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Relationship between the Opposition to Registration of Trademark and Trials and Appeals

1. Opposition to Registration and Trial for Invalidation

(1) Proceedings in the Case Where a Trial for Invalidation and an Opposition to Registration Are Co-pending

A Where a trial for invalidation and an opposition to registration are co-pending for the same registration (where the designated goods or designated services are the same in whole or in part), the proceedings for the opposition to registration have priority over those for the trial for invalidation in principle.

B Where, with respect to proceedings for the opposition to registration, the procedures for a trial for invalidation have already progressed, and it is possible to render a decision on the trial for invalidation at an early stage; or there is a dispute concerning the said registration of trademark between the holder of a trademark right and the demandant, and the expeditious processing of the trial for invalidation is requested, etc.; the proceedings for the trial for invalidation shall have priority over those for the opposition to registration if the panel finds that it is appropriate to do so.

(Explanation)

(A) Since the procedures involved in the opposition to registration and in the trial for invalidation are different, the proceedings may not be consolidated.

(B) Where an opposition to registration and a trial for invalidation for the same registration are co-pending, one way to consider the situation is to conduct the proceedings concurrently; however, if the proceedings for both are conducted concurrently,

a it becomes necessary for the holder of a trademark right to handle both procedures at the same time,

b if the trademark right is invalidated (revoked) in the course of the procedures for either of the invalidation trial and the opposition, there would be no need to conduct the proceedings for the other; thus, conducting the proceedings for both the invalidation trial

and the opposition concurrently causes an unnecessary burden on the Patent Office and the holder of a trademark right,

c where both procedures are taken based on the same reasons and same evidence, it is appropriate that one of the proceedings have priority over another, since it is not desirable to cause discrepancy in the results of the two proceedings.

(C) If the opposition to registration of trademark system and the trial for invalidation system are compared,

a in the opposition to registration of trademark system, where, even if an opposition is filed against a registration, it is determined that there is no reason for revocation of the registration, the decision to maintain the registration is immediately rendered,

b whereas, in the trial for invalidation, the number of cases in which written refutation is submitted, as well as those in which re-written answers are submitted because presentation of reasons and evidence is allowed is large; in the opposition to registration, the number of such cases is expected to be relatively smaller,

c since an objection may not be made against the decision to maintain a registration, it is considered that, in general, decisions on oppositions to registration are made final and binding more quickly than the trial decisions on trials for invalidation.

(D) On the other hand, from the perspective of timing, where it takes a considerable time to complete the formality check for an opposition to registration, etc., it is possible that a trial for invalidation may be concluded at an early stage upon launching the proceedings for an opposition to registration. In such cases, where the panel determines that it is appropriate to do so, proceedings for a trial for invalidation have priority over those for the opposition to registration.

(E) Furthermore, where the holder of a trademark right requests expeditious processing of a trial for invalidation due to the existence of a dispute pertaining to the said registration of trademark, etc., it may be appropriate in some cases that proceedings for a trial for invalidation have priority over those for an opposition to registration.

(F) Accordingly, where both procedures are co-pending, the proceedings for the opposition to registration have priority over those for the trial for invalidation in principle. Where the procedures for a trial for invalidation have already progressed and it is possible to render a

decision on the trial for invalidation at an early stage, etc., and where the panel finds that it is appropriate to do so, the proceedings for the trial for invalidation shall have priority over those for the opposition to registration.

(2) Specifics of Handling the Situation

A Where a trial for invalidation may be concluded at an early stage

Where, upon conducting for the opposition to registration, the trial for invalidation may be concluded at an early stage, the trial decision on the trial for invalidation shall be rendered first. In such case, in principle, proceedings for the opposition to registration shall be conducted,

(A) after the trial decision to invalidate the registration becomes final and binding, or,

(B) before the trial decision to maintain the registration (to not approve the request for trial) becomes final and binding.

B Where priority processing for the trial for invalidation is requested

Where the holder of a trademark right claims that the proceedings for a trial for invalidation should be conducted first due to the existence of a dispute pertaining to the said registration of trademark, and where the panel finds that it is appropriate to do so, the proceedings for the trial for invalidation shall have priority over those for the opposition to registration.

C In cases other than the above A and B, in principle, the procedures for the trial for invalidation shall be suspended, and the proceedings for the opposition to registration shall have priority over those for the trial for invalidation. After the decision on the opposition to registration becomes final and binding, the proceedings for the trial for invalidation shall be continued.

(3) Suspension of Procedures (→26-01 6.)

(Relevant provisions)

the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 168 (1) (In relation to litigation)

Where deemed necessary during a trial, the trial proceedings may be suspended until the decision on the opposition to grant of patent, or another trial decision, has become final and binding, or until court proceedings have been concluded.

A Where either of the proceedings, those for trial for invalidation or those for the opposition to registration, has priority over another, the procedures of the said another trial shall be suspended as needed (the Trademark Act Article 43-15 and Article 56 (1) → the Patent Act Article 168).

Whether or not the trial needs to be suspended is at the discretion of the administrative judge (Tokyo High Court Decision on May 28, 1948 (1947 (O) 11).

The decision rendered is not intended to approve the right to request suspension (Prewar Supreme Court Decision on November 28, 1938) (1938 (O) 1270)).

B In the event of suspending the procedures, a written notice of suspension shall be sent to the holder of a trademark right, the opponent, and the intervenor.

In the event of cancelling the suspension of the procedures, a written notice of cancellation of suspension shall be sent to the holder of a trademark right, the opponent, and the intervenor.

C If the opinions of the holder of a trademark right, the opponent, and the intervenor concerning the decision of suspension are submitted in a written statement, etc. in response to the written notice of suspension, the opinions shall be taken into account.

2. Opposition to Registration and Trial for Rescission

(1) Where the Opposition to Registration and the Trial for Rescission Are Co-pending

Even in the case where an opposition to registration is pending, a request for a trial for rescission of misuse of registered trademark (the Trademark Act Article 51, the Trademark Act Article 53) and a request for a trial for rescission based on confusion of the registered trademark arising from division or transfer of a similar trademark (the Trademark Act Article 52-2) may be filed by the holder of a trademark right, exclusive right to use, or non-exclusive right to use. A request for a trial for rescission of registration may be filed by an agent or representative (the Trademark Act Article 53-2).

A request for trial for rescission of registered trademark not in use (the Trademark Act Article 50) may not be filed until three years have passed from the registration of the establishment of the trademark right.

(2) Proceedings When an Opposition to Registration and a Trial for Rescission Are Co-pending

Where an opposition to registration and a trial for rescission are co-pending for the same registration, the proceedings for the opposition to registration shall have priority over those for the trial for rescission in principle, taking into account a difference in the timing of the extinguishment of the trademark right between the decision revoke registration of a trademark, in the opposition to registration, to become final and binding, and the trial decision to revoke, in the above trial for rescission, to become final and binding (a final and binding decision to revoke registration of a trademark in an opposition to registration: the Trademark Act Article 43-3 (3), a final and binding trial decision to rescind in a trial for rescission: the Trademark Act Article 54).

A In such case, the procedures for the trial for rescission are suspended, and once the proceedings for the opposition to registration is completed and the decision on the opposition to registration becomes final and binding, the suspension of the procedures for the trial for rescission is cancelled, and reopened.

B Where a decision on the opposition to registration is rendered
Proceedings for the trial for rescission is conducted,

(A) after the decision to revoke the registration of a trademark becomes final and binding, or

(B) immediately after the decision to maintain the registration of a trademark is rendered.

(Revised Feb. 2015)