

## Questionnaire on TM5 Bad Faith Filing Project

### I. General questions:

**Q1.** Is there a definition of “bad faith” in your legal system (either by legislative instruments or through case-law)?

**Q2.** Is bad faith raised ex-officio or upon a party's claim/objection? (where the answer can depend on different case constellations, please refer to the detailed questions in (iii) of II. Q1 ~ Q5 of the questionnaire)

**Q3.** What is the earliest moment within your system that 'bad faith' can be claimed? What is the latest? (i.e. are there time limits for claiming bad faith).

**Q4.** What is the crucial moment at which the 'bad faith applicant' must have had bad faith to fall foul of the provisions. (e.g. filing date, final decision by examiner etc)? (where the answer can depend on different case constellations, please refer to the detailed questions in (ii) of II. Q1 ~ Q5 of the questionnaire)

**Q5.** Is the subjective state of mind of the 'bad faith' applicant relevant in the assessment of bad faith, i.e. is there a subjective element which is being assessed and, if so, how does the examiner deduce that this subjective element exists in a given case?

**Q6.** Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)? (where the answer can depend on different case constellations, please refer to the detailed questions in (iv) of II. Q1 ~ Q5 of the questionnaire)

**Q7.** Is there a defined list of conditions ('check-list') according to which 'bad faith' is established?

### II. Laws/Regulations and Examination Guidelines/Practices in TM5 Partner Offices, which Deal with Bad Faith Filings

*[JPO comment]The JPO assumed the following five view points which might be applicable to bad faith filings. We welcome your opinion/ input on these categories.*

Please provide any relevant article(s) in laws, regulations, examination guidelines, examination practices, giving specific examples such as examples of examinations, trial decisions, court decisions, etc.

### **Q1. From The View of “Intent to Use”**

Can a filing be refused (or invalidated) for “bad faith” based on the absence of “actual use” or lack of “intent to use” the trademark at the time the application is filed? (Yes/No)

IF YES:

- i) Please provide any provision(s) of the relevant laws or regulations.
- ii) Please provide the timing when the provisions apply, e.g. at the filing date, final decision by examiners, etc.).
- iii) Is the above provision(s) determined by ex-officio examination or is it left to opposition or invalidation/cancellation of the registration”?
- iv) Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)?
- v) Please provide examination guidelines.
- vi) Please provide examination practices.

For example, if a (bad faith) registration is challenged on the basis of non-use, what evidence would be required to prove actual use (is bona fide use in the ordinary course of trade necessary, i.e., whatever use is normal and ordinary in that type of business)?

For example, how are the following facts or circumstances considered, in regard to “Intent to use”?

For example, could applicants be required to submit evidence of intent to use?

- In cases when applicants designate a wide variety of classes or a large number of goods or services
- In cases when applicants file a large number of applications to register the trademarks of others
- In cases when persons (natural persons) designate goods or services that require large-scale equipment or investment. (Example: general retail services).
- In cases when it is clear that applicants will not carry out their businesses in connection with designated goods or services because the scope of the applicants’ businesses are legally limited, or because persons executing businesses connected with the designated goods or designated services are

legally restricted. (Example: agencies for legal procedures relating to lawsuits or other legal issues).

- In cases when it is obvious that the filing is done under the intent to block entry into the market by others.

- In cases where the mark they registered (allegedly in bad faith) is subsequently revoked for non-use?

- Are there other reasons affecting decisions on “Intent to use”?

vii) Please provide relevant examples of examinations, trial decisions, or court decisions.

## **Q2. From The View of “Unfair Intention” Except for Q1**

Is there any legislation for refusing an application (or invalidating the registration) on the basis of unfair intention, except for cases that fall under Q1? (Yes/No)

IF YES:

i) Please provide provision(s) of the relevant laws or regulations.

ii) Please provide the timing when the provisions apply, e.g. at the filing date, final decision by examiners, etc.).

iii) Is the above provision(s) determined by ex-officio examination or is it left to opposition or invalidation/cancellation of the registration”?

iv) Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)?

v) Please provide examination guidelines.

vi) Please provide examination practices.

For example, how are the following facts or circumstances considered, in regard to unfair intension?

-Applicants’ actions or facts involved with filing, such as business partnerships, prior business contacts, demands to buy filed or already registered trademarks, etc. In addition, does it make a difference if the demand for compensation is disproportionately high?

- In cases when applicants designate a wide variety of classes or a large number of goods or services

- In cases when applicants file a large number of applications for trademarks of others

- Are there other reasons affecting decisions on unfair intensions?

- Is any relationship between the original owner of the trademark and the applicant required?

vii) Please provide relevant examples of examinations, trial decisions, or court decisions.

### **Q3. From The View of “Protecting Well-Known/Famous”**

Can a bad-faith filing be refused (or invalidated) based on legislation for well-known/famous marks, including protection against trademark dilution? (Yes/No)

IF YES:

- i) Please provide provision(s) of the relevant laws or regulations.
- ii) Please provide the timing when the provisions apply, e.g. at the filing date, final decision by examiners, etc.).
- iii) Is the above provision(s) determined by ex-officio examination or is it left to opposition or invalidation/cancellation of the registration”?
- iv) Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)?
- v) Please provide examination guidelines.
- vi) Please provide examination practices.

For example, please explain the practical steps and how to evaluate the following points.

- How do you define the difference between 'well-known', 'famous' and 'reputed' trade marks? Do you have any guideline for approving well-known or famous marks? What kind of evidence is needed to establish the fact or degree of “well-known” or “famous” trademarks?
- Could bad faith provisions also apply if the well-known or reputed original mark was registered in the territory in which the bad faith application was made, but had not been used for an extended period of time?
- Do you have any legislation or practice on examination that specifically deals with trademarks that are well known or famous only abroad but are not registered domestically?
- Regarding well-known and famous trademarks that are known only abroad but are not registered domestically, how is “well-known” or “famous” determined? What evidence is needed to prove that the trademarks are well-known or famous?
- Are well-known and famous trademarks protected under other classes or in the area of dissimilar goods and services? (How do you search and examine cross-classes?)
- How does the level of recognition interact with the burden of proof of bad

faith?

(e.g. If the mark has a greater degree of recognition, is less proof of bad faith needed? (or vice versa?)

- Would the level of distinctive character of the mark be taken into account? (For example, in cases when the mark is so fanciful that it is highly unlikely for the applicant to come up with an identical or similar mark by chance.)

- Would the fact that the mark is identical or similar to other' s house-marks be taken into account?

- Is there a time limit for claiming that a mark has been registered or is being used in bad faith where bad faith regarding a well-know or famous mark is concerned?

- Is it relevant if the mark that is claimed to have been applied for in bad faith has acquired itself well-known character or reputation in the territory in which it has been registered?

- Are there other reasons affecting decisions on well-known or famous marks?

vii) Please provide relevant examples of examinations, trial decisions, or court decisions.

#### **Q4. Unfair Application filed by an Attorney**

Is there any legislation for refusing an unfair application (or invalidating the registration) filed by an attorney? (Yes/No)

IF YES:

i) Please provide provision(s) of the relevant law or regulation.

ii) Please provide the timing when the provisions apply, e.g. at the filing date, final decision by examiners, etc.)..

iii) Is the above provision(s) determined by ex-officio examination or is it left to opposition or invalidation/cancellation of the registration”?

iv) Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)?

v) Please provide examination guidelines.

vi) Please provide examination practices.

vii) Please provide relevant examples of examinations, trial decisions, or court decisions.

#### **Q5. From The View of The Relationship with Other Rights**

Is there any legislation for refusing an application (or invalidating the registration) as

bad-faith on the basis of certain factors such as copyrights, rights of publicity, rights to a trade name or other person's name, etc.? (Yes/No)

IF YES:

- i) Please provide provision(s) of the relevant law or regulation.
- ii) Please provide the timing when the provisions apply, e.g. at the filing date, final decision by examiners, etc.)..
- iii) Is the above provision(s) determined by ex-officio examination or is it left to opposition or invalidation/cancellation of the registration”?
- iv) Are there rules on burden of proof? If so, who bears it? Are there situations in which there is a presumption of bad faith (as a result of legal provisions or case law)?
- v) Please provide examination guidelines.
- vi) Please provide examination practices.
- vii) Please provide relevant example of examinations, trial decisions, or court decisions.

#### **Q6. Any other views except for Q1- Q5**

If there are any other views/situations that deal with bad faith filings, please provide information.

### **III. Procedures**

#### **Q1. Procedures for Oppositions in Pre-Publication**

- Are there any countermeasures against bad faith filings by a third party (e.g. providing information before substantive examination by the examiner)?
- If a third party provides such information to examiners, how will examiners/offices deal with such information?

#### **Q2. Integration of Procedures Related to Oppositions or Appeals and Trials**

- Some bad faith filings consist of so many applications. One example is a trademark indicating various goods or services in various fields. In cases like this, it seems that all the evidence proving “intent to use” or the degree of “famous/well-known” could be the same. In connection with this, are there any procedures to consolidate several trials?

### **IV. Others**

- Please provide measures or policies that you have in place for dealing with bad faith filings, and if there are any specific matters that should be noted in particular.