 77 → the Patent Act Article 195-4).

C A decision dismissing a procedure for a case of opposition to registration other than the written opposition

Any person receiving the decision dismissing a procedure for an opposition to registration other than the written opposition (the Trademark Act Article 43-15 (1)→ the Trademark Act Article 56 (1) → the Patent Act Article 133-2 (1)) may enter an appeal under the Administrative Appeal Law (the Trademark Act Article 63-2 → the Patent Act Article 184-2).

## **(3) Decisions against Which Actions May Not Be Instituted**

A A decision to maintain the registration (the Trademark Act Article 43-3 (4))

B A decision dismissing an opposition to registration (the Trademark Act Article 43-15 (1) → the Trademark Act Article 56 (1) → the Patent Act Article 135)

No appeal shall be available under the Administrative Appeal Law against the decisions of above A and B (the Trademark Act Article 43-3 (5), Article 43-15 (2), and Article 77 (7) → the Patent Act Article 195-4).

**(4) Time Limit for Institution of Action**

The actions of the above (2) A and B may be entered within thirty days (an additional time limit of ninety days for overseas residents) from the date on which a certified copy of the decision has been served (the Trademark Act Article 63 (2) → the Patent Act Article 178 (3)).

**(5) Defendant**

In an action against a decision, the Commissioner of the Patent Office shall be defendant (the Trademark Act Article 63 (2) → the Patent Act Article 179).

## **8. Final and Binding Registration**

Where a decision on an opposition to registration has become final and binding, the decision shall be registered (the Trademark Registration Order Article 1 (1)).

## **9. Publication In the Trademark Bulletin**

A decision on an opposition to registration having become final and binding shall be published in the trademark bulletin (the Trademark Act Article 75 (2) (vi)x).

A decision on an opposition to registration having become final and binding shall be published in the Official Gazette of the JPO Published Appeal and Trial Decisions.

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