

judgedate:

February 28, 2002

caseid:

2001 (Gyo-Hi) 12

casename:

A case of seeking rescission of the JPO decision

casetitle:

Judgment relating to whether or not a rescission lawsuit instituted singularly by the joint holder of the trademark right for the invalidation decision of the trademark registration is allowed

summary_judge:

Each of the joint holders of the trademark right can institute a rescission lawsuit of the invalidation decision singularly, when the decision to the effect that the trademark registration is to be invalidated is made.

court second:

Tokyo High Court, Judgment of October 11, 2000

references:

Article 252 of the Civil Code, Article 40 of the Code of Civil Procedure, Article 35 of the Trademark Act, Article 46 of the Trademark Act, Article 56, paragraph (1) of the Trademark Act, Article 63 of the Trademark Act, Article 73 of the Patent Act, Article 132 of the Patent Act

Main text

Judgment in prior instance shall be reversed, and this case shall be remanded to Tokyo High Court

Reasons

Reasons for the petition for acceptance of final appeal by attorney of the final appeal, ●●●●

1. Outline of factual relationships and the like finalized in the court of prior instance is as follows.

Appellants of final appeal as well as D and E jointly owned the trademark right according to the registered trademark (establishment registered on August 31, 1993, Registration No. 2564665, hereinafter, referred to as the "present registered trademark") for the trademark in which vertically written characters of "水沢うどん (Mizusawa Udon)" with designated goods of "Udon noodles, instant Udon noodles" in Class 32 in the Appended Table of the enforcement ordinance of the Trademark Act (before revision by the 1991 Ordinance No. 299). Appellees made a request for an invalidation trial of the trademark registration according to the present registered trademark with Appellants as well as D and E as demandants on October 27, 1997.

The Japan Patent Office made a decision on the aforementioned trial case on April 6, 2000 to the effect that the trademark registration according to the present registered trademark was to be invalidated for the reason of applicability to Article 3, paragraph (1), item (iii) of the Trademark Act. The certified copy of the aforementioned decision was delivered to Appellants as well as D and E on the 26th day of the same month, and Appellants instituted a lawsuit against the aforementioned JPO decision on May 25 of the same year. However, D and E prepared the statement on abandonment of the share that the trademark right according to the present registered trademark shall be abandoned as of April 30 of the same year and did not institute a lawsuit against the aforementioned JPO decision by the time limit of action against the decision.

Appellants as well as D and E filed a petition of share transfer registration that the shares of D and E shall be transferred to each of Appellants with the cause of the aforementioned share abandonment on July 17 of the same year.

2. In the present lawsuit, only Appellants sought rescission of the JPO decision, but the court of prior instance judged as follows and dismissed the present lawsuit.

The lawsuit that seeks rescission of the JPO decision to the effect that the trademark registration is to be invalidated (hereinafter, referred to as the "invalidation

JPO decision") for the jointly owned trademark right needs to be final and binding in a unified manner since it determines presence/absence of one right owned by all the joint holders and is a compulsory joinder.

Since the time limit of action against the decision has elapsed without institution of a lawsuit by D and E, the present lawsuit according to the institution only by Appellants is unlawful.

3. However, the aforementioned judgment of the court of prior instance cannot be accepted. The reasons therefor are as follows.

(1) In the case of the jointly owned right generated by the filing of the trademark registration, when a trial is to be requested for the right, all the joint holders should do that jointly (Article 132, paragraph (3) of the Patent Act applied *mutatis mutandis* to Article 56, paragraph (1) of the Trademark Act). This is exactly because coincidence of intentions of all the joint holders is required for obtainment of one trademark right which is to be held by the joint holders. On the other hand, once the establishment of the trademark right is registered, the joint holders of the trademark right can use the registered trademark without consent of the other joint holders, although consent of the other joint holders is required for procedures such as transfer of the share, establishment of exclusive use right, or the like (Article 73 of the Patent Act applied *mutatis mutandis* to Article 35 of the Trademark Act).

Incidentally, in the case where the invalidation decision of the trademark registration was made for the once registered trademark right, if the time limit of action against the decision has elapsed without institution of a lawsuit seeking rescission thereof, the trademark right is deemed never to have existed, and the right to exclusively use the registered trademark retrospectively lapses (Article 46-2 of the Trademark Act). Therefore, since the institution of the aforementioned lawsuit of rescission falls under a preservation act preventing lapse of the trademark right, it is understood that it can be made singularly by each of the joint holders of the trademark right. And even with such understanding, the right of the joint holder who did not institute a lawsuit is not ruined.

(2) Regarding the jointly owned trademark right, since the situations of respective profits and interests of the joint holders can be different, if cooperation by the other joint holders cannot be gained for the institution of a lawsuit or if the registration is not completed within the time limit of action against the decision even though the share was disposed of after the invalidation decision, the invalidation decision might be made even after extinction of the trademark right (see Article 46, paragraph (2) of the same Act), and such a case is assumed that a long time has elapsed since the

establishment of the trademark right was registered and whereabouts of the other joint holders become unknown. If the rescission lawsuit against the invalidation decision of the jointly held trademark registration is understood to be the compulsory joinder in such a case, and it is supposed that the lawsuit instituted only by some of the joint holders to be unlawful, the invalidation decision is final and binding at the same time as expiration of the time limit of the action against the decision, and the trademark right is deemed never to have existed, which can be an unreasonable result.

(3) Even if it is understood that each of the joint holders of the trademark right can singularly institute a lawsuit to rescind the invalidation decision, if the judgment approving the claim is final and binding in the lawsuit, the effect of the rescission reaches to the other joint holders (Article 32, paragraph (1) of the Administrative Case Litigation Act) and the trial proceeding is performed in relation with all the joint holders at the Patent Office again (Article 181, paragraph (2) of the Patent Act applied *mutatis mutandis* to Article 63, paragraph (2) of the Trademark Act). On the other hand, if the judgment to dismiss the claim is final and binding in the lawsuit, the invalidation decision is final and binding by expiration of the time limit of the action against the decision in relation with the other joint holders, and the right is deemed never to have existed (Article 46-2 of the Trademark Act). In any case, such a situation that contradicts the request of unified final and binding is not generated. Moreover, if each of the joint holders instituted a rescission lawsuit jointly or individually, the lawsuits should be understood to fall under the quasi-mandatory joinder, and they are combined and then, examined/judged, whereby the request for unified final and binding is fulfilled.

(4) As held as above, [summary] it is reasonable to understand that when the invalidation decision of the jointly held trademark registration is made, each of the joint holders of the trademark right can singularly institute the rescission lawsuit of the invalidation decision.

4. Then, the judgment of the court of prior instance that the present lawsuit is unlawful has violation of the laws and orders which obviously affects the judgment. The gist has grounds. The Supreme Court 1960 (O) 684, First Petty Bench judgment on August 31, 1961/Minshu vol. 15, No. 7, page 2040, Supreme Court 1977 (Gyo-Tsu) 28, Second Petty Bench judgment on January 18, 1980/Court Collection Civil No. 129, page 43, and Supreme Court 1994 (Gyo-Tsu) 83, Third Petty Bench judgment on March 7, 1995/Minshu vol. 49, No. 3, page 944 are cases different from the present case, which is not appropriate. Therefore, the judgment in prior instance shall be reversed, and the present case shall be remanded to the court of prior instance so that

this case is to be examined.

Therefore, the judgment shall be rendered as in the main text unanimously by all the judges.

Supreme Court, First Petty Bench

(Presiding judge: FUKAZAWA Takehisa, Judge: IJIMA Kazutomo, Judge: FUJII Masao, Judge: MACHIDA Akira)