

## **Expanding the subject matter for Accelerated Trademark Examination since January, 2009**

In response to the increasing need for Accelerated Trademark Examination, in January 2009, the Japan Patent Office (“JPO”) announced that it would expand the subject matter for Accelerated Trademark Examination and revised the Guidelines for Accelerated Trademark Examination. After February 1, 2009, an applicant who seeks to expedite the examination of its trademark application can also request an Accelerated Trademark Examination even if it does not have an urgent situation.

### **1. Prior requirements for Accelerated Trademark Examination**

Since September 1997, the JPO has been accepting requests to expedite the examination of trademark applications if:

- (1) the applicant or the licensee has already been using or made preparations to use the trademark applied for in relation to its designated goods or services; and
- (2) there are any urgent situations that require leading the trademark application to registration such as:
  - A. it is clear that an unauthorized party is using or preparing to use an identical or similar trademark applied for in relation to identical or similar designated goods or services which the applicant or the licensee is using or has made preparations to use;
  - B. the applicant receives a cease and desist letter from a third party regarding the applicant’s use of the trademark applied for;
  - C. a third party has approached the applicant to request a license to use the trademark applied for; or
  - D. the applicant filed a trademark application for the same mark with patent and trademark offices outside Japan or with an intergovernmental organization.

### **2. Revised requirements for Accelerated Trademark Examination**

In addition to trademark applications which meet the requirements above, the JPO has also started to accept requests to expedite the examination of trademark applications **if the application as filed designates only goods or services which the applicant or licensee has already used or has made preparations to use**. In other words, in order to request an Accelerated Trademark Examination, the applicant must show its actual use of the trademark applied for, or a considerable amount of preparation for those trademarks that it plans on using, for all of the designated goods or services by submitting evidence. If the application includes goods or services which either the applicant or the licensee has not used or has not made preparations to use, the applicant must delete such goods at the same time of or before requesting an Accelerated Trademark Examination.

### **3. The Accelerated Trademark Examination procedure**

An applicant who seeks to expedite the examination of its trademark application has to file an on-line or written request which explains the situations for expediting the examination of its trademark application. An applicant can file a request at any time after the filing of a trademark application with the JPO. No official fee is required. The applicant can also request Trial Examiners for an Accelerated Trademark Examination when its trademark application is pending at the Board of Appeals.

Once the JPO receives a request, the examiner or Trial Examiners in charge will check whether it meets the above requirements. If the examiner or Trial Examiners in charge believes that it satisfies the requirements, then he/she will treat the trademark application as a priority and start the examination. The registration process will be shortened to 4 months, whereas it usually takes 8 to 10 months for a trademark application to be registered. If the examiner or Trial Examiners in charge does not believe that it satisfies the requirements, then he/she will just notify the applicant of the denial of the request. This examiner’s decision is final and not contestable.

Trademark Committee