



<日本>

商標実務と他法域との関わりについて

東和国際特許事務所
弁理士

平林 岳治

特許と商標の両方に携わる実務家として、両法域の様々な案件に関わってきたが、最近、商標実務において、特許案件に携わってきた経験を活用する場面が幾度かあった。

具体的には、商標の中間処理で、指定商品・指定役務が明確でないとされる拒絶理由が通知され、これに対して、対応する特許出願の明細書や図面の記載に言及して指定商品等の説明を行うことがあった。このような拒絶理由は、概して、従来なかったような商品・役務を指定商品等とした場合によく通知される。また、海外クライアントから依頼された日本への商標出願において、英語など外国語で当初起案された指定商品等の表示を日本語に翻訳した場合、さらに、出願時に優先権を主張した関係から、もとの出願の指定商品等の表示を忠実に日本語に翻訳した場合に通知されることが多い。

このように、対応する特許出願の出願書類に記載された事項を商標出願の指定商品等の表示に即して読み解き、対応箇所を具体的に挙げて、説明資料の一部として商標審査官に示すことは、他の説明資料として日本語による商品カタログ等を併せて提出することができる場合はもとより、そのような資料を入手するのが難しい場合には特に、拒絶理由に応答するための有用な措置となり得る。

また、このような商標案件において、対応する特許出願の書類に言及するとき、この特許出願を同一代理人が受任している場合には、異なる法域の案件同士を適切に関連付けることがより容易である。弊所でも、実際の事案を経験する中、両法域の案件を共に受任して、詳細な出願経過を把握しつつ、参照可能であることに一定のメリットがあると感じている。

< Japan >

Trademark Practice in Association with Other Jurisdictions

Towa International Patent Firm

Patent Attorney

Takeharu Hirabayashi

As a practitioner of both patent and trademark cases, I have been involved in a variety of cases in both jurisdictions, and recently I have had several occasions to utilize my experience I had with patent cases in trademark practice.

Specifically, during prosecution of a trademark application, we were notified of reasons for refusal that the designated goods and/or services were not clear, and in response, we sometimes explained the designated goods, etc. by referring to the description and drawings of a corresponding patent application. Such reasons for refusal are often notified in cases where the designated goods or services are goods or services that were hardly seen in the past. In addition, in the case of a trademark application to Japan requested by an overseas client, those reasons for refusal are often notified when the indication of the designated goods, etc., originally drafted in a foreign language such as English, was translated into Japanese, or when the indication of the designated goods, etc., in the original application was faithfully translated into Japanese because a priority was claimed at the time of filing the application.

Then, it would be necessary to read and understand the matters stated in the corresponding patent application documents in line with the indication of the designated goods, etc. in the trademark application, specifically list the corresponding recitations, and present them to the trademark examiner as part of explanatory materials. This can be a useful measure to respond to the reasons for refusal, not only when explanatory materials such as a product catalog in Japanese can be provided along with the corresponding recitations, but also especially when such materials are difficult to obtain.

Furthermore, when referring to the corresponding patent application documents in such a trademark case, it would be easier to properly relate the cases from different jurisdictions if the patent application is being prosecuted by the same agent. From our experience in actual cases, it has been implied that there are certain advantages in having cases from both jurisdictions assigned to us, and being able to refer to them while having detailed records of progress of the applications.