

Decision on opposition

Opposition No. 2015-900229

Tokyo, Japan

Trademark Right Holder DIRECTOR OF FINANCIAL AFFAIRS DIVISION IN
MINISTER'S SECRETARIAT OF CABINET OFFICE
OF JAPAN

Osaka, Japan

Trademark Opponent BEST LICENSE CO. LTD.

Decision on the opposition to the grant of the trademark registration No. 5756402 has resulted in the following decision.

Conclusion

The trademark registration No. 5756402 is maintained.

Reason

No. 1 The Trademark

Trademark registration No. 5756402 (referred to as "the Trademark" below) consists of standard characters of "マイナンバー (MY NUMBER) " written in katakana, and the application for its registration was filed on May 30, 2014. Decision of registration was made on March 5, 2015 with designated goods and services of Class Nos. 9, 16, 25, 35, 36, 38, 41, 42, and 45 which are as specified in the Trademark Registry, and the trademark was registered on April 10, 2015. The gazette containing the trademark was published on May 19, 2015.

No. 2 Gist of the grounds of the opposition to registration

1 The grounds of the opposition

The Trademark is identical or similar to the prior trademark of application No. 2015-6041 (referred to as "cited application" below), and the designated services in Class36 of each are identical or similar. Therefore, the Trademark violates Article 8(1) of the Trademark Act and violates Article 4(1)(xi) of the Trademark Act according to the registration of the cited application. Also, the Trademark falls under Article 43(2)(i) of

the Trademark Act.

Therefore, the registration of the Trademark regarding the above designated service must be cancelled

2 Regarding cited application

The cited application cited by the opponent consists of standard characters of Alphabetic characters of "MY NUMBER" with the attached services of Class 36 as the designated services. The cited application was filed for trademark registration on January 26, 2014 while insisting that the cited application is an application for trademark registration pursuant to the provision of Article 10(1) of the Trademark Act having Trademark Application No. 2014-73104 of which the application for its registration was filed on September 1, 2014 (referred to as "original application 1" below) as the original application.

Also, the original application 1 was applied for trademark registration while insisting that the original application 1 is the application for trademark registration pursuant to the provision of Article 10(1) of the Trademark Act having Trademark Application 2014-20555 whose application for registration was filed on March 18, 2014 (referred to as "original application 2" below) as the original application.

In addition, the designated services of the cited application, and the original applications 1 and 2 are the same as each other and are the services of Class 36 described in the Attachment.

Also, these applications for trademark registrations were finally dismissed. The original application 2 was dismissed on September 24, 2014, and the original application 1 was dismissed on March 11, 2015. The cited application was dismissed on August 6, 2015.

No. 3 Judgment by the body

1 Regarding the validity to apply Article 10(1) and 10(2) of the Trademark Act to the cited application

The opponent filed the cited application for its trademark registration while insisting that the cited application was the application for trademark registration pursuant to the provision of Article 10(1) of the Trademark Act. However, the Article 10(1) of the Trademark Act determines the requirements for division of the application for its trademark registration. In Article 10(1), it is defined that "An applicant for trademark registration may file one or more new applications with regard to part of an application which designates two or more goods or services as its designated goods or designated services, provided that the application for trademark registration is pending

in examination, trial examination, or retrial examination, or that a suit against a trial decision to refuse the application is pending in court". In Article 10(2), it is defined that "In the case of the preceding paragraph, the new application for trademark registration shall be deemed to have been filed at the time of filing of the original application for trademark registration; provided".

The cited application was filed for its trademark registration while insisting that the cited application is the application for trademark registration pursuant to the provision of Article 10(1) of the Trademark Act as another application regarding the original application 1 as insisting that the original application 1 is the application for trademark registration pursuant to the provision of Article 10(1) of the Trademark Act as a new application in accordance with the original application 2 as indicated in the above description in No. 2, 2.

However, the designated services of the original application 1 include all the designated services of the original application 2. The original application 1 does not satisfy the requirement of Article 10(1) of the Trademark Act such as "An applicant for trademark registration may file one or more new applications with regard to part of an application (underlined part is decided by the collegial body)".

Therefore, the original application 1 cannot be assumed to be filed upon the application of the original application 2 which is insisted as the original application for its trademark registration.

Therefore, the designated services of the cited application include all the designated services of the original application 1 and the cited application does not satisfy the requirement of Article 10(1) of the Trademark Act. Therefore, the cited application cannot be assumed to be filed upon the application of the original application 1 which is insisted as the original application for its trademark registration.

2 Regarding the applicability of Article 8(1) and 4(1)(xi) of the Trademark Act

As described in 1, the cited application does not satisfy the requirement of Article 10(1) of the Trademark Act and is not the application in the same Article. Accordingly, Article 10(2) is not applied, and the application date of the cited application is assumed to be January 26, 2015.

Therefore, the cited application was filed after May 30, 2015, which is the application date of the Trademark.

Also, the cited application has already been dismissed as described in No. 2, 2.

Therefore, the registration of the Trademark is not contrary to Article 8(1) of the Trademark Act.

In addition, as described above, the cited application was filed after the

application date of the Trademark and has been already dismissed and is not registered.

Therefore, the registration of the Trademark is not contrary to Article 4(1)(xi) of the Trademark Act.

3. Summary

As described above, the registration of the Trademark is not contrary to Articles 8(1) and 4(1)(xi) of the Trademark Act and does not fall under Article 43-2(i) of the Trademark Act. Therefore, the registration of the Trademark should be maintained in accordance with the provisions of Article 43-3(4) of the Trademark Act.

Therefore, the decision shall be made as described in the conclusion.

Attachment

Acceptance of deposit (including a case of claim issue) and acceptance of fixed deposit; loan of funds and discounting of bills; domestic exchange transaction; guarantee of obligation and acceptance of bills; loan of securities; acquisition and transfer of monetary claim; safe deposit of securities, precious metals, and other articles; exchange; fiduciary service for financial futures transactions; acceptance of money, securities, monetary claim, movable property, trust of land or fixtures or superficies right, or right of lease of land; commission of offering claims; foreign exchange transactions; service regarding letter of credit; issuance of prepaid voucher; acting collection of gas rate or electricity rate; acting collection of commodity price; sales and purchase of securities; contract pertaining to securities index futures trading; securities option transactions; securities futures trading in the foreign market; sales and purchase of securities; contract pertaining to securities index futures trading; intermediary, brokerage or agency service of securities option transactions and securities futures trading in the foreign market; sales and purchase of securities in the securities market; intermediary, brokerage or agency service of entrustment of contract pertaining to securities index futures trading, and securities option transactions; intermediary, brokerage or agency service of entrustment of sales and purchase of securities in the foreign securities market and securities futures trading in the foreign market; securities forward delivery transaction; securities over-the-counter index forward delivery transaction; intermediary, brokerage or agency service of securities over-the counter option transaction or securities over-the-counter index swap transaction or entrustment of these transactions; brokerage for clearing of securities; underwriting of securities; secondary distribution of securities; dealing in public offering or secondary distribution of securities; provision of information on stock companies; fiduciary service of futures transactions in the merchandise market; offering installment payments; intermediary for conclusion of

insurance contracts; underwriting of the insurances; agency for conclusion of damage insurance contracts; assessment of damages regarding damage insurance; underwriting of damage insurance; calculation of insurance premium rate; management of building; intermediary or agency of building lease; lease of building; sales and purchase of building; intermediary or agency of sales and purchase of building; building or land appraisal; management of land; intermediary or agency of land lease; lease of land; sales and purchase of land; intermediary or agency of sales and purchase of land; provision of information on building or land; evaluation of antique; evaluation of work of art; evaluation of jewels; investigation on company's credibility; tax consultation; tax agency; charity donations; payment and settlement operations; exchange transactions; banking; and securities business.

December 28, 2015

Chief administrative judge:	IDE, Eiichiro
Administrative judge:	KANEKO, Naohito
Administrative judge:	ENOMOTO, Masami