

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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March 31, 2015

To: Shri Chaitanya Prasad
Controller General of Patent, Design and Trademarks,
Ministry of Commerce & Industries
Government of INDIA
Udyog Bhavan, New Delhi-110011,
India

Re: JIPA Comments on the draft of Manual of Trade Marks, Practice & Procedure

Dear Shri Chaitanya Prasad,

We, the Japan Intellectual Property Association (“JIPA”), are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 900 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems.

(<http://www.jipa.or.jp/english/index.html>)

Having learned the draft of Manual of Trade Marks, Practice & Procedure published by Government of India on March 10, 2015, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,

(*Takatoshi Kondo*)

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JIPA Comments on the Draft of Manual of Trade Marks, Practice & Procedure

Japan Intellectual Property Association

JIPA has closely and carefully examined the proposed draft of Manual of Trade Marks, Practice & Procedure published by Government of India on March 10, 2015.

JIPA hereby presents its comments on this proposed legislation.

Chapter II

Examination of Applications filed for Registration of Trademarks

➤ Serial No. 10.5 (p.42)

<Comment 1>

In descriptions of goods and services, we would request that the Nice Class Headings should be acceptable not only in Class 42 to 44 , but also in all other classes.

Accordingly, as the examples of wide and vague specifications, from page 42 "Some examples" to page 43 "TM-16." , we would request to delete these mentions.

<Comment 2>

We would request to specify on this draft that in descriptions of goods and services , "parts and fittings" or "parts and accessories" are accepted, which we believe is the case in practice.

<Reason 1 & 2>

It may be understood that "all goods" or "all services" are not specific enough, and "large variety of goods and services in a class" is impractically wide for the purpose.

However, if the descriptions are required to be too specific, there would be rooms for unnecessary arguments in case of bad-faith use of the trademark on similar but unspecified goods; there should be some allowance for the scope of the trademark rights. In other words, the descriptions of goods and services should work as prohibitive caution to possible infringer.

We believe Nice Class Headings should work best for the purpose above, while being reasonably specific. Accordingly, we request that Nice Class Headings be accepted for the description of the goods/services, while any addition of more specific description being recommended.

<Comment 3>

What criteria are required to use proof, whether there are criteria such as the number of designated goods, how much use or proof is required, and whether it is acceptable if the mark is still not used but there is a business plan? Please clarify.

<Reason 3>

Unification and clarification of examination

- Serial No. 11.1 (p.43)

<Comment>

Please clarify the criteria on how Examiners specify the sounds.

<Reasons>

Unification and clarification of examination

- Serial No. 11.2 (p.45)

<Comment>

What is "a person of average intelligence"? Doesn't it related to any particular industry? Isn't there any cases where attention, which demander or trader in any particular industry has, should be taken into consideration? Please clarify

<Reason>

Unification and clarification of examination

Chapter III

Post Examination Disposal of Applications Filed For Registration of Trademarks

- Serial No. 3.2.3 (p.81)

<Comment>

The "Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit". In order to review the oral evidence or how the oral testimony was going, please make documentation. It will be useful especially in the case where the oral evidence or testimony has become an important ground in the examination.

<Reason>

Clarification of examination

- Serial No. 3.2.4 (p.82)

<Comment>

Regarding unconventional trademarks, it is understandable of the difficulty to describe in detail on similarity, but in the near future please clarify the guideline or criteria on similarity in the examination to assist examiners and help applicants (Japan Patent Office will start to accept unconventional trademark application in April 2015, and published the guideline in examination).

<Reason>

Unification and clarification of examination

- Serial No. 3.10.3 (p.94)

<Comment>

It will be helpful to be able to change trademark agent on several cases in bulk.

<Reason>

Simplification of procedures

Chapter IV

Tribunal Section (Opposition & Rectification Proceedings)

- Serial No. 1.1 (p.103)

<Comment>

Please leave this as it is.

<Reason>

Opposition is the purpose to ensure accuracy of the examination, and it does not need to be filed by an interested party.

- Serial No. 1.6 (p.104)

<Comment>

Please unify the office to the particular single one.

<Reasons>

Unification of opposition examiners' judgment

- Serial No. 4.2 (p.111)

<Comment>

Please leave this as it is.

<Reason>

Simplification of process

Chapter V

Pre-Registration Amendment

- Serial No. 1.9 (p.126)

<Comment>

It doesn't need to require the return of the original.

<Reason>

Simplification of procedures, and shortening the period required for correction.

Chapter VI

Renewal, Assignment/Transmission, Registered User and Post Registration Changes of Registered User

- Serial No. 1.7 (p.129)

<Comment>

For trademark registrations passing the deadline more than 6 months, please limit the restoration only if it has an appropriate reason to restore.

<Reason>

Comparison with third parties interest

(END)