

TM5

Manga Booklet

**For Counter Measures
Against Bad-Faith
Trademark Filings**





What is it?

You are able to provide useful information for examinations such as that a TM application does not satisfy the requirements for registration or falls under the grounds of unregistrability.

The provision of of useful information for examinations contributes to accurate and fast examinations. This system is helpful for countermeasures against Bad faith filings.

Outline (requirement)

Who? - Anyone

When? - As long as application is pending at the JPO

How much? - Free of charge

For which provision? - another person's well-known mark, contravention of public order or morality, distinctiveness etc.

What documents? - a periodical, catalogues, pamphlets and trading documents etc.

For detail: https://www.jpo.go.jp/e/system/trademark/shinsa/touroku_jouhou.html

Be aware of the scope of Trademark Protection

Do a TM Search to Prevent Bad-faith Filings



All done! Anyhow, my trademark has been registered. what a relief.



We want to extend our product line to include real "robots" someday, but should focus on the core business for now.



A few years later...

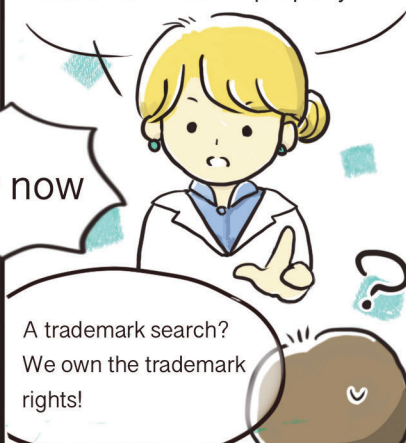
Our business is doing well! Let's extend our product line to include JPO branded "robots" that has always been our dream...



Have you done a trademark search properly?

Hey now

A trademark search? We own the trademark rights!



- ✓ The scope of protection depends on the type of goods.
→ You have the right to use the trademark for the goods "toy"!
- ✓ In Japan, the "J-PlatPat" search engine is available.
- ✓ A trademark search helps us to stop bad-faith trademark filings.

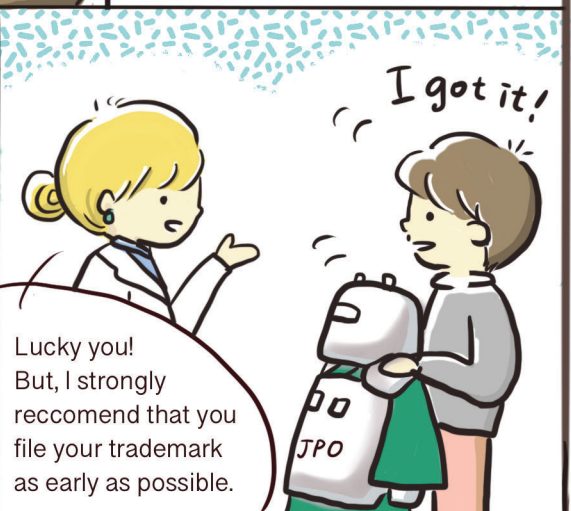
Trademark Search is Essential!

There's no prior trademark for our goods "robots"!




A month later...

We have found that someone filed the same trademark, and his filing date is just a few days later. This time, we were OK because we filed our trademark earlier.



 Trademark protection has no effect on any of the goods/services that are not similar to the designated goods/services.

 It may be that your trademark is being targeted. If you have a plan to extend your product line, file your trademark as early as possible!

 The J-platpat is the database of trademarks registered in Japan you can use for free. Using this database, you can do a trademark search before you file your trademark, and watch out for a bad-faith trademark to take a preemptive action!

 Trademarks by nature are territorial. Thus, the applicant needs to file his trademark on a country by country basis.

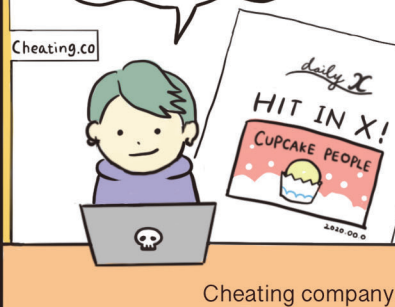
 J-platpat <https://www.j-platpat.inpit.go.jp/t0100>

Tips

A Bad-faith Filing can Lead You to...



Boy, these popular cakes in country-X are not sold and the trademark has not registered in Japan yet!



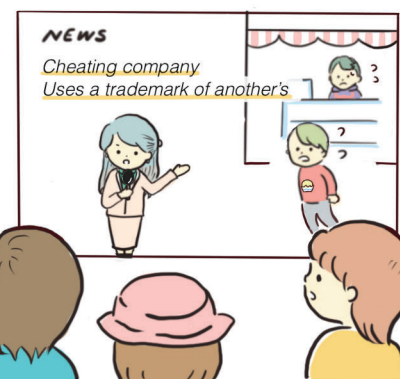
And then, in Japan...



But then, on the website...



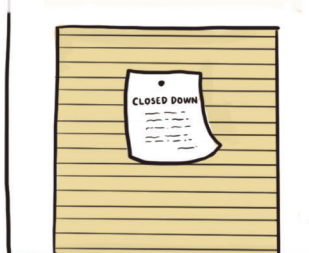
Japanese consumers bombarded with a responsible company with criticism on social media.



Then, it was featured in the news on TV and more Japanese consumers blamed the company.



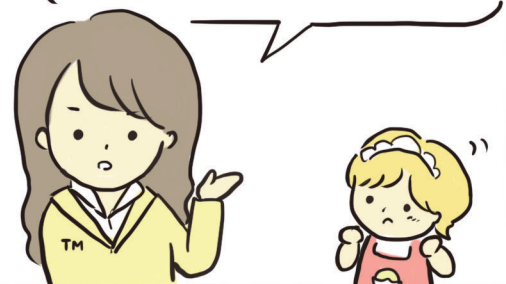
Eventually, they published an apology and their shop was forced to close soon.



Moreover, the trademark owner filed an opposition to revoke the registered trademark.



This time, you were OK, but it's not easy to revoke the registered trademark. If you have a new plan for your business, don't forget to file your trademark first!



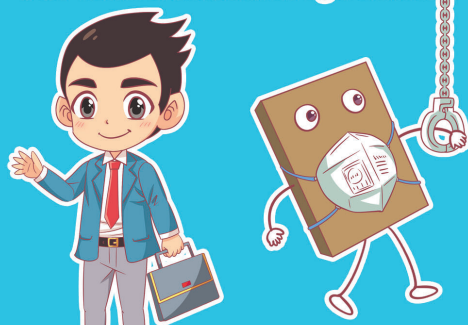
- ✓ Even if you could start your business in Japan and register the trademark which is well-known abroad but unknown in Japan, this kind of information spreads on social media as most people are internet users. As a result, a responsible person can get bombarded with criticism by the society.
- ✓ If the unfair intentions become apparent afterwards, the registered trademark may be revoked.
- ✓ It is not a good idea to file a bad-faith trademark even if it is not registered in the country yet.
- ✓ Each country provides regulations to revoke the registered trademark filed in bad faith. The TM5 has published the Case Examples of Bad-Faith Trademark Filings, which you can use as a reference.

TM5 Bad-Faith Trademark Filings(English) <http://tmfive.org/continuationexpansion-of-bad-faith-project-2-2-2-2/?red=>



The story of Xiaoming and trademark

Cracking down on bad-faith trademark registrations

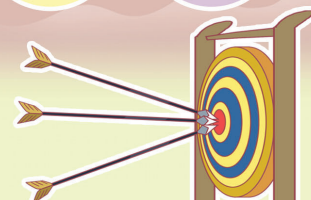


In 2019, China's Trademark Law was amended for the fourth time to include a key change involving banning bad-faith applications for trademarks not for practical use from the source.

初审

异议

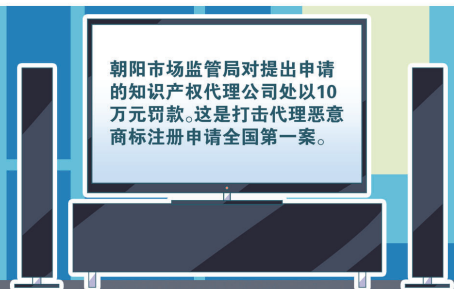
评审



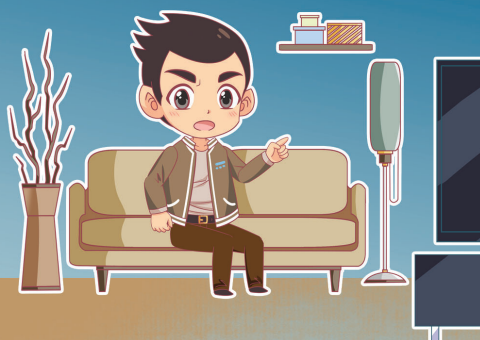
The Trademark Office of CNIPA has strengthened coordination throughout the examination, opposition and review process to precisely crack down on bad-faith applications for trademarks not for practical use.



According to the new Trademark Law, bad-faith applications for trademarks not for practical use will be rejected.



The China National Intellectual Property Administration (CNIPA) rejected 63 bad-faith applications for trademarks related to the COVID-19 pandemic including Huoshenshan. The intellectual property agency filing the applications was fined RMB100,000 (\$15,210) by the Market Supervision Administration of Chaoyang District, Beijing.



That was too much! They took advantage of public attention on the epidemic to file trademark applications. I support CNIPA's decision.



CNIPA has taken a firm stand to crack down on bad-faith trademark applications involving the epidemic. It asked relevant local authorities to question and punish applicants and agencies infringing relevant regulations and require violators to make corrections.



Those measures safeguard social justice and fairness and create a favorable social atmosphere for epidemic prevention and control.



Xiaoming's tips: Although the application for trademark registration is the most convenient and efficient way for market entities to conduct IP protection in market operation, the application shall not violate the Trademark Law or the Rules on Regulating Trademark application and Registration Conducts.



Cancellation of Bad Faith Trade Marks

Measures against Bad Faith Filings





Business is going well. Should I file a trade mark application? No need to rush, everybody knows the name of my bakery!!

SUGDREAM



Ha! SugDream isn't registered yet! I will register it before they do!!



Some days later

Oh no! Now I want to register the trade mark but someone else got there first! What can I do? Help! I will ask the EUIPO.



This could be a **BAD FAITH** filing! That is an application for registration with the intention of undermining the interests of third parties in a manner inconsistent with honest practices. In other words, someone is registering trade marks with malicious intentions.

INFO



So, can I prevent a bad faith filing?

No, you can't, but you can apply to have the mark cancelled by the EUIPO or a national court once the mark has been registered. The EUIPO or the court will examine the facts/evidence.



Don't panic! A trade mark registration can be declared invalid if it can be proved that the trade mark owner was acting 'in bad faith' when they filed it.

INFO



The EUIPO or the court will examine the facts/evidence. Are the signs identical/confusingly similar? Did the applicant know about your mark? Is there dishonest intention?

COURT



Result: the trade mark will be declared invalid from the filing date.

Now I can file my trade mark!

The relevant point in time is the application date of the trade mark registered in bad faith.

Invalidity applications can be successful even if the trade mark registered in bad faith was for different goods and/or services.

Burden of proof: it is up to you to prove that the other party acted in bad faith.

Fee for invalidity application: EUR 630

For info visit [EUIPO trade mark guidelines webpage](#)



Korean Intellectual
Property Office

1. Information Provision System against Bad-Faith Filings

POPO TV

It is one of the most popular cookies these days. I'll try them and tell you how they taste!

A influencer POPO!

Wow~!!!

The sale has sharply increased after streaming

month	sales
2	1.0
3	1.5
4	2.0
5	2.5
6	3.0
7	3.5

Hey, your business seems to be going great!

When will you get trademark registration? It's very important for your business.

I registered mine last year.

Trademark registration?

Someone has filed to register the same trademark.

Huh...! What am I supposed to do?

In this case, you should remember "Information Provision System" of KIPO.

Provision of information System

- * Who can use? Anyone
- * When? Before the decision of TM registration
- * How much? Free of charge

I'll prevent the registration of a bad-faith trademark through the 'Information Provision System'.

The examiner may refer to "provision of information" during the examinations.

Result of the review on provision of information

been ☒ accepted been ☐ dismissed

The provision of information was accepted.

Refusal!

It has been a hard time to get back my TM right. It is important to file applications in Korea as early as possible.

- * The trademark "A" is a randomly selected mark for this illustration.
- * As provision of information is available in the process of examination, bad-faith TM filings can be refused in a short period of time without charge. It helps secure a business by prohibiting the registration of illegitimate trademarks.



2. The Scope of Trademark Protection

— Things to consider when expanding your business —

<p>REGISTERED TRADEMARK Cookies, class 30</p>	<p>Thanks to you, I was able to protect my TM right.</p>	<p>My business is also going well. So, I plan to sell fruit juices too!</p> <p>Best New</p>
<p>It tastes better with cookies. Have you ever thought about any names for juice?</p> <p>Of course, it should be the same as cookies. Is there any problem?</p> <p>I already registered my trademark!</p>	<p>The scope of trademark protection trademark is limited to the designated goods/services. If you have new goods or services, an additional application is required.</p> <p>Fruit juice falls into a different category from cookies. You need to register new one.</p>	<p>REGISTERED TRADEMARK Cookies, class 30</p> <p>fruit juices class 32</p> <p>The certification says that cookies are in class 30. But fruit juices are in class 32.</p>
<p>Should I search again if there is any prior trademark?</p> <p>[A] no results !!!! KIPRIS "TN=[A]" No results</p> <p>Absolutely! Fortunately, there is none.</p>	<p>class 25 class 43 class 28 </p> <p>restaurant</p> <p>The KIPO classifies goods and services into 45 groups, from class 1 to class 45.</p> <p>It is recommended to use KIPRIS to search trademarks registered by others!</p>	<p> fruit juices</p> <p> cookies</p> <p>I got it!</p>

- * The trademark "A" is a randomly selected mark for this illustration.
- * Trademark registration in the Republic of Korea has effect only within the territory of ROK.
If the applicant wants to use it overseas, (s)he needs file an application on a country by country basis.
- * KIPRIS(<http://kipris.or.kr>) is a search engine provided by KIPO. You can search and browse data, applied for or registered trademarks in Korea, for free.



Korean Intellectual
Property Office

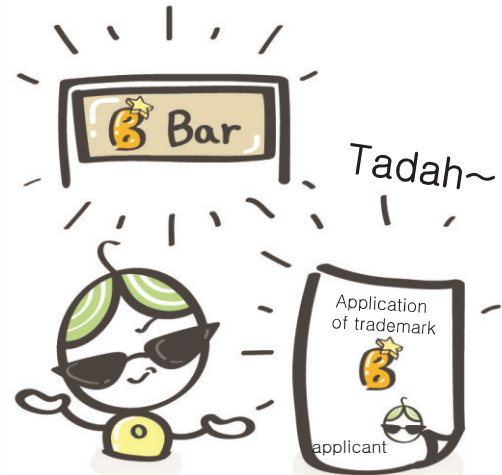
3. The End of Bad-faith Filings - Trademark Invalidation Trial -



Would I be able to
succeed if I have such
fancy brand like that?



This mark seems like
has not been filed in Korea yet.
I'm going to file it as my trademark.



Tadah~

Applicant

One year later

HAHA,
this trademark is mine !!



Meanwhile..

Our trademark was already
registered in Korea.



We will launch a business in Korea...

The trademark
is the same
as yours.

You can request
a trademark
invalidation trial.



To request an
invalidation
trial



Trademark is identical to
a trademark recognized by
consumers outside the ROK
as indicating the goods of a
particular person,
and are used to obtain
unjust profits.

Invalidation!!

WIN!



I've regretted "bad faith" intention.

Even if someone
registered the
trademark imitating a
popular foreign
trademark, it could
be invalidated
by an invalidation
trial requested by
interested parties.



**Bad-faith filing is unacceptable
in any case!**

- * The trademark "B" is a randomly selected mark for this illustration.
- * Bad faith intention is a factor considered by IPT or Court in determining invalidation or revocation of the registered trademarks.
- * TM5 has published Case Examples of Bad-faith Trademark Filings, which can be used as a reference, via TM5 website(tmfive.org).

他社/他者の商標登録を使用しないで下さい。
Don't Use Well-Known Marks in Your Trademark!



Monitor your Trademark Rights! 商標権を監視!

