

## **PART 3. PROCEDURAL ASPECT OF TRADEMARK LAW**

**CHAPTER 10: OVERVIEW**

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## **CHAPTER 10. OVERVIEW**

### **Section 1. Patent Office**

#### **I. Organizations**

##### **1. Patent Office**

The Japanese Patent Office is an affiliated agency of the Ministry of Trade and Industry (current Ministry of Economy, Trade and Industry). Its main responsibility is to handle clerical work related to inventions, utility models, designs, and trademarks (Law concerning Establishment of the Ministry of Trade and Industry, Articles 36 and 37). Its functions consist of rendering decisions and issuing examiner's decisions as to the acceptance of applications for industrial property rights, registration of industrial property rights, conducting appeals and trials with respect to such rights, and supervising patent attorney qualification examinations (Law concerning Establishment of the Ministry of Trade and Industry, Article 38).

The Commissioner of the Patent Office represents and assumes responsibility for the whole organization. Inside the organization, he is in control of the Trademark, Design, and Administrative Affairs Departments where each examiner conducts examination of applications. There is also an Appeals Department where appeal examiners deal with various appeal/trial cases. In this sense, the Patent Office is a quasi-judicial organization.

##### **2. Affiliated Organizations**

Organizations affiliated with the Patent Office are the Industrial Property General Information Institute, the Industrial Property Training Institute, and the Industrial Property Council. The Patent Office is the "special industrial property service" and the Industrial Property General Information Institute is the "central office for communicating to the public information regarding patents, utility models, industrial designs, and trademarks" to be set up under the Convention (Paris Convention, Article 12). The Industrial Property Training Institute is an institute for training the staff of the Patent Office. The Industrial Property Council is an advisory body related to industrial property rights that also gives opinions when an arbitration decision is rendered for establishing a right to work a patent invention under Section 83 (2) of the Patent Law (Order of Industrial Property Council; Patent Law, Section 85 and other provisions).

#### **II. Trials and Trial Examiners**

##### **1. Trial**

###### **(1) Collegial System in Trials**

A trial is a quasi-judicial procedure of importance related to the acquisition and loss of rights. Hearings in a trial must be conducted in a careful and fair manner. A trial is conducted by a collegial body of three or five trial examiners (Section 56 (1); Patent Law, Section 136 (1)). A "trial examiner" is either an individual trial examiner or a

collegial body of examiners, depending on the situation. Should the collegial body not reach an agreement, the body shall make its decisions by a majority vote (Section 56 (1); Patent Law, Section 136 (2)).

#### (2) Qualifications of Trial Examiners

Any person who falls under any one of the following subparagraphs and who has finished the prescribed training course at the Industrial Property Training Institute is qualified as a trial examiner (Section 56 (1); Patent Law, Section 136 (3); Trademark Order, Section 2 (3); Patent Order, Section 13).

- ① a person who has held a position as a trial examiner at the Patent Office for 5 years or more;
- ② a person who has been engaged in handling industrial administration affairs for a total of 10 years or more, and who has been, for any 3 years or more during the aforementioned period, engaged in the examination business at the Patent Office;
- ③ a person who has been engaged in handling industrial administration affairs for a total of 12 years or more, and who is acknowledged to have a level of learning and experience equal to or higher than persons set forth in subparagraph ② above.

### 2. Appointment and Supplementation of Trial Examiners

Trial cases require examiners who have different expertise depending on the content of each case. The Commissioner of the Patent Office shall designate the trial examiners constituting the collegial body for each trial case (Section 56 (1); Patent Law, Section 137 (1)). When any trial examiner designated is unable to participate in the trial due to illness or other reasons of preclusion, the Commissioner of the Patent Office shall relieve him of duty and appoint another trial examiner to take his place (Section 56 (1); Patent Law, Section 137 (2)).

### 3. Trial examiner-in-chief

The Commissioner of the Patent Office shall designate one of the trial examiners as the trial examiner-in-chief (Section 56 (1); Patent Law, Section 138 (1)). The trial examiner-in-chief shall preside over matters relating to the trial (Patent Law, Section 138 (2)), dismiss written demands for trials in cases of non-compliance with the formal requirements (Patent Law, Section 133), give a person demanding a trial an opportunity to submit a written reply (Patent Law, Section 134), and supervise and take command of trial examiners.

### 4. Exclusion of Trial Examiners

A system of exclusion of trial examiners has been established in order to avoid doubts and to ensure fairness in trial examinations. Any trial examiner who has a ground for exclusion shall be precluded from performing his functions. In any of the following cases, trial examiners shall be precluded (Section 56 (1); Patent Law, Section 139):

- (i) where the trial examiner or his spouse or former spouse is or was a party, an intervener, or an opponent in the case;
- (ii) where the trial examiner is or was a relative by blood within the fourth degree, a

relative by affinity within the third degree or a relative cohabiting with a party, an intervener, or an opponent in the case;

(iii) where the trial examiner is a guardian, a supervisor of the guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party, an intervener, or an opponent in the case;

(iv) where the trial examiner has become a witness or an expert witness in the case;

(v) where the trial examiner is or was a representative of a party, an intervener, or an opponent in the case;

(vi) where the trial examiner participated as an examiner in the examiner's decision being challenged in the case;

(vii) where the trial examiner has a direct interest in the case.

Should there be any grounds for exclusion, trial examiners are precluded from performing their duties without question. Either a party or an intervener may present a motion for exclusion (Section 56 (1); Patent Law, Section 140).

## 5. Challenge of Trial Examiner

Where there are circumstances preventing a fair trial on the part of a trial examiner, a party or an intervener may challenge him (Section 56 (1); Patent Law, Section 141 (1)). "Circumstances preventing a fair trial" means circumstances that are objectively considered to prevent a fair trial, such as the trial examiner being a relative by blood or a relative by affinity with a party, an intervener, or an opponent in the case, or having a direct interest in the case.

Upon a motion of a party or an intervener, a challenge may be made and a trial examination will be conducted to examine whether or not there are grounds for the challenge. Challenging is not the same as "exclusion", which is an automatic procedure taken without questioning. After a party or an intervener has made a written or oral statement to a trial examiner with regard to the case, the party or the intervener may not challenge him (Section 56 (1); Patent Law, Section 141 (2)). The exception is where the party or intervener did not know that there was a ground for challenging or where a ground for challenging arose subsequently (Section 56 (1); Patent Law, Proviso of Section 141 (2)).

## 6. Formal Requirements of Exclusion or Challenge Motions

### (1) Formalities

If there is a ground for exclusion, the Commissioner of the Patent Office must relieve the trial examiner of duty. Should the Commissioner not remove him from duty despite a ground for exclusion, a party to the case may present a motion for exclusion. In case of a challenge, however, the Commissioner is not obliged to relieve the trial examiner of duty even if there are grounds for the challenge. The grounds for the challenge are examined in a trial when the party makes such a motion. The person filing a motion is required to submit to the Commissioner a document setting forth the grounds for exclusion.

### (2) Substantiation of Grounds

The grounds for exclusion or challenge shall be substantiated within three days from the date on which the motion was presented (Section 56 (1); Patent Law, Section 142 (2)).

## 7. Ruling on Exclusion or Challenge Motions

When a motion for exclusion or challenge has been made, the ruling thereon is rendered in a trial. A trial for exclusion or challenge is separately held from the trial for the principal case. The Commissioner, therefore, must designate a trial examiner other than those concerned in the motion; the trial examiners concerned may not be involved in the trial for exclusion or challenge. However, the trial examiner concerned in the motion may usually testify as to his opinion (Section 56 (1); Patent Law, Section 143 (1)).

The ruling shall be in writing and shall state the reasons therefor. No appeal shall be made against the ruling (Section 56 (1); Patent Law, Section 143 (2)&(3)). This provision has been made in order to expedite the settlement of the motion and proceed with the principal case.

## 8. Suspension of Trial Proceedings

When a motion for excluding or challenging a trial examiner has been presented, it may not be reasonable for the trial examiner to continue the trial. Therefore, the trial proceedings shall be suspended until a ruling is made. In cases where there are matters requiring urgent attention, such as examination of a witness who is likely to die, the proceedings need not be suspended (Section 56 (1); Patent Law, Section 144).

# III. Substantive Examination and Examiner

## 1. Substantive Examination

The substantive examination system of trademark registration has been adopted in most countries, although the content and extent of examination varies depending on the legal system of each country. Germany, Britain, France and the United States are among the countries that have adopted such a system, although the United States has adopted a different trademark registration system.

"Examination" is an administrative act to decide whether or not an application for registration should be accepted after examining the formality and content of the application.

## 2. Examiners

Examination is the most basic and important process in relation to trademark registration. To be qualified as a trial examiner, a person must meet the requirement of any one of the following subparagraphs and must have finished the prescribed training course at the Industrial Property Training Institute (Section 17; Patent Law, Section 47 (2); Trademark Order, Section 2 (3); Patent Order, Section 12).

① a person who has held a position as an examiner at the Patent Office for 4 years or

more;

② a person who has been handling clerical work such as industrial administration for a total of 6 years or more, and who was, for any 2 years or more during the aforementioned period, engaged in examination business at the Patent Office;

③ a person who has been handling clerical work such as industrial administration for a total of 8 years or more, and who is acknowledged to have a level of learning and experience equal to or higher than the persons set forth in subparagraph ② above.

### 3. Exclusion of Examiners

A system of exclusion of examiners has been established in order to avoid doubts and ensure fairness in examinations. Any examiner who has a ground for exclusion shall be precluded from performing his functions. In any of the following cases, examiners shall be precluded from conducting examination on trademark applications and opposition to trademark registration (Section 17; Patent Law, Sections 48 & 139):

(i) where the examiner or his spouse or former spouse is or was a party, an intervener, or an opponent in the case;

(ii) where the examiner is or was a relative by blood within the fourth degree, a relative by affinity within the third degree or a relative cohabiting with a party, an intervener, or an opponent in the case;

(iii) where the examiner is a guardian, a supervisor of the guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party, an intervener, or an opponent in the case;

(iv) where the examiner has become a witness or an expert witness in the case;

(v) where the examiner is or was a representative of a party, an intervener, or an opponent in the case;

(vi) where the trial examiner has a direct interest in the case.

## IV. Trial Clerk

The trial clerk system was established pursuant to the 1999 amendment of the Law in order to improve the procedures for trial cases and oppositions. For each trial case or opposition case, the Commissioner of the Patent Office shall designate a trial clerk. The provisions of the Patent Law are applied mutatis mutandis to trial clerks (Section 43-5-2 (2); Patent Law, Section 144-2 (3)-(5). Trial clerks are also in charge of preparing records with respect to oral trials (Section 56 (1); Patent Law, Section 144-2, 147 (1) & (2), 150 (4)).

### Section 2. Capacity and Representative

#### I. Capacity of a Party and Capacity to Engage in Proceedings

##### 1. Capacity of associations, etc. which are not legal entities

(a) There are various active associations that are not legal entities. An association or foundation that is not a legal entity may have an officer representing it or an administrator has been designated, in its name:

- (i) make a request for examination;
- (ii) demand a trial for invalidation of trademark registration;
- (iii) demand a retrial against a final and conclusive trial decision for invalidation (Sections 46, 57, 77(2); Patent Law, Section 6 (1)). Partnerships (PS) and Komandit Gesellschaft (KG) are acknowledged, in practice, to have the capacity of parties, subject to registration in their respective countries.

Since trial decisions and rulings were divided as to whether an association or foundation had the capacity to carry on proceedings under the former Trademark Law, the provision has been revised under the current Law as described above. In associations that have no officers or administrators, all members become eligible to have the capacity of parties. The representative of the administrator of the office must be designated pursuant to the articles of incorporation or the articles of association. Section 6 of the Patent Law, however, is not a provision acknowledging the eligibility to enforce a right, but simply acknowledges the capacity to engage in proceedings.

- (b) An association or foundation that is not a legal entity may permit a representing officer a designated administrator may to make it a party, in its name, to a retrial against a final and conclusive trial decision (Section 77 (2); Section 6 (2)).

## 2. Capacity of Minors, etc. to Engage in Proceedings

- (a) Minors (and majors placed under guardianship) may proceed before the Office only through their legal representatives. However, this provision shall not apply where a minor can perform a legal act independently (Section 77(2); Patent Law, Section 7 (1)). Where a person placed under curatorship proceeds before the Office, he shall obtain the consent of his curator ((Section 77(2); Patent Law, Section 7 (2)).

- (b) Where a legal representative proceeds before the Office and there is a supervisor of the guardian, the legal representative shall obtain the consent of the supervisor (Section 77(2); Patent Law, Section 7 (3)). Where a person placed under curatorship or a legal representative takes part in a procedure with regard to opposition to a patent, a trial, or retrial demanded by an adverse party, the consent of the curator or supervisor of the guardian shall not be required (Section 77(2); Patent Law, Section 7 (4)).

### (c) Ratification of Acts of Persons Lacking Capacity

The acts of a minor (other than one who has independent capacity to perform legal acts) or of a major placed under guardianship may be ratified by his legal representative (or the principal when he has gained capacity to proceed before the Office) (Section 77(2); Patent Law, Section 16 (1)). The acts of a person who has no power of attorney may be ratified by the principal when he has capacity to proceed before the Office or by his legal representative (Section 77(2); Patent Law, Section 16 (2)). The acts of a person placed under curatorship carried out without his curator's consent may be ratified by such person with his curator's consent (Section 77(2); Patent Law, Section 16 (3)). The acts of a legal representative carried out without consent of a supervisor of the guardian, where there is such a supervisor, may be ratified by the legal representative when he has obtained the supervisor's consent or by the principal when he has gained capacity to proceed before the Office (Section 77(2); Patent Law, Section 16 (4)).

## **II. Administrator**

### **1. Trademark Administrator for Residents Abroad**

(a) A person who is a resident abroad should obtain a trademark administrator in order to protect himself and third parties as well as to facilitate the smooth progress of procedures taken to the Patent Office, etc. A person who has neither his domicile nor residence (nor, in the case of a legal entity, its place of business) in Japan ("resident abroad") may not, except where prescribed by Cabinet Order, proceed before the Office, or institute a suit against any measure taken by an administrative agency in accordance with this Law or an order or ordinance thereunder, except through his representative with respect to his trademark. The representative must have his domicile or residence in Japan (Section 77(2); Patent Law, Section 8 (1)). The Cabinet Order sets forth a case where a resident abroad (representative of a legal entity), who had a trademark administrator, stayed in Japan (Trademark Order, Section 2; Patent Order, Section 1). The court held that a person who has neither his domicile nor residence in Japan is deemed to reside abroad, even if he is a Japanese national.

With respect to a trademark right or other right relating to a patent of a resident abroad, (i) where there is a trademark administrator, the venue of court (location of the property under Section 5 (iv) of the Code of Civil Procedure) shall be the domicile or residence of such administrator or, (ii) where there is no such administrator, it shall be the location of the Patent Office (Section 77(2); Patent Law, Section 15).

(b) The trademark administrator shall, in addition to the authorities specifically given to him, represent the principal in all procedures and in any suit instituted against measures taken by an administrative agency (Section 77(2); Patent Law, Section 8 (2)). The authorities granted to the trademark administrator include negative acts such as withdrawal of a trademark application or of a demand for a trial. However, the trademark administrator is granted only procedural authority but not substantive authority such as assignment of a trademark right or a right to file applications.

### **2. Scope of Powers of Attorney**

The trademark administrator for a resident abroad has general power of attorney, while other representatives are not authorized to carry out any acts such as withdrawal, abandonment of applications, etc., unless expressly empowered to do so. It was stipulated by the former Law that the power of attorney of a representative other than a trademark administrator must be established by a document (a power of attorney) (Former Trademark Law, Section 77 (2), and former Patent Law, Section 10; these provisions were deleted). Such proof became unnecessary later and the general power of attorney system was introduced.

In Japan, general power of attorney, wherewith a representative can carry out every procedure from application to extinguishment of a trademark right, was not acknowledged. Because of this, power of attorney for trademark applications had to be established for each case.



As described above, the system of comprehensive representation or general power of attorney was not allowed with regard to trademark registration applications. However, the Trademark Law Treaty acknowledges a continual representation of the principal in carrying out all procedures from application up to extinguishment of a trademark right and comprehensive representation in application filing and registration so as to simplify the procedures (Treaty, Section 4). As a result, when Japan ratified the Treaty, the 1996-Revised Law came to acknowledge general powers of attorney.

A representative of a person who is domiciled or a resident (or, in the case of a legal entity, an establishment) in Japan, and who is proceeding before the Office, shall not, unless expressly so empowered, convert, abandon or withdraw a trademark application, withdraw a demand, request, or motion, demand a trial against decision of refusal or a trial against decision to decline amendment, surrender a trademark right, or appoint a sub-representative (Section 77 (2); Patent Law, Section 9).

Where a person proceeding before the Office has two or more representatives, each of them shall represent the principal (Section 77 (2); Patent Law, Section 12). A joint representative may not be appointed. Any action by the Patent Office is regarded as effective, if directed at only one of the representatives or the principal (customarily to a representative).

When an additional representative is appointed without dismissing any existing representative, documents must be sent out to the new representative. However, should there be a request that documents be sent to one of the existing representatives, that rule will not apply (Trademark Examination Guidelines, p. 79-4).

### 3. Extinguishment of Power of Attorney

#### (1) Extinguishment, Etc.

Because a power of attorney is based on trust between the principal and the representative, it should essentially become extinguished upon the principal's death. However, it would serve the protection of the successor or third parties and the stability of the procedures before the Patent Office, if the power of attorney were not extinguished on the principal's death or on the occurrence of other events. Therefore, the power of attorney of a representative of a person proceeding before the Office shall not be extinguished on the death of the principal, or on merger in the case of a legal entity, or on the termination of the duty of trust, where a trustee is the principal, or on the death of a legal representative, or on the modification or extinguishment of his power of attorney (Section 77 (2); Patent Law, Section 11; Formality Examination Manual, p. 40).

#### (2) Replacement, Etc.

The provisions concerning appointment or replacement of a representative, or rejection of procedure have been formulated in order to protect the principal. The Commissioner of the Patent Office or the trial examiner-in-chief may, if he considers a person proceeding before the Office to be incompetent, order a representative to act (Section 77

(2); Patent Law, Section 13 (1)). The Commissioner of the trial examiner-in-chief may, if he considers the representative of a person proceeding before the Office to be incompetent, order him to be replaced (Section 77 (2); Patent Law, Section 13 (2)). In cases of such appointment or replacement, the Commissioner or the trial examiner-in-chief may order that a patent attorney be the representative (Section 77 (2); Patent Law, Section 13 (3)).

The Commissioner or the trial examiner-in-chief may dismiss any action taken before the Office by the person or the representative after the issuance of an order so as to protect the principal (Section 77 (2); Patent Law, Section 13 (4)).

### (3) Mutual Representation of Parties

Where two or more persons are jointly proceeding before the Office, each of them shall carry out procedures such as the conversion, surrender, and withdrawal of an application, the withdrawal of an application for registration of an extension of the term of a patent right, the withdrawal of a demand, request, or motion, a demand for a trial against decision of refusal or a decision to decline amendments which would be against their interests, and shall represent the other or others with respect to any procedure other than such procedures. However, where they have appointed a representative for both or all of them and have notified the Office, the representative shall represent all the parties (Section 77 (2); Patent Law, Section 14). If only some of the parties have representatives, the representatives shall proceed before the Office only in the scope covered by Section 14 of the Patent Law (Formality Examination Manual, p. 42).

## **III. Patent Attorney**

### 1. Duties

#### (1) The Patent Attorney's Responsibilities

A patent attorney represents persons who file applications, oppositions, demands for decisions, demands for trials, demands for certification to the Patent Office with regard to patents, utility models, designs, international applications and international applications for registration, and objections under the Administrative Appeal Law with regard to patents, utility models, designs, and trademarks. A patent attorney also carries out prescribed procedures on behalf of the principal to the Minister of Trade and Industry related to a decision rendered, makes appraisal of these matters, and conducts other activities concerning these matters (Patent Attorney Law, Section 1).

A warning given after the laying open of a patent application for claiming compensation (Patent Law, Section 65 (1)) is interpreted as part of the patent application process. However, a patent attorney is not responsible for the action of a person who has been warned that he may be infringing a trademark.

#### (2) Special Provisions regarding Duties

A patent attorney may act as an assistant in litigation with regard to patents, utility

models, designs, trademarks, international applications, and applications for international registrations (Patent Attorney Law, Section 9). While permission by the court is required for becoming an assistant pursuant to Article 60 of the Code of Civil Procedure, such court permission is not required for becoming an assistant pursuant to Section 9 of the Patent Attorney Law. The only requirement is that the assistant submit a notification. The person signing the notification is the person who will appear in court to make a statement with the party to the litigation or his attorney (lawyer) for the litigation.

A patent attorney may act as an attorney in an action against a trial decision as set forth in Section 63 (1) of the Trademark Law, or in a patent litigation such as an appeal in which no defendant exists (Patent Attorney Law, Section 9-2). The patent attorney may act as an attorney not only for the first instance submitted to the Tokyo High Court, but also for a Jokoku appeal to the Supreme Court. However, he may not act as an attorney for other general litigations, stay of execution (provisional disposition, provisional attachment), or preservation of evidence.

### (3) The Patent Attorney's Mission

Patent attorneys represent persons who file applications, oppositions, demands for trials with the Patent Office, and objections under the Administrative Appeal Law, act as assistants in civil procedure litigations, act as agents for appeals in which no defendants exist, or conduct appraisals and give legal advice. They strive to defend the rights of their clients. They also contribute, as experts on the Trademark Law, to the establishment of well-organized business practices by disseminating information about the trademark system, enhancing studies in this area, preventing unfair competition, and enlightening the public through these activities. They make efforts not to incur the distrust of businesses and consumers in the trademark system by assisting the apparent abuse or illegitimate exercise of trademark rights, or filing illegitimate applications of famous foreign trademarks.

### (4) Prohibited activities

No patent attorney may agree to act on behalf of the principal in a case for which he acted as the agent for the opponent, nor can he act as an agent for a case that he handled when he held office at the court or the Patent Office (Patent Attorney Law, Section 8).

In one case, where a patent attorney, after retirement, instituted, in violation of the provision of Section 8 (2) of the Patent Attorney Law, a litigation for invalidation of the decision of the case for which he acted as a trial examiner while holding office at the Patent Office, his act fell under events that disqualified him as a patent attorney and the litigation was dismissed as illegal (No. 225, Tokyo High Court, Hanyu, p. 225, May 28, 1968, "Manufacturing Method of Packed Konnyaku (food)"). This act of instituting a litigation in violation of Section 8 is deemed to be invalid as long as the opponent makes objections regarding the effectiveness of such an act, just as an act to bring litigation in violation of Section 25 (4) of the Attorneys-at-Law Act is deemed to be invalid in such a case where the validity of such an act is disputed. (Vol. 23, No. 2, Supreme Court, Minshu, p. 328, Feb. 13, 1969, "Manufacturing Method of Packed

Konnyaku (food)"; No. 552, Hanji, p. 37; No. 234, Hanyu, p. 131. The violation of Section 8 occasionally occurs by mistake, since patent attorneys process a great volume of clerical work. See also No. 15, Supreme Court, Sokuho (Prompt Report), p. 305, June 15, 1976; Vol. 3, No. 2, Tokyo High Court, Mutaishu, p. 338, Sep. 29, 1971 and No. 1441, Tokyo High Court, Hanji, p. 133, Sep. 16, 1992.)

However, in another case where a patent attorney, who was representing a party in a demand for a trial for invalidation, was at the same time the representative for the foreign patent application covering the invention that was the subject of the first claim, the court held that the representation of the patent attorney was an action that disqualified him as a patent attorney (No. 550, Tokyo High Court, Hanyu, p.266, Dec. 24, 1984, "Formulation of thorbic acid used as preservative of boiled fish paste products", No. 194, Tokki (Special Number), p. 49).

No patent attorney shall disclose or make improper use of any trade secret. Should he violate this provision, he would be liable to imprisonment with labor not exceeding six months or a fine not exceeding three thousand yen (Patent Attorney Law, Section 22).

## 2. Qualifications

### (1) Qualification Requirements

Any person who falls under all of the following subparagraphs is qualified to act as a patent attorney (Patent Attorney Law, Section 2 (1)):

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- ① A major who is a Japanese national or who has any foreign nationality prescribed by the Minister of Trade and Industry;
- ② A person who is domiciled or a resident in Japan;
- ③ A person who has passed the patent attorney examination.

### (2) Special Provision concerning Qualifications

Any person who falls under any one of the following subparagraphs shall be qualified as a patent attorney without passing the examination referred to in the preceding subparagraph ③ (Patent Attorney Order, Sections 1 to 12; Regulations concerning Patent Attorney Examination (Patent Law, Section 3)):

- ① a person who is qualified as a lawyer;
- ② a person who has held a position at the Patent Office as a trial examiner or an examiner for 7 years or more.

### (3) Disqualification

A person who has been sentenced to imprisonment with labor, or heavier penalties, or who has fallen under any ground for disqualification, such as bankruptcy (Patent Attorney Law, Section 5), is not qualified as a patent attorney.

### (4) Registration

Any person who intends to become a patent lawyer shall file an application for registration as a patent attorney and register himself as such with the Patent Attorney's Association (Patent Attorney, Section 6; Patent Attorney Order, Sections 13 to 22).

#### (5) Prohibition of business practice by an unqualified patent attorney

To act, by profession or for compensation, as a representative for filing applications and take other procedures before the Patent Office regarding patents, utility models, designs, and trademarks, make opposition and take procedures before the Minister of Trade and Industry with regard to a trial decision, or to make appraisals and prepare any document concerning these acts is prohibited for any person, unless qualified as a patent attorney (Patent Attorney Order, Section 38). Any person who has violated this provision shall be punished by imprisonment with labor not exceeding one year or a fine not exceeding ten thousand yen (Patent Attorney Law, Section 22-3, 22-4 (1)).

No person, unless qualified as a patent attorney, shall use the title or name of patent attorney, patent office, or any other similar title or name for the purpose of making profit. Any person who has violated this provision shall be liable to a fine not exceeding ten thousand yen (Patent Attorney Law, Section 22-3, 22-4 (2)).

### 3. Patent Attorney's Association

#### (1) Purpose

The purpose of the Patent Attorneys' Association is, in view of their mission and function, to provide guidance to patent attorneys and conduct clerical work, such as communication among members, in order to maintain the dignity of the profession, and improve and develop the business of patent attorneys (Patent Attorney Law, Section 11).

#### (2) Activities of The Association

The Association of Patent Attorneys is a legal entity that is located at the site of the Patent Office. The Association is operated under the supervision of the Minister of Trade and Industry with patent attorneys as its members. It conducts activities related to the purposes set forth in the preceding paragraph, and provides regulations concerning its activities and fees. It oversees members and, in case of any member's breach of the Patent Attorney Law and Regulations, it takes disciplinary action against such a member (Patent Attorney Law, Section 10 to 20; Patent Attorney Order, Sections 23 to 37). It controls any acts likely to degrade the social reputation of patent attorneys such as supporting abuse of the trademark registration system. There was a case in which a demand by a member for invalidation of a resolution of the board of directors of the Association was not approved on the grounds that the resolution did not have sufficient legal effects to cause litigation (No. 689, Tokyo District Court, Hanji, p. 338, Oct. 6, 1972; No. 289, Hanyu, p. 380). This ruling must have been granted because the court respected the autonomy of the Association and considered that the case should be solved within the Association.

The Association handles clerical work related to patent attorney registration as set forth

in Paragraph (1) above (Patent Attorney Law, Sections 6 to 7-5; Patent Attorney Order, Sections 13 to 22).

### **Section 3. General Rules concerning Procedures**

#### **I. Production of Documents, Etc.**

The Patent Office proceeding are typically conducted ex officio, and appeal or trial examinations are generally conducted by documentary proceedings. The Commissioner of the Patent Office, or the examiner, may require a party to produce documents or other evidence necessary for a procedure other than one relating to an opposition to a patent, a trial, or a retrial (Section 77 (2); Patent Law, Section 194 (1)). Procedures relating to opposition to a patent, a trial, or a retrial are not covered under Section 77 (2) of the Law nor under Section 194(1) of the Patent Law. The examiner requires the production of documents, samples or specimens for examination processing. This is not applicable to a case of opposition to registration. In such a case, trial regulations are applied instead.

##### (1) Application by electronic means

Since January 2000, applications for trademark registration and demands for trial, etc. have been made electronically using computers. Since then, a separate fee has been charged for database preparation with respect to any application by documents.

##### (2) Entrusting investigations

The Commissioner of the Patent Office, or the examiner, may entrust a related administrative organization or an educational establishment or other body with the search necessary for an examination.

#### **II. Time Period/Time Limit and Designated Date/Time**

##### 1. Time Period/Time Limit and Designated Date/time

"Time period/time limit" means a length of time continuing from one point to another point in time, or "a time period specified for conducting an act"; that is, a length of time during which each party or interested party is supposed to carry out a procedure independently. "Designated Date/time" means the date or time designated for a party or an interested party to carry out a procedure in front of the trial examiner.

Time periods or time limits under the Trademark Law are divided into "legal period" and "designated time limit".

(a) "Legal Period": A legal period means a fixed time period prescribed by the Trademark Law or orders pursuant to the Trademark Law, including the period for making an opposition to the granting of a trademark registration, the period for payment of registration fees, the period for demanding a trial, the period for demanding retrial, and the time limit for actions against decisions.

(b) "Designated Time Limit": A designated time limit means the longest time period for response allowed by the Commissioner of the Patent Office, a trial examiner-in-chief, or an examiner through written invitations. It is stipulated as "a designated period of reasonable length" by the law. For instance, the period for submitting amendments, the period for submitting arguments, the period for submitting written replies, and the period for submitting refutations. In practice, each of such time limits is designated on a case-by-case basis (Formality Examination Manual, p. 9).

(c) "Invariable Period": There are the following two types of time periods: a variable "normal period" and an "invariable period". The time limit for submitting amendments is an example of the former and the time limit for instituting an action against (appeal) a decision is an example of the latter (Section 63 (2); Patent Law, Section 178 (4)).

## 2. Computation of Time Periods

### (1) Computation of time periods

The Civil Code (Section 139) stipulates how to compute a time period or a time limit. The Patent Law, Section 3, a special provision concerning computation of time limits, is applied *mutatis mutandis* to the Trademark Law.

① Exclusion of the first day of the period The first day of the period shall not be included unless the period begins from 12.00 a.m.

② Computation according to the calendar Where the period is expressed in months or years, it must be counted according to the calendar. When the period is not computed from the beginning of a month or year, it shall expire on the day preceding the day of the last month or year corresponding to the day on which computation begins. However, where there is no corresponding day in the last month, it shall expire on the last day of that month (Section 77 (1); Patent Law, Section 3 (1)).

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For instance, "thirty days from the day (May 1) on which a trial decision is delivered" means the thirtieth day (May 31) counted from the day following the date of delivery (May 2). The first day of the period shall not be included unless the period begins from 12.00 a.m. If the prescribed period is one month from May 1, the period expires on June 1. If prescribed for one month from May 31, the period expires on June 30 (the last day of the month), since there is no corresponding day (31) in June. The 10-year term of a trademark right established on May 2, 1978 expires on May 2, 1988, the day preceding the tenth anniversary (corresponding day), counted from May 3 (May 2 is not counted), 1978.

Section 77 (1) of the Trademark Law and Section 3 (1) of the Patent Law fall under the "cases otherwise specified" as stipulated in Section 138 of the Civil Code. The provisions concerning computation of time periods/limits in the Civil Code are not applicable to the Trademark Law.

(2) Holidays, etc.

Government agencies are closed and Japanese residents take holidays on Sundays and national holidays (Law concerning National Holidays, Article 2), so that the Patent Office is closed on January 2 and 3, and December 29 to 31. Where the last day of a period prescribed for the filing of a patent application or demand or for any other procedure relating to a patent falls on a Sunday or such a holiday, the last day of the period shall be the first day following such holiday or holidays (Section 77 (1); Patent Law, Section 3 (2)).

This paragraph (2) is applicable only to a time limit designated for accomplishing a procedure, and not to a substantive period such as the term of a trademark right. If the expiration date of the term of a trademark right falls on a Sunday or such a holiday, the term expires.

### 3. Extension of Legal Periods

#### (1) Extension by the Commissioner of the Patent Office

The Patent Office is located in Tokyo. This gives disadvantages to persons residing in remote places, including overseas countries. Most cases are handled, in practice, based on the domicile of the principal, although some are based on the domicile of trademark administrator. The Commissioner of the Patent Office may, for the benefit of a person residing in a place that is remote or difficult to access (islands around Hokkaido, etc. See Formality Examination Manual, p. 10), extend upon request (or ex officio) a period, such as the period for payment of registration fees (Section 41), the period for demanding a trial against an examiner's decision of refusal (Section 44 (1)), the period for demanding a trial against a ruling to decline an amendment (Section 45 (1)), or the period for demanding a retrial (Section 77 (1); Patent Law, Section 4). A time period must be extended before its expiration. No period may be extended after the expiration of the initial period.

#### (2) Nature of extension

The extension of time periods is made at the discretion of the Commissioner of the Patent Office and so that a trial decision to dismiss an appeal for extension of period cannot be opposed (Daishinin, Hanrei, p. 83, Sep. 12, 1939). The court held that a trial decision that dismissed an appeal for extension of period without sufficient examination was considered premature (Vol. 15, No. 5, Tokyo High Court, Gyoshu, p. 797, May 26, 1964).

### 4. Change of Designated Time Period/Limit

Trademark cases involve the general public, and so trial examiners must examine each case sufficiently. The Commissioner of the Patent Office, the trial examiner-in-chief, or the examiner, therefore, may extend the time limit upon request or ex officio (Section 77 (1); Patent Law, Section 5 (1)).

### 5. Change of Designated Date



In cases where a party or an interested person is unable to appear in court due to illness, etc. (see Trial Examination Manual, 33-02, edited by the Patent Office), the trial examiner-in-chief may change the date for oral proceedings or examination of evidence by himself, upon request, or ex officio, so as to ensure sufficient examination (Section 77 (1); Patent Law, Section 5 (2)). The Law stipulates that designated dates may be changed at the discretion of the trial examiner-in-chief; therefore, it is regarded as impossible to appeal an examiner's decision to change the date.

## 6. Missing the Time Limit

Typically when a party misses the legal period for a procedure, he loses his right to take the procedure. However, he does not necessarily lose his right should he miss a designated time limit. The Commissioner of the Patent Office may dismiss the amendment procedure at his discretion when a person whom he has invited to make an amendment fails to do so within the designated time limit. (Section 77 (2); Patent Law, Section 18. See, Hiroteru Yamazaki, "Basics of Application Formalities", p. 127, for the details of time limits.).

### **III. Time When Submission of Application Takes Effect**

#### 1. Mailing Time Principle

The Trademark Law of our country adopts the first-to-file principle (Section 8). If a date or time limit is specified for submission of a document or any other matter to the Patent Office, the procedure may be dismissed once the date or the time limit lapses. However, under this rule, a person residing in a remote place or place from which it is difficult to reach Tokyo, where the Patent Office is located, would suffer considerable disadvantage. Circumstances of the post office might delay the delivery. Therefore, under the Trademark Law, an application or the like that is submitted shall be deemed to have reached the Office at the date when it was handed in to a post office.

#### 2. Details of the Mailing Time Principle

Where a request, document or any other matter to be submitted to the Patent Office in accordance with this Law, or an order or ordinance thereunder, is sent by mail within a specified time limit, the request, document or matter shall be deemed to have reached the Office (i) at the date and time when it was handed over to the post office, if such date and time can be proved by a receipt-of-mail certificate, or (ii) at the date and time on the postmark if they are clearly indicated, or (iii) at 12.00 p.m. on the date indicated on the postmark if only the date is clear (Section 77 (2); Patent Law, Section 19).

### **IV. Transmittal of Documents**

Transmittal of documents is an action of the Commissioner of the Patent Office to notify the parties or interested parties of the content of the documents filed, etc.

Transmittal of documents is different from giving notice in that it follows certain

formalities. Because such transmittal greatly affects the interests of an applicant, it was addressed in the enforcement regulations under the former Law. The current Law, however, provides for the transmittal of documents in the main body of the Law and supplements such provision with enforcement regulations given in the form of a ministerial ordinance (Section 77 (5); Patent Law, Section 189).

The provisions of the Code of Civil Procedure are applied *mutatis mutandis* to the method of transmittal (Section 77 (5); Patent Law, Section 190). The transmittal of documents has a legal effect and therefore may be the basis for a dispute. Therefore, the transmittal must be made by a method by which the fact and time of transmittal can be evidenced.

The following three types of transmittal methods are possible: (i) by personal delivery; (ii) by public notice; and (iii) by post. An ordinance of the Ministry of Economy, Trade and Industry shall prescribe the documents to be transmitted in addition to those provided for in this Law (Section 77 (5); Patent Law, Section 189).

#### (1) Personal delivery

Transmittal by personal delivery is made by mail, or by an official or a trial clerk designated by the Commissioner of the Patent Office. All transmittals shall be made by personal delivery unless made by public announcement or sent by mail.

The provisions concerning the method of transmittal in the Code of Civil Procedure (Code of Civil Procedure, Sections 98 (2), 99 to 103, 105, 106, 107 (1) (excluding Paragraphs (ii) and (iii)), and 107 (3) and 109) shall apply *mutatis mutandis* to the transmittal of documents provided for in this Law or in an ordinance of the Ministry of Economy, Trade and Industry.

#### (2) Transmittal by public notice

Where the domicile or residence of a person to whom transmittal is to be made or any other place to which transmittal is to be made is unknown, or if transmittal in accordance with Section 107 (1) (excluding Paragraphs (ii) and (iii)) of the Code of Civil Procedure is not possible, transmittal may instead be effected by public notice (Section 77 (5); Patent Law, Section 191 (1)).

The transmittal by public notice shall take effect 20 days from the date on which the notice was published in the Official Gazette (Section 77 (5); Patent Law, Section 191 (3)).

#### (3) Transmittal by post

Where a resident abroad has a trademark administrator, the transmittal shall be made to the trademark administrator (Section 77 (5); Patent Law, Section 192 (1)).

Where a resident abroad has no trademark administrator, the documents may be dispatched by registered airmail (Section 77 (5); Patent Law, Section 192 (2)).

Where documents have been sent by post, the transmittal shall be deemed to have been made at the time of dispatch (Section 77 (5); Patent Law, Section 192 (3)).

## **V. Amendment of Proceedings**

### **1. Significance**

Amendment of proceedings means correcting or adding to matters to complete the trademark application procedure. There are formality amendments and substantive amendments. "Formality amendments" are corrections of formalies relating to trademark registration procedures, while "substantive amendments" are corrections of the substance of a trademark registration identifying the subject trademark by the mark and designated goods or designated services; that is, an amendment of the specimen of the trademark (a document indicating the trademark covered by the application) and an amendment of the description of "designated goods or designated services."

### **2. Formality Amendment by Ex Officio**

The Commissioner of the Patent Office may invite amendment, designating a reasonable time limit, in the following cases: (i) when the provisions concerning the capacity of minors or majors under guardianship or a legal representative to proceed before the Office (Patent Law, Section 7 (1) to (3)) or scope of powers of attorney (Section 9) have not been complied with, (ii) when the formal requirements specified in this Law or in an order or ordinance thereunder have not been complied with, or (iii) when the fees due to be paid with respect to the relevant procedure have not been paid (Section 77 (2); Patent Law, Section 17 (3)).

### **3. Amendment Procedure**

In the event of an incomplete document or irregular procedure, the Commissioner may invite amendment (i.e., correction and supplement) of such procedure, designating a reasonable time limit (order of amendment, amendment by ex officio). However, the person who is proceeding before the Office may amend the procedure by himself, whenever he becomes aware of the irregularity (voluntary amendment).

Any amendment, except in the case of payment of fees, shall be submitted in writing (Section 77 (2); Patent Law, Section 17 (4)). This provision has been formulated because, in many cases, the time of submission frequently becomes an issue later. In a case of non-payment of fees, the procedure can be amended by paying the shortage within the designated time limit (Trademark Enforcement Regulations, Section 22; Patent Enforcement Regulations, Section 11).

A decision to dismiss the procedure is rendered unless the shortage of fees is paid within the designated time limit. Such amendment shall be made before the decision of dismissal at the latest. Payment of the shortage after the dismissal decision is not regarded as an effective amendment even if the decision has not become final and conclusive (No. 782, Supreme Court, Hanji, p. 33, July 4, 1975).

#### 4. Restrictions on Amendments

It is most desirable that an application be complete and no supplement or correction be necessary from the beginning; nevertheless, it would be too severe to require such completeness from an applicant. However, to permit correction without any time limit would make the application procedure unstable and cause delays. Such inefficient processing of applications would not be desirable.

(a) Time: Amendments are admitted at any time while a case is pending for appeal, trial or retrial with respect to a demand for examination or opposition (Section 68-2).

(b) Scope of amendment: Any amendment to the designated goods or designated services stated in the request or to the trademark for which registration is sought shall be made in so far as such amendment does not change the “gist” thereof (Section 16-2).

The Trademark Examination Guidelines show examples of changes of gist (Trademark Examination Guidelines, p. 68 & p. 69).

1. The criteria for deciding whether the change is a change of gist or not are as follows:

(1) Designated goods or designated services

(a) Any change or expansion of the scope of the designated goods or services is a change of gist, whether the scope is changed or expanded to cover any dissimilar goods or services or to cover any other similar goods or services;

(b) Limitation of the scope of the designated goods or services, and correction of mistakes or ambiguous statements is not regarded as a change of gist.

(2) Trademarks

(a) Where any characters or symbols such as "JIS", "JAS", "patent", "utility model", or "design", or any characters that indicate the place where the goods were produced or the services were provided are indicated in an appending part of a trademark, deletion of such characters or symbols shall not be regarded as a change of gist.

(b) Any change, addition or deletion of the generic name that is not an appending part, indication of the quality, characters, graphics, symbols or three-dimensional shape shall be regarded as a change of gist.

(Examples of substantive changes of “gist”)

① To delete or change the characters, "Yokan", of the trademark, "Sakura Yokan (pickled cherry blossom-flavored sweetened and jellied bean paste)";

② To add the characters, "Yokan (sweetened and jellied bean paste)" to the trademark, "Sakura (cherry blossom)";

③ To delete or change the characters, "Ginko (Bank)", of the trademark, "Tsubaki (camellia) Ginko";

④ To add the characters, "Ginko (Bank)" to the trademark, "Tsubaki (camellia).

(c) Changing the color of a trademark shall be regarded as a change of gist.

(d) Changing a two-dimensional trademark to a three-dimensional trademark by adding a statement indicating that the trademark is a "three-dimensional trademark" or changing a three-dimensional trademark to a two-dimensional trademark by deleting such a statement shall be regarded, in principle, as a change of the gist.

(e) Adding or deleting, after filing for trademark registration, a statement indicating that the trademark consists of "standard characters" pursuant to the provision of Section 5 (3) shall, as a rule, be regarded to be a change of the gist.

(f) Making a request, after filing for trademark registration, for application of the Proviso of Section 5 (4) as to colors shall be regarded to be a change of the gist.

The amendment of an erroneous indication as to the applicant or an erroneous application by a sole proprietor under a trade name shall be permitted if the request for amendment is submitted together with certain prescribed documents (Formality Examination Manual, p. 85 & p. 104).

## 5. Dismissal of Amendment

(a) Where an amendment to the designated goods or designated services stated in the request or the trademark for which registration is sought would change the gist thereof, the examiner shall decline the amendment by a ruling (Section 16-2 (1)). The ruling to decline an amendment shall be in writing and state the reasons therefor (Section 16-2 (2)).

Where a ruling to decline an amendment has been rendered, the examiner's decision with respect to the trademark application shall not be rendered before the expiration of 30 days from the transmittal of that ruling (Section 16-3 (3)).

Although a person who has received a ruling to decline an amendment may demand a trial thereon (Section 45 (1)), the examiner shall suspend the examination of the trademark application until the trial decision has become final and conclusive (Section 16-2 (4)).

(b) Where an applicant for a trademark registration has filed a new trademark application for the trademark as amended within 30 days from the transmittal of a ruling to decline an amendment, the trademark application shall be deemed to have been filed at the time of submission of that amendment (Section 17-2 (1); Design Law, Section 17-3 (1)). In this case, the original trademark application shall be deemed withdrawn (Section 17-2 (2); Design Law, Section 17-3(2)). If an applicant desires, for the application of this provision (Section 17-2 (1); Design Law, Section 17-3), a statement to the Commissioner of the Patent Office indicating such desire shall be submitted at the same time as the new trademark application (Section 17-2 (1); Design Law, Section 17-3 (3)).

(c) If the applicant has received no invitation to amend after the registration of a trademark, or the trademark has been registered although the invitation to amend has not been complied with, the application for a trademark without amendment shall be regarded to have been registered.

## **VI. Dismissal of Procedure**

### **1. Case Where Procedure is Dismissed**

The Commissioner of the Patent Office may dismiss a procedure at his discretion when a person whom he has invited to make amendment fails to do so within the designated time, that is: (i) when the provisions concerning the capacity of minors or majors under guardianship or a legal representative to proceed before the Office (Patent Law, Section 7 (1) to (3)) or scope of powers of attorney (Section 9) have not been complied with, (ii) when the formal requirements specified in this Law or in an order or ordinance thereunder have not been complied with, or (iii) when the fees due to be paid with respect to the relevant procedure have not been paid (Section 77 (2); Patent Law, Sections 17 (3) & 18).

### **2. Revision concerning Disposition for Refusal of Receipt**

#### **(1) Previous Conditions**

The Trademark Law of Japan adopts the first-to-file system. Whether an application has been filed earlier or later materially concerns the interests of the parties. Therefore, documents related to a procedure for which a legal period is designated shall not be refused without legitimate reasons. Application filings tend to be incomplete in terms of formality. It is reasonable to invite as much amendment as possible, if the flaw is immaterial.

In a case where an application procedure (an examination procedure or a trial procedure) is legally inadequate and the flaw cannot be corrected by an amendment, the filing documents will not be received and will be returned to the applicant. Such disposition for refusal of receipt has existed for some time. The former Trademark Enforcement Regulations (Section 6-2) listed various grounds for refusal. However, the portion corresponding to this Section 6-2 of the Enforcement Regulations was deleted on the occasion of the enactment of the current Trademark Law, and the provision has been added that the Commissioner of the Patent Office may invite amendment in a case when the formal requirements specified in this Law or an ordinance thereunder have not been complied with, and other specified cases (Section 77 (2); former Trademark Law, Section 17 (2)). However, in practical procedures, document filings are refused in certain cases pursuant to internal regulations of the Patent Office (Patent Office Order Regulations, 36 So No. 906 etc.). In addition, in cases where an application procedure has an essential flaw that affects the form of the procedure as an application, the Commissioner of the Patent Office may refuse the receipt of the application, that is, he may dismiss the procedure, without inviting amendment (Vol. 3, No. 1, Tokyo District Court, Mutaishu, p. 11, Jan. 29, 1971; Vol. 18, No. 3, Tokyo District Court, Shogetsu, p.

370, Sep. 29, 1971). However, no document filings shall be refused without appropriate examination except in cases of excessively inadequate documents. If the rejection of filing documents without serious formality deficiencies is made without inviting amendment, the applicant would sustain an unreasonable disadvantage. Furthermore, if an appeal is made to the Commissioner, the procedure for refusal of receipt may take longer than an amendment procedure. (Vol. 2, No. 1, Tokyo District Court, Mutaishu, p. 181, Apr. 22, 1970. In this case, whether the application was for a patent or a utility model was ambiguous. Tokyo District Court, Jan. 29, 1971 as stated above. This case lacked the attachment of a necessary drawing.)

## (2) Trademark Law Treaty and revisions concerning disposal of refusal of receipt

An application or a request may not be refused in whole or in part by the Office without giving the applicant or the requesting party an opportunity to state opinions on the intended refusal within a reasonable time limit (Treaty, Article 14). This stipulation applies to the disposal of refusal of receipt.

The 1996-Revised Law has made it clear that the Law discontinues the "disposal of refusal of receipt" as lacking definite legal ground and treats such disposal as dismissal. It provides that the Commissioner of the Patent Office shall dismiss an irregular procedure that cannot be amended (Section 77 (2); Patent Law, Section 18-2 (1)). With a view to secure the propriety of the procedure and protect the rights of the applicant, the Commissioner shall notify the person who is proceeding of the reasons for dismissal, designating an adequate time limit, and give him an opportunity to submit a statement giving an explanation (Section 77 (2); Patent Law, Section 18-2 (2)). We would like to give attention to the future development of this system.

## **VII. Succession and Continuation of Procedure**

### 1. Succession to Effects of Procedure

The effects of the procedure regarding a trademark right shall extend to a successor in title in order to (i) protect a successor who owns a trademark right or other right relating to a trademark, (ii) to stabilize the trademark registration procedure, (iii) to avoid trouble caused by repeating the same procedure for each occasion of succession, and (iv) to ensure smooth progress of the procedure (Section 77 (2); Patent Law, Section 20).

If a change of applicant notification has been submitted after an invitation of amendment has been made, the effects of such invitation of amendment shall extend to the successor in title. In a case where a trademark right is transferred while the case is pending in the Patent Office, the procedure in question shall be continued. Opposition to the granting of a trademark registration, however, is simply regarded as being offering of information, and therefore the position of the person who has filed such opposition shall not be succeeded (Vol. 35, No. 4, Supreme Court, Minshu, p. 827, Jun. 19, 1981). The situation will be the same after changing to a post-grant system.

### 2. Continuation of Procedure

Where a patent right or other right relating to a patent is transferred while the case is pending in the Patent Office, the Commissioner of the Patent Office or the trial examiner-in-chief may continue the procedure concerned on behalf of the successor in title (Section 77 (2); Patent Law, Section 21).

While succession to the effects of a procedure concerns the effects of a procedure before the transfer of the right, continuation of a procedure concerns the procedure after the transfer of the right ("Chikujo Kaisetsu (Commentary on the Trademark Law)" p. 68). The provision of Section 77 (2) of the Law has been formulated in order to maintain the stability of the proceedings, although it is most desirable that the successor continues the procedure after the transfer of a trademark right or other rights to a trademark. The Commissioner of the Patent Office or the trial examiner may determine, at his discretion, whether the procedure should be continued on behalf of the original owner of the right or his successor in order to ensure the smooth processing of the trademark-related procedures (former "Chikujo Kaisetsu (Commentary on the Trademark Law)" p. 72; Toyosaki p. 93; Miyake p. 77). The original owner of the right is also regarded as remaining qualified, and thereby an attempt has been made to maintain the consistency and stability of the procedure (Vol. 6, Daishinin (former Supreme Court), Minshu, p. 400, May 25, 1927; Vol. 8, Daishinin (former Supreme Court), Minshu, p. 32, Jan. 30, 1929).

However, once the transfer of the right has taken place, it would not be illegal, but rather, undesirable if the procedure were still continued on behalf of the original owner of the right. It would be more reasonable to have the successor continue the procedure (Kaneko/Someno, p. 59). Therefore, in actual situations, the Commissioner of the Patent Office tries, in as many cases as possible, to continue a procedure on behalf of the successor (Haruo Goto, "Annotated Trademark Law", p. 52).

### 3. Suspension of Procedure (interruption or suspension)

#### (1) Suspension of procedure

"Suspension of the procedure" means a situation where a procedure cannot be continued under the law. For instance, should death or other material event occur to a party to a procedure or his representative while the procedure for examination, trial or retrial is pending in the Patent office, it would be reasonable to suspend the procedure so as not to cause disadvantage to the party. The suspension of procedure consists of (a) interruption, and (b) suspension.

(a) Interruption of procedure: "Interruption of procedure" is a system to interrupt the procedure so as to protect the party's procedural benefit, upon occurrence of a certain event, until the party is replaced by his successor due to such an event.

(b) Suspension of procedure: "Suspension of procedure" is a system under which the Commissioner of the Patent Office or a trial examiner, as a legally natural course of events, or upon motion or ex officio, suspends a procedure when the continuation of the procedure faces difficulty due to the occurrence of a natural disaster or any other material event.



If a procedure is interrupted or suspended, the procedure shall be stopped during the time limit designated for the procedure. The procedure shall be resumed after the expiration of the interruption or suspension period and continued for the time limit designated for the procedure. The procedure is stopped only with respect to the time limit designated for the procedure. The progress of the trademark right concerned shall not be stopped.

## (2) Motion for Resumption

If a patent right or other right relating to a patent is transferred while the case is pending in the Patent Office, the Commissioner of the Patent Office or the trial examiner-in-chief may continue the procedure concerned after the transfer (Section 77 (2); Patent Law, Section 21).

A procedure that is interrupted after the rendering of an examiner's decision or a trial decision needs to be resumed.

The Commissioner of the Patent Office or the trial examiner shall, upon a motion for the resumption of a procedure interrupted after the transmittal of a ruling, examiner's decision, or a trial decision, rule as to whether the procedure may be resumed. Such a ruling must be in writing and state the reasons therefor (Section 77 (2); Patent Law, Section 22). Appeals against such a ruling must be made under the Administrative Appeal Law.

## (3) Resumption

If a person who is to resume the procedure for an examination or a trial examination of the opposition and ruling thereon, a trial, or retrial which has been interrupted fails to do so, the Commissioner of the Patent Office or the trial examiner shall, upon motion or ex officio, order such person to resume the procedure and designate an adequate time limit for this purpose. In this case, if the procedure is not resumed within the time limit designated, the resumption may be deemed by the Commissioner of the Patent Office or the trial examiner to have commenced on the date when the time limit expired. When the resumption is deemed to have taken place, the Commissioner of the Patent Office or the trial examiner-in-chief must notify the parties concerned (Section 77 (2); Patent Law, Section 23).

## (4) Application mutatis mutandis of the provisions of the Code of Civil Procedure

The provisions of the Code of Civil Procedure as to interruption or suspension of litigation are often applied to an examination or a trial examination of opposition and to any ruling therefrom, and to trial or retrial procedures. In these cases, the use of the word "court" in said Code shall read "Patent Office", as stated below (Section 77 (2); Patent Law, Section 24).

Interruption is caused by the following events: the disappearance of the party such as death (Code of Civil Procedure, Section 24 (1) (i)), or merger of the legal entity concerned, the party's loss of the capacity to proceed, death of the legal representative

or his loss of power of attorney (the same Code, Section 124 (1) (iii)), termination of the duties of the trustee (the same Code, Section 124 (1) (iv)), death or disqualification of a qualified person such as the trustee in bankruptcy appointed for the party (the same Code, Section 124 (1) (v)), and bankruptcy of the party. Except for the case of bankruptcy, however, the procedure is not interrupted if the party has a legal representative designated for an examination, a trial, or a retrial (the same Code, Section 124 (2)).

The suspension takes place when the Patent Office is unable to perform its duties (legally natural suspension; Code of Civil Procedure, Section 130) or the party is unable to proceed for an indefinite time period (suspended by the decision of the Commissioner of the Patent Office or a trial examiner-in-chief; Code of Civil Procedure, Section 131).

#### (5) Effects of interruption and suspension

It is illegal to continue a procedure while it is suspended. Should a trial decision be rendered while a trial procedure is interrupted due to the death of the party and before the resumption procedure is commenced, the decision would be regarded as illegal and would be reversed in a suit against the decision (No. 232, Tokyo High Court, Hanyu, p. 138, Apr. 25, 1966; No. 237, Tokyo High Court, Hanyu, p. 305, Apr. 26, 1966).

The interruption of a procedure is terminated when the successor to the party resumes the procedure or the Patent Office issues an order to resume the procedure, while the suspension of a procedure is terminated when the reason for the suspension ceases to exist or the decision of suspension is annulled. After the cancellation of such suspension, the designated time period resumes (Code of Civil Procedure, Section 132 (2)).

### **VIII. Request for Certification, Etc.**

Anyone may request the Commissioner of the Patent Office to issue a certificate, a copy, or an abstract of documents, to allow the inspection or copying of documents or to issue documents whose contents are recorded in the part of the Trademark Register prepared by magnetic tapes, where such documents relate to trademark or defensive mark registrations. However this provision shall not apply in the case of documents liable to contravene public order or morality and the like (Section 72; See pp. 207ff. of "Basics of Application formalities" by Hiroteru Yamazaki for practical procedures.)

When the establishment of a trademark right has been registered or the establishment of a right based on a defensive mark has been registered, the Commissioner of the Patent Office shall issue to the owner of the right a certificate of trademark registration or a certificate of defensive mark registration.

The re-issuance of a certificate of trademark registration or a certificate of defensive mark registration shall be prescribed by an ordinance of the Ministry of Economy, Trade and Industry (Section 71-2).