



## **JAPAN PATENT ATTORNEYS ASSOCIATION**

3-4-2, Kasumigaseki Chiyoda-ku, Tokyo 100-0013, JAPAN

Telephone: + 81-3-3581-1211 / Facsimile: +81-3-3581-9188

Internet: <http://www.jpaa.or.jp>

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The Japan Patent Attorneys Association, the professional association of more than 9,000 patent attorneys practicing in all aspects of intellectual property law in Japan, would like to submit our comments on the introduction of the division of the international registration at the level of the designated Contracting Party.

We believe that there are needs for the division of the international registration for the Japanese practitioners, especially when the international registration is provisionally refused citing prior filed registration at the national level, with respect to some of the designated goods and/or services.

The Japan Patent Office conducts substantive examination including the determination of the existence of relative grounds for refusal and one of the major reasons for refusal to the applications in Japan is based on the relative grounds. Generally, the relative ground refusals include cases where only some of the designated goods and/or services are disputed.

As mentioned in MM/LD/WG/9/2, an applicant of the national route application in Japan is allowed to proceed the undisputed part of the application to registration by dividing the disputed part when an Office Action is issued. In practice, division of the disputed part of the application is commonly made to overcome the Office Action in Japan.

On the other hand, in the same situation as the above, a holder of the international registration designating Japan is not allowed to divide the disputed part from the undisputed part of the application at the national level when a provisional refusal is issued.

Considering the above, it does not seem to be well-balanced between the national route in Japan and the international route designating Japan to seek protection of the mark in Japan, which makes us concerned that the national route in Japan appears more preferable for the users who seek the protection of marks in Japan.



Regarding the Japanese users who are to designate a Contracting state or region that allows the division of the application in its national route, they might consider the national route is more user-friendly because no division is available in the international route.

Thus, we would like to express our welcome to the introduction of the division of the international registration at the level of the designated Contracting Party.

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