

CHAPTER 12. EXAMINATION

I. The Substantive Examination Principle and Non-Substantive Examination System

1. Substantive Examination Principle

The principle of substantive examination is adopted in the Trademark Laws of many countries, although the extent of examination varies from country to country. It is the appropriate choice when establishing rights such as trademark rights since they affect consumers. This is especially true of for registration, because in cases where the trademarks being registered have not been in use, issues relating to their use have not materialized at the time of registration. To register trademarks without the process of examination, as those advocating "non-substantive examination" would have it, would be wrong.

2. Non-Substantive Examination System

When a trademark is registered without examination, as in a non-substantive examination system, it is difficult to ensure the exercise of stable and secure rights. Trademarks registered under non-substantive examination systems have little authority, and therefore companies may not feel secure in using them. For example, when the first to file claims his right to use the trademark, the effect of the trademark will be contended in court. In lawsuits involving trademark infringement, the non-substantive examination system would create uncertainties in areas such as the validity of the trademark registration. Because the rights given to the owner of the trademark right cannot be sufficiently protected under this system, the substantive examination principle is more appropriate. When laws have been drawn up or amended in other parts of the world, the substantive examination principle has been upheld in most cases.

3. The Situation in Other Countries

Germany's utility model is a well-known example of the non-substantive examination system. (In Japan too, the non-substantive examination system is applied to the law for the registration of utility models.) To find an example of this system for trademarks, we need to go back to the old Trademark Law of France. The French Trademark Law had utilized a trademark depository system and a non-substantive examination system until 1857, when it underwent a series of amendments. The Industrial Property Rights Bureau has been given the task of examining the reasons behind non-registration and the procedural violations of the depository system that led to the 1964 Trademark Law that is in use today. For all new applications for registration, laws incorporating the substantive examination principle have been in effect since December 28, 1991. France should therefore not be viewed as an example of the non-substantive examination system but rather as an example of a country that has made the transition to one practicing the substantive examination principle. It must be noted however that the scope of the examination is narrower than those countries which have traditionally practiced substantive examination; for example examination is not carried out to determine the similarities and differences of the trademark in question in comparison to previously registered trademarks.

Societies that have legislated substantive examination for trademark applications,

including Japan, Germany, the United Kingdom, and the USA, adopt the same substantive examination principle in trademark registration. Naturally, government agencies lack the resources to carry out a full-scale examination of trademark registration and so a combination of public inspection, that is, publication of applications, and opposition to registration is utilized in most countries. Of the countries that hold public inspection of applications, such as Germany, the United Kingdom, and the USA, there are those, the UK and the USA among them, that have kept the pre-grant opposition system. On the other hand, Japan has moved on to the post-grant opposition system whereby trademark rights are granted swiftly and opposition dealt with later. Other countries that have taken this latter route include Germany (1995), Switzerland (1993), and Finland (1996).

II. Examination

1. The Significance of Examination

"Examination" is the administrative procedure for an examiner to deliberate the formality and content of the registration application and decide whether or not to register it.

The examination procedure is of the utmost importance in administering Trademark Law. The qualifications of the examiners are laid down by Cabinet Order (Trademark Enforcement Order, Section 2 (3), Patent Law, Section 12). In order to ensure impartiality and fairness, the examiner will be removed from examination if he is found to be in a position to directly benefit or lose from the outcome, or if he is related to the applicants in question (Section 17 applies *mutatis mutandis* to Patent Law Section 48, 139 (1) to (5) and (7)). He is banned from examining the application for registration of trademarks and opposition to registration (See Chapter 10, Section 1).

The examination can be divided into formality checks and substantive examination. In practice, when the Patent Office receives an application for registration of a trademark, they will check that all the obvious formalities, such as the inclusion of a name, are satisfied, and if anything needs to be corrected, they will send out an invitation to amend.

2. Formality Check

A formality check is initially conducted upon receipt of an application. It is carried out by the examiner to ensure that the formal requirements regarding the application for registration of a trademark have been met. He will examine the items mentioned in Trademark Law 77 (2), which applies *mutatis mutandis* to Patent Law Section 17 (3). For those applications that do not comply with the formal requirements, the Patent Officer will send out an invitation to amend the application within a given period of time, after which, if an amendment is not made, he can dismiss the application (Section 77 (2), Patent Law Section 18).

3. Substantive Examination

Once the examiner decides that the application complies with formal requirements, a substantive examination will take place. Substantive examination is the examination carried out by the examiner on the substance of the application for registration of a trademark. If the examiner finds that the application for registration of a trademark falls into one of the reasons for rejection outlined in Trademark Law Section 15, then he will

reach a decision to reject that application (Section 15).

4. Reasons for Rejection

The reasons for rejection are limited to those found in the list given in Section 15 (1)-(3) of the Law (Section 15 (1) to (3); discussion can be found in "Substantive Trademark Law", Chapter 5.2). There has been criticism against having a list because it limits the possible reasons for rejection. Restricting the reasons for invalidation of registration to those on the list may be beneficial to the stability of the trademark right, but to limit the reasons for rejection of registration applications can create other problems. For example, an application which should have been refused on the grounds of the applicant not having the capacity to exercise the right can be accepted by mistake. If this happens, the application cannot be refused because it is not on the list of reasons for rejection. It will have to go through a trial for invalidation and be invalidated at those proceedings. This situation applies to all reasons other than those listed. Even so, the current legal formalities are necessary to ensure that examination is carried out smoothly and with consistency. The following are the reasons for rejection:

- 1) The trademark being applied for registration cannot be registered if it falls under Section 3 (conditions for registration of trademarks, the existence of characteristics that distinguish it from other products), Section 4 (1) (grounds for non-registrability), Section 8 (2) or (5) (first-to-file system), Section 51 (2), Section 52 (2), Section 53 (2) (prohibition of re-registration for a certain time period after the registration of the trademark has been cancelled), or Section 77 (3), which will be applied *mutatis mutandis* to the Patent Law, Section 25 (eligibility of foreigners to enforce a right).
- 2) The trademark being applied for registration cannot be registered according to the regulations of the Treaty.
- 3) The application for registration of a trademark does not fulfill the requirements outlined in Section 6 (1) or (2) (one application per trademark policy).

For the cases outlined above the examiner must reach a decision of refusal (Section 15). For all cases with reasons other than those listed above, the examiner must not reach a decision of refusal.

The Patent Office has provided "Examination Guidelines" in order to process the great volume of applications (Edited by Trademark Dept., Patent Office: "Trademark Examination Guidelines" [6th Edit., Japan Institute of Invention and Innovation, 1997]. As above: "Examination Guidelines for Similar Goods and Services based on 'Classification of Goods and/or Services'" [8th Edit. Japan Institute of Invention and Innovation, 1996]). They are of great significance and have been quoted in many parts of this book, but despite their influence, it should be remembered that they are not legally binding (Vol. 14, No. 1, Tokyo High Court, Gyoushu, p. 87, Jan. 29, 1963).

5. Submission of Written Arguments

On concluding that the application should be rejected, the examiner should not immediately reach a final decision of refusal, but instead he must communicate to the applicant the reasons for the rejection and allow him the opportunity to submit a written argument for his case by designating a reasonable period of time (Section 15 (2). The "format of the written argument" should follow that of format 49 in the Enforcement Regulations under the Trademark Law Section 22 (5), and the Regulations under Patent Law 32 (1)).

This procedure allows the applicant to defend his application and allows the examiner a

chance to reconsider after reading the written argument. The applicant may also accept the reasons for refusal and submit a written amendment showing a revision, such as a limitation of the designated goods and services (Sections 16 (2), 68 (2)).

When there are multiple reasons for refusal, the examiner may submit the multiple reasons for refusal simultaneously (Trademark Examination Guidelines, p. 79).

Written arguments submitted after the deadline will not be accepted. Those accepted within the set time period are examined to see if the reasons for refusal still exist, and if so, a final "decision of refusal" will be reached.

6. Decision of Refusal and Decision to Register

When a decision of refusal has been reached, the applicant may request a trial to object to the decision. If there is any reason to believe that the objection is valid, the examiner will decide to register the trademark. On the other hand, should the examiner's decision of refusal is affirmed, the applicant may take it up with the courts (under the jurisdiction of the Tokyo High Court or similar) in a bid to have it canceled. The outcome of this may be contested by appealing to the Supreme Court in accordance with the code of civil procedure.

If no reason for rejection can be found, a "decision to register the trademark" must be reached (Section 16). Furthermore, if a new reason to reject the application is found after the written argument has been submitted, the process of communicating the reason for refusal to the applicant and giving him the opportunity to submit a written argument must be repeated.

7. Suspension of the Examination Procedure

The examination procedure may be suspended, if necessary, until a ruling on opposition to the grant of a trademark registration has been reached, or until the litigation process has been completed (Section 17, Patent Law Section 54). The decision to suspend the examination process is taken at the discretion of the examiner and the courts. Its association with a decision or lawsuit does not automatically assume that it has to be suspended.

III. Abolition of the Application Publication System and a New System of Providing Information

Granting a trademark right that gives a particular individual exclusive use of the mark to the exclusion of all other persons has a great prohibitive impact on all third parties. It is because of this that, until recently, Trademark Law had taken the same position as the Patent Law in contrast to the Design Law in that, where no reason for refusal is found for application for a trademark registration, its application would be published. This publication of the application, involving the "publication of decision policy" and the "system of opposition prior to registration" has now been abolished along with its counterpart in Patent Law, in favor of bestowing rights more swiftly.

For a period of two months after the publication of the trademark in the Official Gazette, the application documents and attachments are offered by the Patent Office for public inspection (Section 18 (4)). As a result, public inspection will be conducted in the form of motions opposing registration or trials for invalidation after bestowing the trademark right. Unfortunately this has proved impractical, and therefore, a system of providing

information has now been created.

With the abolition of the system of opposing registration prior to trademark registration, a risk emerged whereby a trademark with a deficiency may find its way past public inspection. Competitors and organizations are able to use the rapid reporting on new applications in order to provide information about possible reasons for refusal. In response to demands for better use of information, the provision of information has been regulated as part of the Enforcement Regulations under the Trademark Law (Enforcement Regulations under the Trademark Law, Section 19).

IV. Opposition to the Granting of Trademark Registrations

1. System of Opposition to the Granting of Trademark Registrations

(1) Its Nature

Anyone may present opposition to the granting of a trademark registration to the Commissioner of the Patent Office within two months from the date of issue of the Official Gazette showing the trademark (Section 43-2).

Here "anyone" refers to either a person or legal entity, regardless of whether or not they have interests in the opposition. This system for opposition had originally been designed to eliminate those applications which would obviously be ruled as invalid in a trial for invalidation prior to granting registration. This was done by submitting the trademark to a "public inspection" prior to registration, thus ensuring a greater degree of scrutiny by allowing the public a chance to oppose it, thereby contributing to the outcome of the examiner's findings. This system however was changed from pre-grant opposition to post-grant opposition, as a result of greater significance being given to prompt granting of rights. As a result, the role of the "public inspection" aspect of this system has somewhat diminished.

The amendment meets the international demands for prompt granting of rights and is in step with plans for greater harmony between countries (For example, joining the Madrid Protocol necessitates communication of the possibility of opposition to its international office [Madrid Protocol Section 5 (2) (c) (i)], which would be an overwhelming clerical responsibility if it had to deal with opposition prior to granting of registration. Furthermore, reasons for refusal need to be sent out within one month of the deadline for the opposition, which would be an impossible task in Japan as things stand.) (Madrid Protocol Section 5 (2) (c) (ii)). On the other hand, because the cases where the decision was overruled as a result of opposition amount to less than 1% of the whole, there is little incentive to eliminate applications that will obviously be invalidated prior to granting of registration. These are the reasons behind the revision from pre-grant to post-grant opposition (Countries still using a post-grant opposition system include Switzerland [as of 4.1.1993], Germany [1.1.1995], and Finland [4.1.1996]).

The descriptions of the nature of opposition to registration have been many. One is that it is purely a means of obtaining information. Another is that it is an endeavor on the part of the examiners to carry out a complete and fair examination by collecting information from publication of the application and opposition to it, thereby discovering new reasons for rejection and having the opportunity to re-examine the evidence (Vol. 35, No. 4, Supreme Court, Minshu, p. 827, June 19, 1981). Motions for opposition can be a means of preventing trademark registration as it protects the profits of the person making the appeal. Some believe strongly in the right to oppose from a public law standpoint (Vol. 6, No. 2, Tokyo District Court, Mutaishu, p. 612, Jan 30, 1974; Vol. 9,

No. 2, Tokyo District Court, Mutaishu, p. 576, Aug 26, 1977; Vol. 10, No. 1, Tokyo District Court, Mutaishu, p. 170, May 2, 1978). Although not specifically addressed, it would be reasonable to expect that the nature of the opposition system to the granting of trademark registration in its revised form would be the same as those listed above.

In practice, the advantage that the pre-grant opposition system had, namely that of submitting the trademark prior to registration to be examined by the public, was too good to discard and so rapid reporting (to be discussed later) and the system of providing information (Enforcement Regulations Section 19) were established. The latter is of special significance in practical issues.

2) Succession of Status

If we believe the first description of the nature of opposition, that it is simply a means of obtaining information, then it would follow that there would be no succession of status for the opponent (The rulings will be listed later. This is the Patent Office's view and it is reflected in their practice to date.). If we believe the latter description of the nature of opposition, there are two camps of thought: that which accepts only comprehensive succession (previously the most widely held view) and that which accepts specific succession in addition to this (the alternative theory) (Supreme Court, June 19, 1981 as before; for more discussion, see Tatsunori Shibuya, [critique] "Commentary on Important Rulings of 1981", p. 255). The law-makers behind the current Law believe that a succession of status does not exist for the opponent (Industrial Property Legislation Revision Deliberation Office at the Patent Office: "Commentary on the 1996 Amendment of the Industrial Property Legislation", p. 101).

2. Procedures for Opposition

The reasons for opposing the granting of registration are:

- 1) where the trademark registration has been effected contrary to Sections 3 (the number of trademark registrations), 4 (1) (trademarks that cannot be registered), 8 (1), (2) or (5) (first to apply), 51 (2) (including its application under Section 52-2 (2)), 53 (2) (ruling to cancel registration of trademark) or Section 25 of the Patent Law as applied under Section 77 (3) (entitlement of right by a foreigner); and
- 2) the registration of the trademark was conducted in violation of the Treaty (Section 43 (2)).

Note that the opposition needs to be in writing. In other words, the reason for opposition, and any necessary evidence must be submitted together with a form for opposition to the granting of a trademark registration within the period specified to the Commissioner of the Patent Office (Section 43-4, for format, see Enforcement Regulations under the Trademark Law Section 12, format 13). The gist of the opposition cannot be changed (Section 43-2) except before a lapse of 30 days after the expiration of the time limit, when the reasons or evidence on the form can be corrected or changed (Section 43 (4) (ii)). This 30-day grace period is for the benefit of persons residing in places that are remote or difficult to access, whereby the Commissioner of the Patent Office (not the trial examiner-in-chief) may extend the period prescribed upon request or ex officio.

Correction is not allowed because it alters the nature of the opposition, which is about giving information. It also speeds up the decision regarding opposition. The examiner

must be sensitive to the opponent's interests and make a decision concerning the reason for opposition within the period specified. At the same time, the opposition is an avenue for a more thorough examination, and allows the examiner the right to re-examine using the reasons and/or evidence submitted as opposition, even after the deadline has passed. Alternatively, the examiner can also reject the application ex officio for a totally different reason.

Applications (Sections 56 (1), Patent Law Section 133 (1)) or procedures that do not meet the formal requirements (Sections 56 (1), 133 (2)) will be dismissed.

Once a decision has been reached, the Commissioner of the Patent Office must send a copy of that decision to the owner of the trademark right, the opponent, and the intervenor (or the person who has not been accepted as intervenor) (Section 43 (13) (ii)).

3. Examination of Opposition

1) Trial by a Collegial body

In order to deal with opposition to the granting of a trademark registration, the Commissioner of the Patent Office appoints 3 or 5 trial examiners, appointing one of them to be the trial examiner-in-chief. Enforcement Regulations on opposition decisions, such as exclusion of an appeal examiner, recusal, and collegial examination will apply (Section 43 (5), Patent Law Sections 136 (2) and 137 to 144). The Commissioner of the Patent Office appoints a new trial clerk, who will be responsible for the minutes. The exclusion and recusal of the Patent Law shall apply in this case as well (Section 43 (5) (ii), Patent Law Section 144 (2) (iii) and (v)).

2) Transmitting a Written Opposition

The trial examiner-in-chief must transmit a copy of the written opposition to the owner of the trademark (Section 43 (4) (iv)). The same applies to the owner of the right of exclusive use and owners of other registered rights (Sections 43 (4) (v), 46 (iii)). Transmitting the copy has the effect of introducing a more confrontational element to the system of opposition to a grant for registration, which consists mainly of a one-way flow of information from one party to the other, resulting in a higher level of examination. It must be noted that legally, the examiner-in-chief's responsibility ends with his transmitting the written opposition to the owner of the trademark. The rest, such as whether he should send the reply and its written refutation, how far he wants to pursue the case, and so on is all up to the individual examiner-in-chief. If there is a need for further explanation, he should transmit the copy, stating the time period during which the owner needs to reply so that he is given the chance to argue his position. The only procedure that he is required to perform is transmitting a copy of the written opposition to the owner of the trademark, as stated in Section 43-4.

3) Examination by Documentary Proceedings

The opposition is in principle examined in documentary proceedings (Section 43-6 (i)). However, intervention is possible (Section 43 (7)) and oral proceedings can be taken upon motion or ex officio by the owner of the trademark, the opponent to the granting of the trademark registration, or an intervenor. In some cases, information cannot be judged without personal evidence, in which case the proceedings for examining personal evidence will be applied. In such a case, the provision of the Code of Civil Procedure shall apply mutatis mutandis to the examination of evidence under the Patent Law. These areas include the summons on a hearing date, the principle of public hearing, interpretation, preparation of records (Sections 43-6 (ii), Patent Law Sections

145 (3) and (5), 146, 147), and also the examination of evidence and preservation of evidence (Section 43-8), Patent Law Sections 150, 151). In practice, examination of personal evidence hardly ever occurs in the proceedings for opposition.

4) Ex Officio Proceedings

In the trial examination of an opposition, the case is reviewed by ex officio proceedings; therefore, even grounds that have not been pleaded by the owner of a trademark right, an opponent, or intervenor may be examined (Section 43-9 (1)). For example, if the opponent is arguing that the appearance is similar and after an appeal examination it is found that there is no similarity in appearance but there is in its sound or concept, then a ruling that there is reason for refusal shall be rendered. However, an examination of the designated goods or services of a trademark cannot take place if they were not the objects challenged by the opposition in the first place (Section 43-9 (ii)). The examination is meant to clarify the grounds for an opposition.

5) Consolidated Appeal/Trial Examination

Multiple oppositions to the granting of a registration for the same trademark will be examined in the same procedure for appeal and trial examination. This single joint procedure can then be divided into separate cases later on (Section 43-10). The fact that it is a consolidated examination will not require notification to the applicant since it is accepted as the norm (this is a questionable matter). Notification after consolidation, submission of the written argument and decisions will all be carried out as a single procedure.

6) Withdrawal of Oppositions

An opposition to trademark registration cannot be withdrawn after a notice of reason for revocation has been sent (Section 43-11). There is a high probability that a fault in the registration has been found in most of the cases that receive a notice of reason for revocation. To accept withdrawal for these cases would be going against the nature of the opposition system, which is an attempt to address the public interest.

4. Ruling on Opposition

Where it is found that the trademark registration concerned in the opposition falls under Section 43-2 (i) or (ii) (a trademark registration effected contrary to the provisions of a treaty), the trial examiners shall render a ruling that the trademark registration is to be revoked ("ruling to revoke" - Section 43-3 (2)). Where a ruling to revoke has become final and conclusive, the trademark right shall be deemed never to have existed (Section 43-3 (3)).

Where it is found that the trademark registration in the opposition does not fall under Trademark Law Section 43-2 (i) or (ii) (a trademark registration effected contrary to the provisions of a treaty), the trial examiners shall render a ruling that the trademark registration is to be maintained (Section 43-3 (4)). No appeal can be filed against this decision (Section 43-3 (5)). This is so that public inspection will be terminated here and the case can move on to either a prompt registration or await procedures for a trial for invalidation.

The ruling on the opposition has to be made in writing, and it must include the following: (Section 43-13 (1)):

- 1) The number of the opposition case.
- 2) The names and domicile or residence of the owner of the trademark right, the opponent, his representative and intervenor.

- 3) The identification of the trademark registration relating to the ruling.
- 4) The conclusion of the ruling and the grounds for the ruling.
- 5) The date of the ruling.

5. Difference between Opposition to the Granting of Trademark Registration and a Trial for Invalidation

A post-grant "opposition" is when a fault or weakness is discovered in the registered trademark and the Patent Office rectifies the fault or weakness, thereby increasing the trustworthiness of the trademark right. In contrast, a "trial for invalidation" is a means of determining the propriety of the trademark registration. Just as infringement lawsuits are filed during the opposition, a demand for a trial for invalidation is also possible during opposition.

1) Person making the appeal is the one demanding a trial

Any person may oppose a post-grant trademark registration, but until recently the persons who could demand a trial for invalidation were limited to those having a vested interest in the case. This however was eliminated as it prolonged the proceedings. But the no-interest/no-right-of-action principle leaves room to believe that if there was no advantage in holding a trial, then a demand for a trial may be rejected (though unlikely).

2) Time Period

Unlike post-grant opposition with the designated time limit at 2 months from the issue date of the Gazette containing the trademark, there are no time restrictions for trials for invalidation. The former needs a time limit to maintain stability of the right, but in the latter case, compensation for damages can be demanded even after the extinguishment of the right.

3) Reasons

The reasons for post-grant opposition do not include 1. where the application for trademark registration has been filed by a person who has not succeeded to the right deriving from the trademark application (Section 46 (1) (iii)) and 2. where, after registration, the registered trademark has become a trademark no longer complying with the provisions of a treaty (Section 46 (1) (iv), (v)). They are however, considered valid reasons in a trial for invalidation.

4) Trial Body

In the past it was the examiner who used to deal with matters relating to opposition, but since the change to post-grant opposition, it has become the responsibility of the collegial body so that there is no difference from trials for invalidation.

5) Trial Procedures

Post-grant opposition is in principle an examination by documentary proceedings, whereas a trial or appeal for invalidation is principally an oral examination. In practice, however, the latter often switches over to an examination by documentary proceedings, so that there is little difference between the two.

6) Trial

For post-grant opposition, the reasons for persons or parties concerned not opposing will be put on trial. The same is true of a trial for invalidation. Designated goods or services for which no demand for opposition or trial/appeal has been made are not within the scope of the trial, this too is the same.

7) Opportunity to refute

The opposed has the opportunity to refute the opposition by submitting a statement of refutation. In a demand for a trial for invalidation, a written reply can be submitted.

8) Ruling

For a post-grant opposition, the ruling will either be to revoke the trademark (ruling for revocation), or to maintain the trademark registration (ruling to maintain). For a trial for invalidation, the ruling will either be to uphold the demand or not to uphold the demand.

9) Appeal An appeal can be made to the Tokyo High Court against a ruling for revocation in the case of post-grant opposition. For a ruling to maintain, no appeal can be made, but for a trial for invalidation an appeal can be made to the Tokyo High Court.

6. Offering of Information

(1) Purpose

The system of post-grant opposition to the registration of trademarks is advantageous to systems using early registration and is in line with the international move for accelerated registration and future treaties between countries. The disadvantage is that, faced with the chaos caused by the sheer volume of firms in any one industry and the overwhelming number of applications in Japan, the loss of pre-registration public inspection with the elimination of the pre-grant opposition has resulted in instability of the rights after registration. To address this, the offering of information to the examiner was formalized and facilitated in order to keep the advantages of public involvement alive.

For this system to work, it is important to accelerate the rapid reporting now in place, which provides information on trademark applications for each industry. It is also imperative that easy access to information concerning applications be available by use of the Internet, etc. A system of providing information already exists for patents (Enforcement Regulations under the Patent Law Section 13 (2)). One such system, which applies mutatis mutandis to this, has been set up in the Enforcement Regulations under the Trademark Law (Enforcement Regulations, Section 19 (1), (2), (3)).

(2) Content

When a trademark has been filed for registration, any person may provide information by submitting to the Commissioner of the Patent Office any publication, a copy of the application for registration of the trademark in question, or any other documentation in order to claim that the application for registration of the trademark in question is not eligible for registration under Trademark Law Sections 3, 4 (1) (i), (vi) to (xi), (xiii), (xv) to (xix), 8 (2) or (5) (Reasons for non-registration that have the public interest in mind, such as the Red Cross and marks of international organizations such as the United Nations, have been excluded because they have little in connection with ordinary traders and consumers).

Needless to say, information is only offered for the duration of the period that the relevant application for registration of the trademark is with the Patent Office.

The offer of information must be written in a format dictated by Section 19 (2) of Enforcement Regulations under the Trademark Law (Enforcement Regulations under the Trademark Law, format number 20). The information offer system in the Patent Law (Enforcement Regulations under the Patent Law Section 13-2 (3)) shall apply mutatis mutandis to the written format. The documents submitted (such as publications) can comprise preceding publications proving grounds for non-registability, catalogs, pamphlets, transaction documents and the like, with a statement indicating the reasons for their relevance.

(3) Effect

The offering of information is a systemized version of the written statements taken from the rapid reporting on trademarks that industrial organizations had always provided. It is not legally binding, but plays an important role in filling the gap left by the pre-grant opposition system in providing stability for rights and contributing to the prevention of

trademark disputes. It is not compulsory, but communicating the case results to the information supplier would be of benefit.

Outline of Procedures for Post-Grant Opposition

1. Registration of establishment of a trademark right
2. Official Gazette showing trademark is published
 - 2a. Within two months
3. Opposition to the granting of the trademark registration is filed
4. Formality check
5. Announcement of registration
6. Designation of appeal examiners
7. Dismissal due to irregular procedures for appeal
8. (Appeal is not allowed)
9. Demand for correction
10. Amended documents
11. Ruling on whether or not the appeal is dismissed
12. Appeal or trial examination
13. Send off copies of the opposition
14. Notification of reasons for revocation
15. Written argument
16. Appeal or trial examination
17. Ruling on revocation of registration
18. Appeal to the Tokyo High Court
19. Appeal to the Supreme Court
20. Ruling on retaining the registration
 - 20a (Request to the owner of the trademark right or representative for intervention)
21. Final and conclusive decision
 - 21a (Appeal is not allowed)
22. Inclusion in the Register
23. Official gazette is published
 - 23a (Final and conclusive decision is listed)

V. Final Decision on Acceptance or Refusal of Registration

(1) Types of Decision

The trial examiners' decision can be either to reject the application for registration of a trademark or to accept the application for registration. (In the same way, the trial examiners can make the trial decision concerning trademark registration, either for or against registration.)

A person who has received the examiners' decision that his application is to be refused and is dissatisfied may demand a trial thereon within 30 days from the time a certified copy thereof was sent notifying the examiners' decision (Section 44 (1)).

(2) Final Decision on Trademark Registration

The examiners' decision concerning trademark registration will come into effect from the moment the certified copy of that decision is sent out. This decision also becomes final and conclusive from the moment the copy is sent out (After a final decision has been reached, amendment to application will not be allowed - Sections 11 (3) and 12

(2)). However, even if the decision is final and conclusive, the trademark right will not come into effect with the sending of the copy of that decision. It only comes into force upon registration (Section 18 (1)).

VI. Payment of Registration Fees

(1) Registration Fees

A person about to receive a trademark establishment registration must pay as a registration fee a sum of money determined by the Trademark Law (Section 40 (1)). The registration fee is sometimes interpreted as an administrative fee (Toyosaki p. 271, Oda/Ishikawa p. 319) or a privilege fee (Yoshifuji p. 539), but it is probably best taken as a form of tax in the broad sense of the word (Kiyose p. 168, Gaku p. 210).

Registration fees can be divided into those that are paid at the time of the establishment of registration (a right-generated fee) and an annual fee payable after the establishment of registration (a right-maintenance fee). In Trademark Law, there are no annual fees to pay, only 1) the registration fee that is a right-generated fee, payable at the time the trademark right is established and registered, and 2) a registration fee for renewal of the term of the trademark right.

(2) Payment of Registration Fees

1) A person who obtains registration of a trademark shall pay the specified amount per case (Section 40 (1)). The registration fee for an individual trademark is the same as that for a defensive mark. 2) A person who applies for renewal of the term of a trademark shall pay the specified amount per case (Section 40 (2)). 3) Registration fees do not need to be paid for trademark rights belonging to the State (Section 40 (3)).

(3) Time limit for Payment of Registration Fee

1) The registration fee for an established trademark right must be paid within 30 days from the date of the transmittal of the examiners' decision or trial decision that the trademark registration is to be effected (Section 41 (1)). 2) A registration fee for renewal of the term of a trademark right must be paid at the time of the application for renewal (Section 41 (3)). 3) Upon the request of a person liable to pay a registration fee, the Commissioner of the Patent Office may extend the deadline for registration payment by a period not exceeding 30 days (Section 41 (2)). In a case where a person could not pay within the extended time period due to circumstances beyond his control, the court ratified the extension (It is a Patent Law matter, but see Vol. 2, No. 2, Tokyo District Court, Mutaishu, p. 635, Dec. 7, 1974). However, when it went to appeal, the decision was overruled (No. 83, Supreme Court, Special Event, p. 31, Sept. 11, 1975. Vol. 6, No. 2, Tokyo District Court, Mutaishu, p. 107, Sept. 18, 1974).

The 1996-revised Law made provisions for payment of registration fees in installments, as mentioned earlier (Section 41-2).

As a result, the registration fee at its establishment and for renewal in regard to the trademark right's 10-year duration can now be paid in two installments, one for the first 5 years and the second for the second 5 years (Section 41-2 (1) and (2)). When paying in installments, if the fees for the first 5-year period have been paid, but not for the second 5-year period, the trademark right will be terminated 5 years prior to its expiration (Section 41-2 (4)).

(4) Payment of Registration Fee by an Interested Person

1) Any interested person may pay a registration fee, even if against the wishes of the person liable to pay the registration fee (Section 41-3). 2) An interested person who has paid a registration fee may demand reimbursement of the expenditure of registration to

the extent that the person liable to pay is actually making a profit (Section 41-3 (2)).

(5) Refund of Registration Fee

1) A registration fee paid by mistake or in excess will be refunded upon request of the person who made the payment (Section 42 (1)). 2) No refund of a registration fee may be requested after one year from the date of payment (Section 42 (2)). In the case of payments in installments, if payment for the second half has already been made and then a ruling to revoke an opposition or a trial for invalidation renders the trademark right non-existent from the beginning, a request for refund of fees may be made until six months from the day when the decision became final and conclusive (Section 42 (2)).

(6) Payment of Registration Fees and Registration

When the registration fee has been paid, the establishment of the trademark right will be entered into the Register (Sections 18 (2), 71 (1) (i)). The trademark right is only established when the registration fee has been paid and the establishment of the trademark right registered.

VII. Registration

(1) Registration is the act of entering the trademark right in the trademark Register. This registering of the trademark is the final goal and purpose of the examination proceedings. The Patent Office must keep a "Trademark Register," which will be discussed later (Section 71 (1), main text). The items to be registered in the Trademark Register will include not only those provided for by the Trademark Law but also those prescribed by Cabinet Order (Section 71 (3)).

Upon registration, the following will be published in the Trademark Gazette: 1) the name and the domicile or residence of the owner of the trademark right, 2) the number and date of the trademark application, 3) the contents of the trademark stated in the application, 4) the designated goods or designated services, 5) the registration number and the date of the establishment (Section 18 (3)). A certificate of trademark registration (or a certificate of a registered defensive mark) will be issued at the time of the registration of the establishment of the mark (Section 71 (2)).

Currently, even after the decision on registration, 1) the transmittal of a copy, 2) the payment of the registration fee, 3) the entry into the Trademark Register, and 4) and its announcement in the Trademark Gazette all take a long time, with delays in between. The trademark right, however, comes into effect at stage 4), so that if delayed, the right is actually not in force however long a period of time has passed. On the other hand, if there is a delay in announcing the trademark registration in the Gazette, the trademark right has already been established and can be proved by the certificate issued by the Patent Office or otherwise. The right can therefore be exercised.

(2) Types of Registration

(a) Registration can be divided into the following three types in accordance with the "procedures for registration": 1) ex officio registration, 2) registration upon request, 3) registration by commission.

1) "Ex officio registration" takes place when registration is based on a certain set of facts. The establishment of a trademark right, establishment of a right based on a defensive mark registration, the renewal of term for the trademark right, the invalidation of a registered trademark, termination of trademark right without abandonment, and final and conclusive trial decision are all registered ex officio.

2) "Registration upon request" is when registration takes place as a result of a request by

a concerned person. Except for a small proportion which takes place ex officio or by commission, most registrations, for example renewal, transfer, establishment of the trademark right to use, renewal of the trademark right to use, and transfer of the trademark right, will be effected upon request.

3) "Registration by commission" is when registration takes place as a result of a commission from the courts or other government or public agencies. Registration regarding restrictions on disposal resulting from seizure, provisional seizure, provisional injunction, and disposal by public sale of a registered trademark right are registered by commission.

(b) Registration can be divided into the following three types in accordance with the breadth of the right: 1) actual registration, 2) provisional registration, and 3) announcement of registration.

1) Actual registration is a normal registration.

2) Provisional registration lacks the procedural completeness of actual registration but a registration is provisionally granted in certain cases.

3) Announcement of registration is made when certain facts are announced to a third party in order to prevent unforeseen losses.

(3) The Trademark Register

(a) Registration in Trademark Register

The following matter will be registered in the Trademark Register kept in the Patent Office (Section 71 (1)):

1) The establishment, renewal of term, division, transfer, modification, extinguishment, restoration, or restriction on disposal of a trademark right.

2) The establishment, renewal of term, transfer, or extinguishment of a right based on a defensive mark registration.

3) The establishment, maintenance, transfer, modification, extinguishment, or restriction on disposal of a right of exclusive or non-exclusive use.

4) The establishment, transfer, modification, extinguishment, or restriction on disposal of rights in a pledge upon a trademark right or a right of exclusive or non-exclusive use.

(b) Loss of the Trademark Register and Effectiveness of a Trademark Right against a Third Party

1) Loss of the Trademark Register

If the loss of the whole or part of the Trademark Register makes uncertain whether a trademark right was entered into the Register, the right will not be extinguished once it has been established by registration. In the same way, it does not lose its effectiveness against a third party. It only implies that strong proof of the existence of the trademark right has been lost.

2) Trademark rights that appear on the Register but are not in Existence

There are cases where a trademark right that appears on the Trademark Register does not actually exist.

Reasons other than abandonment, such as termination of the trademark right as a result of expiration of term, revocation, or the lack of a successor will not render the trademark right ineffective against a third party. Its deletion may not be recorded simultaneously with termination of the right, but the trademark right itself no longer exists. On the other hand, the registrar may erroneously delete a registration. If this is the case, the registrar's error will not terminate the trademark right (the opposite scenario is a possibility also). The Trademark Register is not the only evidence of the existence of the trademark right, only strong evidence.

3) Loss of the Register and the Restoration of Registration

Some argue that although the loss of the Register does not go so far as to terminate the trademark right, nevertheless it makes opposing a third party more difficult as the Register is the sole evidence of the existence of the trademark right. This argument can be refuted since for a start, the Register is not the sole evidence of the trademark right's existence. The argument also reflects confusion between the substantive law and the evidentiary law. If the loss of the Register implies that the trademark right cannot be backed up in the face of opposition of any kind, then the legislative basis of restoring registration will be lost if the Register is somehow lost in whole or in part as a result of a natural disaster. Also, an actual infringement of a right may well end up not being acknowledged as an infringement under a substantive law if the Register is lost or damaged. Once a trademark right has been established through registration, the loss of the Register in part or in whole due to natural disaster or other causes, will not have any bearing on the right itself (No. 109, Supreme Court, Minshu, p. 431, June 26, 1973. Vol. 2 No. 2, Tokyo High Court, Mutaishu, p. 464, Sept. 18, 1970). The trademark right remains effective and intact. The problem is in how to prove it.

(4) The Effectiveness of a Registration that has an Error

(a) 1) Application forms that violate the formality requirements in the Enforcement Regulations under the Trademark Law, 2) an error in the proceedings leading up to the examination for registration, and 3) the name of the representative being omitted in the examination for registration are all errors and omissions relating to matters that are not so crucial as to invalidate the examination. The trademark in question will, despite the minor errors in examination, be considered effective.

If the trademark filed for registration has gone through the examination procedure, the registration fee has been paid, and the trademark entered in the Trademark Register, then the trademark right is in effect and can be contested against a third party.

(b) If however, information of significance such as the application number or the applicant's name has not been filled in or is in error, the examination of the trademark for registration was invalid. The establishment of the registration therefore is also invalid. Furthermore, a trademark right that has been registered as established despite not going through an examination for the registration of the trademark will naturally be invalid and the trademark right not established.