

# 「Comparative Analysis on TM5 Trademark Examination Results」

**October, 2021**

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## Project of ‘Comparative Analysis on TM5 Trademark Examination Results’

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### ○ Overview and Objective

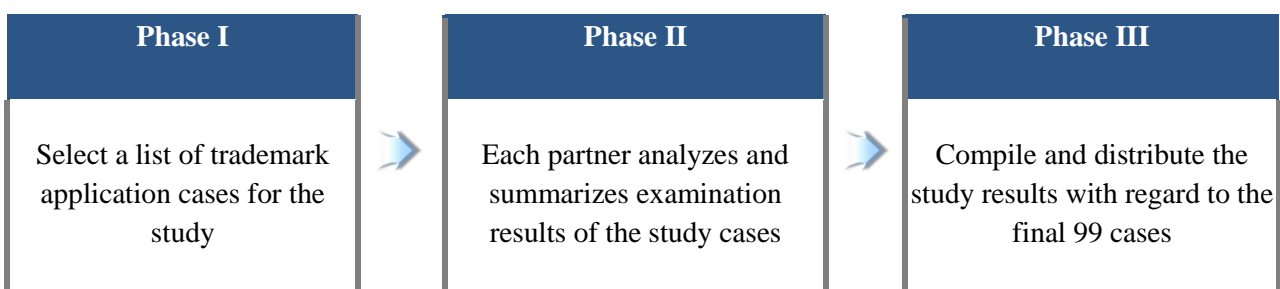
- As the TM5 Partners have their own trademark examination standards, applicants can be confused due to some divergences thereof. Hence, we conducted a study to compare and analyze examination results of international trademark applications commonly filed through the Madrid Protocol. Based on the study result, we will produce and provide the user guidance by summarizing characteristics of each jurisdiction’s examination standards to support international applicants.

### ○ Progress

- We completed a preliminary study, after each of TM5 Partners had conducted comparative analysis from June 2016 through May 2017 on 49 cases which had been selected among international trademark applications commonly filed in five jurisdictions through the Madrid System. The second study was conducted with another 50 cases in the same way from January 2018 through May 2019. The results were drawn from the comparative analysis on a total of 99 target trademark applications examined by TM5 Partners.

### ○ Methods

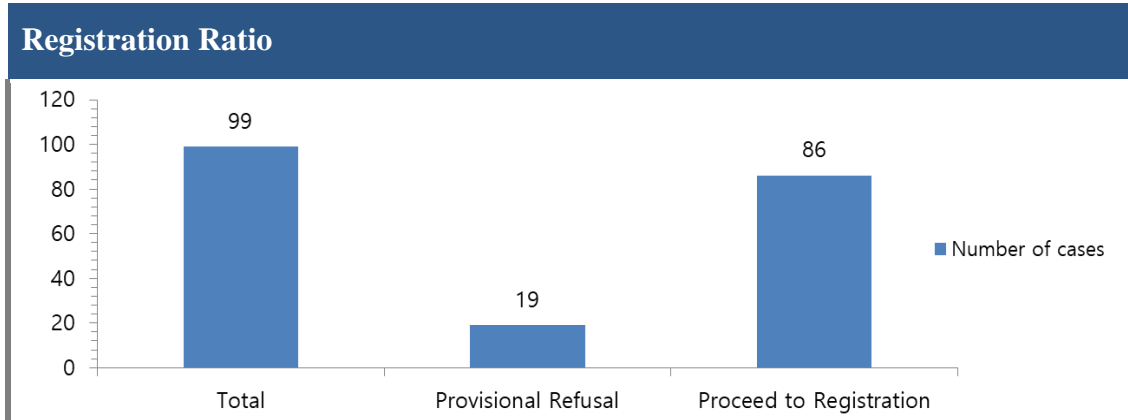
- TM5 Partners respectively selected 30 trademark applications commonly filed in TM5 jurisdictions through the Madrid System, and among them 10 cases were chosen for the study by each Partner (this was completed twice);
- With respect to the study cases finally selected, TM5 Partners set out ① their general guidelines for trademark examination ② the provisions applied to rejected cases, refusal grounds, remedies to overcome the refusals and whether to grant registration;
- Based on each Partner’s detailed comparative analysis on examination results, we produce the guidance for users including considerations they need to take when filing a trademark application.





## Europe (EUIPO)

- Europe has **high probability of registration** among TM5 members, along with the USA, **with the lowest provisional refusal cases.**




- \* Only 19 cases out of the 99 cases had been refused provisionally and the final 86 cases were registered afterwards as the refusal grounds were overcome.

**Refusal Grounds & Number of Cases**

Grounds	Provisional Refusal	Final Refusal
Non-distinctiveness of the mark	13	11
Opposition filed by an identical or similar prior trademark holder	5	2
Non-submission of documents related to collective marks	1	0

- Europe shows the **highest number of refusal cases** based on **Non-distinctiveness of the mark.**

Case	Comments
 (1173096)	The mark is non-distinctive since the consumer will understand the mark as “A system for speaking to someone on the telephone with an advantage quality”
EXPRESSROUTE (1187078)	The mark is non-distinctive since the customers only recognize that the quality of the services is “very fast-path services that a message taken from its source to its destination”

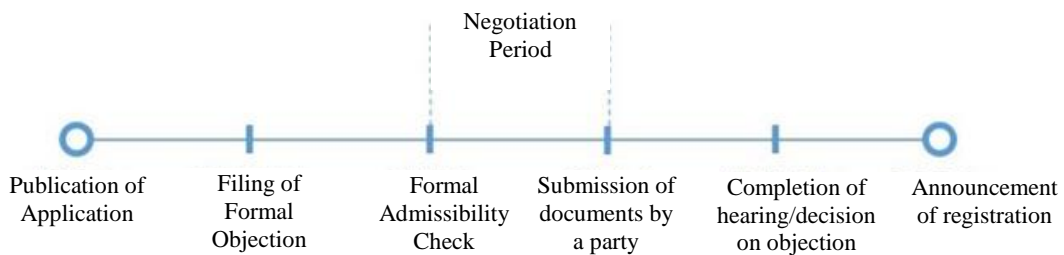
○ In addition, **none of the 99 cases were refused on the ground of the comprehensiveness or the lack of clarity of goods/services.**

- Europe examines identification of designated goods/services entered in trademark application based on the “**Nice Classification**,” and has a wide range of acceptance in examining goods/services. Regarding generic names, **Class Headings<sup>1</sup> of the “Nice Classification”** are generally acceptable, thereby practically causing no grounds for refusal regarding the matter, and vague identifications are mostly accepted within their literal meaning where the names of goods/services are actually known and used by the consumers and suppliers in the market.

○ **Absolute grounds for refusal<sup>2</sup> are examined ex officio; however, relative grounds for refusal<sup>3</sup> of the trademarks previously registered or filed shall be examined only when opposition is filed.**

- **Opposition** proceedings begin when a third party requests the Office to reject a European Union trade mark application (EUTM application) or an international registration designating the EU on the basis of the earlier rights it holds in the European Union (such as an EUTM, a national mark protected in Member State of the EU, an earlier well known mark, an earlier non-registered trade mark or any other signs used in the course of trade of more than mere local significance).

#### <Opposition Proceeding>



○ **EUIPO does not examine similarity to the earlier filed or registered marks at application level.**

- The distinct nature of EUTM examination is that there is an investigation regarding the existence of possible trademarks which are identical or similar to the trademark for which an application is filed. If any marks are found, the Office notifies both the applicant and the right holder of the prior trademark; however, this notice is not a ground for refusal but a simple notification. It is up to the right holder of prior trademark whether to oppose the registration of the subsequent application by filing a formal objection (opposition). This search is systematic regarding earlier European Union trademarks and optional for national searches in six Member States against payment of a fee.

<sup>1</sup>Class Heading: Name or title representing each goods and entire goods or services of service businesses under the Nice Classification;

<sup>2</sup>Absolute grounds for refusal: The grounds for refusal without any conditions or restrictions (i.e. distinctiveness);

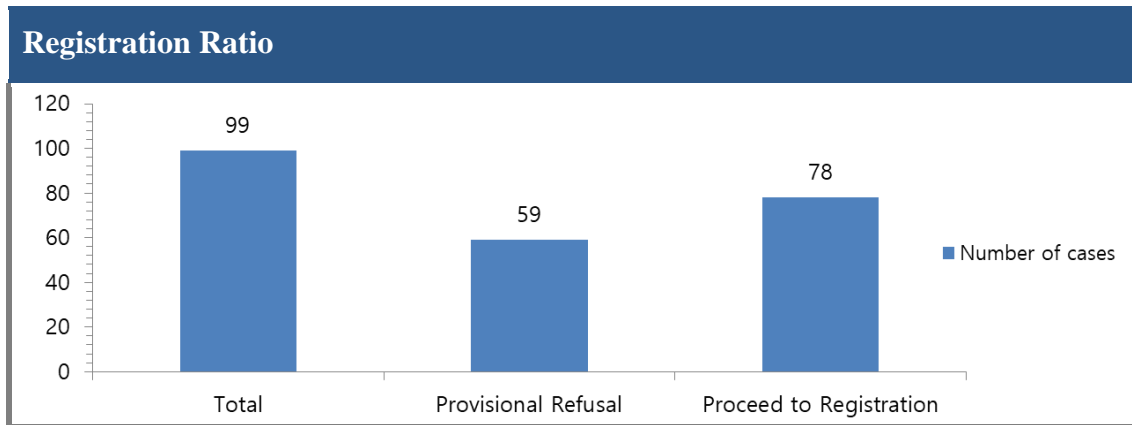
<sup>3</sup>Relative grounds for refusal: The grounds for refusal rendered based on the analysis of relationships conflicting or comparative;

### Key Point

- o A member country where **trademark registration is the easiest** because the grounds for refusal rarely occur; however, EUIPO examination is unique in the sense that meanings in 23 languages are examined, objection in either one of these languages is enough to refuse registration.
- o **Advance search must be performed** as the **possibility for opposition filing** by the right holders of identical/similar prior trademarks **persists**;
- o Europe **accepts** most **Class headings of the Nice Classification**, which are understood as being generic terms, and **identifies goods/services using criteria of clarity and precision.**

## Japan (JPO)

- In Japan, most of its **grounds for refusal are based on comprehensiveness/lack of clarity of the goods/services**, and Japan also displays unique tendency, that is, some cases are **refused by being subject to ascertaining the intent to use of marks**.




- \* Out of the total 99 cases, 59 had been provisionally refused, but finally 78 cases were registered including those overcame the provisional refusal.

**Refusal Grounds & Number of Cases**

Grounds	Provisional Refusal	Final Refusal
Comprehensiveness and the lack of clarity of goods/services	40	11
Similarity to the first filed or registered marks	18	7
Ascertainment of intent to use	15	4
Non-distinctiveness of the mark	9	7
Deceptive marks	4	2
Non-submission of documents related to collective marks	1	1
Use of famous person's name or title	1	0

- The most frequent ground for refusal is comprehensiveness and the lack of clarity of goods/services.

The number of provisional refusals referring to this ground are relatively large than those by other TM5 offices. Therefore, it is recommended to check the goods/services on the J-PlatPat beforehand. (URL: <https://www.j-platpat.inpit.go.jp/t1201>)

Case	Comments
 (1208733) <hr/> Y means "Yes" (1170315)	Vague and broad description of services Publication of education materials → <i>Publication of education textbooks</i>  Vague and broad description of goods Leggings → <i>legging(trousers), leggings(leg warmers)</i>

○ Among TM5 member countries, Japan has a **relatively high number of cases refused by being subject to ascertaining the intent to use of marks.**

- To reduce trademarks not in use, the JPO issues a provisional refusal against trademark applications which designate goods/services ranging widely in one class to confirm applicants' actual use or intent to use. Applicants can overcome this ground for provisional refusal by providing documents proving that the applicant is conducting business in connection with the designated goods/services or showing that the applicant has will and plans to conduct business thereof.

○ Japan examines identifications of goods/services based on the “**Examination Guideline on Similar Goods/Services,**” and a **written statement by an applicant is required to be submitted** when it is necessary to explain the specifics of the goods/services, such as a **new identification of goods/services previously not existed.**

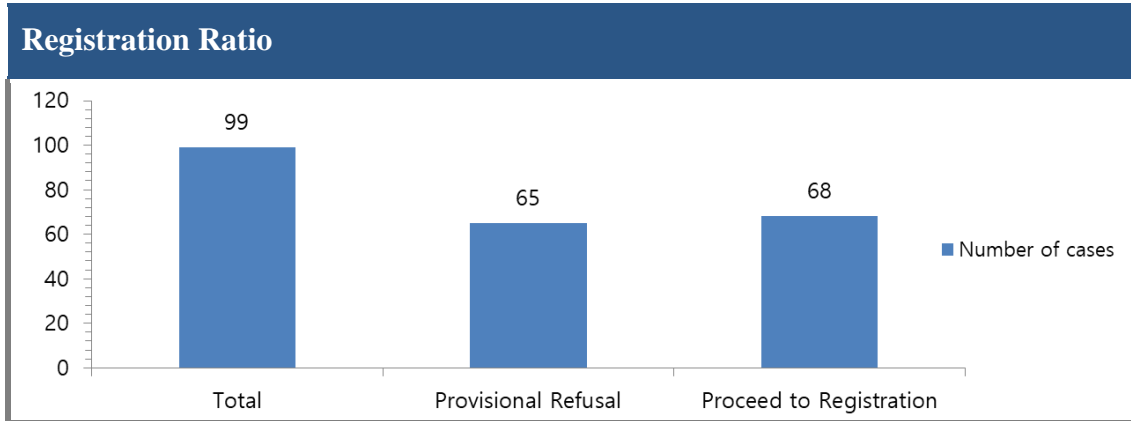
### Key Point

- Since **the marks without intent to use** are actively employed as the practical grounds for refusal, **an applicant is required to prove the fact of using and intent to use the mark** in such cases.
- To overcome the grounds for refusal, applicants need to cooperate with the examination process, that is, to respond to the provisional refusal by submitting documents such as amendments and written opinions as necessary.



## Korea (KIPO)

○ In Korea, most of its grounds for refusal are based on **comprehensiveness/lack of clarity of the goods/services, identical/similar prior marks and non-distinctiveness of marks.**

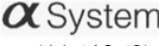


\* 65 out of the 99 cases were provisionally refused and 68 cases were eventually registered by overcoming the ground for refusals.

**Refusal Grounds & Number of Cases**

Grounds	Provisional Refusal	Final Refusal
Comprehensiveness and the lack of clarity of goods/services	30	10
Similarity to the first filed or registered marks	24	12
Non-distinctiveness of the mark	23	18
Famous marks	1	1
Deceptive marks	1	0
Ascertainment of intent to use	1	0



○ Korea shows the **highest number of refusal cases** based on **comprehensiveness and the lack of clarity of goods/services.** If the purpose, material, condition, or operation of the product is unclear, the KIPO issues a provisional refusal against a trademark application but the applicant can overcome such provisional refusal by amending the application with a more specific and clear identifications of goods/services.

Case	Comments
BEAUTY MEETS INNOVATION (1198333)	Unclear purpose of goods fragrances → <i>fragrances for personal use [perfume]; fragrances for household purposes</i>
 System (1164362)	Vague and broad description of goods Electronic machines, apparatus and their parts → <i>electronic coding units</i>
MYCOFE (1186691)	Unclear purpose and operation of goods ice cream makers → <i>electric ice cream makers for household purposes</i>

O KIPO appears to have **relatively strict criteria for non-distinctive marks**, resulting in 18 final refusals, which is the highest number among TM5 Partners in this category.

Case	KIPO	Comments
L'O (1165961)	X	The mark is non-distinctive since it is a simple combination of the letters "L" and "O"
SHARED GOALS. SHARED SUCCESS. (1111131)	X	It is a trademark that cannot be identified by the consumer as to what kind of business the product is related to; this is considered to represent a slogan or sales message in connection with the designated goods/services

O There are relatively **more** provisional refusal cases arising from **identical/similar prior marks** than any other TM5 Partners.

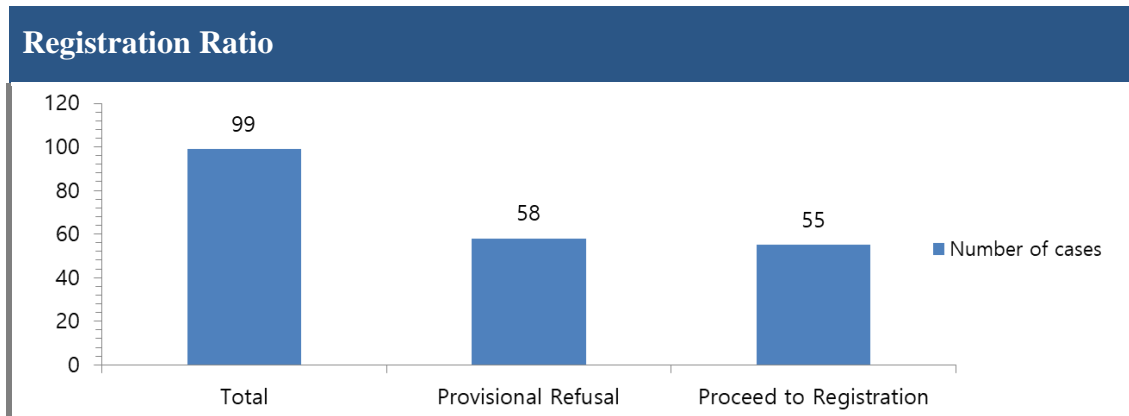
Case	Prior Mark	Comments
<b>HiSense</b> (1164392)	 (flow by hisense)	The mark cannot be accepted because it sounds the same as 'hisense', the dominant part of the prior mark
INVISIBLE 'SCREEN (1161007)		The mark cannot be accepted because they are similar in sound and meaning to prior mark

### Key Point

- o Korea has more final refusal cases on the basis of identity/similarity to a prior filed/registered mark than any other TM5 Partners.
- o Korea has **the highest number of refused cases based on non-distinctiveness of trademarks** among TM5 partners, and **relatively strict examinations are conducted regarding the relevance between the marks and designated goods/services.**
- o A trademark consisting solely of a simple and common sign is considered to lack distinctiveness and cannot be perceived as a source identifier.

## China (CNIPA)

O In China, most of the reasons are the **similarity to the first filed or registered marks or the lack of distinctiveness**.



\* Out of the total 99 cases, 58 cases were provisionally refused and the final 55 cases were accepted to register after overcoming the refusal grounds.

**Refusal Grounds & Number of Cases**

Grounds	Provisional Refusal	Final Refusal
Similarity to the first filed or registered marks	32	25
Non-distinctiveness of the mark	19	15
Comprehensiveness and the lack of clarity of goods/services	5	1
Deceptive marks	2	2
The nature of exaggeration and fraud in advertising	2	2
Contrary to socialist morality and such	1	1
Use of conspicuous geographical indication	1	0

O There are relatively **more cases** of refusals based on **Non-distinctiveness of the mark**.

Case	Comments
NanoMultispring (1160774)	The mark is non-distinctive since the mark consists exclusively of indications that direct reference to the technical characteristic of the goods

- O There are **5 cases of refusals stemming from comprehensiveness/lack of clarity of goods**, most of which were refused because of the issues with the **Class 35 ‘Wholesale and Retail Services.’**
- China basically does not accept wholesale or retail service for individual goods (Class 1 to 34) in Class 35. However, as an exception, 'wholesale or retail service of medicine' has been accepted.
- O For the **unique cases of the grounds for refusal in China**, a mark could be rejected on the grounds that the mark falls under the **‘trademark contrary to the socialist moral customs or having other negative impact to the society.’**

Case	Comments
RIOT POINTS (1113191)	Determination was made where ‘RIOT’ means civil commotion and the mark delivers unhealthy influence

- O China basically complies with the clarity of identifications listed in the Nice Classification and examines the name of designated goods based on the **‘Similar Goods & Services Classification.’**
- Article 15 of the Enforcement Ordinance of the Trademark Law in China prescribes that the **description of goods shall be submitted where the identification of goods not listed in the ‘Similar Goods & Services Classification’ is indicated.**
- O Unique Features of Trademark Examination Process in China
  - **Examination on goods and formalities<sup>4</sup>** are conducted as a preliminary examination, and amendment will be ordered where irregularities are found, whereas a receipt of application will be issued if not. When the amended goods are not accepted, the application will be finally refused; hence, the possibility for registration will be escalated if amendment is made by using the goods listed in the ‘Similar Goods & Services Classification.’
  - **When the grounds for refusal arise after a substance examination, a final office action of refusal will be immediately issued** without giving an opportunity to submit opinions to the applicant. In order to protest such decision, the applicant may respond by means of a request for review through the Trademark Review and Adjudication Section.<sup>5</sup>

In relation to the examination system, it is a required procedure for Korea, Europe, Japan, and the U.S. to allow the applicant to submit a written opinion as a response to provisional refusal after substantive examination, while it is unique that China is discretionary concerning the matter.

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<sup>4</sup>Formality Examination: A procedure examining whether the application documents, including an application form and written statement, fulfill procedural and formal requirements stipulated by the applicable laws.

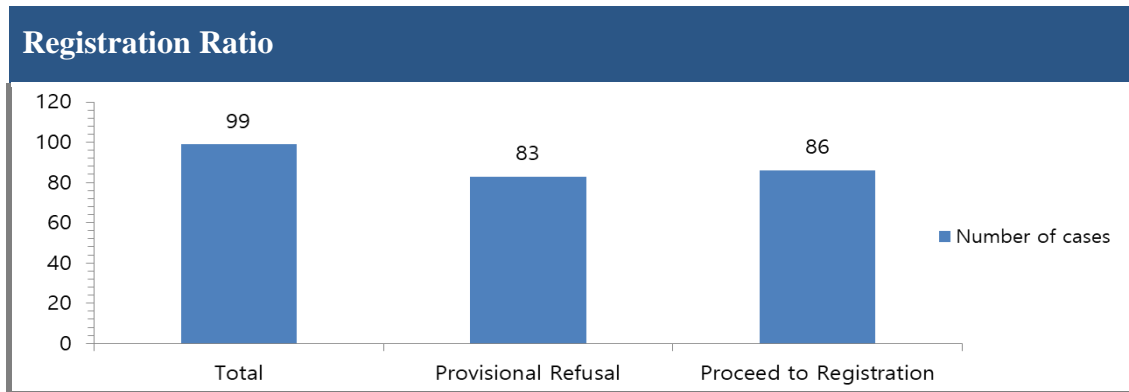
<sup>5</sup>Trademark Review and Adjudication Section: A section which reviews and examines trademarks.

### Key Point

- o **During the phase of substance examination, under Rule 17(5)(e) of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, a request for appeal against decision of refusal to the Trademark Review and Adjudication Section needs to be claimed.**
- o **Because China offers the lowest final registration rate among TM5 partners, it is necessary to fully prepare for trademark applications in a meticulous manner.**

## USA (USPTO)

- The USPTO has the **high probability of registration** among TM5 members, however, it provides **formality checks and substantive examination rejections together, resulting in the largest number of grounds for provisional refusals.**



- \* 83 of the total 99 cases were provisionally refused and 86 cases eventually attained registration by applicants either complying with all application filing requirements or successfully arguing against it.
- \* **Most applicants overcame the grounds for refusal by providing written responses, which resulted in the highest final registration rate among TM5 Partners along with Europe.**

**Refusal Grounds & Number of Cases**

Grounds	Provisional Refusal	Final Refusal
Lack of required specificity or clarity of goods/services	69	10
Unclear description of the mark	39	4
Disclaimer required	26	2
Failure to claim ownership of a prior registration	18	1
Similarity to prior filed or registered marks	14	5
Failure to provide applicant's entity/ and/or citizenship	13	1
Unclear transliteration/ and/or translation statements	10	0
Failure to provide color claim and description	7	1
Non-distinctiveness of the mark	4	1
Insufficient information about the nature of the goods	3	1



○ Among TM5 Partners, the U.S. had the **highest number of refused cases** based on **lack of required specificity or clarity of the goods and services**.

Case	Comments
HOMESAFE (1184010)	Vagueness and broadness of goods Checking apparatus and instruments → <i>speed checking apparatus for vehicles</i>

○ The U.S. **recognizes the Nice Classification as the standard for classification but does not accept example identifications as listed in Nice, and examines all goods and services based on USPTO’s ‘Acceptable Identification of Goods and Services Manual (ID Manual),’** which is a more comprehensive, specific and independent guideline of its own. Goods and services not found in the ID Manual may still be acceptable, but must meet the USPTO’s rules regarding specificity and clarity.

- **Examination is conducted in order to clarify classes of goods or the scope of rights for the goods,** and the examining attorney will generally suggest an acceptable identification of goods/services if the applicant has submitted one that is not acceptable.

○ If a trademark application is rejected by the grounds of unclear description of the mark, the applicant should provide **a more detailed description of the mark**. The examining attorney will generally suggest an acceptable description of the mark if the applicant has submitted one that is not acceptable.

Case	Comments
 (1187626)	It does not describe all the significant aspects of the applied-for mark
 (1180091)	The mark is not standard characters, applicant must provide a more detailed description of the applied-for mark

○ **With respect to distinctiveness, the U.S. is the Partner that requires disclaimers<sup>6</sup> the most frequently.**

- Among TM5 Partners, the U.S. prescribes the provision of disclaimer, and the U.S. tends to require disclaimers more often than Europe.

○ When a refusal issues because it is unclear whether the applicant owns a previously filed **application or registration which is identical/similar to the trademark for which an application is filed,** the applicant must submit a declaration that **it is the owner of the prior registration or application.**

<sup>6</sup>Disclaimer: When a filed trademark contains the parts that are non-distinctive, its application form and registration certificate states that an exclusive right for such parts shall not be claimed.

- With regard to the refusal based on unclear translation/transliteration of letters, **a transliteration and translation is required for marks which are not in Latin characters, and a translation is required for Latin character marks that are not in English.**
- When applications are filed from Korea, China, Japan and some of **non-English-speaking** European nations, **refusals have been issued in relation to the above on numerous occasions.**
- For **trademarks with signs and colors combined, failure to claim the presence of color and describe its location in the applied-for mark will be subject to the grounds for refusal.**

#### ○ **Attainment and Maintenance of Rights under Principle of Use**

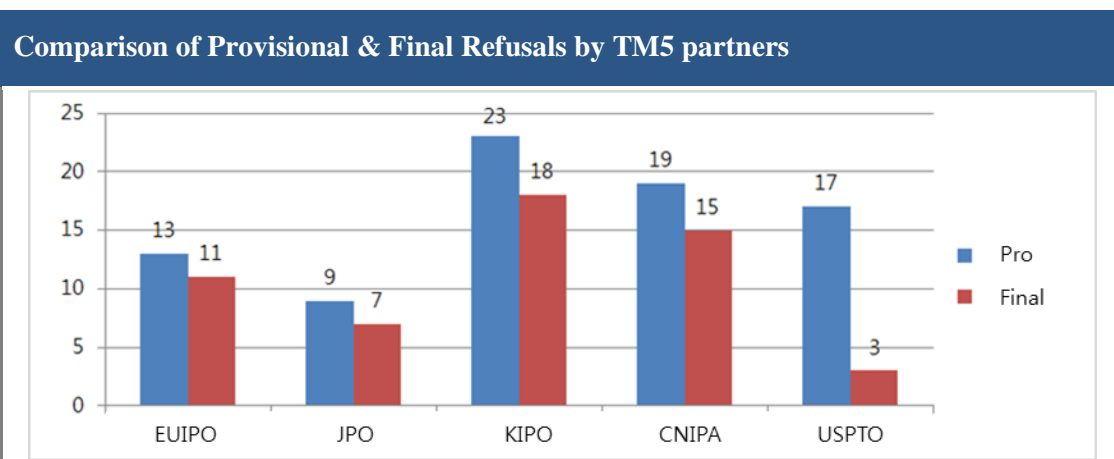
- While most countries employ the “**First-to File**” regime which grants rights when a trademark is registered, the U.S. utilizes the “**First-to-Use**” regime which recognizes rights for using the trademark first. First-to-use means that trademark holders establish rights in a trademark through use of the mark in commerce. Applicants must submit documentary evidence demonstrating use of the mark in commerce during the application process before the mark is registered.
- The applicant is required to submit evidentiary documents showing use of the mark once again between the 5th and 6th year following the registration of the trademark and also between every 9th and 10th year following the registration, which is also the period for registration renewal. As evidenced above, the U.S. ensures trademark rights are maintained only for those trademarks and goods that are proven to be in actual use.
- **The Principal Register and Supplemental Register systems** are also based on the principle of first-to-use in the U.S. In general, trademarks registered after all requirements for registration are fulfilled are registered to the “Principal Register”, whereas trademarks are registered to the “Supplemental Register” if they satisfy other requirements for registration but are not recognized for their “distinctiveness.” The Supplemental Register does not grant all of the benefits of the Principal Register, but it is possible to convert some marks to the Principal Register if the trademark acquires distinctiveness.



### Key Point


- o Among TM5 Partners, the U.S. issues more initial refusals but also registers **the most cases** once these refusals are overcome by the applicant.
- o Among TM5 Partners, the U.S. refuses the most cases based on **lack of specificity/clarity regarding the goods and services**. It is necessary to refer to the entries in the ‘**Acceptable Identification of Goods and Services Manual**,’ for guidance on crafting acceptable identifications, rather than relying solely on the Nice Classification.
- o **Examinations on formalities are conducted together with substantive examinations**. Rejections based on formalities are common; hence, it is necessary to **review the details concerning formalities examination** when filing an application.
- o Initial refusals of applications **frequently occur** based on the **failure to enter a disclaimer for lack of distinctiveness** of a particular term or feature of the mark, as well as for **failure to indicate the colors found in trademarks appearing in color**.

## Comparison of Refusals based on Distinctiveness



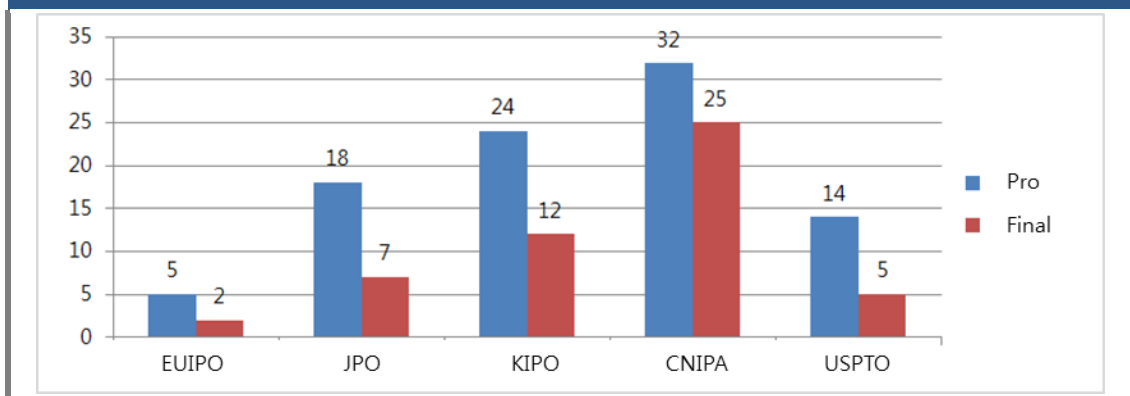
\* The number of final refusal cases regarding distinctiveness is relatively high in Korea and China. While the number of provisional refusal cases in the U.S. was high, the majority of the refusals were eventually overcome by submission of responses by the applicant.

Comparison of 4 sample cases refused in some offices by lacking distinctiveness are shown below. And for more specific information including goods and services, please refer to the Madrid Monitoring system.

Refusal Cases						
CASE	EUIPO	JPO	KIPO	CNIPA	USPTO	REMARKS
<b>HOMESAFE</b> (1184010)	O	X	X	X	O	It is non-distinctive and misleading as to the quality of the goods or services (similarly examined by Korea, Japan, and China).
<b>OP9</b> (1163533)	O	X	O	X	X	The mark merely describes a feature, ingredient or characteristics of applicant's goods (similarly examined by Japan, China, and U.S.).
 (1108281)	O	O	X	X	X	The main part of the trademark, "GRAND WINES", misleads as to the quality of the goods or services (similarly examined by Korea, China, and U.S.).
<b>MicroCapture</b> (1115820)	X	O	X	O	O	It is perceived intuitively by consumers as an object that can catch or obtain even the smallest things (similarly examined by Korea and Europe).




## Comparison of Refusals due to Similarity to Earlier Marks

Comparison of Provisional & Final Refusals by TM5 partners

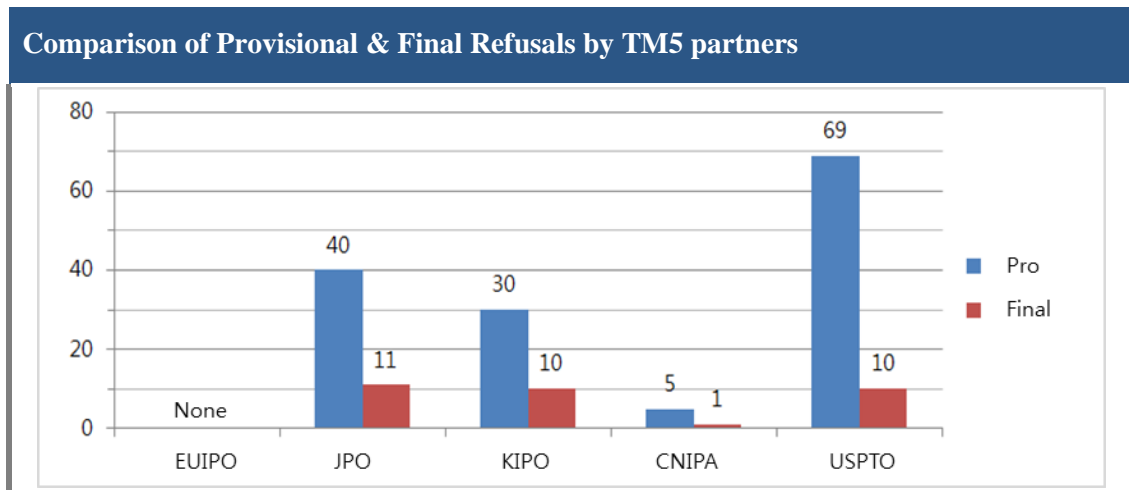


\* The number of cases refused due to the similarity of marks is relatively high in Korea and China. In Europe, many of the refusals were eventually overcome by deleting the goods/services in conflict.



Refusal Cases

CASE	EUIPO	JPO	KIPO	CNIPA	USPTO
 (1192421)	O	X ウーフー WooHoo	X 	O	X 'WOOUF!'
 (1159264)	O	O	X OTTIMO Optimos	X OPTIMA OptiQ	X Optimos
APAMAN (1111006)	O	O	X apaman shop apaman shop with Japanese characters	X Ataman apamanshop	O

## Comparison of Refusals due to Comprehensiveness and Lack of Clarity



\* The number of final refusal cases regarding specificity and the lack of clarity is relatively high in the U.S., Japan, and Korea. However, a large number of the refusals were overcome upon submission of responses by the applicant.

Refusal Cases						
CASE	EUIPO	JPO	KIPO	CNIPA	USPTO	REMARKS
 (1201522)	O	X	X	X	O	[Class 16] gift cards → note cards used with gifts (JAPAN) [Class 25] hats → top hats; rain hats (KOREA) [Class 35] 'Retail and wholesale services' is not acceptable (CHINA). * The mark has vague/broad description with regard to the designated goods in Class 16 (JAPAN), 25 (KOREA), and 35 (CHINA).
 (1107106)	O	X	X	O	X	[Class 14] goods in precious metals or coated therewith, not included in other classes; → <i>accessories in precious metals or coated therewith</i> ; [Class 18] goods made of these materials and not included in other classes; → <i>bags of leather</i> ; (KOREA) * The mark has vague/broad description with regard to the designated goods in Class 14 (JAPAN), 14/18 (KOREA), 14/18/20 (U.S.).