

66-00 T

Opposition to Registration of Trademark

1. Purport of the System

With the revision of the Trademark Act in 1996, the pre-grant opposition system to registration of trademark was abolished so that prompt grant of right will be facilitated in application for registration of trademark. Then a post-grant opposition system to registration of trademark was introduced to achieve the purposes of public interests of increasing the public's confidence in the registration by giving extensive opportunities to a third party to request for revocation of the registration of trademark for a certain period after the registration of establishment of the trademark right, so that in the event of opposition to registration, the JPO examines whether or not its decision of registration was appropriate, and remedies any defects that may be discovered. In addition, since the main purpose of the opposition to registration system is not to solve specific disputes between parties, the filing of an opposition is not limited to specifically-interested persons, but is allowed extensively to any person.

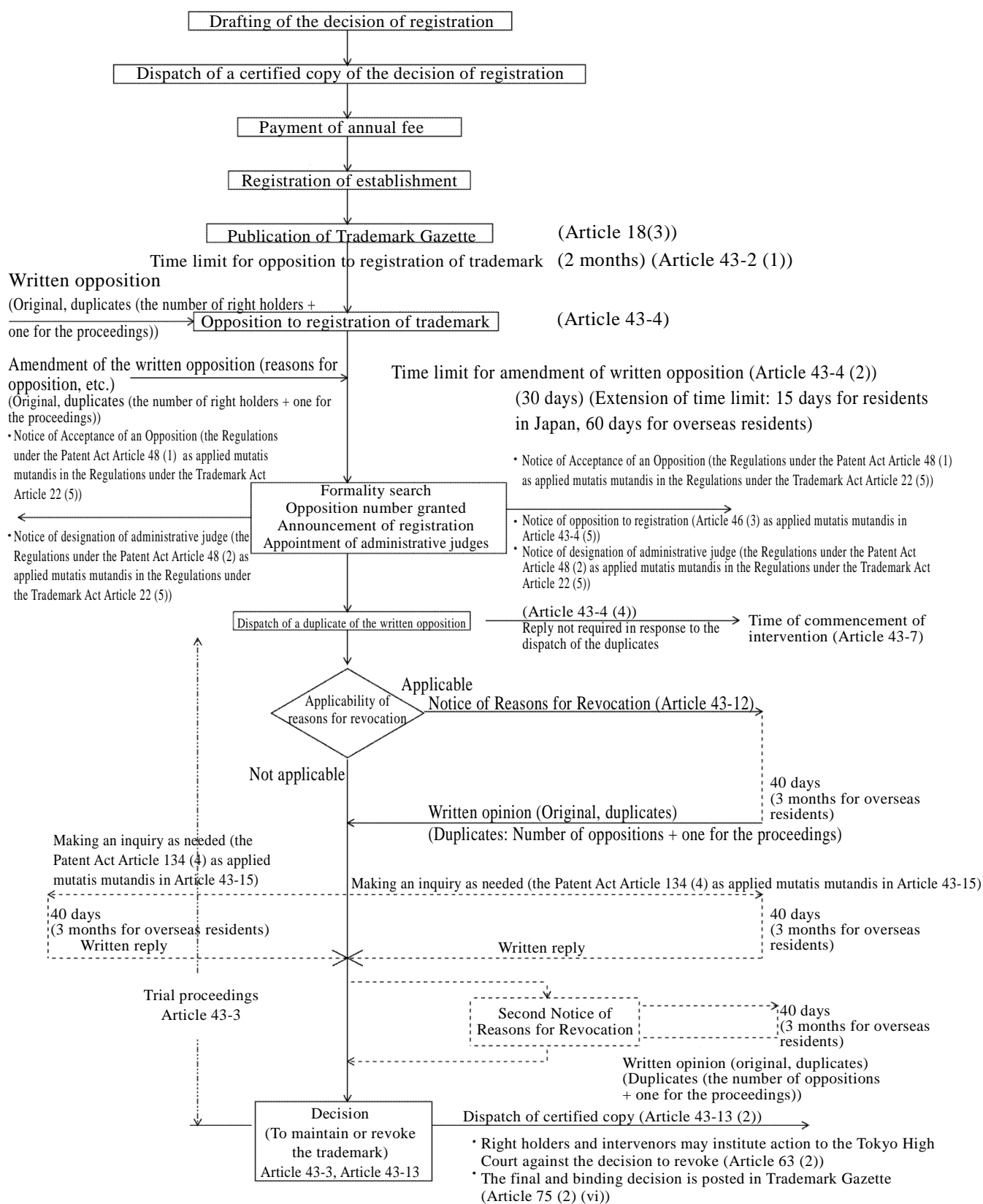
2. Outline of the system

In the opposition to registration system, any person may request for revocation of registration of trademark within two months from the date of publication of the gazette containing the trademark (the Trademark Gazette which is published after the registration), on the grounds that registration of the trademark falls under any of the items of the Trademark Act Article 43-2, and an opposition to registration may be filed for each of designated goods or designated services.

(The Trademark Act Article 43-2 to Article 43-15)

(Revised Feb. 2015)

Flow Chart: Outline of Opposition to Registration of Trademark System after Enactment of Revision of the Trademark Act in 1996 (April 1, 1997)



66-01 T

Procedures for Opposition to Registration of Trademark

1. Relevant Provisions

The Trademark Act Article 43-2 (Opposition to registration of trademark)

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:

- (i) where registration of trademark has been made in violation of the Trademark Act Article 3, 4(1), 7-2(1), 8(1), 8(2), 8(5), or 51(2) (including its mutatis mutandis application under the Trademark Act Article 52-2(2)), 53(2) or the Patent Act Article 25 as applied mutatis mutandis under the Trademark Act Article 77(3);
- (ii) where registration of trademark has been made in violation of a treaty;
- (iii) where registration of trademark has been made for an application for registration of trademark which does not satisfy the requirements prescribed in the Trademark Act Article 5 (5).

2. Opposition to Registration

(1) Any person may file an opposition to registration on the grounds that the registration of trademark falls under any of the items of the Trademark Act Article 43-2;

Provided, however, that after the extinguishment of the trademark right (including the abandonment of trademark right), it is understood that an opposition to registration may not be filed.

(2) An opposition to registration of trademark 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.

While some of the registrations concerning applications filed on and after April 1, 1997 may cover multiple classes of designated goods or designated services, an opposition to registration may be filed for each of designated goods or designated services irrespective of the class even where the registration covers multiple classes.

3. Reasons for Opposition to Registration

Reasons for opposition to registration are limited to those prescribed in the Trademark Act Article 43-2 (including its mutatis mutandis application under Article 68 (4)), and no opposition to registration may be filed based on any other reasons.

(1) Reasons for Opposition as Prescribed in the Trademark Act Article 43-2 Are As Follows.

A Relevance to item (i)

Violation of requirements for registration of trademark (the Trademark Act Article 3)

Violation based on reasons for non-registrability (the Trademark Act Article 4 (1))

Requirements for registration of a regional collective trademark (the Trademark Act Article 7-2)

Violation of a prior application (the Trademark Act Article 8 (1), (2), and (5))

Prohibition of re-registration in the event of rescission of registration of trademark (the Trademark Act Article 51 (2) [including its mutatis mutandis application under the Trademark Act Article 52-2 (2)] and Article 53 (2))

Violation of enjoyment of rights by foreign nationals (the Trademark Act Article 77 (3) → the Patent Act Article 25)

B Relevance to item (ii) violation of a treaty

C Relevance to defensive mark registration (the Trademark Act Article 68 (4))

Violation of requirements for defensive mark registration (the Trademark Act Article 64)

Violation of enjoyment of rights by foreign nationals (the Trademark Act Article 77 (3) → the Patent Act Article 25)

(2) Relevance to Reasons for Refusal

In relation to the reasons for refusal as prescribed in the Trademark Act Article 15, cases where the trademark fails to satisfy the requirements prescribed in the Trademark Act Article 6 (Single

trademark on each application) including the cases where the designated goods or designated services, under which the trademark is registered, do not belong to the appropriate classes of goods and services, etc., do not constitute reasons for opposition to registration.

(3) Relevance to Reasons for Invalidation

In relation to the reasons for invalidation as prescribed in the Trademark Act Article 46 (1), the case of a usurped application (the Trademark Act Article 46 (1) (iii)), the case where, after registration of trademark, enjoyment of rights by foreign nationals is no longer possible, the case of violation of a treaty (the Trademark Act Article 46 (1) (iv)), and the case of falling under reasons for non-registrability related to public interests (the Trademark Act Article 46 (1) (v)), do not constitute reasons for opposition to registration.

(4) Relevance to a Trial for Rescission As Prescribed in the Trademark Act Article 53-2

While the reasons for opposition to registration include violation of a treaty, an opposition to registration may not be filed based on the reason that the agent or representative of a person who is the proprietor of a trademark in one of the countries of the Union to the Paris Convention, etc. filed an application for registration of, and was granted the right for, the trademark concerned under its own name without such proprietor's authorization (the Paris Convention Article 6-7 (1), the WTO/TRIPS Agreement Article 2 (1), the Trademark Law Treaty Article 15). In such a case, only the trial for rescission as prescribed in the Trademark Act Article 53-2 will be requested.

(Explanation)

Under the Trademark Act, implementation of the Paris Convention Article 6-septies after the registration of establishment of a trademark right is applicable only in a trial for rescission (the Trademark Act Article 53-2) (a trial for invalidation under the Trademark Act Article 46 may not be requested).

While the Paris Convention Article 6-septies provides that "the proprietor of the mark shall ... be entitled to oppose the use of his mark," it is understood that the "opposition to registration" as referred to therein means "pre-grant opposition" and does not include "post-grant opposition."

4. Timing During Which an Opposition to Registration May Be Filed

(1) An opposition to registration may be filed within two months from the date of publication of the gazette containing the trademark (the Trademark Act Article 43-2).

(2) An amendment of the written opposition to registration of a trademark shall not change the gist thereof. However, provided that such amendment is made no later than 30 days from the expiration of time limit for filing an opposition to registration, an amendment to change the gist of the opposition with respect to the reasons for opposition to registration and the indication of supporting evidence (Refer to 66-03, 1. (3) "Reasons for Opposition to Registration of Trademark and Indication of Supporting Evidence" shall be allowed. In addition, for a person in a remote area or an area with transportation difficulties, the time limit may be extended further (the Trademark Act Article 43-4 (3)).

<Extension of Time Limit>

- ◆ Overseas resident ...Extension of 60 days
- ◆ A person domiciled or resident in Japan and in a remote area or an area with transportation difficulties (refer to the table below) or a representative thereof ...Extension of 15 days

Tokyo	The Izu Islands, The Ogasawara Islands
Ishikawa Prefecture	Wajima-shi Ama-machi (Hegurajima)
Kagoshima Prefecture	The Nansei Islands
Okinawa Prefecture	Neighboring islands other than Okinawa mainland
Hokkaido	Neighboring islands of Hokkaido

5. Withdrawal of Opposition to Registration

(Relevant provisions)

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

(1) An opposition to registration, once filed, may not be withdrawn after the notice under Article 43-12 (Note 1) is served.

(2) The Patent Act Article 155 (3) as applied mutatis mutandis under Article 56 (2) of this Act (Note 2) shall apply mutatis mutandis to the withdrawal of an opposition to registration.

(Note 1) Notice of reasons for revocation of registration of trademark

(Note 2) Withdrawal of request for trial

(Reference)

The Patent Act Article 155 (3)

(3) When a request for a trial for patent invalidation has been filed with regard to two or more claims covered by a patent that has two or more claims, the request may be withdrawn for any of the claims.

An opposition to registration may be withdrawn until the Patent Office issues a notice of reasons for revocation of registration of trademark (the Trademark Act Article 43-12), and an opposition may be withdrawn 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.

6. Making Application Documents, etc. Available for Public Inspection

(Relevant provisions)

The Trademark Act Article 18 (Registration of establishment of trademark right)

(4) The Commissioner of the Patent Office shall make application documents and their annexed articles available for public inspection at the Patent Office for two months from the date of issuance of the trademark gazette containing matters listed in each item of the preceding paragraph (hereinafter referred to as "gazette containing the trademark") pursuant to the provisions of the preceding paragraph.

Upon registration of establishment of a trademark right, application documents and their annexed articles shall be made available for public inspection at the Patent Office for two months from the date of issuance of the trademark gazette containing matters such as the registration number, the

trademark stated in the application (registered trademark), and the designated goods or designated services, ("gazette containing the trademark") (the Trademark Act Articles 18 (3), (4)).

[Reference] Comparison of Reasons for Opposition to Registration of Trademark, Reasons for Invalidation, and Reasons for Refusal under the Trademark Act

Reasons for opposition	Reasons for invalidation	Reasons for refusal
Requirements for registration of registration the Trademark Act Article 3	Same as left	Same as left
Reasons for unregistrability the Trademark Act Article 4 (1)	Same as left	Same as left
Requirements for registration of regional collective trademarks the Trademark Act Article 7-2 (1)	Same as left	Same as left
Prior application the Trademark Act Article 8 (1), (2), (5)	Prior application the Trademark Act Article 8 (1), (2), (5)	Prior application the Trademark Act Article 8 (2), (5)
Prohibition of re-registration of a trademark whose registration is prohibited the Trademark Act Article 51 (2), Article 52-2 (2), Article 53 (2)	Same as left	Same as left
Enjoyment of rights by foreign nationals the Trademark Act Article 77 (3) → the Patent Act Article 25	Same as left	Same as left
Violation of a treaty Trademark Act Article 43-2 (1) (ii)	Same as left	Same as left
Requirements under Article 5, paragraph 5 Trademark Act Article 43-2 (1) (iii)	Same as left	Same as left
		Single trademark on each application Trademark Act Article 6 (1), (2)
	Registration of a person who is not a patentee Trademark Act Article 46 (1) (iv)	
	Reason occurring after the grant Trademark Act Article 46 (1) (v) - (vii)	

(Revised Oct. 2015)

66-02 T

Holder of Trademark Right, Opponent, Intervenor

1. Holder of Trademark Right

If a trademark right is jointly owned, all of the joint holders are holders of the trademark right.

2. Opponent

In the opposition to registration system, "any person" may file an opposition to registration, and the filing of oppositions to registration is not restricted to interested persons.

In the event of death of the opponent, or extinguishment due to merger, the status of the opponent in relation to the opposition shall not be succeeded.

3. Intervenor

(1) Relevant Provisions

The Trademark Act Article 43-7 (Intervention)

In an examination to render a decision on an opposition to registration, any person who has a right relating to the trademark right or any other person who has an interest in the trademark right may intervene in the examination in order to assist the holder of trademark right until the decision on the opposition to registration is rendered.

The Trademark Act Article 43-7 (2) and Article 56 (1) → the Patent Act Article 148 (Intervention)

(4) The intervenors as prescribed in the intervention for assistance by the interested person under the preceding paragraph may undertake all trial procedures.

(2) Persons Who Can Intervene

A The person must have a right relating to the trademark right or any other person who has an interest in the trademark right.

A person who has a right relating to the trademark right can be, for example, the holder of an exclusive right to use or a non-exclusive right to use.

B The intervention must be to assist the holder of trademark right.

(3) Time of Intervention

Intervention is made for an opposition to registration which is already pending; thus, intervention should be requested for a pending opposition to registration and before the decision is made for the opposition.

4. Effects of Suspension or Termination

(1) Relevant Provisions

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

(3) Where any ground for suspension or termination of procedures is applicable to one of the joint holders of trademark right for an examination and decision on an opposition to registration, the said suspension or termination shall have effect on all such joint holders of trademark right.

The Trademark Act Article 43-7 (2) and Article 56 (1) → the Patent Act Article 148
(Intervention)

(5) Where there is a ground for suspension or termination of trial procedures on behalf of the intervenor under paragraph (1) or (3), the said suspension or termination shall have effect on the original parties.

The Trademark Act Article 43-7 (2) and Article 56 (1) → the Patent Act Article 149
(Intervention)

A person applying to intervene shall submit an application for intervention to the chief administrative judge.

(2) Where an application for intervention is submitted, the chief administrative judge shall serve a copy of the application for intervention to the original parties and intervenor(s) and give such persons an opportunity to present opinions, designating an adequate time limit.

(3) Where an application for intervention is filed, the administrative judge of the trial in which the applicant intends to intervene shall render a decision through a trial.

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

(5) The decision under paragraph (3) shall not be subject to appeal.

(Revised Feb. 2015)

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)

66-04 T

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)

66-05 T

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)

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.

(Revised Feb. 2015)

s

66-07 T

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)