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Date of the judgment

2005.07.14

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Case Number

2004(Gyo-Hi)4

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Reporter

Minshu Vol. 59, No. 6

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Title

Judgment concerning when an amendment to delete some items of the designated goods or services in the original application for trademark registration becomes effective in a case where a divisional application is filed and the amendment is made while a suit against the JPO trial decision to refuse the trademark application is pending at court

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Case name

Case to seek revocation of JPO trial decision

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Result

Judgment of the First Petty Bench, quashed and decided by the Supreme Court

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Court of the Second Instance

Tokyo High Court, Judgment of October 7, 2003

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Summary of the judgment

In cases where a divisional application is filed and an amendment is made to delete some items of the designated goods or services in the original application for trademark registration while a

suit against the JPO trial decision to refuse the trademark application is pending at court, the amendment does not become effective retrospectively at the time of the filing of the trademark application.

References

Article 10(1) and (2) and Article 68-40(1) of the Trademark Law, Article 22(4) of the Regulations under the Trademark Law, and Article 30 of the Regulations under the Patent Law

Article 10(1) and (2) of the Trademark Law

(Division of trademark application)

1. An applicant for trademark registration may divide his application for trademark registration designating two or more items of goods or services in order to establish one or more new trademark applications while the original trademark application is pending in the examination, trial or retrial, or a suit against the JPO trial decision to refuse the trademark application is pending at court.

2. In the case of the preceding paragraph, the new trademark application shall be deemed to have been filed at the time of the filing of the original trademark application. However, this provision shall not apply in relation to Article 43(1) and (2) of the Patent Law (Law No. 121 of 1959) which is applicable mutatis mutandis under Article 9(2) and Article 13(1) (including cases where it applies mutatis mutandis under Article 43-2(3) of the said law that is applicable under Article 13(1)).

Article 68-40(1) of the Trademark Law

(Amendment of procedures)

A person who has carried out procedures relating to an application for trademark registration, application for defensive mark registration, demand or other procedures relating to trademark or defensive mark application may make an amendment only during the pendency of the case in the examination, opposition to registration, trial or retrial.

Article 22(4) of the Regulations under the Trademark Law

Provisions of Article 26(2), Article 27(1) to (3), Article 27-4, Article 28, and Article 30 of the Regulations under the Patent Law (trust, statement of shares, procedures for priority claim under the Paris Convention, notification of the patent number, and amendment to be made with respect to division of the patent application) shall apply mutatis mutandis to applications for trademark registration or applications for defensive mark registration. In this case, "Article 195(5) of the

Patent Law" in Article 27(3) of the Regulations under the Patent Law shall read "Article 76(4) of the Trademark Law," and "specification, claims or drawings attached to the request" in Article 30 of the Regulations under the Patent Law shall read "request."

Article 30 of the Regulations under the Patent Law

(Amendment to be made when dividing a patent application)

A person who intends to file a new patent application in accordance with Article 44(1) of the Patent Law shall make an amendment of the specification, claims or drawings attached to the request of the original patent application at the time of the filing of the new patent application, if such amendment is necessary.

Main text of the judgment

The judgment of the second instance shall be quashed.

The claim made by the jokoku appellee shall be dismissed.

The jokoku appellee shall bear the whole cost of the lawsuit.

Reasons

Concerning the grounds for the petition for accepting the jokoku appeal argued by the attorneys for jokoku appeal TSUZUKI Hiroshi, et al.

1. The outline of the facts legally determined by the judgment of the second instance is as follows.

(1) The jokoku appellee, on February 9, 2000, filed an application for trademark registration with respect to the trademark indicated as Item A in the attachment, designating the services in Classes 35, 37, 38, and 42 set forth in Schedule 1 of the Trademark Law Enforcement Order (before amendment by Cabinet Order No. 265 of 2001), which are indicated as Item B in the attachment (the trademark and the application for trademark registration shall hereinafter be referred to as the "Trademark" and the "Trademark Application" respectively; the designated services in Class 35, those in Class 37, those in Class 38, and those in Class 42 shall hereinafter be referred to as "Services A," "Services B," "Services C," and "Services D" respectively).

(2) The Japan Patent Office (JPO), as of March 5, 2001, notified the jokoku appellee of reasons for refusal of the Trademark Application. Despite the written amendment submitted by the jokoku appellee on April 18, 2001, to delete Services A from the scope of designated services, the JPO made a decision to refuse the Trademark Application on June 1, 2001.

On June 27, the jokoku appellee filed an appeal against the JPO decision of refusal. On January

21, 2003, the JPO made a trial decision to dismiss the appeal on the grounds that the Trademark was similar to another's trademark registered based on an earlier application and the designated services for the Trademark are identical or similar to those covered by the registered trademark, and therefore the Trademark fell under Article 4(1)(xi) of the Trademark Law (this trial decision shall hereinafter be referred to as the "JPO Trial Decision").

(3) The jokoku appellee filed this suit to seek revocation of the JPO Trial Decision, and subsequently, on March 11, 2003, in accordance with Article 10(1) of the Trademark Law, filed a new application for trademark registration (divisional application), designating Services D, part of the items of the designated services for the Trademark Application, and also submitted a written amendment to reduce the items of the designated services for the Trademark Application to Services B and Services C.

On June 2, 2003, in accordance with Article 10(1) of the Trademark Law, the jokoku appellee filed another new application for trademark registration (divisional application), designating Services B (except for "building construction work") and Services C, part of items the designated services for the Trademark Application, and also submitted a written amendment to reduce the items of the designated services for the Trademark Application to "building construction work."

The jokoku appellee argues that the items of the designated services in the Trademark Application have been reduced through the amendments upon the filing of the divisional applications after the suit was filed, and therefore the JPO Trial Decision was made based on an erroneous judgment on similarity as a result of an erroneous recognition of the scope of the designated services.

2. The court of the second instance upheld the jokoku appellee's claim, on the following grounds.

(1) When a divisional application is filed, the items of the designated goods and services for the original application shall necessarily be divided into those for the original application and those for the divisional application, as long as the requirements set forth in Article 10(1) are satisfied. Consequently, deletion of some the items of the designated goods or services for the original application, which results from their transfer into the divisional application, is included in the procedures for filing the divisional application, and therefore it does not require any additional procedures.

Reduction of the items of the designated goods or services to be covered by the trademark in the original application because of the filing of a divisional application necessarily follows that the scope of issues to be examined and determined in a suit against a JPO trial decision has been reduced to that extent; therefore, in the suit against the JPO trial decision, the court should make

examination and determination regarding the remaining items of the designated goods or services, by using the time of the JPO trial decision as the reference time.

(2) The designated services for the Trademark Application was, as a result of the two divisional applications filed after the suit was filed, reduced to "building construction work." Consequently, the designated services for the Trademark cannot be deemed to be identical or similar to the designated services for another's registered trademark. For this reason, the JPO Trial Decision that regarded the Trademark as falling under Article 4(1)(xi) of the Trademark Law is erroneous, and it should be revoked as illegal with respect to the part concerning the designation of "building construction work." The remaining part of the JPO Trial Decision had already become invalid due to the two divisional applications.

3. However, the judgment of the second instance mentioned above cannot be accepted, on the following grounds.

Article 10 of the Trademark Law provides as follows. "(1) An applicant for trademark registration may divide his application for trademark registration designing two or more items of goods or services in order to establish one or more new trademark applications while the original trademark application is pending in the examination, trial or retrial or a suit against the JPO trial decision to refuse the original trademark application is pending at court. (2) In the case of the preceding paragraph, the new trademark application shall be deemed to have been filed at the time of the filing of the original trademark application." Article 22(4) of the Regulations under the Trademark Law, which applies *mutatis mutandis* Article 30 of the Regulations under the Patent Law to applications for trademark registration, requires that a person who intends to file a new patent application in accordance with Article 10(1) of the Trademark Law shall make an amendment of the request of the original trademark application at the time of the filing of the new trademark application, if such amendment is necessary.

As mentioned above, Article 10(1) of the Trademark Law provides that in the case of "division of an application for trademark registration," a new trademark application may be filed and such a new application shall be deemed to have been filed at the time of the filing of the original application, but it does not include any provision as to the consequence of the original application after the new application has been filed. Furthermore, Article 22(4) of the Regulations under the Trademark Law provides that a person who intends to file a new application for trademark registration in accordance with Article 10(1) of the Trademark Law shall make an amendment of the request of the original trademark application at the time of the filing of the new trademark application. In light of these provisions, it is reasonable to construe that the effect of deleting some items of the designated goods or services, which are to be covered by the new trademark application, from the scope of designated goods or services for

the original trademark application will be brought about only by an amendment made to the request of the original trademark application.

In cases where a new trademark application is filed and an amendment is made to the request of the original trademark application in accordance with Article 10(1) of the Trademark Law while a suit against the JPO trial decision to refuse the original trademark application (JPO trial decision of refusal) is pending at court, the amendment does not fall under the scope of amendment provided in Article 68-40(1) of the Trademark Law; therefore, the provision of the said paragraph shall not make the amendment effective retroactively at the time of the filing of the trademark application. Furthermore, the Trademark Law does not provide for any other cases where an amendment becomes effective retroactively at the time of the filing of the trademark application. If an amendment may become effective retroactively at the time of the filing of the trademark application even while a suit against the JPO trial decision of refusal is pending at court, it would be contrary to the purport of Article 68-40(1) of the Trademark Law, which allows an amendment only during the pendency of the case in the examination, opposition to registration, trial or retrial, thereby setting a time limit for making an amendment (See 1981 (Gyo-Tsu) No. 99, judgment of the Third Petty Bench of the Supreme Court of October 23, 1984, Minshu Vol. 38, No. 10, at 1145).

If the applicant for trademark registration who has been given a JPO trial decision of refusal files a new trademark application under Article 10(1), designating items of the designated goods or services for the original trademark application other than those judged to have reasons for refusal by the JPO trial decision, the new trademark application shall be deemed to have been filed at the time of the filing of the original trademark application, which enables the applicant to avoid refusal of the whole of the original trademark application due to reasons for refusal found in respect of only part of the scope of designated goods or services. Consequently, in a case where a new trademark application is filed under Article 10(1) of the Trademark Law and an amendment is made to delete some items of the designated goods or services from the request of the original trademark application while a suit against the JPO trial decision of refusal is pending at court, even if the amendment does not become effective retroactively at the time of the filing of the trademark application, it would not be detrimental to the trademark applicant's interests or contrary to the purport of Article 10 of the Trademark Law..

For the reasons stated above, in cases where a new trademark application is filed in accordance with Article 10(1) of the Trademark Law and an amendment is made to delete some items of the designated goods or services from the request of the original trademark application while a suit against the JPO trial decision of refusal is pending at court, the amendment does not become effective retroactively at the time of the filing of the trademark application, and therefore the JPO trial decision cannot be deemed to have made an erroneous judgment regarding the scope

of the designated goods or services. The judgment of the second instance that is contrary to this reasoning contains an apparent violation of laws that has affected the judgment, and the jokoku appellant's argument is well-grounded.

4. Consequently, the judgment of the second instance should inevitably be quashed. Also, the jokoku appellee's claim should be dismissed as groundless.

Therefore, the judgment was rendered in the form of the main text by the unanimous consent of the Justices.

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Presiding judge

Justice IZUMI Tokuji

Justice YOKOO Kazuko

Justice KAINAKA Tatsuo

Justice SHIMADA Niro

Justice SAIGUCHI Chiharu

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(Attachment)

A. Trademark: "eAccess"

B. Designated services

Class 35: Marketing research, provision of information on sales of goods

Class 37: Building construction work, machinery installation work, electrical work, telecommunication work, maintenance or repair of telecommunication appliances, maintenance or repair of computer hardware (including central processing unit and computer program-integrated electronic circuits, magnetic disks or other peripheral equipment), maintenance or repair of distributing or control apparatus

Class 38: Cellular telephone communication, telex communication, communications by computer terminals, communication by telegram, communication by telephone, communication by facsimile, radio paging, television broadcasting, cable television broadcasting, radio broadcasting, Internet access service, rental of telephones, facsimile apparatus, and other communication apparatus

Class 42: Designing of buildings, development of telecommunication equipment, planning, survey, research, and consulting on telecommunication business, planning, survey, research, and consulting on cable television broadcasting business and cable broadcasting business, development of hardware and software for telecommunication, development of equipment for

cable television broadcasting, and information processing by computers

(This translation is provisional and subject to revision.)