

#### 44.01

### **Handling of Cases where Two or More Trademark Applications were Filed on the Same Date Provided in Article 8(2), (4) and (5) of the Trademark Act**

When two or more trademark applications relating to identical or similar trademarks which are to be used on identical or similar goods and/or services have been filed on the same date (hereinafter referred to as “co-pending applications filed on the same date”) as provided for in Article 8(2), (4) and (5) of the Trademark Act (hereinafter referred to as the “Act”), the JPO shall conduct the following administrative procedures:

1. When a trademark application (including international trademark applications; the same applies below) competes with an identical or similar trademark application that is filed by another applicant on the same date, the JPO shall send the applicants a written directive for consultation pursuant to the provision of Article 8(4) of the Act and a notification of reasons for refusal pursuant to Article 8(2) and (5) of the Act at the same time. (As for international trademark applications, the JPO will report to the International Bureau the provisional refusal covering the content of the reasons for refusal and the directive for consultation.)

However, this shall not apply to cases where the applicants of the co-pending applications filed on the same date (including applicants of international trademark applications; the same applies below) have reached agreement through consultation pursuant to the provision of Article 8(2) of the Act and reported to the JPO that one applicant was decided, or have reported that they could not reach an agreement, before the JPO could send the above documents concerning the directive for consultation and the notification of reasons for refusal.

2. (1) The JPO will conduct the procedures for a lottery under the name of the JPO Commissioner (the JPO decides on the date and place for the lottery, and sends a notification of such to the applicants for co-pending applications filed on the same date by two weeks before the date of the lottery) in any of the following cases: when the trademark applicants have submitted, in response to the notification of the reasons for refusal and directive for consultation in 1. above, a document reporting that they have not agreed upon one applicant in the consultation, when the applicants have not submitted a document reporting that they have reached an agreement within the time limit designated by the JPO Commissioner, or when the applicants have submitted a document reporting that they did not reach an agreement before the JPO could send the above documents concerning the notification of the reasons for refusal and the directive for consultation as 1. above.

(2) Matters concerning the lottery mentioned in (1) and the conducting of a public lottery shall be posted in the JPO by two weeks before the date of the lottery.

3. (1) The Director of the Trademark Division shall conduct the lottery. However, when circumstances prevent the Director of the Trademark Division from conducting the lottery, the

Senior Director shall conduct it instead.

(2) Two or more witnesses must be present at the lottery.

(3) The applicants concerned in the lottery can serve as witnesses. However, even if all or a number of the applicants concerned in the lottery are absent, the person in charge of conducting the lottery can designate other persons as witnesses in order to carry out the lottery.

(4) The lottery must be conducted publicly.

4. The lottery is conducted using a lottery machine.

5. When the lottery is over and one applicant has been decided, the person in charge shall create one copy of a record describing the result of the lottery and attach it to the filing document of the chosen trademark applicant. In this case, for other applications, the person shall create copies of the record and attach them to the filing documents of other applications.

6. The above procedures and any other affairs related to the lottery shall be handled by the Trademark Division of the Trademark, Design and Administrative Affairs Department.

Supplementary Provisions:

1. The above provisions shall become effective on March 14, 2000.

2. "Handling of Cases Where Two or More Trademark Applications Were Filed on the Same Date Provided in Article 8(2) to (5) of the Trademark Act" (38 *Tokuso* No.724) shall be abolished.

[Explanation]

(1) Under the previous procedures, when identical or similar trademark applications filed by different applicants on the same date compete with each other, the JPO would first direct the applicants to hold a mutual consultation under the name of the JPO Commissioner, and then render a decision to register a trademark application of one applicant, which has been decided through consultation, as well as notify other applicants of the reasons for refusal pursuant to Article 8(2) of the Act.

However, in the past, when the applicants did not reach an agreement through the consultation, or when the applicants did not report the consultation result within the time limit specified in a written directive for consultation, the JPO would send a notification to conduct a lottery under the name of the JPO Commissioner and would then conduct the lottery. Then, the JPO would render a decision to register a trademark application of one applicant as decided by the lottery, and would notify the other applicants of the reasons for refusal pursuant to Article 8(5) of the Act.

In accordance with Article 2 of the Enforcement Order of the Trademark Act revised in 1999, the notification period for the reasons for refusal is one-year and six-months from the

filing date; therefore, it is difficult, based on the previous procedures, to provide notification of reasons for refusal pursuant to Article 8(2) or (5) of the Act within the period.

Accordingly, the previous procedures have been revised, and when an application competes with a similar application filed by another applicant on the same date, the JPO shall send the following two notifications at the same time:

1) a reason for refusal under Article 8(2) of the Act on the grounds that the applicant is not the one decided in the consultation between the applicants of competing applications (notification for a directive for consultation pursuant to Article 8(4) of the Act shall be made at the same time),

and

2) a reason for refusal stating that the trademark application shall fall under Article 8(5) of the Act and cannot be registered, in the event that the applicant is not the one decided by the lottery conducted under the name of the JPO Commissioner when the applicant has not been the one decided in consultation or when the result of the consultation has not been reported within the period designated in a directive for consultation.

Incidentally, the examiner must clearly describe the reasons for refusal and the conditions of refusal and make statements that leave no room for misunderstanding.

In this case, a notification of reasons for refusal under Article 8(5) of the Act is conditional; however, the conditions of refusal are clearly described on the notification of reasons for refusal, and such notification of reasons for refusal is not considered to cause a disadvantage to the applicant.

(2) When a document stating that the applicants reached an agreement in the consultation is submitted in response to a directive for consultation provided under Article 8(4) of the Trademark Act, the JPO shall render a decision to register the trademark application decided in the consultation. After the registration of the trademark application, the JPO shall render a decision to refuse the applications of the other applicants based on the previously-notified reason for refusal under Article 8(2) of the Act.

In addition, when the applicants have submitted a document reporting that they could not reach an agreement in the consultation, or when the applicants have not submitted a document to report that they have reached an agreement within the designated period, the JPO shall, as usual, go forward with the procedures for a lottery conducted under the name of the JPO Commissioner.

(3) Since the applicable provisions and the notification period for the reasons for refusal are the same for an international trademark application as for a national trademark application, the JPO shall send a notification of reasons for refusal stating that the trademark falls under Article 8(2) and (5) of the Act and a directive for consultation pursuant to Article 8(4) of the Act at the same

time, in the same way as for a national trademark application. (The JPO shall report the provisional refusal containing the reasons for refusal and the directive for consultation.)

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

[Article 8 \(Prior application\)](#)