

Date	January 15, 2018	Court	Intellectual Property High Court, Fourth Division
Case number	2017 (Gyo-Ke) 10107		
– When the JPO has rendered a decision to the effect that a trademark registration should be rescinded, one of the joint holders of the trademark right can institute an action to seek rescission of said JPO decision alone.			

Reference: Article 252 of the Civil Code, Article 40 of the Code of Civil Procedure, Article 35, Article 50, Article 56, paragraph (1), Article 63 of the Trademark Act, Article 73, and Article 132 of the Patent Act

Number of related rights, etc.: Trademark Registration No. 5151243, Rescission Trial No. 2014-300025

Summary of the Judgment

On April 2, 2007, the plaintiff and Company A filed an application for the registration of a trademark consisting of the four lines of characters, namely, "緑健青汁", "りよくけん青汁", "リヨクケン青汁", and "RYOKUKEN AOJIRU", for the designated goods of Class 32 "instant green juice (beverages) mainly made from green vegetables (including powdered vegetables), green vegetable juice (beverages) mainly made from green vegetables (including powdered vegetables)" as provided in the Appended Table of the Enforcement Order of the Trademark Act. The establishment of said trademark was registered on July 18, 2008 (hereinafter referred to as the "Registered Trademark"). On January 10, 2014, the defendant filed against the plaintiff and Company A as demandees a request for a trial to rescind the trademark registration concerning the Registered Trademark. On March 31, 2017, the JPO rendered a decision to rescind the trademark registration concerning the Registered Trademark in said trial on the ground that the trademark falls under Article 50 of the Trademark Act. In this action, the plaintiff alone sought the rescission of said JPO decision.

As a defense before the merits, the defendant alleged that the action in question constitutes an inherently mandatory joint suit and thus the institution of the action by the plaintiff alone is unlawful. However, the court dismissed this allegation as below. Then, the court dismissed the plaintiff's claim by holding that the trademark registration concerning the Registered Trademark should be rescinded pursuant to the provisions of Article 50 of the Trademark Act, since there is no fact that the Registered Trademark was used during the period for which use thereof is required to be proven.

"It is provided that, when the JPO has rendered a decision to rescind a trademark registration concerning a trademark right that has once been registered, based on the ground of non-use of the registered trademark, and when the statute of limitations for

filing an action has lapsed without the institution of an action to seek the rescission of said JPO decision, said trademark right is deemed to have become expired on the date of registration of the request for a trial and the right to the exclusive use of the registered trademark is to be extinguished (Article 54, paragraph (2) of the Trademark Act). Therefore, the institution of said action constitutes an act of preservation to prevent the extinguishment of the trademark right. Thus, it is construed that said action can be filed by one of the joint holders of the trademark right alone. In addition, even when it is construed that said action can be instituted by one of the joint holders of the trademark right alone, it would not infringe the right of the other joint holders that did not institute the action.

Moreover, there could be a case where the whereabouts, etc. of any other member of the joint holders become unknown after a long time since the registration of the establishment of the trademark right, and a case where other joint holders would not cooperate in instituting an action. If an action to seek the rescission of a JPO decision to rescind the trademark registration concerning joint ownership in such cases is construed to constitute an inherently mandatory joint suit and an action instituted by one of the joint holders alone is considered to be unlawful, it could lead to an inappropriate result, as the JPO decision for rescission becomes final and binding upon the expiration of the statute of limitations for filing an action and the trademark right would be deemed to have become extinguished on the date of registration of the request for the trial.

Furthermore, even if it is construed that an action to seek the rescission of a JPO decision to rescind the trademark registration can be instituted by one of the joint holders of the trademark right alone, when the judgment that upheld the claim becomes final and binding in that action, the effect of said rescission of the JPO decision would extend to other members of the joint holders (Article 32, paragraph (1) of the Administrative Case Litigation Act) and the JPO would recommence the proceedings of the trial in relation to all joint holders (Article 181, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 63, paragraph (2) of the Trademark Act). On the other hand, if the judgment to dismiss the claims has become final and binding in that action, the JPO decision for rescission would become final and binding upon the expiration of the statute of limitations for filing an action for other joint holders and the trademark right would be deemed to have become extinguished on the date of registration of the request for a trial (Article 54, paragraph (2) of the Trademark Act). In either case, a circumstance that goes against the requirement for determination as a unified manner would not arise. When individual joint holders have instituted

actions to seek rescission of a JPO decision jointly or separately, these actions should be construed to constitute similar mandatory joint suits. Thus, these actions are to be examined and determined jointly and the requirement for determination as a unified manner would be fulfilled.

According to the above findings, it is appropriate to construe that, when the JPO has rendered a decision to the effect that a trademark registration should be rescinded, one of the joint holders of the trademark right can institute an action to seek rescission of said JPO decision alone (see 2001 (Gyo-Hi) 142, judgment of the Second Petty Bench of the Supreme Court on February 22, 2002, Minshu Vol. 56, No. 2, at 348).