

Responses of each Office to the Questionnaire

Note: “[Office-X] (ex. [JPO-6])” in the item of judgment example etc. indicates the case number of “Upgraded Case Examples of Bad-Faith Trademark Filings”. TM5 website (<http://tmfive.org/continuationexpansion-of-bad-faith-project-2-2-2-2/?red=>)

I. General

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

JPO

In the Trademark Act of Japan, there is no definition for the term “bad faith.”

However, Article 4, Paragraph (1), Item (xix) of the Trademark Act, which is the section that most likely applies to bad faith trademark applications, stipulates that “unfair purposes” are “referring to gaining unfair profits, causing damage to the other person, or any other unfair purpose.”

According to the Trademark Examination Guidelines, for example, trademarks presented below fall under Article 4, paragraph (1), item (xix) of the Trademark Act.

(a) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract

(b) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of goods.

CNIPA

There is no definition of “bad faith” in the China Trademark Law.

EUIPO

There is no definition of bad faith in the European Union Trade Mark Regulation

(EUTMR). The General Court –first instance – and the Court of Justice of the European Union –second instance – have provided guidance on how to assess bad faith. Finally, in 2019 the Court of Justice gave a definition:

Bad faith is found where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark filed its application for registration not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin (Judgment of the European Court of Justice of 12/09/2019, C-104/18 P, *STYLO & KOTON*, § 46)

KIPO

There is no definition of “bad faith” in the Korean Trademark Act (hereinafter “TMA”).

And there is no definition of “bad faith” in the Intellectual Property Tribunal (hereinafter “IPT”) and/or Courts’ precedents, either. However, the Patent Court or Supreme Court states that in determining whether there is bad faith in trademark application, the below factors can be considered;

- (i) the degree of fame of the well-known/famous mark;
- (ii) the degree of creativity of the well-known mark;
- (iii) whether there was a negotiation with the applicant and the well-known trademark owner;
- (iv) whether there is relationship between the applicant and trademark owner;
- (v) whether the applicant prepared for a business using the registered trademark; or
- (vi) whether the designated goods/services are same or similar, or have economic relationship.

Further, Trademark Examination Guidelines defines “bad-faith” as cases where;

- (i) the applicant files an application with the intent of preventing true trademark owner to enter into the domestic market or force the trademark owner to make an agent agreement with the applicant;
- (ii) the applicant files an application with the intent of diluting a well-known mark,

even though the filed trademark does cause confusion as to the source of goods or services; or

- (iii) the applicant files an application that is same or extremely similar to another person's trademark that has creativity.

Finally, please be advised that under the TMA, even if the trademark application filed in bad-faith, **such mark would not be rejected or invalidated unless the mark (subject for imitation)'s well-known status or fame is proved** (TMA Article 34(1)(xiii)).

USPTO

While there is no uniform legal definition in the United States for the term bad faith, courts typically consider bad faith to mean that the accused party meant to capitalize on the trademark owner's goodwill by trying to confuse consumers into believing that the defendant's product is created or sponsored by, or affiliated with, the plaintiff.

Q2. Is bad faith raised ex-officio or upon a party's claim/objection? (Where the answer can depend on different case constellations, please provide any provision(s) of the relevant laws or regulations. Please also refer to the detailed questions in (iii) of II. Q1 ~ Q5 of the questionnaire)

JPO

Bad faith can be raised both ex-officio and upon a party's claim/objection in an opposition or invalidation/cancellation trial.

[Applicable provisions]

①Examination (by ex officio)

§ 3(1)

§ 4(1) (vii), (viii), (x), (xv), (xix)

②Opposition, trial (post registration)

§ 3(1) ,

§ 4(1) (vii), (viii), (x), (xv), (xix)

§ 53-2

③Counterclaim in national infringement case

CNIPA

Bad faith can be raised in examination(by ex officio), opposition and cancellation(invalidation) procedures.

[Applicable provisions]

- ① Examination (by ex officio)
Article 4.1
- ② Opposition
Articles 4.1,13,15,32
- ③ Cancellation (Invalidation)
Articles 4.1,13,15,32,44.1

EUIPO

Bad faith is never raised ex officio.

Only on the basis of an application for invalidity before EUIPO, or a counterclaim in national infringement proceedings (Article 59(1)(b) EUTMR).

KIPO

- ① Examination (by ex officio)
§ 34(1)(xi), (xii), (xiii), (xx)
- ② Opposition, trial
§ 60(opposition)
§ 119(Trial to Revoke Trademark Registration)

USPTO

Bad faith typically is not raised by the USPTO during examination. However, bad faith may be raised in an opposition, cancellation or infringement proceeding as a factor to be considered in a likelihood of confusion analysis.

Q3. (1)What is the earliest moment within your system that 'bad faith' can be claimed? Please provide any provision(s) of the relevant laws or regulations.
(2)What is the latest? (i.e. are there time limits for claiming bad faith).Please provide any provision(s) of the relevant laws or regulations.

JPO

(1) At the earliest, the examiner may refuse a bad faith application during examination phase. During the examination phase, any person can provide information to the examiner.

[Applicable provisions]

§ 3(1)

§ 4(1) (vii), (viii), (x), (xv), (xix)

(2) There is a 5-year exclusion period to request an invalidation trial in connection with the main paragraph of Article 3, Paragraph(1), Article 4, Paragraph (1), Items (viii), (x) and (xv). However, under Article 47, Paragraph (1), there is no 5-year exclusion period to request trials for invalidation against trademark registrations in violation of Article 4, Paragraph (1), Items (vii) and (x) (“the case where a trademark has been registered for the purpose of unfair competition”), item (xv) (“the case where a trademark has been registered for unfair purposes”), and item (xix).

However, the trials to cancel trademark registrations under Article 53-2 cannot be demanded after five years has passed from the date on which the trademark right was established.

CNIPA

Bad faith applications not intended for use can be refused registration at the earliest under Article 4.1. Bad faith can also be claimed in the proceedings for appeal/trial of a trademark. The claim must be submitted within five years from the date of trademark registration. For the right holder of a famous trademark, time limit of five years is not set. However, there is no time limit for invalidating bad faith registrations that violate Article 4.1 or obtained by other unfair means.

EUIPO

Only after registration of the EUTM. Article 59(1)(b) EUTMR

There are no time limits for claiming bad faith

KIPO

At the earliest, the examiner may refuse a bad faith application during examination phase or the owner for famous mark can provide information to the trademark examiner or file an opposition during the trademark examination phase

At the latest, an interested party may raise an invalidation proceeding with the IPT. Further, interested party can claim that a mark should be invalidated based on TMA

Article 34(1)(xiii). at the phase of the Patent Court. However, in the Supreme Court, interested party cannot add new invalidation action grounds which had not been raised in the IPT and/or Patent Court. And there is no statutory limitation for filing an invalidation action based on TMA Article 34(1)(xiii). For your information, the first phase for invalidation action is IPT; and the IPT's decision can be appealed to the Patent Court as the second phase. The Patent Court's decision can be appealed to the Supreme Court as the final phase.

[Applicable provisions]

§ 34(1))(xi), (xii), (xiii), (xx)

USPTO

Bad faith is not an independent ground for opposition or cancellation of a registration, but may be asserted as part of a likelihood of confusion or false association claim.

Thus, the only time limits are the time limits that apply to the particular ground for opposition or cancellation. Bad faith may be asserted either at the outset of a proceeding, or after discovery has been conducted.

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)

JPO

Basically, the determination of whether applicants have filed under bad faith, i.e., “bad faith applicants,” is based on standards assessed both at the time when they file their applications and examiners conduct examination on them.

CNIPA

“Bad faith applicants” are determined both at the time they file their applications and at the time examiners conduct examination on them.

EUIPO

The crucial moment at which the bad faith applicant must have had bad faith to fall foul of the provisions is the time of filing the application for registration of the EUTM.

KIPO

At the time when the bad-faith applicant's trademark application filed with the Korean Intellectual Property Office (hereinafter "KIPO")

USPTO

In the usual case, bad faith is assessed as of the time of adopting the mark, or in the case of an intent-to-use application, as of the time of filing the application.

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?

JPO

Yes, the subjective state of mind of the "bad faith applicant" is relevant in the assessment of bad faith. However, it is often impossible to gather solid evidence proving bad faith (unfair intention), so the JPO may deem bad faith from circumstantial evidence.

Please refer to the response to I. Q7 for specific means by which the JPO assesses bad faith.

Especially, in the examination process, a trademark in correspondence to (1) and (2) is presumed to be used for unfair intention.

- (1) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.
- (2) The above-mentioned well-known trademark is composed of a coined word or has a distinctive feature in composition.

CNIPA

Subjective factors inferred from objective circumstances of the cases. The examiner assesses mainly based on proof submitted by the parties concerned, such as, whether the applicant of a bad faith filing and the holder of the trademark communicated to each other or not, whether the applicant of the bad faith filing intends to gain unfair profits or not, whether a trademark under a bad faith filing has significant originality or not, and whether the previous trademark is well-known or not.

EUIPO

Yes. A ‘dishonest intention’ is necessary. See the definition above (I.Q1). Bad faith is found (...) where the proprietor of an EU trade mark filed the application:

- with the intention of undermining the interests of third parties in a manner inconsistent with honest practices,
- or with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark

KIPO

No. The examiner does not assess the subjective state of mind of the ‘bad faith.’

USPTO

Yes, the subjective state of mind of the bad faith applicant is relevant in the assessment of bad faith. However, direct evidence of wrongful intent is often unavailable, so courts and the USPTO’s Trademark Trial and Appeal Board (TTAB) may infer bad faith from circumstantial evidence. Courts and the TTAB draw inferences from all of the surrounding circumstances, such as, but not limited to, whether the defendant was aware of the plaintiff’s mark when it selected its mark; the degree of similarity of the respective marks; evidence of any copying or imitation of the plaintiff’s mark, packaging formats or design elements; any prior business or employment relationship with the plaintiff; and the credibility of the defendant’s explanation of the resemblances in the marks or packaging.

An examiner would not consider bad faith in his or her likelihood of confusion analysis; rather, it would be considered if raised during an opposition or cancellation proceeding.

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)

JPO

As a basic principle, the burden of proof in establishing bad faith rests on the parties who claim that the applications were made in bad faith.

Bad faith may be inferred from circumstantial evidence. For example, factors to be

considered in determining whether bad faith exists include: the background of applications such as applicants' actions and facts involved with filing, including relationship between the applicants and the genuine trademark owners, and any distinctive feature in composition of filed trademarks. Especially, in the examination process, in case requirements described in Q5 are satisfied, unfair intentions may be presumed.

CNIPA

There is a principle of burden of proof, which is subjected to the holder of a trademark. For example, a case where an applicant of a bad faith filing makes registered trademark based on bad faith of many other trademarks of other persons and is subjected to opposition, and a holder of the trademark submits other proofs of the bad faith is presumed to be bad faith is established.

In general, the burden of proof in establishing bad faith rests on the parties who claim that the applications were made in bad faith. For example, if an applicant files many applications which are similar to various parties' trademarks and one of such application is opposed by one party, the party can submit evidence that the applicant has filed in bad faith on the ground that it imitates various parties' trademarks. However, it requires the applications to prove that they do not file "bad faith applications not intended for use" under Article 4.1.

EUIPO

There is a presumption of good faith until proof to the contrary is adduced. It is for the invalidity applicant (or for the defendant in national infringement proceedings) to prove the bad faith.

KIPO

In general, the owner for well-known or famous mark bears the burden of proving there was bad faith in filing the bad-faith trademark application.

USPTO

Bad faith intent will be considered as a factor in a likelihood of confusion analysis. *See, e.g., Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961) (intent of the junior user in adopting the mark is a relevant factor in deciding whether confusion is likely); *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1013 (CCPA 1979) ("Evidence of the applicant's intent is probative, but not conclusive where

confusion is otherwise unlikely”). Please note, however, that it is not necessary to prove bad faith in order to establish a likelihood of confusion. The burden of proof to establish likelihood of confusion, and any assertion of bad faith, is on the opposer or petitioner, who must establish its case by a preponderance of the evidence.

Some courts have held that a finding of culpable intent creates a “presumption” that confusion is likely, i.e., it is presumed that the applicant intended to cause confusion and that they were successful. Other courts have held that intent creates an “inference” that consumers are likely to be confused, and still others will simply give this factor great weight in a likelihood of confusion analysis.

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

JPO

There is no defined checklist of conditions according to which bad faith is established.

A judgment on an “unfair purposes” must be made with full consideration given to the following materials for instance, if available.

- (a) Materials proving a fact that another person's trademark is well known among consumers
- (b) Materials showing that a well-known trademark is composed of a coined word or has a distinctive feature in composition
- (c) Materials proving a fact that the owner of a well-known trademark has a concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)
- (d) Materials proving a fact that the owner of a well-known trademark has a plan to expand its business in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.)
- (e) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc. or a fact that the applicant is seeking to prevent foreign right holders from entering the Japanese market
- (f) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark

CNIPA

The following factors shall be totally considered to determine a bad faith filing:

(1) Whether a trade relationship or a cooperative relationship existed or not between the applicant of the pending trademark and the holder of the trademark:

(2) Whether the common area of the applicant of the pending trademark and the holder of the trademark or the goods/services of the both sides are within the same sales route and range or not:

(3) Whether another conflict has been present between the applicant of the pending trademark and the holder of the trademark or not, and whether the both sides knew trademark of a prior user or not:

(4) Whether intercommunication between the applicant of the pending trademark and the members of the holder (organization) of the trademark has been made or not:

(5) Whether the applicant of the pending trademark intends to gain unfair profits after registration or not, and whether the applicant of the pending trademark conducts misleading advertisement, enforces dealing and partnering (on a trademark) to the prior user, releases the trademark to the prior users or other persons at a high price, and charges them a license fee or compensation of infringement of right by utilizing a certain good fame and impact of the trademark possessed by the trademark holder, or not:

(6) Whether the trademark has more significant originality than trademarks of other persons or not; and

(7) Cases considered as bad faith filing

EUIPO

No. But there are a number of factors identified by different judgments which are likely to indicate the existence of bad faith. See point 3.3.2. of EUIPO Guidelines

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%9494-article-59-1--b--eutmr>

KIPO

Please refer to I-Q1.

USPTO

No, there is no defined list of conditions according to which bad faith is established. The courts may infer it from circumstantial evidence. As noted above, the court draws inferences from all of the surrounding circumstances, such as, but not limited to, whether the defendant was aware of the plaintiff's mark when it selected its mark; the degree of similarity of the respective marks; evidence of any copying or imitation of the plaintiff's mark, packaging formats or design elements; any prior business or employment relationship with the plaintiff; and the credibility of the defendant's explanation of the resemblances in the marks or packaging.

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

JPO

<General Statement>

In the Japanese trademark system, applicable provisions that might apply in eliminating bad faith trademark applications differ due to various factors such as whether or not another person's trademark, which was the target of the bad faith trademark application, is well-known in Japan.

The provisions that apply to cases in which the other person's trademark is well-known in Japan are as follows: Article 4, Paragraph (1), Item (x) (“[the trademark] is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto”), and Article 4, Paragraph (1), Item (xv) (“[the trademark] is likely to cause confusion in connection with the goods or services pertaining to a business of another person”). In applying these provisions, there is no need to verify “unfair purposes” of

applicants.

And, even if a claimed trademark is unlikely to cause confusion as to the sources of the goods or services, when it is “identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person,” and when “such trademark is used for unfair purposes,” Article 4, Paragraph (1), Item (xix) shall be applied. The key point here is that this provision applies also to trademarks that are well known only in foreign countries.

Furthermore, there is the possibility that Article 4, Paragraph (1), Item (vii) might apply when more emphasis is given to the background of the applications and to subjective bad faith of applicants. In that case, whether or not another person’s trademark is well known is a factor to be considered, but is not a requirement. Also, the main paragraph of Article 3, Paragraph (1) might apply when there are concerns about the applicants’ own intentions to use the trademark themselves.

CNIPA

Article 4.1, Article 13, Article 15, Article 32 and Article 44.1 of the Trademark Law deal with bad faith applications.

EUIPO

Article 59(1)(b) EUTMR: An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings (b) where the applicant was acting in bad faith when he filed the application for trade mark.

Further explained in EUIPO Guidelines for Examination, Part D, Cancellation, Section 2, Substantive Provisions, Subsection 3.3, Bad faith.

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1--b--eutmr>

KIPO

TMA Article 34(1)(xiii)

Trademark Examination Guidelines Section 5.13.

And the bellows are the recent Patent Court’s decision in relation with bad-faith filing;

Case No.: 2012Heo5059 rendered on November 22, 2012 by the Patent Court

Saudi Arabia's company ("Registrant") filed three applications for the mark which is composed of device and letters of "TIFFANY" in Classes 24, 35, and 36 for beddings related goods and services on March 3, 2009, and obtained registration of those applications.

The owner for TIFFANY mark filed invalidation actions against the subject registrations with the IPT on June 20, 2011 by arguing the fame of the "TIFFANY" mark and bad faith of the Registrant. Initially, the IPT dismissed the invalidation actions holding that 1) the economic relationship between the compared goods/services (i.e., "jewelry," etc. versus "beddings," etc.) and 2) the bad faith of the Registrant cannot be recognized.

The Patent Court on appeal, however, overturned the IPT decisions by recognizing the fame of the "TIFFANY" mark for "jewelry" and the bad faith of the Registrant. The Patent Court recognized the bad faith of the Registrant by emphasizing several factors such as 1) the Registrant's likely knowledge of the fame of the "TIFFANY" mark, 2) sufficient probability of the owner for TIFFANY mark also expanding its business into "beddings" in the future considering the trends of luxury fashion brands, 3) likelihood of consumers' misunderstanding or confusion as to source of goods with the use of the subject registrations by the Registrant, and 4) the overlap of the targeted consumers of "beddings" and "jewelry."

USPTO

N/A

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)

JPO

Yes.

In the Trademark Act of Japan, the main paragraph of Article 3, Paragraph (1) stipulates: "Any trademark used in connection with goods or services pertaining to the business of an applicant may be registered." Accordingly, bad faith trademark

applications, which applicants file without any intent to use the trademarks, may be refused or invalidated on legal grounds. However, please note when the main paragraph of Article 3, Paragraph (1) was adopted, the original intent was not to prevent “bad faith trademark applications” per se. In other words, even in cases when applicants file trademark applications without any bad faith intended, the filed trademarks can be refused (or invalidated) if the applicants have no intention to use them.

CNIPA

There is no requirement in the Trademark Law for a trademark owner to have an intention to use the mark when applying for it. However, if an applicant files a large quantity of trademarks beyond reasonable use necessity, the applications may be considered to be filed in bad faith under Article 4.1.

If, a "bad faith" trademark registration is required to be cancelled based on the continuous absence of “actual use” for three years, the “actual use” can be proved by proofs of actual use, (for example), use of the trademark on goods, packaging or container of goods, or transaction documents of goods, or proofs of the use of the trademark in advertisement, exhibition and other commercial events (Section 3 of the "Trademark Law").

EUIPO

Yes.

KIPO

Yes.

The TMA provides a ground for rejecting or invalidating a trademark registration based on a lack of intent to use (TMA Article 3). However, the purpose of TMA Article 3(1) is not closely related to prohibiting a trademark in bad-faith’s application from registering and/or invalidating (this means that even if there is no bad-faith in filing trademark application, the mark can be rejected (or invalidated) in case of that there is lack of intent to use).

USPTO

If a party is not using a mark in commerce, an application may be filed at the United States Patent and Trademark Office (USPTO) under Section 1(b) of the Trademark Act on the basis of an intent to use in commerce, under Section 44 of the Trademark Act on the basis of a foreign registration, or through a Madrid filing under Section 66(a) of the

Trademark Act. In such cases, an applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce. Such an application may be refused or challenged on the basis that an applicant did not have a “bona fide intent” to use the mark in commerce at the time an application was filed. Please note, however, that this is a different standard than “bad faith.”

Note: In addition to a declaration stating that the applicant is using the goods or services in commerce or has a bona fide intent to use the mark, an application must include an allegation that to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate, and that the verifier believes the applicant to be the owner of the mark and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. An applicant that knowingly makes a false, material representation with the intent to deceive the USPTO may be challenged on the basis of fraud.

IF YES:

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

JPO

Main Paragraph of Article 3, Paragraph (1)

Article 3 Any trademark used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark falls under items of this section.

CNIPA

The provision is applied to ex officio examination. In practice, it is difficult to determine “bad faith applications not intended for use”.

EUIPO

In accordance with Article 59(1)(b) EUTMR, an EUTM ‘shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the applicant was acting in bad faith when he filed the application for the trade mark’.

The guidance on intent to use has been provided by the case-law of the European Court of Justice

The registration of a trade mark by an applicant without any intention to use it for the goods and services covered by that registration may constitute bad faith where there is no rationale for the application for registration (29/01/2020, C-371/18, SKY, § 77).

The absence of any intention to use a trade mark for some or all of the goods and services applied for constitutes bad faith if the EUTM applicant acted with the intention of undermining the interests of third parties in a manner inconsistent with honest practices or — without even targeting a specific third party — of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark.

When the absence of any intention to use a trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services, bad faith is found only in relation to those goods or services (29/01/2020, C-371/18, SKY, § 81; 11/06/2009, C-529/07, Chocoladenfabriken Lindt & Sprüngli, § 44; 07/07/2016, T-82/14, LUCEO[EUIPO-7], § 126).

Bad faith has also been found where an EUTM owner tries to artificially extend the grace period for non-use, for example by filing a repeat application of an earlier EUTM in order to avoid the loss of a right as a result of non-use (13/12/2012, T-136/11, Pelikan, § 27).

KIPO

Principal Paragraph of Article 3(1)

Any person who uses or intends to use a trademark in the Republic of Korea may obtain registration of his/her trademark.

USPTO

15 U.S.C. § 1051(b)(3)(B) provides that, in an intent-to-use application filed under 15 U.S.C. § 1051(b) (“Section 1(b) application”), an applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verified statement is not filed with the initial application, the applicant will be required to submit

a verified statement during prosecution of the application that states that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services as of the filing date of the application. 37 C.F.R. § 2.34(a)(2).

15 U.S.C. §§1126 and 1141(5)(a) provide that a verified statement of the applicant's bona fide intention to use the mark in commerce must also be included in applications filed under Sections 44 (on the basis of a foreign registration) and 66(a) (a Request for Extension of Protection filed through the Madrid Protocol).

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

JPO

The relevant moment for determining whether there is intention to use is the time of decision to grant/refuse registration of the trademark.

CNIPA

N/A

EUIPO

Bad faith can only be invoked against a registered EUTM. The relevant moment for determining whether there was bad faith on the part of the EUTM owner is the time of filing the application for registration of the EUTM.

KIPO

N/A

USPTO

The applicant must have had a bona fide intent to use the mark at the time of filing the application.

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

JPO

Under the above provision, the said trademark applications can be legally refused by ex-officio examination. However, in fact, in the examination process, it is difficult to

determine whether the applicants have filed the trademark applications without any intent to use them. As a result, this may pose difficult problems when refusing bad faith applications based on ex-officio examination on the grounds that the applicants have no intent to use the trademarks. On the other hand, in court decisions, a precedent was set whereby a bad faith filing was invalidated on the grounds that the applicant had no intent to use the trademark. (For the details, please see vii)

CNIPA

The provision is applied to ex officio examination. In practice, it is difficult to determine “bad faith applications not intended for use”.

EUIPO

There is no ex-officio examination of bad faith in the EUTM system. It is for the interested party to file an application for a declaration of invalidity before EUIPO’s Cancellation Division or a counterclaim in national infringement proceedings.

KIPO

The above provision can be the grounds for refusal, however, in the examination process, it is hard to be evaluated intention to use by an examiner. The purpose of TMA Article 3(1) is not closely related to prohibiting a trademark in bad-faith’s application from registering and/or invalidating

USPTO

An application may be refused by the examiner if an applicant has failed to include a verified statement of intent to use in commerce. If a verified statement is provided, an examiner will not evaluate the good faith of an applicant during examination and will not make an inquiry unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce. A third party may challenge intent to use either in an opposition filed against a Section 1(b) application, or in a cancellation proceeding filed against a registration issued under Sections 44 (on the basis of a foreign registration) or 66(a) (a Request for Extension of Protection filed through the Madrid Protocol).

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)?

JPO

If it is determined that there is any doubt as to the applicants' intent to use trademarks, applicants or rights holders may be needed to submit certain documents proving their intention to use them (The burden of proof in establishing the intent to use rests in the applicants and/or rights holders). ("RC TAVERN" Case: Intellectual Property High Court (Gyo-Ke) No. 10019 2012, Date of Court Decision May 31, 2012. Rescission of a trial decision. For the details, please see vii)) [JPO-10]

CNIPA

When there is prima facie evidence of "bad faith applications not intended for use", the burden of proof lies in the applicants to prove that it does not constitute "bad faith applications not intended for use".

EUIPO

There is a presumption of good faith. It is for the invalidity applicant (or the defendant in national infringement proceedings) to prove the bad faith.

KIPO

Applicants or right holders may have the burden of proof their intention to use trademarks.

USPTO

In the event that an application or registration is challenged on the basis of lack of intent, the opposer/petitioner has the burden of proof in establishing applicant's/registrant's lack of intent. However, failure to produce documents verifying a bona fide intent to use the mark in commerce is sufficient to establish a rebuttable presumption that the applicant lacks such intent. For example, if opposer/petitioner requests documents during discovery proving applicant's/registrant's intent, and applicant/registrant fails to provide any documents, it is presumed that the applicant/registrant lacks intent and must rebut the presumption some other way. Such documents include business plans, documents demonstrating that applicant has the ability to manufacture the products or has experience in the relevant field, documents relating to market research, etc.

v) Please provide examination guidelines.

JPO

Trademark Examination Guideline, Main Paragraph of Article 3, Paragraph(1)

The Trademark Examination Manual 41.100.03, 4. (See vi for details)

CNIPA

Trademark Examination and Trial Guidelines 2021, Part II, Section 2, Examination and Trial for the Bad-faith Trademark Applications without the Intention to Use.

<http://sbj.cnipa.gov.cn/sbj/zcwj/202112/sbcsln.pdf> (Chinese version only)

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1--b--eutmr>

KIPO

Trademark Examination Guidelines Section 2.2:

There are doubts as to the intent to use as follows; (i) Where an individual designates goods requiring large-scale capital, facilities, etc.; (ii) In the case of designating multiple types of unrelated goods/services are claimed irrespective of number of classes; (iii) Where an individual designates two or more goods/services that are not connected with a product or service that requires certain qualifications, etc. under the law; (iv) If there is a doubt that an applicant is filing a mark without intention to use it, but only as a bid to preoccupy the mark, or to exclude anyone else from registering the mark.

USPTO

The Trademark Manual of Examining Procedure (TMEP) § 818 lists the elements an examiner must require in an application filed under Section 1(b) or

Section 44. TMEP § 1904.01(c) provides guidelines for requiring a declaration of the applicant's bona fide intention to use the mark in commerce in a §66(a) application.

vi) Please provide examination practices (Specific judgment method).
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(1) Describe the factors to be considered in determining the lack of intention to use the trademark. For example, whether an applicant designates a wide variety of goods or services, or whether the applicant has filed many applications to register another person's trademark.

JPO

The Trademark Examination Manual

41.100.03“Regarding the Operation for the Examination for Confirming the Applicant's Use or Intention of Use of a Trademark”

“4. When the examiner has reasonable doubts as to whether the applicant uses or has the intention to use the trademark due to the number of applications filed by the applicant in the past”

If the following conditions set forth in (a) and (b) below are met, the examiner determines that the application is in violation of the main paragraph of Article 3, Paragraph (1) on the grounds that there is an extremely low probability for the applicant to use the trademark and there are reasonable doubts as to whether or not the applicant uses or has the intention to use the trademark.

In addition, when the following conditions are met, even when the applicant has submitted a document certifying his/her intention to use the trademark, it is obvious that the applicant will not use the trademark for the goods or services pertaining to the applicant's business and thus, the reasonable doubts will not be resolved.

(a) The applicant has filed an unconceivably high number of applications for a trademark to be used by a single applicant for the goods or services in consideration of the past number of applications filed by the applicant (not less than 1,000 applications per year).

(b) The applicant's use or intention of use of the trademark cannot be confirmed from the applicant's website or broadcast, etc. (e.g. according to the applicant's website, the applicant is only found to be engaged in the sale or licensing of trademark, etc.).

CNIPA

N/A

EUIPO

Same as above

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1-b--eutmr>

KIPO

The examiner may request evidence of use or a declaration in support of use and/or intent to use (i.e., printed materials, product photographs, invoices, declaration describing plans for use, etc.) when there is a doubt as to the intent to use. Further, the said guideline exemplifies that there is a doubt as to the intent to use if (i) Where an individual designates goods requiring large-scale capital, facilities, etc.; (ii) In the case of designating multiple types of unrelated goods/services are claimed irrespective of number of classes; (iii) Where an individual designates two or more goods/services that are not connected with a product or service that requires certain qualifications, etc. under the law; (iv) If there is a doubt that an applicant is filing a mark without intention to use it, but only as a bid to preoccupy the mark, or to exclude anyone else from registering the mark.

USPTO

N/A

(2) Please describe proof of use or other related matters affecting decisions on intention to use.

JPO

Nothing, in particular.

CNIPA

Nothing, in particular.

EUIPO

N/A

KIPO

Nothing, in particular.

USPTO

N/A

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

JPO

“RC TAVERN” case (Intellectual Property High Court (Gyo-ke) No. 10019 2012, Date of Court Decision May 31, 2012. Rescission of a trial decision) [JPO-10]

The main paragraph of Article 3, Paragraph (1) of the Trademark Act stipulates the requirement for trademark registration as “Any trademark to be used in connection with goods or services pertaining to the business of an applicant.” “Any trademark to be used in connection with goods or services pertaining to the business of an applicant” means any trademark actually used in connection with goods or services relating to the business of applicants at least at the time of registration decisions, or any trademark with applicants’ intent to use for goods or services relating to the business of the applicants in future.

When the above requirement is applied to the “RC TAVERN” case, let’s consider the details of the case as follows:

(1) Since around September 17, 2009, the plaintiff was advertising and promoting, mainly in central Tokyo, a restaurant with the name “RC TAVERN.” The plaintiff used a trademark consisting of the Roman alphabet words “RC TAVERN” in the upper part and the Japanese katakana characters “アールシータバーン” in the lower part (a trademark being used by the plaintiff).

(2) On October 1, 2009, the plaintiff opened the restaurant bearing the trademark in Marunouchi, Chiyoda-ku, Tokyo, engaging in providing food and beverage services.

(3) The defendant filed an application to register the subject trademark in this case on October 24, 2009, and obtained trademark rights for this trademark on March 26, 2010. However, since then and up to the present, the defendant has never used this registered trademark for the designated services of “providing foods and beverages” or for any other purposes/services in other businesses.

(4) The registered trademark in this case is similar to a trademark being used by the plaintiff.

(5) A trademark being used by the plaintiff is a coined word by combining the letters “RC,” which are the acronym of the letters of a restaurant “Rose & Crown” managed by the plaintiff; and the word “TAVERN,” which generally means a drinking spot or bar,

and is particularly distinctive. Also, the filing date of the trademark in this case was very close to the timing of advertising and promoting the restaurant as well as the opening date of the restaurant. Based on these facts, it could be determined that, after recognizing the trademark being used by the plaintiff, the defendant filed a trademark application to register the subject trademark in this case, which is similar to the plaintiff's trademark.

(6) Furthermore, in addition to the subject trademark in this case, the defendant filed applications to register 44 trademarks in a short period between June 27, 2008 and December 10, 2009, and obtained trademark rights for them. Nonetheless, since then and up to the present, the defendant has never used these registered trademarks for the designated services or for any other businesses. The scope of the designated services is also excessively wide and lacks consistency. Moreover, for 30 of these trademark registrations, there are shops and companies that are actually using similar trademarks and trade names without any relation to the defendant. And, from what we can confirm at this point, for 10 of them, the defendant's trademark applications were filed after the actual use of others' trademarks and trade names that were similar to the defendant's trademarks.

Considering all of the above circumstances, it is very likely that, for certain trademarks or trade names being used by others, the defendant filed trademark applications with a wide variety of the designated services. As a result, it should be determined that the defendant has been merely collecting trademark registrations. Consequently, the subject trademark in this case does not fall under a trademark that is actually used in connection with goods and services relating to the business of the defendant at the time the decision to register it was decided. In addition, it is also difficult to admit that the defendant had the intent to use this registered trademark for goods or services relating to his own business in the future.

Accordingly, in regard to the subject trademark in this case, the trademark registration cannot be acknowledged to have been registered for "any trademark to be used in connection with goods or services pertaining to the business of an applicant." It should be determined that this trademark registration is a violation of the main paragraph of Article 3, Paragraph (1) of the Trademark Act.

CNIPA

N/A

EUIPO

The registration of a trade mark by an applicant without any intention to use it for the goods and services covered by that registration may constitute bad faith where there is no rationale for the application for registration (29/01/2020, C-371/18, SKY, § 77).

The absence of any intention to use a trade mark for some or all of the goods and services applied for constitutes bad faith if the EUTM applicant acted with the intention of undermining the interests of third parties in a manner inconsistent with honest practices or — without even targeting a specific third party — of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark.

When the absence of any intention to use a trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services, bad faith is found only in relation to those goods or services (29/01/2020, C-371/18, SKY, § 81; 11/06/2009, C-529/07, Chocoladenfabariken Lindt & Sprüngli, § 44; 07/07/2016, T-82/14, LUCEO, § 126).

Bad faith has also been found where an EUTM owner tries to artificially extend the grace period for non-use, for example by filing a repeat application of an earlier EUTM in order to avoid the loss of a right as a result of non-use (13/12/2012, T-136/11, Pelikan, § 27).

29/01/2020, C-371/18, SKY,
11/06/2009, C-529/07, Chocoladenfabariken Lindt & Sprüngli,
07/07/2016, T-82/14, LUCEO, [EUIPO-7]
13/12/2012, T-136/11, Pelikan,
12/09/2019, C-104/18 P, STYLO & KOTON

KIPO

“istar logistics case”(2010Heo4397, the Patent Court on Oct. 7, 2010)

USPTO

Honda Motor Co. v. Friedrich Winkelman, 90 USPQ2d 1660 (TTAB 2009). This case represents an example of a Trademark Trial and Appeal Board decision finding that the applicant did not have a bona fide intent to use. The applicant, Friedrich Winkelman, applied to register the mark V.I.C. for transportation vehicles under Section 44(e) of the Trademark Act (based upon a German registration), which requires an assertion of a bona fide intent to use in commerce. The application was opposed by Honda Motor Co. on grounds of likelihood of confusion and lack of bona fide intent to use in commerce. Applicant Winkelman responded to Honda's interrogatories (discovery requests) that he "has not had activities in the U.S. and has not made or employed a business plan, strategy, arrangements or methods there" and "has not identified channels of trade that will be used in the United States." The Board held that the lack of documents verifying bona fide intent to use the mark is sufficient to establish a rebuttable presumption that the applicant lacks such intent. The Board held that applicant must rely on specific facts that establish the existence of an ability and willingness to use the mark in the U.S. at the time of filing the application, and that the applicant failed to prove bona fide intent.

Nintendo of America, Inc. v. Adar Golad, Opposition No. 91178130, 2011 WL 2360099 (TTAB May 31, 2011) [not precedential]. The Trademark Trial and Appeal Board (TTAB) found that there was no business plan or any other documentation showing plans to "advertise, manufacture or otherwise use the mark FLASHBOY in commerce on the goods for which applicant seeks registration." In order "[t]o show a bona fide intent to use, there must be 'objective evidence,' that is evidence in the form of 'real life facts and by the actions of the applicant.' J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 19:14 (4th ed. 2009). There should be some 'definite' (if not necessarily 'concrete') plan by applicant. For example, 'written plan of action for a new product or service,' or a 're-branding of an existing line of goods or services.' *Id.*" Although Applicant had foreign trademarks and a European patent, Applicant did not establish "a nexus as to how these would be used to launch FLASH BOY for the presently applied-for goods."

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)

JPO

Yes.

CNIPA

Yes.

EUIPO

No specific legislation. Only case-law (explained under next heading)

KIPO

Yes.

USPTO

Although the U.S. does not have a stand-alone refusal for bad faith, bad faith is one of the factors the TTAB or a court will weigh in determining likelihood of confusion. Bad faith may also be addressed through challenges on the grounds of misrepresentation of source under Trademark Act Section 14(3).

IF YES:

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

JPO

As a provision for refusing an application on the basis of unfair intention, Japan has Article 4, Paragraph (1), Item (xix) of the Trademark Act.

Article 4, Paragraph (1), Item (xix)

Trademark identical with or similar to another person's well-known trademark which is used by the applicant for an unfair intention

A trademark being identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding Items)

Also, although Japan does not have a stand-alone refusal for bad faith, a case in which applications are contrary to the public interest and/or international faith, Article 4, Paragraph (1), Item (vii) may be applicable.

Article 4, Paragraph (1), Item (vii)

Contravention of public order or morality;

CNIPA

Article 32 of the "Trademark Law" provides that, no trademark application shall cause damage to the right previously held by another party when filing, nor shall an applicant rush to register in an unfair manner a trademark that is already in use by another party and that enjoys substantial influence.

Paragraph 2 of Article 15 of Trademark Law provides that, Where a trademark applied for registration is identical with or similar to an unregistered trademark of another party in prior use on identical or similar goods, and the applicant has a contract, business relationship or other relationship other than that prescribed in the preceding paragraph with that party, thus the applicant is fully-aware of the existence of the trademark of that party, this application for registration shall be refused upon the opposition filed by that party.

Paragraph 1 of Article 15 of Trademark Law provides that, Where an agent or representative, without the authorization of the principal, seeks to register in the agent's name the principal's trademark and where the principal objects, registration shall be refused and the use of the mark shall be prohibited.

EUIPO

Only case-law

Dishonest intention on the part of the EUTM owner is a subjective factor that has to be determined by reference to objective circumstances (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 42). Several factors can be relevant. For example:

a) Bad faith exists where applications for trade marks are diverted from their initial purpose and filed speculatively or solely with a view to obtaining financial compensation (07/07/2016, T-82/14, LUCEO, EU:T:2016:396, § 145) [EUIPO-7].

b) Bad faith is found when it can be inferred that the purpose of the EUTM applicant is to ‘free-ride’ on the reputation of the invalidity applicant (14/05/2019, T-795/17, NEYMAR, EU:T:2019:329, § 51) or on its registered marks and to take advantage of that reputation (08/05/2014, T-327/12, Simca, EU:T:2014:289, § 56), even if those marks have lapsed (21/12/2015, R 3028/2014-5, PM PEDRO MORAGO (fig.), § 25).

c) The existence of a direct or indirect relationship between the parties prior to the filing of the EUTM, for example a pre-contractual, contractual or post-contractual (residual) relationship, can also be an indicator of bad faith on the part of the EUTM owner (11/07/2013, T-321/10, Gruppo Salini, EU:T:2013:372, § 25-32). The EUTM owner’s registration of the sign in its own name in such cases can, depending on the circumstances, be considered a breach of honest commercial and business practices.

d) A request for financial compensation made by the EUTM owner to the invalidity applicant may lead to a finding of bad faith if there is evidence that the EUTM owner knew of the existence of the earlier identical or similar sign and expected to receive a proposal for financial compensation from the invalidity applicant (08/05/2014, T-327/12, Simca, EU:T:2014:289, § 72) [EUIPO-9].

KIPO

Trademark Act Article 34(1)(xiii)

Any trademark which is identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the ROK or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person.

USPTO

The United States does not have laws or regulations relating to bad faith; however, bad faith is a factor the TTAB or a court will weigh in determining likelihood of confusion. A likelihood of confusion analysis has been developed through case law. *See, e.g., In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). Please note, however, that it is not necessary to prove bad faith in order to establish a likelihood of confusion.

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

JPO

At time of decision (Article 4(1)(vii))

At time of application and decision (Article 4(1)(xix))

CNIPA

The above provisions may apply during the proceeding of a trademark opposition and the proceeding for appeal/trial, after the final decision of examination is submitted by the examiners.

EUIPO

At the filing date.

KIPO

At the time when the bad-faith applicant's trademark application filed with the Korean Intellectual Property Office (hereinafter "KIPO")

USPTO

An examiner would not consider bad faith in a likelihood of confusion analysis during examination. The TTAB or a court would consider the bad faith intent of the applicant at the time of adopting the mark or filing for an intent-to-use application.

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

JPO

An application on the basis of unfair intention may be refused by ex-officio examination. Additionally, it may be determined in opposition proceedings or invalidation trials.

CNIPA

They may apply during the proceedings of opposition and for trial/appeal afterward.

EUIPO

It is not raised ex officio. Only on the basis of an application for a declaration of invalidity before EUIPO, or a counterclaim in national infringement proceedings.

KIPO

The above provision can be determined by ex-officio examination. Further, during an opposition or invalidation action, the plaintiff can also raise an argument that a mark is filed with unfair intention.

USPTO

In the United States, bad faith is not considered during ex-officio examination. A determination of bad faith in a likelihood of confusion analysis is left to opposition or cancellation of a 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)?

JPO

The burden of proof in establishing bad faith rests on parties who claim that there is bad faith intent.

CNIPA

There is a principle of burden of proof, which is subjected to the holder of a trademark. For example, a case where an applicant files a large number of other trademarks of other persons and is subjected to opposition, and a right holder of the trademark submits other proofs of the bad faith, is presumed to be bad faith and the bad faith is established.

EUIPO

There is a presumption of good faith. It is for the invalidity applicant to prove the bad faith.

KIPO

In general, the owner for well-known or famous mark bears the burden of proving there was bad faith in filing the bad-faith trademark application.

USPTO

The burden of proof to establish likelihood of confusion, and any assertion of bad faith, is on the opposer, who must establish its case by a preponderance of the evidence. The Board or courts will consider circumstantial evidence to determine whether there is bad

faith intent. Once an opposer has established a prima facie case that the applicant acted in bad faith, the burden would shift to the applicant to prove that it had not acted in bad faith.

Some courts have held that a finding of culpable intent creates a “presumption” that confusion is likely, i.e., it is presumed that the applicant intended to cause confusion and that they were successful. Other courts have held that intent creates an “inference” that consumers are likely to be confused, and still others will simply give this factor great weight in a likelihood of confusion analysis.

v) Please provide examination guidelines.

JPO

Article 4(1) (xix) (Trademark identical with or similar to another person’s well-known trademark which is used by the applicant for an unfair intention)

1. For example, trademarks presented below fall under the provision of this paragraph.
 - (a) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract
 - (b) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of goods.
2. “A trademark which is well known among consumers” includes not only a trademark which is well known among end consumers but also a trademark which is well known among traders in the industry and also includes not only a trademark which is known throughout the country but also a trademark which is well known in a certain area.
3. “A trademark which is well known among consumers abroad” must be well known in one country other than Japan but is not necessarily required to be well known in

several countries. In addition, when the trademark is well known abroad, the fact as to whether or not the trademark is well known in Japan is disregarded.

4. A judgment on an “unfair purposes” must be made with full consideration given to the following facts, if materials mentioned in (a) to (f) below are available.
 - (a) Materials proving a fact that another person’s trademark is well known among consumers
 - (b) Materials showing that a well-known trademark is composed of a coined word or has a distinctive feature in composition
 - (c) Materials proving a fact that the owner of a well-known trademark has a concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)
 - (d) Materials proving a fact that the owner of a well-known trademark has a plan to expand its business in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.)
 - (e) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc. or a fact that the applicant is seeking to prevent foreign right holders from entering the Japanese market
 - (f) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark
5. A trademark contained in an application for trademark registration which satisfies the requirements mentioned in (1) and (2) below is treated by presuming them as those using another person's trademark for unfair purposes.
 - (1) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.
 - (2) The above-mentioned well-known trademark is composed of a coined word or has a distinctive feature in composition.
6. Judgment of whether the trademark is well known or not apply mutatis mutandis Part III, Chapter 9, Item 1(Article 4(1)(x)) of the Trademark Examination Guidelines.

Article 4(1)(vii) (Contravention of public order or morality)

Trademarks that are "likely to cause damage to public order or morality" are, for example, the trademarks that fall under the cases prescribed in (1) to (5) below.

- (1) Trademarks which are, in composition per se, characters or figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds that are unethical, obscene, discriminative, outrageous, or unpleasant to people.
It is judged whether characters, figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds are unethical, discriminative or unpleasant to people, with consideration given to their historical backgrounds, social impacts, etc. from a comprehensive viewpoint.
- (2) Trademarks which do not have the composition per se as prescribed in (1) above but are liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for the designated goods or designated services.
- (3) Trademarks with their use prohibited by other laws.
- (4) Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith.
- (5) Trademarks whose registration is contrary to the order predetermined under the Trademark Act and is utterly unacceptable for lack of social reasonableness in the background to the filing of an application for trademark registration.

CNIPA

In order to determine whether bad faith (misappropriation) is present or not, the following factors shall be totally considered:

- (1) Whether a trade relationship or a cooperative relationship existed or not between the applicant of the pending trademark and the holder of the trademark:
- (2) Whether the common area of the applicant of the pending trademark and the holder of the trademark or the goods/services of the both sides are within the same sales route and range or not:
- (3) Whether another conflict has been present between the applicant of the pending trademark and the holder of the trademark or not, and whether the both sides knew trademark of a prior user or not:
- (4) Whether intercommunication between the applicant of the pending trademark

and the members of the holder (organization) of the trademark has been made or not:

(5) Whether the applicant of the pending trademark intends to gain unfair profits after registration or not, and whether the applicant of the pending trademark conducts misleading advertisement, enforces dealing and partnering (on a trademark) to the prior user, releases the trademark to the prior users or other persons at a high price, and charges them a license fee or compensation of infringement of right by utilizing a certain good fame and impact of the trademark possessed by the trademark holder, or not:

(6) Whether the trademark has more significant originality than trademarks of other persons or not; and

(7) Cases considered as misappropriation

EUIPO

EUIPO Guidelines for Examination, Part D, Cancellation, Section 2, Substantive Provisions, Subsection 3.3, Bad faith.

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1--b--eutmr>

KIPO

Examination Guidelines Section 5.13, 5.20, and 5.21.

USPTO

Examination guidelines are not applicable for a determination of bad faith since an examiner will not consider intent during examination.

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?

JPO

The following are not mandatory requirements, but are factors to be considered in determining whether bad faith exists: (1) background involved with application, (2) applicants designated an excessively broad range of classes or goods or services, (3) applicants filed a large number of applications for unregistered trademarks of others, and (4) the relationship between the original owner of the trademark and the applicant.

CNIPA

Please see answer to v) above.

EUIPO

The existence of a direct or indirect relationship between the parties prior to the filing of the EUTM is a relevant factor when assessing the existence of bad faith.

A request for financial compensation made by the EUTM owner to the invalidity applicant may lead to a finding of bad faith if there is evidence that the EUTM owner knew of the existence of the earlier identical or similar sign and expected to receive a proposal for financial compensation from the invalidity applicant (08/05/2014, T-327/12, Simca, § 72) [EUIPO-9].

KIPO

Whether there is relationship between the applicant and trademark owner is one of the factors in determining whether there was unfair intention in filing trademark application.

USPTO

These factors would be considered by the TTAB or a court in determining intent, and would likely weigh in favor of a finding of bad faith.

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

JPO

The following are not mandatory requirements, but are factors to be considered in

determining whether bad faith exists: (1) background involved with application, (2) applicants designated an excessively broad range of classes or goods or services, (3) applicants filed a large number of applications for unregistered trademarks of others, and (4) the relationship between the original owner of the trademark and the applicant.

CNIPA

N/A

EUIPO

Dishonest intention on the part of the EUTM owner is a subjective factor that has to be determined by reference to objective circumstances (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 42). Several factors can be relevant. For example:

a) Bad faith exists where applications for trade marks are diverted from their initial purpose and filed speculatively or solely with a view to obtaining financial compensation (07/07/2016, T-82/14, LUCEO, EU:T:2016:396, § 145) [EUIPO-7].

b) Bad faith is found when it can be inferred that the purpose of the EUTM applicant is to ‘free-ride’ on the reputation of the invalidity applicant (14/05/2019, T-795/17, NEYMAR, EU:T:2019:329, § 51) or on its registered marks and to take advantage of that reputation (08/05/2014, T-327/12, Simca, EU:T:2014:289, § 56 [EUIPO-9]), even if those marks have lapsed (21/12/2015, R 3028/2014-5, PM PEDRO MORAGO (fig.), § 25).

c) The existence of a direct or indirect relationship between the parties prior to the filing of the EUTM, for example a pre-contractual, contractual or post-contractual (residual) relationship, can also be an indicator of bad faith on the part of the EUTM owner (01/02/2012, T-291/09, Pollo Tropical chicken on the grill, EU:T:2012:39, § 85-87; 11/07/2013, T-321/10, Gruppo Salini, EU:T:2013:372, § 25-32). The EUTM owner’s registration of the sign in its own name in such cases can, depending on the circumstances, be considered a breach of honest commercial and business practices.

d) A request for financial compensation made by the EUTM owner to the invalidity applicant may lead to a finding of bad faith if there is evidence that the EUTM owner knew of the existence of the earlier identical or similar sign and expected to receive a proposal for financial compensation from the invalidity applicant (08/05/2014,

T-327/12, Simca, EU:T:2014:289, § 72) [EUIPO-9].

KIPO

Case No. 2007Heo2626 rendered on June 25, 2008 by the Patent Court, the above was considered as one of the factors in recognizing the unfair intention in filing trademark application.

USPTO

As noted above, the fact that an applicant has designated a wide variety of goods or services but cannot show evidence of intent to use in commerce may lead to a determination of a lack of bona fide intent to use and may also weigh in favor of a finding of bad faith and likelihood of confusion.

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

JPO

The following are not mandatory requirements, but are factors to be considered in determining whether bad faith exists: (1) background involved with application, (2) applicants designated an excessively broad range of classes or goods or services, (3) applicants filed a large number of applications for unregistered trademarks of others, and (4) the relationship between the original owner of the trademark and the applicant.

CNIPA

N/A

EUIPO

There are no special rules when the applicant files a large number of applications for trademarks of others, since filing for just one trademark owned by a third party is already a relevant indication of bad faith. See Neymar and Simca examples above.

KIPO

Case No. 2002Dang3052 rendered on Dec. 15, 2003 rendered by Intellectual Property Tribunal, the above factors was considered as one of the factors in recognizing the unfair intention in filing trademark application. This case was appealed by the registrant for SamsCulb mark and the IPT's decision was supported by the Patent Court.

In this regard, please be advised that the Patent Court did not mention the above as one of factors in recognizing the unfair intention in filing trademark application.

USPTO

Filing for a large number of applications for the trademarks of others could be considered evidence of bad faith. *See, e.g., L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012) (applicant found to have acted in bad faith and lacked bona fide intent to use because of pattern of filing ITU applications for disparate goods under the well-known or famous marks of others).

- Are there other reasons affecting decisions on unfair intentions?

JPO

The following are not mandatory requirements, but are factors to be considered in determining whether bad faith exists: (1) background involved with application, (2) applicants designated an excessively broad range of classes or goods or services, (3) applicants filed a large number of applications for unregistered trademarks of others, and (4) the relationship between the original owner of the trademark and the applicant.

CNIPA

N/A

EUIPO

EUIPO Guidelines for Examination, Part D, Cancellation, Section 2, Substantive Provisions, Subsection 3.3, Bad faith.

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1--b--eutmr>

KIPO

- (i) the degree of fame of the well-known/famous mark;
- (ii) the degree of creativity of the well-known mark;
- (iii) whether the applicant prepared for a business using the registered trademark; or
- (iv) whether the designated goods/services are same or similar, or have economic relationship.

USPTO

The TTAB or a court has broad discretion to consider any number of factors that could provide circumstantial evidence of bad faith. For example, if an applicant has acted in bad faith during discovery and has not been forthcoming, this could be evidence of bad faith in adopting a mark.

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

JPO

The following are not mandatory requirements, but are factors to be considered in determining whether bad faith exists: (1) background involved with application, (2) applicants designated an excessively broad range of classes or goods or services, (3) applicants filed a large number of applications for unregistered trademarks of others, and (4) the relationship between the original owner of the trademark and the applicant.

CNIPA

N/A

EUIPO

No relationship between the original owner of the trademark and the applicant is required in order to find bad faith. However, if such relationship exists, it could be a relevant indicium.

KIPO

No. However, if there is any relationship between the original owner of the trademark and the applicant, the possibility of recognizing the unfair intention by the IPT and/or Court become higher.

USPTO

No, an opposer does not need to prove a relationship between the original owner of the trademark and applicant in order to establish bad faith.

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

JPO

○"Asrock" case (Intellectual Property High Court (Gyo-ke) No. 10297 2009, Date of Court Decision August 19, 2010) [JPO-2]

The Asrock case is a court case in which the court decided that the case would fall under Article 4, Paragraph (1), Item (vii), regardless of whether the cited trademark was well-known and/or famous at the time of filing. The reasons of this court decision are as follows: (1) when it has been confirmed that the applicant (the defendant) filed the trademark application preemptively by plagiarizing the other person's trademark, such trademark application could not be reasonably admitted on the basis of the spirit of the law, even though the first-to-file system exists in Japan in terms of filing trademark applications and the actual use of trademarks is not a requirement for registration, and (2) the defendant's trademark registration was also considered to be against the purpose of the Trademark Act, namely, Article 1, and obstructing fairness and justice in the trademark system.

○"KYOKUSHIN" case: Intellectual Property High Court (Gyo-ke) No.10032 2005, Date of Decision December 26, 2006. Rescission of a trial decision.

The KYOKUSHIN case is a court case in which the subject trademark was determined to fall under Article 4, Paragraph (1), Item (vii). In other words, the conditions of the case were: (1) the background of the trademark application significantly lacked social mores, and (2) the approval of the trademark registration was manifestly intolerable as a trademark that was against the public mores and morality, which are implied in the Trademark Act.

○"DUCERAM" case: Tokyo High Court (Gyo-ke) No. 185 1998, Date of Decision November 22, 1999.

The DUCERAM case is a court case in which the subject trademark was determined to fall under Article 4, Paragraph (1), Item (vii), based on the illegality in negotiations with a foreign company and the background facts involved with filing, regardless of the well-known status of the subject foreign trademark.

○"Kranzle" case: Intellectual Property High Court (Gyo-ke) No. 10668 2005, Date of Decision December 12, 2005.

The Kranzle case is a court case in which the subject trademark was determined to fall under Article 4, Paragraph (1), Item (vii). In the Kranzle case, the plaintiff (the applicant of the subject trademark) claimed that Article 4, Paragraph (1), Item (vii) stipulates that a trademark is to be prohibited on the basis of public benefit, and that a self-oriented private interest should not be subject to Article 4, Paragraph (1), Item (vii). On the other hand, the defendant claimed that the plaintiff had filed the trademark application for unfair purposes without the defendant's permission, only with reference materials showing that the plaintiff had been the defendant's distributor in Japan. In other words, the defendant insisted that the plaintiff's trademark registration was absolutely intolerable and was not due to a merely private interest claimed by the plaintiff, because; (1) the plaintiff had filed the trademark application by pretending to gain acceptance or consent of the Kränzle company of Germany (the defendant) and had obtained trademark rights for this trademark, (2) accordingly, the applicant's background with this trademark registration significantly lacked social validity, and (3) the approval of this trademark registration would disrupt business transactions and be ultimately contrary to international fidelity.

CNIPA

(1) No. 1611206 "黑面蔡" trademark opposition issue: 廖照雄氏(hereinafter referred to as an opponent) employing Beijing 天平 Patent & Trademark Agent Ltd. as an agent submitted opposition to 錦美食品 SHOKO (hereinafter referred to as appellee) employing Sichuan Trademark Office as an agent regarding to Trademark No. 1611206 "黑面蔡" which passed the early examination of our office and appeared in the "trademark bulletin," and our office accepted the opposition based on Section 30 of the "China Trademark Law." The appellee has not answered to it within a predetermined time limit.

The reason for the opposition of the opponent: the trademark “黑面蔡” is originally possessed by 黑面蔡 Food Co. Ltd., and it is mainly used for beverage-based goods, the “黑面蔡” brand has extremely high name recognition in Taiwan and all places where Taiwanese are living. The opponent is one of the executive directors of 黑面蔡 Food Co. Ltd. On September 25 in 1996, the opponent purchased 56 trademarks including “黑面蔡” through the Taiwan Court and got their right of exclusive use.

The name of the holder (appellee) of the trademark right of the said opposition issue is 錦美 Food SHOKO, and the person in charge of this company is Mr. 江美珠 who is

also the supervisor of 黑面蔡 Food Co. Ltd.

Trademark "黑面蔡" is a famous brand created by 黑面蔡 Food Co. Ltd., so, Mr. 江美珠 should know that Trademark "黑面蔡" and 56 trademarks of "黑面蔡" are already belonged to the opponent. The act of the holder (appellee) of the trademark right is a misappropriated application, and use and registration of the trademark under opposition has extremely damaged the opponent i.e. the original right holder of the trademark "黑面蔡."

The view of our office based on statements of facts and reasons by the party concerned is as follows: Trademark "黑面蔡" under opposition is a trademark of pure Chinese (spelling), which is registered on April 24 in 2000 and designated to goods, such as "bovine milk beverage (mainly made of bovine milk)" in 29th class, milk tea (mainly made of milk), and cacao bovine milk (mainly made of milk). The opponent calls himself as the holder of the right of Trademark "黑面蔡," and the appellee has filed and registered the said trademark. At the same time, the opponent provided the following sources of evidence (copy):

1. Registration document of 黑面蔡 Food Co. Ltd.
2. Trademark transfer registration literature published by Central Standards Division, Economic Department, Taiwan Ministry;
3. The registration card of Trademark "黑面蔡" in Taiwan;
4. The employer certificate of registration of 錦美 Food SHOKO, etc.

Evidence 1. Name of Mr. 廖照雄 appears in the name list of the executive board members of 黑面蔡 Food Co. Ltd.

Evidence 2. The opponent has acquired the rights of trademarks No. 119123, 123596, etc, (Taiwan area) through cession and registered of the transfer at Central Standards Division, Economic Department, Taiwan Ministry.

Evidence 3. The holder of the right of No. 119123 Trademark "黑面蔡" (Taiwan area) is Mr. 廖照雄 i.e. the opponent.

Evidence 4. The person in charge of 錦美 Food SHOKO i.e. holder of the said trademark (appellee) is Mr. 江美珠. Although the above sources of evidence are copies, the relative relationship of them can be proofed, thereby, they are worthy of belief for our office. Therefore, the holder of the said trademark (appellee) should know the fact that Trademark "黑面蔡" is possessed by the opponent in Taiwan area. Nevertheless, the act of the holder of the said trademark (appellee) for filing to register objected Trademark "黑面蔡" with respect to our office acts against the principle of faith and trust.

On the basis of Section 33 of the "China Trademark Law," our office decided this case as follows: the reason for opposition of the opponent establishes, thereby, registration of Trademark No. 1611206 "黑面蔡" is not permitted. According to Section 33 of the "China Trademark Law," if being unsatisfied to this decision, the party concerned can apply for a new trial to Trademark Tribunal within fifteen days from the date of this decision.

(2) No. 1033444 Crayon Shin-chan figure trademark disputed issue:

The pending trademark is filed to the Trademark Office on January 9, 1996, by Guangzhou city 誠益 Glass Company and registered on June 21, 1997, and designated to use for goods, such as, clothes of 25th class, subsequently the expiring date of the right of trademark was extended to June 20, 2017 through a renewal procedure.

Through the Trademark Office, firstly, the pending trademark was previously transferred to the 響水県世福経済発展 Inc. and after that, transferred to 江蘇蠟筆小新服飾 Inc. That is, it is the appellee of this opposition issue.

The opponent (Japan Futabasha Publishers, Ltd.) required for revoking the registration of the pending trademark on March 8, 2007.

The actual condition of the misappropriated application by the original holder of the right of the pending trademark (Guangzhou city 誠益 Glass Company): Guangzhou city 誠益 Glass Company has filed and registered the following trademarks in a number of categories, such as, categories of 9th, 18th, 25th, 44th:

「SNOOPY」、「史诺比」、「梦迪娇」、「蒙特娇」、「浪琴」、「Burberrys」、
「CHANEL」、「WALT DISNEY」、「POLO CLUB」、「Gillette」、「VOLVO」、「高
露洁」、「GUESS」、「Calvin Klein」、「BETU」、「百图」、「FENDI」
"SNOOPY," "史诺比," "梦迪娇," "蒙特娇," "浪琴," "Burberrys," "CHANEL,"
"WALT DISNEY," "POLO CLUB," "Gillette," "VOLVO," "高露洁," "GUESS,"
"Calvin Klein," "BETU," "百图," "FENDI"

The above trademarks have been opposed and applied for a new trial, or required for revoking the registration as improper trademarks by the holders of relevant right. Both of the Trademark Office and our Committee determined that the former holder of the right of the pending trademarks has copied or imitated well-known trademarks with bad faith, and, as a result of total consideration of the actual conditions of other trademarks that are the same as or similar to well-known trademarks, filed and registered by the former holder of the pending trademarks, decided to revoke the registration of the respective trademarks based on the ground that the holder acted against the principle of faith and trust and mislead consumers.

The main claim of the opponent (Japan Futabasha Publishers, Ltd.): artworks of "蠟筆小新" (Crayon Shin-chan) are works designed uniquely by Mr. Usui Yoshito, and it is impossible for the holder to design the same person perfectly.

Since the image of "Crayon Shin-chan" is spread broadly in China with high name recognition, it is difficult for the holder to say that he did not know the fact, thereby, holder's intention of plagiarism and misappropriated application are very clear.

The original holder of the pending trademark (Guangzhou city 誠益 Glass Company) has filed misappropriated applications of total nine trademarks including the pending trademark in classes of 9th, 16th, 18th, 25th and 28th, further profited unfairly through transferring the misappropriate trademarks, thereby the bad faith of the holder is clear.

The original holder of the pending trademark (Guangzhou city 誠益 Glass Company), not only filed misappropriated application of the trademark of "Crayon Shin-chan" series of the opponent, but also filed and registered nearly 50 famous trademarks of

other parties in 9th class, after that.

Examples of them include globally famous brands, such as Colgate, SNOOPY, and 7UP.

The former holder of the pending trademark (Guangzhou city 誠益 Glass Company), has filed misappropriated application of other party's trademarks for a long time period, thereby, the company can be seen as an unfair company.

The above act of the original holder of the pending trademark is already recognized as an act of unfair competition constituting infringement of other party's right and misappropriated application of other party's trademark by Beijing high people's Court.

The characters and figures of "Crayon Shin-chan" submitted by the opponent as sources of evidence have stronger originality and obviousness, and they are already known with comparatively high name recognition in Japan, Hong Kong, and Taiwan before filing of the pending trademark.

Since the hub of the original holder of the pending trademark is Guangzhou neighboring to Hong Kong, the holder must be aware of the characters or images for animation of "Crayon Shin-chan" by judging from the name recognition of "Crayon Shin-chan," and the fact of filing and registering the trademark of them in Mainland China in spite of this, gives subjective bad faith.

As a result of totally considering the fact that the original holder of the pending trademark has filed misappropriated application of other party's famous trademarks in a large scale, the act of the original holder to file and register the pending trademark acts against the principle of faith and trust, disturbs management and order of Trademark registration and public order, damages public benefit, thereby registration of the pending trademark falls under "registration under other unfair measures" in Section 41(1) of the "Trademark Law."

Therefore, according to provisions of Section 41(1) and Section 43 of the "China Trademark Law," our Committee decided as follows: registration of the pending trademarks shall be revoked.

(3) No. 4809737 Trademark "ERE" disputed issue:

The applicant (東方希望包頭稀土鋁（鋁）業有限責任公司) request the appellee (the holder of the trademark right: 何天慶370728690812021) to erase registration of registered trademark No. 4809737 "ERE" (hereinafter referred to as the pending trademark). Our Committee legally received the request and constituted a judicial group according to the provision of Act 24 of "Trademark Review and Adjudication Rules" and legally held a trial.

Allegations of the opponent:

1. "ERE" i.e. the pending trademark is the abbreviated name of the English name of the opponent company, the opponent has been using Trademark "ERE" in manufacture and sale of an aluminum metal, since the company was established on October 28, 2003, and the beginning time of its use is clearly before the filing date of the pending trademark.
2. The "ERE" aluminum metal produced by the opponent has substantial influence in markets all over the country, and the opponent has also received high concern and support of the (Communist) party and Government as one of important project among national high recommendation enterprises. Moreover, since the opponent is a very large-sized aluminum power company, and has also great influence within the industry, the opponent have greatly contributed to society, while developing itself.
3. The appellee (holder of the trademark right i.e. 何天慶), in spite of lacking of producing capacity, has registered Trademark "ERE" for goods in 6th class as a position of individual and other many trademarks, such as, "齐鲁雄风", "齐鲁骄子", and "巴蜀骄子", however, the holder does not engaged in production and operation of the relevant goods. Moreover, the appellee (holder of the trademark right i.e. 何天慶) and 孫欣 (trademark representative) have a kinship, and 孫欣 has been committed to misappropriated applications of trademarks and unjust extortion acts for a long period and has received written ultimatum from the national Trademark Office.

The appellee, after filing the misappropriated application of Trademark "ERE," using the power of the right has demanded to seizure of "ERE" brand aluminum metals exceeding 1000 tons to the Commerce and industry Office of several countries together with 孫欣 etc. and has wrung money out of the opponent, and as a result the applicant

has damaged by exceeding two million yuan. The above act not only breaks the "Trademark Law," but also violates criminal relating laws. Thus, according to provisions in Section 31 and Section 41 of the "Trademark Law," the opponent demands to erase the pending trademark.

The opponent submitted to our Committee main sources of evidence for the following three parts:

Sources of evidence of part I:

1. Documents prepared when the opponent filed Trademark "ERE" on November 5, 2003 and the trademark was registered for goods of rare earth aluminum of 1st class:
2. Press information where, on November 3, 2003, Communist Party Committee Secretary of Inner Mongolia Autonomous Region visited to the opponent and witnessed and stated that representation of "ERE" was printed on the aluminum metal produced by the opponent:
3. Information published by branch of rare earth 高新区 of Baotou Shi Commerce and industry Office, proving the scale of production/sale of aluminum metal products where the opponent used Trademark "ERE":
4. Supply/sales contract (documents, divided to three parts) of aluminum metal products signed between the opponent and Baotou aluminum business stock Inc. in 2004:
5. Information published by two companies, such as, Baotou Shi 青山特铸Inc. proving that the opponent has ordered the mold of "ERE" aluminum metal since 2004:
6. Press information regarding aluminum metal relevant to "ERE" of the opponent, appearing in "東方稀鋁（鋁）報" in February and May, 2004, and in January, 2005

Sources of evidence of part II:

1. Information of the opponent regarding production scale, situation of tax payment, and situation of sale/quality of the "ERE" brand aluminum metal products:

2. Press information when the national leader visited to the opponent:
3. Financial report of the opponent from FY2004 to FY2007, and information regarding audit of revenue report in fiscal 2006 and FY2007:
4. The receipts of partial added-value taxes when the opponent sold the aluminum metal products across the country:
5. Vouchers published by nine companies, such as Hangzhou metallic material Limited Company, proving that they purchased "ERE" brand aluminum metal products of the opponent, since 2004:

Sources of evidence of part III:

1. Information regarding results of survey on the other several trademarks possessed by the appellee (the holder of the trademark i.e. 何天慶), such as "齐鲁雄风":
2. Personal information of the appellee (the holder of the trademark i.e. 何天慶), 孫欣 and 何桂芳, such as census register:
3. "Written ultimatum regarding to the act of representative 孫欣 to illegally file a misappropriated application of other party's trademark" published by the Trademark Office in 1998:
4. "Notification of executing enforcement measures" and "notification of suspending treatment" made against the "ERE" brand aluminum metals of the opponent by the Commerce and industry Offices of Zibo, Wuxi, Tianjin and Baotou:
5. Sources of evidence of CD disk in which dialogues when the appellee (the holder of the trademark right i.e. 何天慶) together with 孫欣 etc. demanded high transfer expenses of the trademark against the opponent is recorded:

Allegations of the appellee (the holder of the trademark right i.e. 何天慶):

1. The appellee satisfies the proactive competency as the applicant of a trademark:

2. Trademark "ERE" did not reach to the standard of a famous trademark, and since no transaction is present between the appellee and the opponent before filing, the appellee did not know the fact that the opponent had already used the pending trademark for aluminum metals. Moreover it was legal for the appellee to register the pending trademark, and the allegations submitted by the opponent are accompanied with no facts.
3. Although the opponent claims the prior use of itself, the Trademark Law of our country is specified to employ the first-to-file rule, and the Trademark Law provides that filing misappropriated application of a trademark that enjoys substantial influence to another party, and the pending trademark does not fall under this case.
4. Even if the opponent used the pending trademark previously for aluminum metals, there is no fact that the opponent used it previously for other goods and also no fact that the pending trademark has comparatively high name recognition.
5. Although the opponent thinks that it is possible to prove that the appellee filed a misappropriated application of other party's trademark, it is not the case.

The results of trial examination and consideration of our Committee are as follows:

1. The pending trademark was filed to the Trademark Office by the holder of the trademark (何天慶) on August 1, 2005, and registered through the Trademark Office on June 7, 2007.

Target products for use are products of 6th class, such as cast steel, a steel wire, a metal plate, an aluminum metal, a metal door, a building with a steel frame structure, alloy steel, a metal instrument, an alloy of common metals, and a metal tube.

2. The holder of the trademark right (何天慶) is one company member of Zhucheng chemical industry Co., Ltd, and is one (founder) of the two stockholders of Shandong Qilu Trademark Office Inc. 何桂芳 is an elder sister of the holder of the trademark right (何天慶), and another (founder) of the two stockholders of Shandong Qilu Trademark Office Inc. 孫欣 is a husband of 何天慶, and one of executives of Shandong Trademark Office (belongs to the Commerce and industry Office, he does not leave from the office yet). The above facts are documented proofs of trademark

papers and statements and sources of evidences of both sides.

Our Committee recognizes that there are two focuses in this disputed issue.

1. Whether the pending trademark is applicable to Section 31 of the "Trademark Law" for "aluminum metals" and similar goods or not.
2. Whether the pending trademark is applicable to Section 41(1) of the "Trademark Law" to erase registrations of the pending trademark for all goods or not.

Our Committee's opinion regarding to focus 1 is as follows:

1. The sources of evidence of parts I and II of the opponent sufficiently prove that, before the filing date of the holder of the trademark right (何天慶), the opponent has already continually used the pending trademark (Trademark "ERE") for products of aluminum metal produced by the opponent, and the pending trademark has had already substantial influence.

2. The decision whether the holder of the trademark right (何天慶) had bad faith or not, is as follows:

1. Trademark "ERE" is a combination of alphabets with no specific meaning, and has a substantial originality.
2. The holder of the trademark right (何天慶) does not have production conditions when the pending trademark is used for goods of 6th class.
3. The evidences 4 and 5 of part III of the opponent prove that, immediately after filing the pending trademark, the holder of the trademark right (何天慶) executed legal enforcement measures of the products of "ERE" brand aluminum metal of the opponent against several Industry & Commerce administrative departments in rapid succession, and more than 1000 tons of cargoes were impounded and seized.

In addition to this, the holder together with 孫欣 threatened the opponent and intended to obtain unfair profit, such as high transfer expenses of the trademark.

From the above three grounds, it is assumable that the holder of the trademark right (何天慶) clearly recognized the pending trademark of the opponent, and then filed the misappropriated application intending profit unfairly, thereby, the holder clearly had bad faith.

Thus, the fact that the pending trademark is registered for "aluminum metal" and the similar goods falls under the situation in Section 31 of the "Trademark Law" where "a misappropriated application of a trademark that is already in use by another party and enjoys substantial influence, is filed in an unfair manner."

Our Committee's opinion regarding to focus 2 is as follows:

Filing and registration of a trademark should satisfy the provision in Section 4 of the "Trademark Law" that "it is required for a natural person, a juridical person and another organization pertaining to production, manufacture, processing, selection and distribution of goods to possess the exclusive registered right of a trademark (relating to the goods) and to file the trademark application of the goods to the Trademark Office, and it is required for a natural person, a juridical person and another organization pertaining to a service to possess the exclusive registered right of a trademark (relating to the service) and to file the trademark application of the service of goods to the Trademark Office."

That is, registration of a trademark should be conducted based on a legitimate operation action, the demand of production, and the purpose of the production.

If registration of a trademark causes unfair profit, misappropriated application, damage the legitimate right of the other party, disruption of management and order of trademarks, and treachery to orderly market of fair competition and faith and trust, the act acts against the above provision, and will fall under the provision in Section 41(1) of the "Trademark Law" that "achieving registration in other unfair manners", thereby, the act should be stopped, and the registration of a trademark registered in an unfair manner should be erased.

In this issue, 1. the holder of the trademark (何天慶) is one of ordinary laborers of a chemical plant and a stockholder of a trademark agent, and did not engaged in the goods and business for which the pending trademark is used, in the past, and does not have

competency for production and operation which are relevant to the goods, and did not move into action of, such as, production and operation which are relevant to the goods, after the registration of the pending trademark,

in addition to this, in the midst of international financial crunch, the holder, regardless of orderly market and together with 孫欣 etc. executed legal enforcement measures of the products of "ERE" brand aluminum metal of the opponent against Industry & Commerce administrative departments of countries, such as, Zibo, Wuxi, Tianjin and Baotou, in rapid succession, to impound and seize more than 1000tons of cargoes of the opponent, and further, threatened the opponent to pay high transfer expenses of the trademark.

It is proved that in the acts of the holder of trademark right (何天慶) and 孫欣 etc. the purpose of filing and registration of the pending trademark is to obtain unfair profit and not to satisfy the original demand for production and operation action.

In addition, they already have caused extensive damage to the other markets of production and operation, and also have caused very bad influence on orderly market economy, resulting in extensive damage to the public interest of the business managers of related industries.

2. The holder of trademark right (何天慶) etc. while plotted together, have accused Industry & Commerce administrative departments of several countries against the products of the opponent. 孫欣, who is a trademark agent and committed extortion (against other person) in order to obtain unfair profit, is one of executives of Shandong Trademark Office, since 1993, together with his families and friends, he filed a misappropriated application of other party's trademark, and transferred it at high expenses to obtain economic profit in an unfair manner.

On November 11, 1998, the Trademark Office notified Shandong Commerce and industry Office and Shandong Trademark Office to strongly punish 孫欣 in written ultimatum (trademark 監 No.452,1998).

孫欣, not only did not change his behavior while considering of his own motive, but also continuously engaged in agency business as a trademark agent together with 何天慶 etc. under the name of Shandong Qilu Trademark Office Inc. Their act of filing a

misappropriated application of other party's trademark to obtain unfair profit is very bad.

On March 18, 2009, the Trademark Office again pointed out Shandong Commerce and industry Office that acts of 孫欣 and 何天慶 etc. already acted against the original intention of the Trademark Law, breached professional ethics of a trademark agent to break the image of the trademark agent, and gave significant loss to related parties and very bad influence to social activity, and thereby, notified the Office to strongly punish 孫欣 and 何天慶 etc. in written ultimatum (trademark 質字 No.57,2009).

The conclusion of the above matters is as follows: the application of 孫欣 and 何天慶 etc. is not intended to conduct production and operation action (relating to the pending trademark), instead, it is a misappropriated application. Their act, by which they obtained an unfair profit while utilizing exclusive registered right protection system of a registered trademark, acted against the intention of the Trademark Law, not only significantly damaged other party's legitimate right and profit, but also, gave very bad influence to social activity, disrupted management and order of trademarks and orderly market economy, and damaged social public interest. The unfair act of filing a misappropriated application acts against Section 4 of the "Trademark Law" providing that a trademark is registered for legitimate production and operation, and falls under the provision that "achieving registration in other unfair manners," thereby, the registration of the pending trademark shall be erased for all designated goods.

Thus, according to Sections 4, 31, 41(1) and (2), and 43 of the "China Trademark Law," our Committee decided as follows:

The registration of the pending trademark shall be erased. The party concerned, if being dissatisfied with this decision, can file an action to Beijing No.1 Intermediate People's Court within 30 days from the date when the party received this written judgment.

At the same time or within 15 days when submitted charging document to People's Court, the party concerned should notify our Committee the charging by sending copy of the charging document by mail or in writing.

EUIPO

EUIPO Guidelines for Examination, Part D, Cancellation, Section 2, Substantive

Provisions, Subsection 3.3, Bad faith.

<https://guidelines.euipo.europa.eu/1803468/1786581/trade-mark-guidelines/3-3-bad-faith-%E2%80%94-article-59-1--b--eutmr>

OUTSOURCE 2 INDIA case (31/05/2018, T-340/16, Outsource 2 India (fig.), EU:T:2018:314)

The German company Outsource2India contacted the Indian company Flatworld Solutions for collaboration in EU, in particular in Germany. The Indian company provided the German one with a login and password to access its website www.outsource2india.com. The Indian company later found out that the German company had created www.outsource2india.de and registered the EUTM. In view of this, the Indian company filed a declaration of invalidity based on bad faith which was upheld by the Cancellation Division. The German company filed an appeal and the Board of Appeal (EUIPO's second administrative instance) annulled the decision of the Cancellation Division stating that it was not apparent from the case file that the intervener had acted in bad faith or with dishonest intent.

Then, the Indian company filed an Application with the General Court claiming that (i) it had trade mark rights in the earlier mark and (ii) the German company was aware of the existence of its sign since they had a pre-contractual relation.

The General Court decided that “*irrespective of whether the wording ‘outsource2india’ is descriptive*”, attention must be paid to:

(i) The commercial intentions of the German company at the time of applying for the contested mark. Because of the negotiations with the Indian company, it was aware of the existence of the earlier similar sign. Moreover, it was also aware of the Indian company's activities under its non registered mark and its domain name, as well as its intention to develop the business, including possible commercial collaboration in Germany

(ii) The behaviour of the German company: It filed the application to register the contested mark shortly after the termination of its pre-contractual relationship with the Indian company.

The General Court ruled that these factors demonstrate bad faith of the German

company.

KIPO

Case No. 2007Heo2626 rendered on June 25, 2008 by the Patent Court (this case was supported by the Supreme Court)

The Court stated that the Defendant (the registrant for TOM & JERRY mark) had filed the “TOM & JERRY with device (Subject Mark) in unfair intention, i.e., as an imitation of the owner for famous TOM & JERRY Character mark (Plaintiff)'s character to exploit or cause damage to the Plaintiff or its licensees. It reasoned:

- (i) The Plaintiff had already registered 13 trademarks in Korea for the TOM & JERRY character and/or words, one of which was almost identical to the Subject Mark.
- (ii) The Defendant later filed and registered 50+ marks for Tom and/or Jerry Characters, some of which were identical to the Plaintiff's marks registered in Korea.
- (iii) The licensees in Korea had sold considerable quantities of goods bearing the Plaintiff's character.
- (iv) Since December 28, 2007, the Tom and Jerry Story (<http://www.tomandjerry.kr>; the Defendant's representative online seller) posted that "Warner Bros." had granted it a trademark license and it was the worldwide, exclusive manufacturer of TOM & JERRY bedding.
- (v) Since February 22, 2007, the Defendant demanded that the Plaintiff's local licensees cease use of the TOM & JERRY character due to trademark infringement, while thereafter insisting that these licensees execute license agreements with the Defendant.

USPTO

Estrada v. Telefonos de Mexico, S.A.B. de C.V., 447 F. App'x 197 (Fed. Cir. 2011). The Federal Circuit upheld the Trademark Trial and Appeal Board, finding likelihood of confusion and that the applicant acted in bad faith in adopting the mark. Applicant Andres Estrada filed for the mark AUDITORIO TELMEX for arena services and entertainment services. Telefonos de Mexico (opposer) challenged the application based on likelihood of confusion with the common law TELMEX mark for telecommunication services. Although Opposer's mark was in use in the U.S., it had no significant market share or proof of fame. Applicant claimed it made up the mark. Opposer has used the TELMEX mark for over 60 years in Mexico for telecommunication services. Applicant lived in Mexico for nearly 30 years, and lived

within 10 miles of the AUDITORIO TELMEX arena sponsored by Opposer, and exhibited bad faith in litigating the case. Under these circumstances, the Court agreed that Applicant's bad faith weighed in support of a finding of likelihood of confusion.

447 F. App'x 197 (Fed. Cir. 2011).

Carr v. Garnes, Opposition No. 91171220, 2010 WL 4780321 (TTAB Nov. 8, 2010) [not precedential]. The TTAB found a likelihood of confusion between the mark FROM AFROS TO SHELLTOES ART, ACTION, AND CONVERSATION for educational services, namely, conducting workshops and seminars in arts and entertainment, hip-hop, cross generational relationships, community building, and art as a political force to lessen misunderstandings between civil rights and hip hop generations, and the common law mark AFROS-N-SHELLTOES ENTERTAINMENT for "disc jockey services and artist management and promotion services, including the representation of rappers, singers and poets, as well as the representation of managers who want to promote their acts and groups." The TTAB found that Applicant Garnes acted in bad faith. Carr had spoken with attorney Marvin Arrington in 2004 regarding his business. Seven months later the attorney formed a corporation with Applicant Garnes and filed the application. Moreover, the parties are both located in Georgia, advertise in the same newspaper, and use the unusual term "shelltoes" in their marks. Applicant did not give an explanation as to how he came to adopt his mark under these circumstances. The TTAB sustained the opposition on the grounds of likelihood of confusion based on the similarity of the marks and services, the identical trade channels, and the fact that applicant acted in bad faith.

Q3. From The View of “Protecting Well-Known/Famous”
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Can a bad-faith filing be refused (or invalidated) based on legislation for well-known/famous marks, including protection against trademark dilution? (Yes/No)
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JPO

Yes.

CNIPA

Yes.

EUIPO

No. Marks with reputation enjoy an enhanced protection in opposition, but this is not linked to bad faith.

KIPO

Yes.

USPTO

Yes, a bad faith filing may be refused or invalidated based on legislation for well-known/famous mark, including trademark dilution.

IF YES:

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

JPO

Article 4, Paragraph (1) “Notwithstanding the preceding Article, no trademark shall be registered if the trademark:”

Item (x)

“[the trademark] is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;”

(xv)

“[the trademark] is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);”

(xix)

“[the trademark] is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided

for in each of the preceding items);

CNIPA

Section 13 of the "Trademark Law" provides that "where a mark is the reproduction, imitation, or translation of other party's famous trademark which has not been registered in China in respect of identical or similar goods, which may cause public confusion, no registration shall be granted and the use of the mark shall be prohibited." Where a mark is the reproduction, imitation, or translation of other party's famous trademark which has already been registered in China in respect of non-identical or non-similar goods, which may mislead consumers and cause damage the interests of the registrant of the famous trademark, no registration shall be granted and the use of the trademark shall be prohibited.

EUIPO

Article 8(5) EUTMR:

Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

KIPO

TMA Article 34(1)(xi), (xiii)

USPTO

In the U.S., well-known marks are protected through a likelihood of confusion analysis (15 U.S.C. §1052(d)), false association (15 U.S.C. §1052(a) and 15 U.S.C. §1125(a)), misrepresentation of source (15 U.S.C. §1064(3)), and dilution (15 U.S.C. §1125(c)). In determining likelihood of confusion, the TTAB or court will weigh a number of factors, including the fame of a mark (how well-known it is), bad faith intent, and similarities of the marks and goods or services. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462

(Fed. Cir. 1991). The flexibility in having a non-exhaustive list of factors for likelihood of confusion allows the Board or court to balance the factors and use a sliding scale in application: for example, the more evidence of bad faith, the less evidence is needed for establishing similarities in the goods or services and the fame of a mark. Moreover, the Board and the courts have flexibility in determining priority of use. “A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which create a public awareness of the designation as a trademark identifying the party as a source.” *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009).

The Trademark Dilution Revision Act of 2006 (TDRA) (15 U.S.C. § 1125(c)) provides for dilution by blurring or tarnishment. The TDRA defines “dilution by blurring” as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” The TDRA provides the following list of non-exhaustive factors that courts may consider in assessing dilution by blurring claims:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) ***Whether the user of the mark or trade name intended to create an association with the famous mark.***
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B). As noted, bad faith intent is a factor considered by the Board or court in determining dilution by blurring.

Bad faith may also be addressed through challenges on the grounds of misrepresentation of source under section 14(3) of the U.S. Trademark Act, 15 U.S.C. § 1064(3). In order to challenge on the grounds of misrepresentation of source, a party may petition to cancel a registration of a mark if the mark is being used by, or with the permission of, the respondent so as to misrepresent the source of the goods or services on or in

connection with which the mark is used, regardless of whether the petitioner has used its mark in the United States. The petitioner must show that respondent took steps to deliberately pass off its goods as those of petitioner. *E.g., Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1632 (TTAB 2014).

Finally, it is possible for an examiner to refuse registration or a third party to challenge registration under Section 2(a) of the Lanham Act, 15 USC § 1052(a), if a mark falsely suggests a connection with persons, living or dead, institutions, beliefs or national symbols, or brings them into contempt, or disrepute. An examiner may use Section 2(a) to refuse registration even in cases where the name of the well-known person, institution, beliefs or national symbols are not registered. The following factors would be considered:

- (i) The mark is the same as, or a close approximation of, the name or identity of a person or institution;
- (ii) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- (iii) The person or institution named by the mark is not connected with the activities performed by applicant under the mark; and
- (iv) The fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

As with claims for likelihood of confusion and dilution, although bad faith intent is not necessary to establish a claim, a finding of bad faith intent would weigh in favor of a finding of false association. *See University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1377 (Fed. Cir. 1983).

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

JPO

At the time of filing their applications and at the time of examiners' decision on them.

CNIPA

The above provisions may apply during the proceedings of opposition and proceedings of trial against the examiner's decision of a trademark, after the final decision by the

examiners.

EUIPO

No bad faith. An opposition on the basis of Article 8(5) can be filed as from the moment when the application is published (Article 44 EUTMR).

KIPO

At the time when the bad-faith applicant's trademark application filed with the Korean Intellectual Property Office (hereinafter "KIPO")

USPTO

A mark must be considered well-known or famous at the time the bad faith mark is adopted.

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

JPO

Bad faith filings can be legally refused by ex-officio examination. Furthermore, they can be determined in opposition proceedings or trials for invalidation.

CNIPA

They may apply during the subsequent proceedings of opposition and proceedings of trial against the examiner's decision.

EUIPO

Not on the basis of bad faith. No ex officio examination, just through opposition before registration (or invalidity application after registration).

KIPO

The above provision can be determined by ex-officio examination. Further, during an opposition or invalidation action, the plaintiff can also raise an argument that a mark is filed with unfair intention.

USPTO

An examiner would not typically consider bad faith during ex-officio examination for

likelihood of confusion or false association. Bad faith would be considered during opposition or cancellation.

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)?

JPO

The burden of proof rests on the parties who claim that the said trademark falls under Article 4, Paragraph (1), Item (x), (xv), and (xix).

CNIPA

There are rules of burden of proof, and the holder of a trademark bears it. Examples of case where misappropriation is presumed and established include a case in which has sufficient sources of evidence to prove that a trademark under a misappropriated application is same with or similar to a famous trademark and a strong originality.

EUIPO

The opponent who claims that its mark enjoys reputation has to prove it.

KIPO

In general, the owner for well-known or famous mark bears the burden of proving there was bad faith in filing the bad-faith trademark application.

USPTO

The burden is on the opposer/challenger to prove fame as well as bad faith intent by a preponderance of the evidence. However, an opposer may use circumstantial evidence of bad faith to support its claim, since direct evidence of bad faith is rarely available.

v) Please provide examination guidelines.

JPO

Article 4(1)(x) (Well-Known Trademark of Another Person)

1. “A trademark which is well known among consumers” includes not only a trademark which is well known among end consumers but also a trademark which is well known among traders in the industry and also includes not only a trademark

which is known throughout the country but also a trademark which is well known in a certain area.

2. A trademark to be cited for the application of the provision of this item must be well known among domestic consumers in Japan at a time when an application for trademark registration is filed (refer to Article 4(3).)
3. To judge whether or not the cited trademark "is well known among consumers," the provisions of Items 2(2) and (3) of Part II (Article 3(2)) of the Trademark Examination Guidelines apply *mutatis mutandis*.
4. A combination of another person's unregistered well-known trademark and other characters or figures are considered "similar" to the unregistered trademark including those trademarks whose description of the composition of appearance is well united or conceptually related. However, in cases where it is clear that the unregistered trademark constitutes part of an established word or other cases, the unregistered trademark will be excluded.
5. Concerning a trademark related to goods or services special in the manner of their transaction or provision (for example, goods such as medicines and drugs for medical use which are distributed in a specific market, or services to test and examine medicines or to research medicines which are provided only in a limited market), full consideration needs to be given to, in particular, the actual state of transaction of the goods concerned or the provision of the services concerned when examining proving method and the recognition based thereon (as mentioned in 3.) whether or not the trademark is well known.
6. In judging whether the trademark mainly used in foreign countries is well known in Japan, full consideration needs to be given to, if submitted, materials showing that the trademark concerned is (i) are well known in a foreign country, (ii) goods on which the trademark concerned is used are exported to several countries or (iii) services bearing the trademark concerned are provided in several countries.
7. Determination regarding trademarks that have been approved as trademarks well known among consumers in trial decisions and decision on objections or judgments (Note1) is made by sufficiently taking into consideration the facts found.

(Note 1) Trademarks may be searched through the Internet under "Japanese well-known trademarks" in the Japan Platform for Patent Information (J-PlatPat) provided by the

JPO.

(Reference) For further details related to the “trademarks well known among consumers,” refer to the Trademark Examination Manual 42.119.01.

Article 4(1)(xv) (Confusion over the Source of Goods and Services)

1. “... likely to cause confusion in connection with the goods or services pertaining to a business of another person” applies not only in the case where the consumers of goods or services (hereinafter referred to as "goods, etc.") are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as those connected with the business of other persons but also in the case where the consumers of the goods, etc. are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as connected with the business of a person who has a certain economic or organizational relationship with the other persons.

(Example) Cases that fall under this item

- (1) In the case where a trademark ㊟ used by a business operator X with respect to the service "provision of ramen" connected with its own business has become well known throughout Japan, the use of the trademark ㊟ by a business operator Y with respect to goods "soba noodles" (although not similar to the service "provision of ramen") connected with its own business leads consumers to mistakenly recognize the goods "soba noodles" as goods connected with another business of business operator X and such consumers would be confused over the source of the goods.
 - (2) In the case where a trademark "JPO" used by a business operator P with respect to goods "telecommunication machines and apparatus" connected with its own business has become well known throughout Japan, the use of the trademark "JPO" by a business operator R with respect to goods "toys" (although not similar to the goods "telecommunication machines and apparatus" and having no relationship with the goods in respect of their manufacturer, seller, distribution route, materials, intended purpose, etc.) connected with its own business leads consumers to mistakenly recognize the goods "toys" not as goods connected with the business of the business operator P but as goods connected with the business of an affiliate of business operator P and to be confused over the source of the goods.
2. To judge the liability of a trademark “likely to cause confusion in connection with the goods or services pertaining to a business of another person” the following facts are comprehensively taken into consideration.

- (a) The degree of similarity between the trademark as applied and the other person's mark.
- (b) The degree to which the other person's trademark is well known.
- (c) Whether the other person's trademark consists of a coined word or has a distinctive feature in its composition.
- (d) Whether the other person's trademark is a house mark.
- (e) Whether there is the possibility of multiple management in the company.
- (f) Whether there is any relationship between goods, services or goods and services.
- (g) Whether there is any commonality between the consumers of goods, etc. and other actual states of transactions.

In determining the degree of being well-known as prescribed in (ii) above, Part II, Item 2(2) and (3) (Article 3(2)) of the Trademark Examination Guidelines applies *mutatis mutandis* but it is not necessarily required that the other person's mark is well known across the country.

3. A trademark with its part indicating a famous trademark of another person shall be handled like as follows:

- (1) The relevant trademark found to be similar to another person's famous unregistered trademark and to be used for goods, etc. identical with or similar to the goods, etc. for which the unregistered trademark is used falls under the provision of Article 4(1)(x)
- (2) A trademark found to be similar to another person's famous registered trademark and to be used for goods or services identical with or similar to the designated goods or designated services pertaining to that registered famous trademark falls under the provision of Article 4(1)(xi).
- (3) A trademark liable to cause confusion over the source of goods or services, however it is recognized as not similar to a famous trademark of another person or is similar to a famous trademark of another person but used for different goods or services, falls under the provision of Article 4(1)(xv), in principle.
- (4) A trademark similar to a famous trademark of another person but the goods or services are not similar to each other and not liable to cause confusion over the source of goods or services, if used for unfair purposes, falls under the provision of Article 4(1)(xix).

4. A combination of another person's famous trademark and other characters or figures are, in principle, handled based on the presumption that it may cause confusion over the source of the goods, etc., including those trademarks for which

the description of the composition of appearance is well united or conceptually related.

However, exemptions will be made when another person's well-known trademark constitutes part of an established word, or, when it is clear that the source will not be confused in relation to the designated goods or designated services.

(Example) Cases that fall under this item

- “arenoma / アレノマ” for clothing with “renoma” (bags etc.)
- “PER • SONY,” “PER SONY,” or “PERSONY” for toys with “SONY” (electrical machinery and apparatus)

(Example) Cases that do not cause confusion:

- “POLAROID” for cameras with “POLA” (cosmetics)

5. When a mark famous in a foreign country is well known by Japanese consumers, determination is made by sufficiently taking into consideration such facts.

6. A three-dimensional trademark indicating the shape of a building,

(1) If the shape of a building (including the shape of the interior; the same shall apply hereinafter) is well known among Japanese consumers as the shape of another person's building before an application is filed for it, the relevant three-dimensional trademark falls under this item.

(2) The shapes of stores, offices or facilities which do not fall under the category of buildings (including the shapes of the interior) are handled in the same manner as above.

(Examples of stores, offices, or facilities which do not fall under the category of buildings)

Mobile vending vehicles, sightseeing vehicles, passenger airplanes, and passenger ships

7. In determining whether or not the relevant mark is famous, trademarks registered as a defensive mark or trademarks found to be famous in trial decisions, objections or judgments (note2) are handled as famous trademarks according to such registration or finding.

(Note2) See (Note1) for information on how to search for the corresponding trademarks.

(Reference) For other materials related to "trademarks well known among consumers," refer to Examination Manuals for Trademarks.

Examination guidelines of Article 4, Paragraph (1), Item (xix)

Please see the above stated II.Q2.v).

CNIPA

Section 14 of the "Trademark Law" provides that in case of recognizing a famous trademark, the following factors should be considered:

- (1) Public awareness with respect to the said trademark:
- (2) Period of continuous use (duration) of the said trademark:
- (3) Duration, degree, and geographical scope of advertising campaign of the said trademark:
- (4) Record indicating that the said trademark has been protected as a famous trademark:
- (5) Other factors by which the said trademark is recognized as a famous trademark

Section 5 of the "Enforcement Regulations of the Trademark Law" provides that if dispute occurs during the proceedings of trademark registration and trademark examination, in case where the said trademark falls under a famous trademark, the party concerned can request the Trademark Office or the Trademark Appeal Board to recognize the said trademark as a famous trademark, thereby, enabling to reject filing of a trademark registration application acting against the provisions in Section 13 of the Trademark Law and to erase trademark registration acting against the provisions in Section 13 of the Trademark Law. The party concerned should submit sources of evidence proving that the said trademark is a famous trademark at the time of filing. The Trademark Office shall make clear the fact, based on the appeal of the party concerned, and determine whether the said trademark is a famous trademark or not based on the provisions in Section 14 of the Trademark Law.

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1788248/trade-mark-guidelines/section-5-trade-marks-with-reputation--article-8-5--eutmr->

KIPO

Examination Guidelines Section 5.11, 5.13.

USPTO

Examination guidelines are not applicable with regard to bad faith since examiners typically will not assess bad faith during examination.

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?

JPO

There is no definition of “well-known,” “famous” and “reputed” trademarks in the Trademark Act of Japan.

The status of being famous or well known shall be determined, for example, by considering all of the following facts:

(1) The level of consumers’ awareness, which will be estimated through a substantive grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

- (i) The composition and mode of the trademark in an application
- (ii) The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use, and areas of use of the trademark
- (iii) The method, period, areas and scale of advertising
- (iv) Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, “the applicant or a person other than its members”) and states of its use
- (v) The characteristics of the goods or services and the actual state of their transaction
- (vi) The outcome of the questionnaire regarding consumers’ awareness of the trademark

- (2) The above facts (1) need to be proved by a method using evidence, including:
- (i) Photographs, movies, etc. showing the actual state of use of a trademark
 - (ii) Business documents (Order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.)
 - (iii) Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving his past record
 - (iv) Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application by persons other than the applicant
 - (v) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (However, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to the conductor, method, and respondents)

CNIPA

Please see answer to v) above.

EUIPO

Both well-known marks (Article 8(2)(c) EUTMR) and trade marks with a reputation (Article 8(5) EUTMR) are marks that can be used by their owner to raise an opposition against an EUTM application or a declaration of invalidity of a registered EUTM (Article 60(1)(a) EUTMR). These are grounds for opposition and invalidity/cancellation that are independent of the invalidity ground of bad faith.

The degree of inherent or acquired distinctiveness enjoyed by the invalidity applicant's sign and by the EUTM owner's sign are relevant factors when assessing bad faith (CJ judgment of 11/06/2009, C-529/07, 'Lindt Goldhase'). Therefore, where there is an increased level of distinctiveness, for example well-known character or reputation, this should be taken into account as one of the factors, but it is not a pre-requisite for a finding of bad faith.

An earlier well known mark (Article 8(2)(c) EUMR) is a trade mark that is well known in an EU Member State, in the sense in which the words well-known are used in Article 6 bis of the Paris Convention. It can be either registered or non-registered.

As regards a registered trade mark which has a reputation in the EU or a Member State (Article 8(5) EUTMR), reputation 'implies a certain degree of knowledge of the earlier

mark among the public’ and it ‘is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks ... and the earlier mark may consequently be damaged’. The earlier mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark (CJ judgment of 14/09/1999, C-375/97 ‘General Motors’, paras 22, 23).

In practical terms, the threshold for establishing whether a trade mark is well-known or enjoys reputation will usually be the same. Therefore, it will not be unusual for a mark which has acquired well-known character to have also reached the threshold laid down by the Court in *General Motors* for marks with a reputation. The Court of Justice qualified the notions of ‘reputation’ and ‘well-known’ as kindred notions (‘notions voisines’), underlining in this way the substantial overlap and relationship between them.

For further information, see EUIPO Guidelines

<https://guidelines.euipo.europa.eu/1803468/1788248/trade-mark-guidelines/section-5-trade-marks-with-reputation--article-8-5--eutmr->

KIPO

There is no definition as to ‘well-known’, ‘famous’ and ‘reputed’ trade marks in the TMA. And the IPT and/or Court require a trademark owner to submit a substantial amount of fame evidence including sales volumes, advertising expenditures, market shares, brand rankings, worldwide trademark registration, promotional materials.

USPTO

The United States considers the fame of a mark in the relevant sector of the public (whether it is “well-known”) in determining whether a mark is likely to cause confusion under Section 2(d) of the Trademark Act. A claim of dilution, however, requires a showing that the mark is “famous” in the United States, that it “is widely recognized by the general consuming public of the United States as a designation of source of the mark’s owner.” The U.S. does not have a separate standard for “reputed.”

TTAB judges use the following non-exhaustive list of factors to determine whether a mark is well-known or famous: degree of distinctiveness; duration and extent of use of the mark; duration and extent of advertising of the mark; extent of geographical trading

area; channels of trade; degree of recognition of the mark in those channels of trade; nature and extent of use of same/similar marks by third parties; and whether the mark is registered.

- 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?

JPO

The time period and scope of use shall be considered as decisive factors in determining whether the original trademark is well-known.

CNIPA

No matter it is a well-known or reputed original mark or not, the registered trademark is protected by Trademark Law as long as it is not cancelled because it is not used.

EUIPO

Yes. It was the case in T-327/12, Simca, EU:T:2014:289, § 40 and 49 [EUIPO-9]

KIPO

We think that if the well-known or reputed original mark was registered, then the bad-faith application can be rejected due to the similarity to the senior mark (i.e., the well-known or reputed original mark).

USPTO

If a mark is registered at the USPTO, but has not been used in the United States for a period of three years, there is a presumption that the mark has been abandoned. If there is a finding of abandonment, subsequent use of the mark would not be considered bad faith.

- 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?

JPO

Yes. Trademarks that are well known or famous only abroad but are not registered

domestically can be protected according to Article 4(1)(xix) of the Trademark Act of Japan.

CNIPA

No, a mark that is only well-known or famous abroad and not registered in China can not be protected according to the Trademark Law.

EUIPO

No, there is no specific legislation or practice regarding trade marks that are famous only abroad. Bad faith has been found even for not well-known or famous marks registered outside the European Union (T-335/14, Doggis, § 50 and ff.)

KIPO

Yes (TMA Article 34(1)(xiii))

USPTO

The United States does not have legislation or practice that allows for protection of a mark that is only well-known or famous abroad and not in the United States.

- 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?

JPO

“A trademark which is well-known among consumers abroad” must be well known in that country, but is not necessarily required to be well known in several countries. In addition, it does not need to be well known in Japan, either.

* The well-known or famous nature of trademarks in foreign countries shall be determined, for example, by considering all of the following facts in those countries:

(1) The level of consumers’ awareness, which will be estimated through a substantive grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

(i) The composition and mode of the trademark in an application

- (ii) The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use and areas of use of the trademark
- (iii) The method, period, areas and scale of advertising
- (iv) Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, “the applicant or a person other than its members”) and states of its use
- (v) The characteristics of the goods or services and the actual state of their transaction
- (vi) The outcome of the questionnaire regarding consumers’ awareness of the trademark

(2) The above facts (1) need to be proved by a method using evidence, including:

- (i) Photographs, movies, etc. showing the actual state of use of a trademark
- (ii) Business documents (Order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.)
- (iii) Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving his past record
- (iv) Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application by persons other than the applicant
- (v) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (However, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to the conductor, method, and respondents)

CNIPA

A mark that is only well-known or famous abroad and not registered in China can not be protected according to the Trademark Law. The mark should be proved that is well-known to the related Chinese public. The evidence of use submitted must meet the requirements of Trademark Law Article 14.1 and The Rules on Determination and Protection of Well-known Trademarks. When determine a trademark is well-known the Trademark Office should consider the factors comprehensively. But the trademark is not requested to meet all of the factors.

EUIPO

The invalidity applicant needs to show that the EUTM owner knew or must have known about the existence of the invalidity applicant’s mark outside the EU. The well-known character of a trade mark may help, depending on the specific circumstances of each

case, to prove said knowledge (e.g. owner established or present in the country where the earlier mark is famous). The evidence to be provided will depend, again, on the specific circumstances of the case (e.g., whether the owner is active in the same sector or in a different one), since what has to be proven is not the degree of knowledge of the average consumer but rather the actual knowledge of the EUTM owner as such.

Nevertheless, the well-known character is not a pre-requisite for a finding of bad faith. As indicated above, bad faith has been found even for not well-known or famous marks registered outside the European Union (T-335/14, Doggis, § 50 and ff.) [EUIPO-4]

KIPO

In this regard, we would like to explain the history of TMA 34(1)(xiii). Before July 1, 2007, even though the previous TMA (before July 1, 2007) allowed for protection of similar trademarks that were famous or well-known but have not obtained prior registration in Korea, the standard of evidence required in showing the fame or well-known status of a mark was extremely high. Thus, many marks that were identical and/or similar to another's unique mark can be registered if the prior user of the mark cannot sufficiently produce convincing evidence showing the fame or well-known status of its mark. In order to properly address these problem, the amended TMA lowered the standard of fame by deleting the word "easily" from Article 34(1)(xiii) of the previous TMA. The previous TMA Article was stipulated as "Trademarks that are identical or similar to a trademark easily recognized in Korea or outside Korea as a source identifier of another person, and which are used to obtain unjust profits or to inflict harm on the person shall not be registered."

The IPT and/or Court require a trademark owner to submit a substantial amount of fame evidence including sales volumes, advertising expenditures, market shares, brand rankings, worldwide trademark registration, promotional materials. Further, the Korean Supreme Court stated that the foreign court's decision which recognized the fame of mark in its own country should be respected (Case No. 2008Hu3131, rendered on November 27, 2008 by the Supreme Court).

USPTO

The United States does not have legislation or practice that allow for protection of a mark that is only well-known or famous abroad.

- 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?)

JPO

In cases when well-known/famous trademarks are likely to cause confusion as to the sources of goods and services (under Article 4, Paragraph (1), Item (xv)), or in cases when they are used for unfair purposes (under Article 4, Paragraph (1), Item (xix)), they shall be protected, even though they are under other classes or in areas of dissimilar goods and/or services.

The JPO has compiled the above mentioned “Japanese Well-known Trademark Search” found in the J-PlatPat into its database for examinations, so as to conduct cross-classes searches and examinations.

Moreover, the JPO also makes effective use of examiners’ Internet research and information provided by third parties (Please see III. Q1).

CNIPA

Well-known trademarks are mainly protected in non-similar goods and services. When determine the scope of protection, the Trademark Office should consider comprehensively about the reputation, similarity and relevance of goods and services of trademarks.

EUIPO

As mentioned above, the degree of inherent or acquired distinctiveness enjoyed by the invalidity applicant’s sign and by the EUTM owner’s sign are relevant factors when assessing bad faith.

The fact that the EUTM allegedly registered in bad faith is identical or similar to a sign to which the invalidity applicant refers may be significant for finding bad faith.

Nevertheless, likelihood of confusion is not a prerequisite of bad faith (12/09/2019, C-104/18 P, *STYLO & KOTON* (fig.), EU:C:2019:724, § 51), although in most of the cases where bad faith is found there is identity or similarity with an earlier sign.

KIPO

Yes.

USPTO

Trademarks that are well-known or famous in the United States may be protected against trademarks for goods in other classes or for goods that are dissimilar, provided that there is a likelihood of confusion. The greater the fame of a mark, the less similarity of goods or services is needed to support a finding of likelihood of confusion. Examiners, when they conduct searches, will search across classes to determine any likelihood of confusion. Moreover, an examiner may give broader protection to a well-known or famous mark, since the more distinctive and famous a mark is, the more likely a consumer is likely to believe the goods come from the same source.

- 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?))

JPO

In applying Article 4, Paragraph (1), Item (x) and (xv), bad faith will not be a requirement. In applying Article 4, Paragraph (1), Item (xix), the status of being well known and unfair purposes may be related to each other. However, even if trademarks are highly well known, it does not mean that there is no need to verify unfair purposes of applicants.

CNIPA

If the trademark has a high reputation, the burden of proof will be reduced relatively.

EUIPO

The degree of recognition enjoyed by the invalidity applicant's sign is only one factor when assessing bad faith. Proving such recognition does not relieve the invalidity applicant of his burden of proof as regards bad faith in general.

KIPO

Please be advised that the degree of fame of the well-known/famous mark is one of factors in determining whether was a bad-faith in filing a trademark application.

USPTO

In determining likelihood of confusion, the TTAB or court will weigh a number of factors, including the fame of a mark (how well-known it is), bad faith intent, and

similarities of the marks and goods or services. It is not necessary to have bad faith or fame in order to determine likelihood of confusion. The flexibility in having a non-exhaustive list of factors for likelihood of confusion allows the Board or court to balance the factors and use a sliding scale in application: for example, the more evidence of bad faith, the less evidence is needed for establishing similarities in the goods or services and the fame of a mark. Similarly, it is typically the case that the more evidence of fame, the less important a showing of bad faith.

- 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.)

JPO

It will be an element to be considered.

CNIPA

Yes. If a filed trademark is same with or similar to a previous trademark with high distinctiveness, it will be earlier to determine a bad-faith file.

EUIPO

The degree of inherent or acquired distinctiveness enjoyed by the invalidity applicant's sign and by the EUTM owner's sign are relevant factors when assessing bad faith.

Moreover, the fact that the invalidity applicant's mark is so fanciful that it is highly unlikely for the EUTM owner to come up with an identical or similar mark by chance is a relevant factor to be taken into account in the overall assessment of bad faith.

KIPO

Please be advised that the degree of creativity of the well-known mark is one of factors in determining whether was a bad-faith in filing a trademark application.

USPTO

Yes, the distinctive character of a mark would be taken into account in determining a likelihood of confusion and may be taken as circumstantial evidence supporting a finding of bad faith.

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

JPO

It will be an element to be considered.

CNIPA

It will be a factor to be considered.

EUIPO

Yes.

KIPO

Yes.

USPTO

Yes, this may be taken into account, again as circumstantial evidence supporting a finding of bad faith.

- 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-known or famous mark is concerned?

JPO

There is no exclusion period to file claims for the above.

CNIPA

No, the owner of a famous trademark shall not be bound by the five-year limitation.

EUIPO

No, bad faith can be claimed any time after registration of the EUTM.

KIPO

At the latest, an interested party may raise an invalidation proceeding with the IPT. Further, interested party can claim that a mark should be invalidated based on TMA Article 34(1)(xiii) at the phase of the Patent Court. However, in the Supreme Court,

interested party cannot add new invalidation action grounds which had not been raised in the IPT and/or Patent Court. And there is no statutory limitation for filing an invalidation action based on TMA Article 34(1)(xiii).

USPTO

Generally, the fame of the mark does not limit the time in which a claim of likelihood of confusion or false association can be brought. A challenge to a registered mark may be brought on the basis of likelihood of confusion within five years of registration. However, if a party can establish fraud on the office, or can establish a false association with an institution, the party may challenge a registration at any point, even beyond five years of registration. Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his or her application with the intent to deceive the USPTO.

- 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?

JPO

There is no exclusion period to request trials for invalidation against trademark registrations filed under bad faith. Also, the determination of whether applicants have filed under bad faith is decided both at the time of filing their applications and at the time of examiners' decision on their applications. Accordingly, even if trademark applications and registrations filed under bad faith were to become well known after a decision has been made to register them, this fact of being well known will have no bearing on the decision of bad faith.

CNIPA

Even if a bad-faith filed trademark gains popularity and influence after registration, it will not be protected by law from the beginning.

EUIPO

Only in very specific circumstances. For example, if the owner of a national mark in the EU applies for an EUTM in order to ensure a wider legal protection for his sign, consideration may be given to the extent of the reputation enjoyed by that national sign at the time when the application for its registration as an EUTM is filed (CJ judgment of

11/06/2009, C-529/07, ‘Lindt Goldhase’, paras. 51-52). Again, it is only one factor to be taken into account in the global assessment of bad faith.

KIPO

The fame of the trademark that is alleged to have been filed in bad faith is not relevant.

USPTO

No, the fame or reputation of a trademark that is alleged to have been applied for in bad faith is not relevant to a likelihood of confusion analysis. The fame of the trademark alleged to have been infringed would only be relevant.

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

JPO

Nothing in particular.

CNIPA

Record of trial or court decision can be taken into consideration.

EUIPO

No further comments.

KIPO

- (i) the degree of fame of the well-known/famous mark;
- (ii) the degree of creativity of the well-known mark;
- (iii) whether the applicant prepared for a business using the registered trademark; or
- (iv) whether the designated goods/services are same or similar, or have economic relationship.

USPTO

Marks that are famous or well known are afforded a greater scope of protection or exclusivity of use. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *See, e.g., Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d

350, 352-53 (Fed. Cir. 1992). The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 963 F.2d at 353.

The Federal Circuit’s language in *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F. 2d 669 (Fed. Cir. 1984), is instructive:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, and there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises “but one inference – that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark,” and that all doubt as to whether confusion, mistake, or deception is likely to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Id. at 676 (citation omitted).

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

JPO

Court Case of Article 4, Paragraph (1), Item (x)

Court decision of “COMPUTERWORLD” Case

Tokyo High Court (Gyo-ke) No. 29 1991, Date of Court Decision February 26, 1992.

<Summary of Court Decision>

The subject trademark in this case consists of horizontally written Japanese katakana characters “コンピューターワールド,” designating goods classified as Class 26 “Newspapers, magazines.”

The cited trademark in this case consists of the Roman alphabet word “COMPUTERWORLD” that is used as a title of “the newspaper.”

The court recognizes that “another person's trademark which is well known among consumers as that indicating goods in connection with the person's business” as stipulated in Article 4, Paragraph (1), Item (x) generally means: (1) a trademark that became “well known among consumers as a trademark indicating goods in connection with the [another] person's business,” as a result of its use mainly in foreign countries as a trademark as well as being reported and cited in the Japanese media as a trademark showing valuable and prestigious goods, and (2) a trademark that became “well known among consumers as a trademark indicating goods in connection with the [another] person's business” as a result of its use in Japan as a trademark. The reason for such recognition is that the legislative intent of Article 4, Paragraph (1), which stipulates the grounds for refusal and invalidation of trademark registration, clearly includes an intention to prevent confusion as to the sources of goods. From the perspective of this legislative intent, there is no reason to allow any confusion as to the sources of goods by approving registration of trademark (1) or trademarks that are similar to trademark (1) through distinguishing trademark (1) from trademark (2). Also, in the provision, there is no specific wording to refer only to trademark (2) as the factor for being “well known among consumers as a trademark indicating goods in connection with the [another] person's business.” Moreover, “[a trademark] which is well known among consumers as a trademark indicating goods in connection with the [another] person's business” does not need to be well known among all of the people in Japan. In case a trademark is required among limited consumers, namely, interested parties in certain areas, due to the nature of the goods, it may be sufficient to be well known among those consumers. (It should not cause any confusion among consumers as to the sources of the goods.)

Since 1967, the plaintiff has issued a weekly newspaper entitled “COMPUTERWORLD” in the U.S., but there is no evidence sufficient to verify that, at the time of filing the subject trademark in this case, this newspaper name became a trademark that is mentioned in the above stated (1) and (2). Nonetheless, the court recognizes the following as salient facts: computers have been developed and successfully commercialized in the U.S. and in the past, the computer related industries in Japan have focused significant attention on computer information in the U.S. Also, the court found the following facts: (1) during the years between around 1970 and 1980, the summaries and headlines of articles in the “COMPUTERWORLD” newspaper have been repeatedly used in magazines and printed publications issued in Japan, which would introduce computer news from outside Japan, (2) the newspaper name of

“COMPUTERWORLD” was clearly specified in these articles as the news sources, and (3) in 1973, the defendant, which has been a major Japanese newspaper in the field, introduced “COMPUTERWORLD” on the front page news of “電波新聞 (electronic newspaper)” (which the defendant issues) as “the most prestigious newspaper in the field.” Based on these facts, the court determines that, at the latest before the subject trademark in this case was filed, the name of the “COMPUTERWORLD” newspaper had been well known among interested parties in the Japanese computer related industries, and that the subject trademark in this case became a trademark as mentioned in the above stated (1).

Accordingly, the subject trademark in this case is determined to fall under Article 4, Paragraph (1), Item (x).

Court Case of Article 4, Paragraph (1), Item (xv)

Court decision of “L'air Du Temps” Case

Supreme Court (Gyo-hi) No. 85 1998, Date of Court Decision July 11, 2000. [JPO-6]

レールデュタン

L'AIR DU TEMPS

Claimed trademark

Cited trademark (Plaintiff's trademark)

<Summary of Court Decision>

The claimed trademark in this case consists of horizontally written Japanese katakana characters “レールデュタン,” designating goods classified as Class 21 “Personal ornaments for wearing.” The appellant (the plaintiff) owns a registered trademark (the cited trademark in this case) consisting of horizontally written Roman alphabet words “L'AIR DU TEMPS,” designating goods classified as Class 4 (current Class 3) “Perfumes.” The appellant has been using the following trademarks for perfumes (the designated goods): a trademark “L’Air du Temps,” a trademark consisting of the Japanese katakana characters “レール・デュ・タン” (in sum, “the trademarks in use in this case”) and the cited trademark.

The court recognizes that “[a trademark that] is likely to cause confusion in connection with the goods or services pertaining to a business of another person” stipulated in Article 4, Paragraph (1), Item (xv) generally means a trademark that is likely to be mistaken for being related to another person’s goods or services (hereinafter referred to

as “another person’s goods”) when this trademark is used in the designated goods or services (hereinafter referred to as “the designated goods”). In addition, the court recognizes that such trademark should also mean trademarks that are likely to be mistaken for being related to the business of a person who has a close business relationship with the above stated another person by being related to this another person’s subsidiary or affiliated companies, or belongs to a certain corporate group that manages product commercialization with a unified collective group mark (hereinafter referred to as “a likelihood of confusion in a broad sense (as to sponsorship or affiliation)”).

Generally, Article 4, Paragraph (1), Item (xv) functions as a provision to prevent a free-ride on well-known or famous indications of these trademarks and diluting such indications (so called “delusion”) as well as protect functions of trademarks indicating distinctiveness from others. Accordingly, the court recognizes that the Article aims to maintain business confidence of persons who use trademarks and protect the interests of consumers. From the perspective of this legislative intent, the court determines that trademarks that are likely to cause confusion in a broad sense (as to sponsorship or affiliation) should also not be registered, in order to protect the legitimate interests of persons who use the indications of well-known or famous trademarks, according to changes in company strategies and the markets such as diversification of business management, formation of a corporate group being united through product commercialization with the unified collective group mark, and building of famous brands.

And, any “likelihood of confusion” should be determined with full consideration given to all factors, based on degree of attention traders and consumers normally pay to the designated goods and services of claimed trademarks. More specifically, factors to be taken into consideration when determining “likelihood of confusion” include: (1) the level of similarity between a claimed trademark and another person’s indication, (2) the level of famous or well-known status of and originality of another person’s indication, (3) the nature of relationship between the designated goods of a claimed trademark and the goods related to another person’s business, (4) the extent of any relationship among intended purposes of use or intended goals, (5) any commonalities among traders and consumers of the goods and services, and (6) the actual state of business transactions.

The court recognizes that the claimed registered trademark “ルールデュタン” is

identical with the trademark “レール・デュ・タン” of the trademarks used by the plaintiff, at least in terms of pronunciation, and that they are similar also in terms of appearance. Moreover, from the perspective of the identification of the cited trademark “L'AIR DU TEMPS” and its designated goods, when pronounced in French, the cited trademark could generate the pronunciation of “レールデュタン” (the claimed registered trademark). Accordingly, the court determines that the registered trademark “レールデュタン” is identical with the cited trademark “L'AIR DU TEMPS” in terms of pronunciation.

Also, the trademarks in use and the cited trademark in this case have been well known among traders handling perfumes and consumers interested in luxury perfumes as an indication of perfumes of the appellant (the plaintiff), and are distinctively original trademarks.

In addition, the court recognizes that among the designated goods of the registered trademark “レールデュタン,” “cosmetic and toilet utensils, personal ornaments, hair ornaments, bags and the like, pouches and the like” and perfumes, which are related to the trial for invalidation, have a close relationship mainly with the intended purposes of use as ornaments for women, and that in most cases, these designated goods have common consumers.

Considering all of the above stated facts, the court judges that using the registered trademark “レールデュタン” for “cosmetic and toilet utensils, personal ornaments, hair ornaments, bags and the like, pouches and the like” is likely to cause a confusion in a broad sense (as to sponsorship or affiliation) among traders and consumers involving such goods. In other words, such goods are likely to be mistaken for being related to those related to the business of the above stated another person who has a close relationship with the appellant (the plaintiff).

Also, the fact that the trademarks in use and the cited trademark in this case have been being used as so called “Pet Marks” may not affect the above stated judgment, based on the famous status of these trademarks in use and the close relationship among the goods related to both of these trademarks in use and the claimed registered trademark.

Court Case of Article 4, Paragraph (1), Item (xix)

“iOffice 2000” Case

(Tokyo High Court (Gyo-Ke) No. 205 2001, November 20, 2001)

iOffice 2000

<Summary of Court Decision>

The subject trademark in this case is “iOffice2000” that consists of letters and numbers, designating goods classified as Class 9 “Electronic circuits, magnetic disks, and magnetic tapes storing computer programs, and other electronic appliances.”

According to the certified facts and items of evidence, the words “Office95,” “Office97,” and “Office2000” are a combination of the word “Office” and the Western calendar year. Accordingly, these words by themselves may not be recognized to have sufficient inherent distinctiveness from other goods. Nonetheless, thanks to advertising, information provided by the media, and news articles in magazines, the court finds that these words have already become famous trademarks of the famous office software of Microsoft Corporation in both the U.S. and Japan, at least before the subject trademark was filed.

The letter “i” by itself is a Roman alphabet letter and seems to have no specific meaning, while the portion of “Office2000” is identical with Microsoft’s famous trademark. Based on these facts, the court finds it likely that the use of the subject trademark “iOffice2000” for the designated goods would cause misidentification, signifying that traders and consumers involving such goods, in some cases, might not notice the letter “i” at the beginning of the word, and may recognize and figure out only the portion of “Office2000” from the subject trademark.

Also, the pronunciation of the subject trademark is produced with a relatively long sound “アイオフィスニセン [AIOFFICENISEN].” Consequently, the court recognizes that the latter portion of the subject trademark could also generate a pronunciation of “オフィスニセン [OFFICENISEN],” namely, the same pronunciation of Microsoft’s “Office 2000.”

Based on this, it could be determined that, after sufficiently recognizing the fact that “Office2000” had already become a famous trademark, the plaintiff filed a trademark application to register the subject trademark in this case, which is similar to “Office 2000,” and used it after it had been registered. Accordingly, the court has to admit that the plaintiff filed a trademark application to register the subject trademark with the

intention of obtaining a free-ride on the fame of Microsoft's trademark "Office2000," and used the subject trademark for groupware, which is obviously closely related to office software. Also, use of the subject trademark by the plaintiff is also found, as a result, to be very likely to dilute the fame of Microsoft's "Office2000."

Therefore, the court concludes that the plaintiff used the subject trademark "iOffice2000" for its goods, groupware, for "unfair purposes," as referred to in Article 4, Paragraph (1), Item (xix), and to the same effect, there is no mistake in the determination and judgment of the trial decision.

"S DESIGN" Case

(Intellectual Property High Court (Gyo-Ke) No. 10220 2009, Date of Court Decision March 30, 2010)



Claimed trademark
(the plaintiff's trademark in this case)



Cited trademark
(the defendant's trademark)

[Court's holding]

The trademark subject to this case is the claimed trademark shown above, designating goods classified as Class 12 "Automobiles and their components and accessories, machine elements for land vehicles, anti-theft alarms for vehicles, AC motors or DC motors for land vehicles [not including "their parts"] and two-wheeled motor vehicles."

The cited trademark is the defendant's trademark shown above, which is used for the defendant's goods and services such as "parts for modifying automobiles and vehicle modifications by using these parts."

Considering all the identified findings on the well-known status of the cited trademark, the cited trademark had been well known among consumers as an indication of the defendant's goods, namely, parts for modifying automobiles and vehicles with modified parts in European countries, mainly in Switzerland and Germany, both at the time of filing the subject trademark and at the time of the examiners' decision on it. Also in Japan, especially among foreign car buyers, the court finds that the cited trademark had

been well known to a considerable extent.

Let's consider the details of similarity between the subject trademark and the cited trademark. The appearance of both trademarks, especially the S-shaped figure that forms a characteristic part that generates distinctiveness, has the following common points: the entire shape of a letter "S," the degree of inclination of the letter, and the use of a three-dimensional shape with gradations of colors. Accordingly, the appearance is considered to be similar.

Also, each S-shaped figure forms the main part of both trademarks and will generate a common pronunciation "エス[S]." However, the "S" is not considered to generate any specific concept. Based on this, the claimed trademark and the cited trademark can be judged to be similar in terms of appearance and pronunciation, without any emitting any specific concept, so both trademarks are judged to be similar.

Next, let's consider the background and details of the unfair purposes. The defendant (SPORTEC Europe, the owner of the cited trademark) claimed that: (1) at the Tokyo Motor Show held in the autumn of 2003, SPORTEC Japan, which was the defendant's de facto distributor in Japan and where the plaintiff served as head, adopted inappropriate display methods without SPORTEC Europe's consent, and that these methods were likely to cause misidentification, in that SPORTEC Japan sells the defendant's products also for Japanese cars. Consequently, the relationship between the defendant and SPORTEC Japan became worse. As a result, on December 9 in the same year, SPORTEC Japan sent a letter to the defendant to request dissolving the commercial relationship and their partnership was cancelled. (2) The plaintiff filed an application to register the claimed trademark on November 13, 2003, which was after the relationship between the plaintiff and the defendant became worse but before their partnership was cancelled. (3) In the autumn of 2004, the defendant sent letters to SPORTEC Japan dealers, demanding that they stop selling imitation SPORTIC wheels, leaving no possibility for the partnership between the defendant and SPORTEC Japan to continue. (4) In November 2006, the plaintiff put up the "SPORTEC" trademark on the wall of a shop "ティーエスエム[TSM]" managed by the plaintiff himself. Also, placed around the shop were catalogues showing the cited trademark of the defendant's products. Considering all these facts, the plaintiff filed an application and obtained registration for the subject trademark under condition that he was inevitably to terminate the partnership with the defendant, with the intention to make profits for his own

business by using the cited trademark and the defendant's goods, which would be attractive to consumers, even after the partnership had terminated. Accordingly, the filing and registration are determined to have been intended for unfair purposes.

“MARIE FRANCE” Case

(Trial Court No. 25958 1995, August 11, 1999) [JPO-7]

MARIEFRANCE

MARIE FRANCE

Claimed trademark (of Japanese fashion maker)

Cited trademark

(the title of a French Magazine “MARIE FRANCE”)

<Summary of Trial Decision>

The claimed trademark consists of horizontally written Roman alphabet letters “MARIEFRANCE,” designating goods classified as Class 25 “Clothes made in France, and coats made in France.” The Roman alphabet letters “MARIE FRANCE” (with a space) have been considered to be well known and famous in France as the title of a French magazine at the time when the claimed trademark in this case was filed for registration.

Also, in terms of the order of the letters, the claimed trademark is completely identical with “MARIE FRANCE,” the title of the French magazine stated above, and thus regarded to be generally accepted as an identical trademark. Accordingly, it is very hard to believe that the applicant of the claimed trademark could file an application out of coincidence or without any cognizance of the fact that the magazine called “MARIE FRANCE” existed which is the same order of letters. Therefore, it was determined that the applicant almost directly applied the title of the “MARIE FRANCE” magazine to the claimed trademark.

Moreover, the designated goods of the claimed trademark were those including “non-Japanese style outerwear for women, namely, coats, sweaters and the like, nightwear, underwear, and swimwear.” In addition to the fact that the contents of the “MARIE FRANCE” magazine consist of women’s fashion information, considering the fact that, also in Japan, significant attention has been paid to fashion trends in France, it

is assumed that, in terms of consumers, the women's fashion magazine and the goods designated by the claimed trademark may overlap to a certain degree.

Based on these, in case the legitimate trademark rights holder of the "MARIE FRANCE" magazine or persons related to the magazine wish to enter the Japanese market, it is likely that confusion will arise as to the sources with the claimed trademark, ultimately leading to the prevention of their entry into Japan.

Consequently, it should be noted that in the application for the claimed trademark, the cited trademark, which is well known and famous in foreign countries, was used almost "as is," in order to be used for unfair purposes, working against the principle of fairness and equity.

Therefore, it was determined that the claimed trademark falls under Article 4, Paragraph (1), Item (xix) of the Trademark Act.

"M.A.C·MAKEUP ART COLLECTION" Case: Decision on Opposition
(Opposition No. 92239 1998, March 28, 2000) [JPO-8]

The claimed trademark consists of the letters "M.A.C" in a stylized, outlined font, with the words "MAKEUP ART COLLECTION" in a smaller, sans-serif font directly below it.

Claimed trademark

The cited trademark consists of the letters "M.A.C" in a stylized, outlined font, identical to the one in the claimed trademark.

Cited trademark

<Summary of Decision on Opposition (Decision Upholding Opposition)>

The trademark in this case is the claimed trademark shown above, consisting of stylized letters "M.A.C." and Roman alphabet letters "MAKEUP ART COLLECTION," which are written horizontally in double column format. It designates goods classified as Class 18 "Bags and the like, pouches and the like, vanity cases, handbag frames, purse frames, saddlery, etc." On the other hand, the cited trademark, which is the opponent's trademark shown above, consists of horizontally written Roman alphabet letters "M.A.C." It represents goods classified as Class 3 "Perfume and flavor materials, cosmetics and toiletries, and dentifrices."

The trial found that the cited trademark used by the opponent has been used as a trademark for "makeup cosmetics and toiletries," and these goods have been very

popular products widely sold in the world, including Canada and the United States.

And, it was also found that the ornamental features of the Roman alphabet letters “MAC” constituting the claimed trademark is completely identical with the inherently distinctive design of the cited trademark, even in its smallest details.

Moreover, the letters “MAKEUP ART COLLECTION” written in the lower part of the claimed trademark seem to be related to makeup cosmetics traded by the opponent. And, its designated goods include vanity cases that the opponent is currently selling as products.

Based on these, it is difficult to believe that the claimed trademark happened to be identical with the cited trademark by coincidence. Accordingly, it could be inferred that, after sufficiently recognizing the fact that the claimed trademark is identical with or similar to the cited trademark that has been well known among consumers in Japan and abroad as a trademark indicating goods related to the other person’s (opponent’s) business, the trademark right holder filed a trademark application to register the claimed trademark and obtained trademark rights for this trademark, by taking advantage of the unregistered condition of the cited trademark, for either of the following purposes: (1) to prevent the cited trademark’s foreign rights holder, the opponent, from entering into the Japanese market, (2) to force the opponent into an agency agreement in Japan, (3) to dilute the cited trademark’s capacity to attract consumers, and (4) to obtain a free-ride on the commercial appeal of the cited trademark, intending to make unfair profits. Consequently, it was determined that the claimed trademark in this case falls under the category of a trademark that is filed for unfair purposes.

Therefore, the claimed trademark in this case falls under Article 4, Paragraph (1), Item (xix) of the Trademark Act.

CNIPA

(1) No. 4481864 "金灶" (金竈) trademark opposition issue:

Canton 海利集團 Inc. (hereinafter referred to as opponent) submitted opposition to 葉川 (hereinafter referred to as respondent) employing Beijing Trademark Office Inc. as an agent against Trademark No. 4481864 "金灶" (金竈) which passed the early examination of our Office and appeared in the "trademark bulletin" No.1073, and our Office accepted the opposition based on Section 30 of the "Chinese Trademark Law."

The respondent has not answered to it within a predetermined time limit.

The view of our Office based on statements of facts and reasons by the party concerned is as follows: In this issue, the opponent claimed that the trademark registered by the opponent for goods in 11th class fell under a famous trademark, and provided relevant evidences.

The evidences provided by the opponent can be proved, and the said trademark has become known widely to the Chinese public through advertisement and use.

Our Office, based on the provisions in Section 14 of the "Trademark Law," recognized Trademark "金灶" (金竈) registered and used for goods "Electric Pot" by the opponent as a famous trademark.

The designate goods "金灶" (金竈) under opposition is "Salami (smoke-dried meat)" in 29th class, and the trademark under opposition since being similar to the opponent's trademark ("金灶"). Our Office judged that the trademark under opposition an imitation of the famous trademark, and if being used for the designated goods, the registered trademark under opposition would mislead and damage the interest of the holder of the right of the said famous trademark.

On the basis of Sections 13(2) and 33 of the "China Trademark Law," our Office decided as follows: the reason of opposition of the opponent establishes, thereby, registration of Trademark No. 4481864 "金灶" shall not be permitted.

According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a new trial to Trademark Appeal Board within fifteen days from the date of this decision.

(2) Trademark No. 1649903 "雅虎 YAHOO" opposition and retrial (trial against the examiner's decision) issue:

The respondent (義烏市 利邦剃須刀 Inc.) of the trademark "雅虎 YAHOO" under opposition filed the application on September 4, 2000, and designated goods, such as a razor, and a razor box of 8th class. The opposition did not establish at the decision of the

Trademark Office.

The opponent (YAHOO), against the decision of our Board, claimed that since having sufficient obviousness and an extremely high name recognition in the Internet field (communication services, such as E-mail in 38th class, and computer website search service in 42th class) and the Internet related field (computer software in 9th class and computer software service in 42th class).

Since the respondent must naturally have known the trademarks of the opponent, the said disputed trademark are imitations and translations of the trademarks already registered by the opponent.

Based on the provisions in Sections 13 and 14 of the "Trademark Law," Section 5 of the "Enforcement Regulations of the Trademark Law" and Section 3 of the "Provisions related to recognition and protection of Famous Trademark," the trademarks under opposition shall not be registered, and the use of them shall be prohibited.

According to our Board's opinion, based on the verification of the sources of evidence submitted of the opponent, Trademark No. 1327419 "雅虎" and Trademark No. 1109289 "YAHOO!," which are registered and used by the opponent for "survey and search of information on network" services in 42th class, have become known widely in China before the filing date of the disputed trademark, thereby, they are famous trademarks that provided by Section 15 of the "Trademark Law."

Thus, the disputed trademark "雅虎 YAHOO" is the reproduction and imitation of other party's famous trademark. To determine whether the registration of the disputed trademark misleads the public or not, factors, such as, the name recognition, originality, degree of similarity, and association to goods of the said trademark should be totally considered.

Considering that "YAHOO!" is seen comparatively rarely in English, and "雅虎" is not a peculiar word in Chinese, it can be said for the above two trademarks to be comparatively original.

Since the part of Chinese character of the disputed trademark is perfectly the same as Trademark "雅虎" of the opponent, and the part of English is substantially the same as

Trademark "YAHOO!" of the opponent, act that the respondent has registered the disputed trademark cannot be said to be fair.

As mentioned above, since the fact that Trademark "雅虎" and Trademark "YAHOO!" of the opponent are registered and used for Internet search service, is widely recognized by the public, to use the said disputed trademark for goods, such as a razor and a razor box, would mislead the public, cause confusion of the source, and damage the interest of the opponent.

The act that the respondent has filed the application of the disputed trademark afterward, falls under the acts to reproduce, imitate and translate other party's famous trademark for non-similar goods, which are clearly stipulated in Section 13(2) of the "Trademark Law." Thereby, the said act may mislead the public and damage the interest of the holder of the right of the famous trademarks. Therefore, the registration of the disputed trademark shall not be permitted.

According to the provisions in Sections 13(2), 33, and 34 of the "Trademark Law," our Board decided as follow: the registration of the disputed trademark shall not be permitted.

(3) Trademark No. 3217926 "神州三号" opposition issue:

Claim of the opponent (China Academy of Space Technology):

The opponent is the developer of the spaceship "神舟 (Shenzhou)" series, and the legal right holder of Trademark No. 1661968 "神舟 (Shenzhou)" and "神舟" series. Since, the Central Government allowed the use of "神舟" as a trademark of the spaceships, and the national leader personally named it, Trademark "神舟" has specialty, obviousness and uniqueness.

The spaceships of the "神舟" series have been launched wonderfully and collected successfully every time, which are surprised globally and advertized and reported through domestic and foreign major media, televisions, radios, newspapers and magazines, Internets, etc. It can be said that Trademark "神舟" is globally famous, and has extremely high name recognition in China and all over the world, thereby,

Trademark "神舟" can already be called as a famous trademark.

The disputed trademark "神舟三号" is the reproduction or imitation of the opponent's famous trademark "神舟." Filing and registering the disputed trademark not only mislead a consumer the source of a product but also make it difficult for the opponent (the right holder of Trademark "神舟") to develop the field of aerospace medicine using the "神舟" brand, and damage the legal interests of the opponent. Therefore, the registration of the disputed trademark goes against the provisions in Section 13(2) of the Trademark Law, thereby, based on this, the said trademark must be erased.

The respondent (Xi'an 亨通光華 Pharmaceutical Inc.) did not answer within the time limit set by our Board. The trial and investigation results of the Trademark Examination Board are as follows:

1. The disputed trademark was one filed to the Trademark Office on June 21, 2002 by the respondent, and registered on September 14, 2003. Designated goods are oral liquid medicine in 5th class, etc.
2. As of 1999, the opponent had registered nearly 70 trademarks, such as "神舟" and "神舟五号," for many classes, goods and services.
3. Trademark "神舟" of the opponent has been used continuously from 1998 up to today.

Before the filing date of the disputed trademark, the opponent have engaged in the research and development and the launching of the spaceship "神舟" three times. Trademark "神舟" is not only painted on spaceships but also widely used in the office building of the opponent. It is also used in places of, such as various space flight exhibitions and international industry fairs.

The returns of Shenzhous 1 to 6 are a symbol of the development of the manned space flight of our country. The bodies of those spaceships are stored in places, such as, China Science and Technology Museum, the Spaceflight Museum of China, the National Museum of China, and are exhibited to the public. Every time when Spaceship "神舟" was launched, Spaceship "神舟" and the opponent were repeatedly reported through Chinese major media including televisions, radios, newspapers, Internets, etc. as well as

foreign major media, newspapers and magazines and radios.

Spaceship "神舟" of the opponent obtained the second prizes and the third prizes in more than 70 outcomes of National Defense Science and Technology, before the filing date of the dispute trademark. In addition, the opponent submitted the documents which proved that Trademark "神舟" deserved protection and the documents which could prove the usage conditions and honors etc. of Trademark "神舟."

The result of deliberations of the Trademark Examination Board is as follows: The opponent was engaged in the research and development of three spaceships of "Shenzhou." Together with much interests from inside and outside of the country at the launch of every time of the spaceship "Shenzhou," it has been reported again and again as top news by each major medium including a television, a radio, a newspaper, a Internet, etc.

The fact that the spaceship "神舟" was launched magnificently is a milestone of the manned space flight history of our country. Trademark "神舟" already has a comparatively high awareness and influence, thereby, Trademark No.1661968 "神舟 shenzhou" of the opponent can be recognized as a famous trademark used for an air transportation tool and a spaceship.

Trademark "神舟" of the opponent has a comparatively high name recognition, thereby, the registration and use of the disputed trademark may cause the public to confuse the source of the trademark with the source of Trademark "神舟" of the opponent, and may mislead the public that there is any relationship between the respondent and the opponent.

Therefore, there is a possibility of confusion or misconception of the source of goods, which may damage the legal use and the interests of the opponent. Therefore, because the registration of the disputed trademark goes against the provision of Section 13(2), the registration shall be erased.

(4) Trademark No. 22534338 "外研社" opposition issue:

Foreign Language Teaching and Research Press Co., Ltd. (hereinafter referred to as opponent) submitted opposition to Shenzhen Xiaotiantian Electronic Co., Ltd. (hereinafter referred to as respondent) against Trademark No. 22534338 "外研社" which

passed the early examination of our Office and appeared in the "trademark bulletin" No.1575, and our Office accepted the opposition based on the "Chinese Trademark Law." The respondent has not answered to it within a predetermined time limit.

The view of our Office based on statements of facts and reasons by the party concerned is as follows: The disputed trademark "外研社" is designated in class 28 "game equipment, toys", etc. The opponent cites that the previous trademark No. 4831675 "外研社 foreign language teaching and Research Press" with picture has been approved to be used in class 16 "books, printed publications", etc. In this case, the opponent claimed that the disputed trademark "外研社" was a malicious plagiarism and imitation of the trademark "外研社 foreign language teaching and Research Press" which is well-known in the class of "books and printed publications" and provided relevant evidences.

The evidences provided by the opponent can prove that the previous trademark No. 4831675 "外研社 foreign language teaching and Research Press" with picture has become known widely to the Chinese public through advertisement and use.

The disputed trademark "外研社" has the characters with the previous trademark "外研社 foreign language teaching and Research Press" with picture of opponent . Our Office judged that the disputed trademark is an imitation of opponent's trademark. If the disputed trademark is approved for registration, it would mislead the public and damage the interest of the opponent.

On the basis of Sections 13(3) and 35 of the "China Trademark Law," our Office decided as follows: the registration of Trademark No. 22534338 "外研社" shall not be permitted.

According to Section 35 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a new trial to CNIPA within fifteen days from the date of this decision.

EUIPO

CJ judgment of 11/06/2009, C-529/07, 'LindtGoldhase'(cited under Q1 above)

Simca was a well-known mark for cars in Europe at least in the 60's and 70's. It remained registered but no cars were produced. Nevertheless, bad faith was found as it

was inferred that the purpose of the EUTM owner was to ‘free-ride’ on the reputation its registered marks and to take advantage of that reputation (08/05/2014, T-327/12, Simca) [EUIPO-9]

Furthermore, as indicated above under vii), bad faith was found in the OUTSOURCE 2 INDIA case (31/05/2018, T-340/16, Outsource 2 India (fig.), EU:T:2018:314) even though the earlier mark was not well-known and had not been registered in the European Union.

KIPO

Case No. 2007Heo2626 rendered on June 25, 2008 by the Patent Court (this case was supported by the Supreme Court)

On appeal, the Plaintiff submitted various merchandising evidence in the U.S., Japan, and Korea to substantiate the fame of the TOM & JERRY character. The registrant ("Defendant") rebutted that (i) the Plaintiff's various versions of the character cannot be recognized as a single source; (ii) the character was used merely as a design, not a source-indicating trademark, and (iii) sales of goods were not substantial (moreover, due to the diverse range of used goods, sales by each product item were very low).

After considering the above, the Patent Court held that the Plaintiff's Character was a famous trademark in the U.S. and Japan, in view of the degree of well-known status, duration, method and mode of use, types of products, and extent of sales. It dismissed the Defendant's arguments as follows:

- (i) The various versions used by the Plaintiff's licensees clearly shared the same basic characteristic shape and appearance and is a basis for judging the well-known status of the Plaintiff's Character.
- (ii) The method and degree of expression among the character versions showed that they function both as a design and source indicator.
- (iii) Further, the extent of sales was not an adequate basis for dismissing the character's fame. Despite the fact that well-known characters - such as the Plaintiff's character - can attract or be easily recognized by consumers, the sales in total or by product item may still be comparatively low. Thus, the sales-based argument was considered insufficient.

USPTO

L'Oreal S.A. v. Marcon, 102 USPQ2d 1434 (TTAB 2012). The fame of the marks L'OREAL and L'OREAL PARIS for cosmetics and personal care products was a major factor in the Board's sustaining opposer's Section 2(d) claim in this opposition to L'OREAL PARIS for "aloe vera drinks." As to the claim that applicant lacked a *bona fide* intent to use the mark, applicant's pattern of filing ITU applications for disparate goods under the well-known or famous marks of others was a basis for sustaining that claim. The Board found opposer's marks to be famous based on billions of dollars in sales, significant market share, huge advertising expenditures, extensive media exposure, impressive brand awareness, and consistent high ranking by *Business Week*. The marks were considered identical and, while at first glance cosmetics and beverages "might not appear to be inherently related," opposer submitted "substantial evidence to show several reasons for finding such goods to be related;" for example, companies have marketed cosmetics and beverages under the same mark. Marcon's history of filing applications for products for which he had no relevant experience convinced the TTAB that adoption of this mark was in bad faith, although the Board observed that even without bad faith it would still find confusion likely.

Q4. Unfair Application filed by Agent or Representative

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

JPO

Yes.

CNIPA

Yes.

EUIPO

Yes.

KIPO

No. KIPO has no such a law. However, if such an application is considered to be filed under the bad-faith, such as free-ride on the fame of a third party, the application can be rejected.

USPTO

An application to register a mark must be filed in the name of the owner of the mark or, in the case of an intent-to-use application under 15 U.S.C. § 1051(b), by the person who is entitled to use the mark in commerce. Normally the owner of a mark is the person who applies the mark to goods that he or she produces, or uses the mark in the sale or advertising of services that he or she performs. An attorney cannot file an application in his or her own name on behalf of the owner, or the application would be void *ab initio* (from the beginning).

In addition, there is a duty of candor and disclosure in practice before the Trademark Office and TTAB. Before signing, filing, submitting, or later advocating any paper to the Office, attorneys have a duty of candor and a reasonable inquiry to confirm: (1) allegations and other factual contentions have evidentiary support and (2) legal contentions are warranted by existing law. 37 C.F.R. § 11.18. An attorney or authorized representative who makes false statements, withholds material information from the Trademark Office, or fails to correct a misrepresentation once known may be subject to disciplinary action under USPTO regulations.

A practitioner may be subject to concurrent disciplinary action before both the USPTO and State authorities. In the USPTO, the Office of Enrollment and Discipline ("OED") is responsible for investigating grievances and allegations of misconduct. Penalties for violating this duty could be a private or public reprimand, suspension (from 1 day up to 5 years), and/or disbarment (for a minimum of 5 years).

IF YES:

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

JPO

Trademark Act

Article 53-2 Where a registered trademark is a trademark pertaining to a right to a trademark (limited to a right equivalent to a trademark right) held by a person in a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or a trademark similar thereto, and the designated goods or designated services thereof are goods or services pertaining to the said right or goods or services similar thereto, and further, the

application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by his/her agent or representative or by his/her former agent or representative within one year prior to the filing date of the trademark registration, the person who has the right pertaining to the trademark may file a request for a trial for rescission of the trademark registration.

CNIPA

Section 15.1 of the "Trademark Law" provides that that where an agent or representative, without the authorization of the client (of the agent or the representative), seeks to register in the agent's name the client's trademark and where the client opposes, registration shall not be granted and the use of the mark shall be prohibited.

EUIPO

Article 8(3) EUTMR: Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

Article 60(1)(b) EUTMR: An EUTMR shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings (...) (b) where there is a trade mark as referred to in Article 8(3) and the conditions set out in that paragraph are fulfilled.

USPTO

Under Section 1(a)(1) of the Trademark Act, 15 U.S.C. § 1051(a)(1), an application based on use in commerce must be filed by the owner of the mark. A Section 1(a) application must include a verified statement that the applicant believes it is the owner of the mark sought to be registered. 15 U.S.C. § 1051(a)(3)(A); 37 C.F.R. § 2.33(b)(1). An application that is not filed by the owner is void. *See* TMEP § 1201.02(b).

An application under Sections 1(b) or 44 of the Act, 15 U.S.C. § 1051(b) or § 1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§ 1051(b)(3), 1126(d)(2), and 1126(e); 37 C.F.R. § 2.33(b)(2). When the person designated as the applicant is not the person with a bona fide intention to use the mark in commerce, the application is void. *See* TMEP § 1201.02(b).

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

JPO

At the time of filing their applications and at the time of examiners' decision on them.

CNIPA

The above provisions apply during the proceedings of opposition and trial against the examiner's decision of a trademark, after the final decision by the examiners.

EUIPO

Two possibilities:

- Opposition before registration: 8(3) EUTMR
- Invalidity request after registration: 60(1)(b) EUTMR

USPTO

These provisions apply at the filing date.

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

JPO

It can be determined in trials for cancellation.

CNIPA

They apply during the subsequent proceedings of opposition and trial against the examiner's decision.

EUIPO

No ex-officio. Just opposition, request for a declaration of invalidity or counterclaim in national infringement proceedings.

USPTO

The examining attorney will accept the applicant's statement regarding ownership of the mark unless it is clearly contradicted by information in the record. *In re L. A. Police*

Revolver and Athletic Club, Inc., 69 USPQ2d 1630 (TTAB 2003). If it is contradicted by the record, registration will be refused under §1 of the Trademark Act, on the ground that the applicant is not the owner of the mark. Similarly, when the record indicates that the applicant is a United States distributor, importer, or other distributing agent for a foreign manufacturer, the examining attorney should require the applicant to establish its ownership rights in the United States in accordance with TMEP §1201.06(a). It may also be determined during an opposition or cancellation.

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)?

JPO

As a basic principle, the burden of proof in unfair applications filed by attorneys rests on the parties who demand trials.

CNIPA

There are rules of burden of proof, and the applicant of opposition or invalidation bears it.

EU IPO

Since it is not possible for the opponent (proprietor of the trade mark) to prove the absence of consent, the burden of proof is reversed and it is up to the applicant (agent or representative) to show that the filing of the application was authorised by the proprietor.

The opposition and invalidity/cancellation ground of an unauthorized filing by agents of the trademark proprietor is a separate ground from that of bad faith.

Article 59(1)(b) EUTMR is the general expression of the principle that commercial transactions must be conducted in good faith. Article 8(3) EUTMR is a manifestation of the principle, although the protection granted in this Article is narrower than the one afforded by Article 59(1)(b) EUTMR (bad faith), because the applicability of Article 8(3) CTMR is subject to the fulfilment of a number of additional conditions laid down in this provision.

USPTO

If a third party brings an opposition or cancellation alleging that the trademark was filed in the wrong name, i.e., the attorney's name, the third party has the burden of proof to establish its claim.

v) Please provide examination guidelines.

JPO

None.

CNIPA

The below conditions must be satisfied for an act to fall under the act where an agent or representative, without the authorization of the client (of the agent or the representative), seeks to register.

(1) An applicant of a disputed trademark registration is an agent or a representative of the holder of a trademark, and the applicant is in a situation provided by 5(2) of this guideline, and acts according to this.

(2) The disputed trademark is used for goods/services or the disputed trademark is used for similar goods/services designated for a trademark of a client of the agent (a party employing the agent) or a client of the representative (a party that is not the representative).

(3) The disputed trademark is the same as or similar to the trademark of the client of the agent (the party employing the agent) or the client of the representative (the party that is not the representative).

(4) The agent or the representative cannot prove that the act of filing and registration is authorized by the client of the agent (the party employing the agent) or the client of the representative (the party that is not the representative).

In the dispute issue of a trademark, the client of the agent (the party employing the agent), the client of the representative (the party that is not the representative) or the party concerned can apply for erasing the registration (of the said trademark) within five years from the registration date of the disputed trademark.

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1787748/trade-mark-guidelines/section-3-unauthorised-filing-by-agents-of-the-tm-proprietor--article-8-3--eutmr->

USPTO

Please see answer above.

vi) Please provide examination practices.

JPO

Please see vii)

CNIPA

Please see v).

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1787748/trade-mark-guidelines/section-3-unauthorised-filing-by-agents-of-the-tm-proprietor--article-8-3--eutmr->

USPTO

Please see answer above.

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

JPO

Intellectual Property High Court (Gyo-Ke) No. 10194 2011

Date of Court Decision January 19, 2012. Litigation requesting rescission of a trial decision. [JPO-11]



The defendant (the demandant for the trial to cancel the trademark in this case) owns a trademark consisting of the letters “Chromax” in Taiwan that is a member of the World Trade Organization (WTO). (The trademark represents goods classified as Class 28 “Golf balls, golf implements,” etc.)

The designated goods of the trademark consisting of standard letters “Chromax” (the trademark in this case [registered in Japan and owned by the plaintiff requesting the court’s decision in this case]) are included in those of the defendant’s trademark. Accordingly, they are considered to be identical with or similar to the designated goods of the defendant’s trademark. Moreover, the subject trademark and the defendant’s trademark are likely to cause confusion as to the sources of the goods between the products with the subject trademark and those with the defendant’s trademark, and both trademarks are found to be similar.

The plaintiff or his representative has not been given exclusive distribution rights in Japan from the defendant or a person/entity who had an import agency in Japan with the defendant within one year before the date when the subject trademark in this case was filed. Nonetheless, thanks to the continuous trades between the plaintiff or his representative and the defendant, certain business practices had been established among them. Accordingly, it can be said that the plaintiff or his representative has been incorporated in some sales system of the defendant’s products in Japan, and that he or she may fall under “his agent or representative within one year prior to the date on which the trademark registration was filed” stipulated in Article 53-2 of the Trademark Act.

Also, it is found that the application for the subject trademark in this case has been filed without the defendant’s consent, within one year before the filing date of the subject trademark, by the trademark rights holder who had equal status to his agent or representative.

Based on the facts stated above, the court made a decision as to whether or not the application for the subject trademark registration was “without a just cause” stipulated in Article 53-2, as follows:

(1) As the background circumstances related to “a just cause” for the trademark application subject to this case, the plaintiff only claimed that, “in order to increase the value of the subject trademark, an advertising and promotion campaign was conducted at great expense, and that, thanks to the advertising and promotion, the value of the subject trademark has been increased in Japan.”

(2) According to the evidence and the entire gist of the argument, the court finds that the

plaintiff conducted advertising and promotions such as advertisement inserted in magazines in order to promote sales of golf balls ("Chromax balls") in Japan, which the defendant manufactures. However, the court cannot admit that, due to the expenditure and activities conducted by the plaintiff and the advertizing promotion campaign stated above, the value of the trademark subject to this case has been increased as an indication of the golf balls stated above.

(3) Based on these, the court recognizes that the plaintiff has not been given the exclusive distributing rights from a person/entity who had an import agency agreement in Japan. And, considering all these facts, including the circumstances that there was only the fact that the plaintiff and his representative continuously conducted business transactions with the defendant, the court determines that the application for the trademark subject to the case was filed "without the approval of the person who has the right pertaining to the trademark, without a just cause."

CNIPA

(1) Trademark No. 3083605 "BRUNO MANETTI" opposition issue:

魯安納輸出 Company employing the China Council for the Promotion of International Trade's Patent & Trademark Office as an agent (hereinafter referred to as opponent) opposed to 艾斯快樂 Co. Ltd. employing 永新 Patent & Trademark Inc. as an agent (hereinafter referred to as respondent), against Trademark No. 3083605 "BRUNO MANETTI" which passed the initial examination of our Office and appeared in "trademark bulletin" No.870. Our Office accepted the opposition according to Section 30 of the "China Trademark Law."

The respondent has answered within a set time limit.

The claim of the opponent:

"BRUNO MANETTI" is the full name of Mr. BRUNO MANETTI who is the founder of the company of the opponent. This trademark has been already registered and used in some countries and communities, and is known to the relevant public. The disputed trademark is a plagiarism of the trademark of the opponent and infringes the name right of Mr. BRUNO MANETTI. The act of the respondent goes against the principle of faith and trust. The registration and use of the disputed trademark leads to unfair competition.

The claim of the respondent:

The name right of BRUNO MANETTI who is the president of the opponent company cannot be an obstacle to register the disputed trademark in China.

In addition, the time when the respondent began to use the trademark "BRUNO MANETTI" is earlier than the time when the opponent began to use the said trademark. The respondent has no intention of plagiarism and filing a misappropriated application.

Our Office's opinion based on the facts and reasons stated by the parties concerned is as follows:

Trademark "BRUNO MANETTI" under opposition is designated for goods such as "suits, leather shoes and ties" in 25th class. "BRUNO MANETTI" is not a combination of existing letters but has more significant originality.

It is proved that, as an agent of the opponent in the authentication proof and the licensing agreement of Trademark "BRUNO MANETTI," the respondent recognized that Trademark "BRUNO MANETTI" is a trademark possessed by the opponent, and the opponent is not given the right to register and use Trademark "BRUNO MANETTI" in China. Therefore, the act of the respondent to file and register a trademark of the opponent, in the name of the respondent's own name goes against Section 15 the "Trademark Law" of our country.

The decision of our Office according to Sections 15 and 33 of the "China Trademark Law" is as follows:

The reason for opposition raised by the opponent is established, thereby, the trademark No. 3083605 "BRUNO MANETTI" shall be deregistered. According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a retrial to the Trademark Appeal Board within 15 days of this decision.

(2) Trademark No.3304260 "头包西灵 (Toubaoxilin)" opposition issue:

On September 12, 2002, the respondent (Sichuan 隆昌華蜀動物藥業 Inc.) filed an application of the disputed trademark to Trademark Office, and the trademark was

registered on February 7, 2004 for goods, such as drugs for veterinaries and goods for animal drugs in 5th class. The opponent (Chongqing 正通動物藥業 Inc.) applied for withdrawal of the registration on April 1, 2004.

The opponent began to use "头孢西林" for products for animal drugs in 2002, and the four characters of "头孢西林" are represented by a specific font and a font size, and displayed at the foreground on the label. Because the sales condition of the above goods in the market was very good, the respondent applied for agency sale to the opponent.

The both sides concluded a sole agency sale protocol in the end of July, 2002, and 華蜀動物藥業 Inc. is given authority and has been selling "头孢西林" products in areas of the whole country.

Based on the above facts, "头孢西林" is the special name of goods, which was made up by the opponent for its products and obtained examination permission of the Correlation Management Section. The opponent had already owned the right of the name of the specific products before the both sides concluded a sole agency sale contract. In actual use, "头孢西林" is situated in the foreground of the label of goods, and it is a main mark for consumers to identify the source of goods.

Therefore, "头孢西林" is a specific name recognized by the opponent, and it is objectively effective in displaying the source of the goods, thereby, the mark should be regarded as a non-registered trademark of the opponent.

The contractual connection provision of the opponent and the respondent in "contract related to Goods '头孢西林'" is already well-defined, and the respondent is a distributor of Products "头孢西林" of the opponent. The opponent has given authority to sell the products in areas of the whole country.

Furthermore, in the contract, it is defined the opponent shall continuously produce and sell the said products even after the contract has finished, and the selling right of the respondent shall be abolished.

In this issue, because it leads confusion to consumers for the respondent to register a trademark where features of the array and combination of characters generally resemble to those of the trademark of the opponent, this act should be prohibited based on Law.

Therefore, the act that the respondent as a product distributor of the opponent registered the disputed trademark extremely resembling to the trademark of the opponent in a name of its own without the permission of the opponent, falls under the act that an agent registers the trademark of a client employing the agent without permission of the client, provided in Section 15 of the "Trademark Law."

The decision of our Board according to the provisions of Sections 15, 41(2) and 43 of the "Trademark Law" are as follows: Registration of registered Trademark No. 3304260 shall be erased.

Court of First Instance:

The Court decided that "the registration of the disputed trademark falls under the misappropriated application of an agent, provided in Section 15 of the 'Trademark Law,' thereby, it should be erased," and supported the decision of our Board.

Court of Second Instance:

The Court decided that "an agent or a representative just indicates a trademark agent or a trademark representative only," and, this court decision means to cancel the decision of the Trademark Examination Board.

Supreme People's Court:

The Court decided that "'an agent or a representative' includes an agent or a representative based on the meaning of specific sales agency relationship, such as, sole agency sale (exclusive sale) and sole agency (exclusive agency)."

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1787748/trade-mark-guidelines/section-3-unauthorised-filing-by-agents-of-the-tm-proprietor--article-8-3--eutmr->

USPTO

Lipman v. Dickinson, 174 F.3d 1363, 1372 (Fed. Cir. 1999). The court found that a practitioner's participation in a material way in preparing and filing a petition with the

Director that relied on affidavits that he knew could not be used for any purpose was a violation of USPTO Disciplinary Rules.

Lipman v. Dickinson, 174 F.3d 1363, 1372 (Fed. Cir. 1999)

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)

JPO

In cases when applications are filed under bad faith for trademarks consisting of or containing other persons' names and titles, they are likely to fall under Article 4, Paragraph (1), Item (viii) of the Trademark Act.

Nonetheless, please note that when the principal provision of Article 4, Paragraph (1), Item (viii) was adapted, the original intent was not to prevent "bad faith trademark applications" per se. In other words, even in cases when applicants file trademark applications without any bad faith intended, the filed trademarks can be refused (or invalidated) if they meet the requirements of Article 4, Paragraph (1), Item (viii).

Also, Article 29 of the Trademark Act may serve as adjustment provisions for trademarks and copyrights. However, this Article is a provision that, in case trademark rights and prior copyrights of others are conflicting, trademarks cannot be used for the conflicting parts, and is not a reason to cancel or invalidate trademarks.

CNIPA

Yes.

EUIPO

Yes, but it is not considered bad faith

KIPO

Yes, but it is not considered bad faith.

USPTO

In the United States, there is no legislation for refusing an application or invalidating a

registration on bad faith grounds for having violated a copyright, a right of publicity, rights to a trade name or other person's name. There is no independent grounds of refusal based on bad faith. However, it may be possible to object to trademark applications on the grounds noted below.

With respect to copyrights and rights of publicity, procedurally it is not possible to refuse an application or file for an opposition or cancellation with the TTAB on the grounds of a copyright or right of publicity (existing under state law). Nevertheless, a party may file a lawsuit in civil court requesting damages, cancellation of a trademark or cease of use of a trademark, on the basis that a trademark infringes a copyright or right of publicity. Bad faith intent may be considered as part of these proceedings.

While it is not possible in an *ex officio* action for an examiner to refuse an application based on prior trade name rights, it is possible to file an opposition, cancellation or a lawsuit on the basis of these rights. The Board or court would apply a similar analysis as trademark infringement, in which bad faith would be a factor considered in determining likelihood of confusion. Please refer to discussion above on likelihood of confusion.

Finally, it is possible for an examiner to refuse registration or a third party to challenge registration under Section 2(a) of the Lanham Act, 15 USC § 1052(a), if a mark falsely suggests a connection with persons, living or dead, institutions, beliefs or national symbols, or brings them into contempt, or disrepute. Courts have held that Section 2(a) embraces "protection of rights of personal privacy and publicity." *See, e.g., Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Quest De La France*, 245 F.3d 1359, 1363 (Fed. Cir. 2001); *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983). An examiner may use Section 2(a) to refuse registration even in cases where the name of the well-known person, institution, beliefs or national symbols are not registered. Although bad faith intent is not necessary to establish a claim, a finding of bad faith intent would weigh in favor of a finding of false association.

The following factors would be considered:

- (i) The mark is the same as, or a close approximation of, the name or identity of a person or institution;
- (ii) The mark would be recognized as such, in that it points uniquely and unmistakably

to that person or institution;

(iii) The person or institution named by the mark is not connected with the activities performed by applicant under the mark; and

(iv) The fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

See, e.g., In re Jackson Int'l Trading Co., 103 USPQ2d 1417, 1419 (TTAB 2012); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507 (TTAB 2009); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); *Association Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007); *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985); *see also Univ. of Notre Dame du Lac*, 703 F.2d at 1375-77 (providing foundational principles for the current four-part test used to determine the existence of a false connection).

It is also possible for an examiner *ex-officio* to refuse registration under Section 2(c) of the Trademark Act, 15 U.S.C. §§ 1052(c). Section 2(c) reads as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a **name, portrait, or signature identifying a particular living individual except by his written consent**, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow. (Emphasis added).

The purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010); *see also Univ. of Notre Dame du Lac*, 703 F.2d at 1376 n.8; *Canovas v. Venezia* 80 S.R.L., 220 USPQ 660, 661 (TTAB 1983).

Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual.

Specifically, consent is required only if the individual will be associated with the goods or services, because the person is publicly connected with the business in which the mark is used, or is so well known that the public would reasonably assume a connection.

However, please be advised that Article 53 of the TMA stipulates that "a trademark owner may not use his/her registered trademark without the consent of the copyright owner, if depending on such use, the trademark right conflicts with the other party's copyright which was vested before the filing date of the trademark application."

For your information, there are cases where a company that owns both the copyright and foreign trademark right is prohibited from using the trademark within Korea, because a third party has already registered the same design as a trademark right with the KIPO. This is possible because copyrights and trademarks have different criteria and purposes for protection and fall within two separate legal systems. Thus, a trademark that is identical or similar to a prior copyrighted work can be applied for and registered by a person other than the copyright holder. However, due to the above TMA Article, in general, a copyright owner may have the legal ground to request, based on his/her copyright, that a local trademark owner stop use of its trademark.

IF YES:

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

JPO

Article 4 Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(viii) contains the portrait of another person, or the name, well-known pseudonym, professional name or pen name of another person, or well-known abbreviation thereof (except those the registration of which has been approved by the person concerned);

(Relationship with another person's patent right, etc.)

Article 29 When the use of a registered trademark in a particular manner in connection with its designated goods or designated services conflicts with another person's right to a patent, utility model or design for which an application has been filed

prior to the filing date of an application of that registered trademark or upon another person's copyright or neighboring right arising prior to the filing date of the same, the holder of trademark right, exclusive right to use or non-exclusive right to use may not use the registered trademark in the same manner on the conflicting part of the designated goods or designated services.

CNIPA

Section 32 of the "Trademark Law" provides that no trademark application shall cause damage to the right previously held by another party, nor shall an applicant rush to register in an unfair manner a mark that is already in use by another party and that enjoys substantial influence.

EUIPO

Kindly note that the EUTM can be declared invalid, but this ground is not linked to bad faith.

Article 8(4) EUTMR: upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation or the law of the Member State governing that sign:

- a) rights to that sign were acquired prior to the date of application for registration of the EU trade mark, or the date of priority claimed for the application for registration of the EU trade mark.
- b) that sign confers on its proprietor the right to prohibit the use of a subsequent mark.

EUIPO Guidelines:

<https://guidelines.euipo.europa.eu/1803468/1786689/trade-mark-guidelines/section-4-rights-under-article-8-4--and-8-6--eutmr>

Article 60(2) EUTMR: an EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Union legislation or national law governing its protection, and in particular:

- a) a right to a name;
- b) a right of personal portrayal;

- c) a copyright;
d) an industrial property right.

EUIPO Guidelines:

<https://guidelines.euipo.europa.eu/1803468/1786465/trade-mark-guidelines/4-3-grounds-under-article-60-2--eutmr-%E2%80%94-4-other-earlier-rights>

KIPO

Trademark Act Article 34(1)(vi)

Any trademark containing the name, title, or trade name, portrait, signature, seal, literary name, stage name, pen name of a prominent person, or his/her abbreviated title: Provided, That where the consent of such person has been obtained, trademark registration may be obtained;

USPTO

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols.

Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c), prohibits the registration of a mark that comprises a name, portrait, or signature identifying a particular living individual except by his written consent.

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

JPO

At the time of filing their applications and at the time of examiners' decision on them.
(Article 4, Paragraph (1), Item (viii))

CNIPA

The above provisions apply during the proceedings of opposition and trial against the examiner's decision of a trademark, after the final decision by the examiners.

EUIPO

Article 8(4) EUTMR: before registration (opposition) and after registration (request for

a declaration of invalidity).

Article 60(2) EUTMR: only after registration (request for a declaration of invalidity or counterclaim in national infringement proceedings)

KIPO

At the time of examiners' decision on them.

USPTO

The provisions apply at the time of the filing date.

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

JPO

Applications may be considered to be filed under bad faith on the basis of certain factors such as other persons' name, and might be refused by ex-officio examination. Additionally, they may be determined in opposition proceedings or invalidation trials.

CNIPA

They apply during the subsequent proceedings of opposition and trial against the examiner's decision.

EUIPO

No ex officio examination. Only opposition, invalidity applications or counterclaim in national infringement proceedings.

KIPO

Burden of proof is on the rightful owner of well-known and famous works of copyright, person's name and trade name.

USPTO

Refusals under Sections 2(a) and 2(c) would be determined during ex-officio examination and opposition/cancellation.

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)?
--

JPO

The burden of proof rests on the parties who claim that the said trademarks fall under Article 4, Paragraph (1), Item (viii).

CNIPA

There are rules of burden of proof, and the holder of a trademark bears it.

EUIPO

This ground is a separate ground from that of bad faith. The burden of proof is on the opponent or the invalidity applicant.

KIPO

N/A

USPTO

Examining Attorney and plaintiff bear the burden of proof to show by a preponderance of the evidence that the mark falsely suggests a connection with another person or is the name of living individual.

v) Please provide examination guidelines.

JPO

Examination Guidelines for Trademarks

Article 4(1)(viii) (Name of Another Person)

1. "Another person" means a person who actually exists other than the applicant him/herself and includes not only natural persons (including foreigners) and corporations but also associations without capacity.
2. Where an applicant's own name is the same as that of another person, the consent of another person concerned is required.
3. It is not necessarily required to determine whether or not the trademark in question falls under the "famous" pseudonym, professional name or pen name of another person, or "famous" abbreviation thereof based on solely the consumers of the designated goods or services of said trademark from the perspective of protecting moral rights of

authors.

4. "Abbreviations" shall be handled as follows;

(1) Trademarks created by removing the type of corporations such as a stock company or general incorporated associations from the "name" of a corporation fall under the category of "abbreviation." The name of an association without capacity does not include the type of corporation, etc. and thus will be handled according to "abbreviations."

(2) "Names" of foreigners fall under the category of "abbreviations" if they do not have middle names.

5. The judgment on whether or not the trademark in question is a trademark which "contains" the name, etc. of another person will be made based on the determination on whether the relevant part will be objectively recognized as the name, etc. of another person and will evoke or remind of the other person.

CNIPA

"The right previously hold by another party" provided in Section 31 of the "Trademark Law" indicates that the right was hold by another party before the filing date of the disputed trademark, and the right includes rights other than the trademark right, such as a trade name right, a copyright, a design right, a name right and a portrait right.

Trademark No. 22966677 "洛天依" opposition issue:

Shanghai Henian Information Technology Co., Ltd. (hereinafter referred to as opponent) submitted opposition to Kazuo Huiyou Food Co., Ltd (hereinafter referred to as respondent) against Trademark No. 22966677 "洛天依" which passed the early examination of our Office and appeared in the "trademark bulletin" No.1577, and our Office accepted the opposition based on the "Chinese Trademark Law." The respondent has answered to it within a predetermined time limit.

The view of our Office based on statements of facts and reasons by the party concerned is as follows: The disputed trademark "洛天依" is designated in class 32 "beer; wort for beer making", etc. "洛天依" is the world's first VOCALOID Chinese sound library and virtual image produced by opponent based on Yamaha's VOCALOID 3 speech synthesis engine. It has become the first virtual singer to appear on the mainstream Chinese TV media and gained high popularity and established a direct and clear corresponding

relationship with its role image. The word "洛天依" is not a common collocation of characters in Chinese, which has strong originality and distinctiveness. The disputed trademark "洛天依" is the same with the role name produced by opponent, which would mislead the public and damage the interest of the opponent.

Our Office judged that the registration of the disputed trademark has constituted the respondent has constitutes the situation that " No applicant for trademark application may infringe upon another person's existing prior rights, nor may he, by illegitimate means, rush to register a trademark that is already in use by another person and has certain influence." in Article 32 of the Trademark Law.

On the basis of Sections 32 and 35 of the "China Trademark Law," our Office decided as follows: the registration of Trademark No. 22966677 "洛天依" shall not be permitted.

According to Section 35 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a new trial to CNIPA within fifteen days from the date of this decision.

Trade Name Right: The right to file application of a letter trademark similar to a trade name which is registered and used by another party earlier and has substantial name recognition, and such disputed trademark that may mislead the public in China, damage the interests of another party holding the trademark right earlier, and is decided as infringing the trademark right held by other party, shall not be given the right, nor the right shall be erased.

Copyright: Act to file application of a trademark of a copyright held earlier by another party without permission of the copyright holder is decided to infringe a copy right held by another party earlier, thereby, the disputed trademark shall not be given the right, nor the registration shall be erased.

Design Right: Act to file trademark application for goods that are the same as or similar to goods of another party's design without permission of the other party is decided to infringe the design right held by other party earlier, thereby, the disputed trademark shall not be given the right, nor the registration shall be erased.

Name Right: Disputed trademark that is an application of another party's name filed without permission of the other party, and infringes or may infringe other party's name right shall not be given the right, nor the registration shall be erased.

Trademark No. 26677654 "松鼠张三疯" opposition issue:

Three squirrels (三只松鼠) Co., Ltd. and Zhang Liaoyuan(hereinafter referred to as opponent) the legal representative of the Three squirrels (三只松鼠) Co., Ltd. submitted opposition to Fujian 357 Investment Co., Ltd (hereinafter referred to as respondent) against Trademark No. 26677654 "松鼠张三疯"which passed the early examination of our Office and appeared in the "trademark bulletin" No.1607, and our Office accepted the opposition based on the "Chinese Trademark Law." The respondent has not answered to it within a predetermined time limit.

The view of our Office based on statements of facts and reasons by the party concerned is as follows: The disputed trademark "松鼠张三疯" is designated in class 29 "processed nuts; snacks based on fruits and vegetables", etc. In this case, the opponent claimed that the respondent maliciously registered his internet nickname "章三疯" and violated his right of name and provided relevant evidences.

The evidences provided by the opponent can prove that the opponent founded Anhui Three Squirrels (三只松鼠) e-commerce Co., Ltd. in 2012, the company takes "three squirrels" (三只松鼠) as its core brand. And its main business is nuts, dried fruits and tea, etc. packaging, research and development and saling online. As the founder and legal representative of the opponent, Zhang Liaoyuan's microblog and blog name is" squirrel father_章三疯" which is original and with strong distinctiveness. Also it has a corresponding relationship with opponent and become well-known in the industry through advertisement and use.

The pronunciation of the disputed trademark "松鼠张三疯"is similar to the microblog and blog name of opponent. The disputed trademark is designated in class 29 which is closely related to "nuts". In this case, it is easy for consumers to correspond the disputed trademark to the opponent, which may damage the interests of the opponent.

Our Office judged that the registration of the disputed trademark has constituted an infringement of the opponent's name right. On the basis of Sections 32 and 35 of the

"China Trademark Law," our Office decided as follows: the registration of Trademark No. 26677654 "松鼠张三疯" shall not be permitted.

According to Section 35 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a new trial to CNIPA within fifteen days from the date of this decision.

Portrait Right: Disputed trademark that is an application of another party's portrait filed without permission of the other party, and infringes or may infringe other party's portrait right shall not be given the right, nor the registration shall be erased.

EUIPO

<https://guidelines.euipo.europa.eu/1803468/1786689/trade-mark-guidelines/section-4-rights-under-article-8-4--and-8-6--eutmr>

<https://guidelines.euipo.europa.eu/1803468/1786465/trade-mark-guidelines/4-3-grounds-under-article-60-2--eutmr-%E2%80%94-other-earlier-rights>

KIPO

Trademark Examination Guideline Section 5.6.

USPTO

Please see answer above.

vi) Please provide examination practices.

JPO

Please see v).

CNIPA

Please see v).

EUIPO

See Guidelines for examples.

<https://guidelines.euipo.europa.eu/1803468/1786689/trade-mark-guidelines/section-4-rights-under-article-8-4--and-8-6--eutmr>

[ghts-under-article-8-4--and-8-6--eutmr](#)

<https://guidelines.euipo.europa.eu/1803468/1786465/trade-mark-guidelines/4-3-grounds-under-article-60-2--eutmr-%E2%80%94other-earlier-rights>

KIPO

N/A

USPTO

Please see answer above.

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

JPO

“SONYAN” Case

Tokyo High Court (Gyo-ke) No. 133 1997, Date of Decision April 26, 1978. [JPO-9]

<Summary of Court Decision>



Trademark in this case

The trademark in this case consists of horizontally written Roman alphabet letters “SONYAN,” designating goods classified as Class 16 (current Class 24) “Woven fabrics, knitted fabrics, felts, other textile fabrics.”

On the other hand, [SONY] has been a trademark for “telecommunication machines and apparatus” including “transistor radios, televisions, tape recorders,” which the plaintiff deals in, and is a coined mark consisting of the horizontally written Roman alphabet letters “SONY,” along with a mark consisting of horizontally written Japanese katakana characters “ソニー.” This also represents the pronunciation of “SONY” in Japanese. Both have been very famous in Japan and abroad. The court found that, at the time when the claimed trademark in this case was filed, the two SONY/ソニー marks were already well known and famous among the public, not only as trademarks for products that the plaintiff manufactures and sells but also as the abbreviated name of the plaintiff.

At the same time, in terms of the style displayed by the letters, “SONYAN” consists of a

set of letters and does not have any inherent distinctiveness in its style. Among these six letters, the first four letters are identical with those of the plaintiff's coined word "SONY." Moreover, judging from the degree of knowledge about English language in Japan, two letters "AN" following these four letters "SONY" may be intuitively understood in most cases to form a word meaning "of," "have characteristics of" or "nationality of."

Based on these, it should be noted that the subject trademark "SONYAN" may easily enable consumers to gain an image of and recognize the plaintiff's famous abbreviated name "SONY," and that, in terms of components, consumers may understand the main part of the trademark "SONYAN" as "SONY" in most cases.

Therefore, it could be said that the trademark in this case is a trademark containing a famous abbreviated name of others and falls under Article 4, Paragraph (1), Item (viii).

CNIPA



(1) Figure Trademark No.7968391 "季世家 1915" opposition issue:

China Guizhou 茅台酒厂 Inc. employing Beijing 恒華佳信 Trademark Agency Inc. as an agent and 季克良 employing Beijing 中理通 Intellectual Property Inc. as an agent (hereinafter referred to as opponents) opposed to 塗彪 employing Guizhou 名之 Intellectual Property Service Inc. as an agent (hereinafter referred to as respondent) against Figure Trademark No. 7968391 "季世家 1915," which passed the initial examination of our Office and appeared in "trademark bulletin" No.1237, and our Office accepted the opposition according to Section 30 of the "China Trademark Law." The respondent has not answered to it within a set time limit.

Our Office's opinion after examination is as follows: Because main features of the figure of head of a person of a trademark under opposition are similar to those of the portrait of 季克良 cited by two opponents, the respondent filed application of this portrait without asking for and permission of the opponent in its own name, and

infringed the portrait right. Our Office's decision according to Sections 31 and 33 of the "China Trademark Law" is as follows: The opposition of the opponent is established, thereby, the registration of Trademark No. 7968391 "季世家 1915" shall not be permitted. According to Section 33 of the "China Trademark Law," if being unsatisfied to this decision, the party concerned can apply for a new trial to Trademark Appeal Board within fifteen days from the date of this decision.

(2) "Figure" Trademark No. 1563706 opposition issue:



李世林 (hereinafter referred to as opponent) opposed to Boading 双泉酒厂 employing Hebei 知力 Trademark Office Inc. as an agent (hereinafter referred to as respondent), against Figure Trademark No.1563706, which passed the initial examination of our Office and appeared in "Trademark Bulletin" No.769. Our Office accepted the opposition according to Section 30 of the "China Trademark Law." The respondent has not answered to it before a set time limit.

The reason for opposition of the opponent: Because the trademark under opposition is the figure of "長寿神," a trademark using "the general name and the figure of this goods" should not be filed. The opponent has already filed application of this figure as the design of a box of old liquor for nutritional fortification in June 1994, and the figure was registered.

The trademark under opposition infringes the right of the opponent, thereby the act to file application of the figure goes against the provision of the "Trademark Law."

Because the respondent is producing and selling of alcoholic-drinks package boxes, on which the design of the opponent is displayed, this act falls under infringement of the opponent's right, and the opponent has already filed a suit in the Court.

Under the premise that the respondent recognizes the act as infringement of the opponent's right, the both sides entered into a settlement agreement, the Court

already has issued the "Documents for Conciliation of Civil Affairs." The infringing act of the respondent has already damaged the interests of the opponent, thereby the Administrative Law Enforcement Division has already examined the respondent and imposed an administrative punishment to the respondent, in some areas.

The opinion of our Office based on facts and reasons stated by the party concerned is as follows: The trademark under opposition consists of Figure of 長寿神, is designated for "liquor (drink), liquid including alcohol, and alcoholic drink (except for beer)" in 33rd class, and was filed an application on January 20, 2000.

According to sources of evidence provided by the opponent, the opponent has already filed an application of a design for a box (of an old liquor for nutritional fortification) on June 27, 1994, and registered as a design (patent No.: ZL 94 3 04253.4)

Because appearances of the trademark under opposition and the design of the opponent are similar to each other, and the filing date of the trademark under opposition is later than that of the design of the opponent, the right of the opponent would be the previously held one.

Registration and use of the trademark under opposition would damage the right previously held by the opponent.

Our Office's decision according to Sections 31 and 33 of the "China Trademark Law" is as follows: The opposition of the opponent is established, thereby the registration of Figure Trademark No. 1563706 shall not be permitted.

According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a retrial against this decision to the Trademark Appeal Board within 15 days of this decision.

(3) Trademark No. 1965652 "洪河" opposition issue:

Chengdu City 洪河聯办 (簡体字) 茶厂 employing Sichuan Trademark Office as an agent (hereinafter referred to as opponent) opposed to Chengdu 峨眉茶業 Inc. (hereinafter referred to as respondent) against Trademark No. 195652 "洪河," which

passed the initial examination of our Office and appeared in "Trademark Bulletin" No.848. Our Office accepted the opposition according to Section 30 of the "China Trademark Law." The respondent has answered to it before a set time limit.

The reason of the opposition of the opponent: "洪河" infringes the right of trade name and the right of goods name of the opponent. The registration of Trademark "洪河" is apparently an act of filing a misappropriated application. The answer of the respondent: The trademark under opposition does not infringe the right of trade name and the right of goods name of the opponent.

Our Board's opinion based on the facts stated by the party concerned is as follows: The Trademark Examination Board decided that Trademark No.987231 and Trademark No.1313779 "洪河" of the respondent were trademarks that were invalid to be registered, and registration of them has already been erased.

In the above two issues, the decision of the Trademark Examination Board is as follows: It is clear that Trademark "洪河" is the name of an enterprise of the opponent, that is, Trademark "洪河" is a trade name. Through long-term use of the opponent, trade name "洪河" is already known to the relevant public in some areas.

The trademark under opposition is completely the same as the constitution of characters of the trade name of the opponent, thereby it may mislead the public, and damage legitimate right and interest of the opponent.

In addition, since at least 1991, the opponent has already been used "洪河" as the peculiar name of Jasmine tea goods and also has been used the name together with "芝龙," which is the trademark of the opponent, for the packing of tea goods.

Through the use by the opponent, "洪河" has already an effect of differentiating the source of goods, thereby it can be said that the mark has remarkable characteristics to be provided to a trademark. In this issue, it can be said that it is a non-registered trademark used for Jasmine tea goods of the opponent.

The act of the respondent is a misappropriated application of the trademark of the opponent and goes against the provisions in Section 31 of the "Trademark Law." Because the situation and the facts of this item are the same as the above two issues,

filing application of the trademark under opposition goes against the provisions of the above Law.

According to Sections 31 and 33 of the "China Trademark Law," our Board decided as follows: The opposition of the opponent establishes, and the registration of Trademark No.1965652 "洪河" shall not be permitted. According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a retrial against this decision to the Trademark Appeal Board within 15 days of this decision.

(4) Trademark No.3266232 "余進華 YUJINHUA" opposition issue:

余進華 employing Wenzhou 興業 Trademark Office Inc. as an agent and Wenzhou Gill 達製靴業 Inc. employing Wenzhou 興業 Trademark Office Inc. as an agent (hereinafter referred to as opponents) opposed to 葉玉弟 (hereinafter referred to as respondent), against Trademark No.3266232 "余進華 YUJINHUA" which passed the initial examination of our Office and appeared in the "trademark bulletin" No.905. Our Office accepted the opposition according to Section 30 of the "China Trademark Law." The respondent has not answered to it within a set time limit.

The opinion of our Office after deliberation is as follows: The opponent 余進華 is the representative director of another opponent Wenzhou Gill 達製靴業 Inc. Wenzhou Gill 達製靴業 Inc. and its registered trademark "吉尔达 JED" have comparatively high name recognition in the leather shoes industry of our country, thereby, the representative 余進華 is also widely known in the industry.

Chinese characters of the trademark under opposition are the same as the name of 余進華, and the designated goods include shoes products of the enterprise of the opponent. In addition, other than the trademark under opposition of this issue, the respondent have filed application of many trademarks which are the same as the names of administrative directors of famous shoemaking industries in Zhejiang, such as "金林兴," "钱金波," "胡启多," "王振滔," "单志敏" and "余阿寿," thereby our Office, while recognizing that the above acts of the respondent to file application of trademarks clearly include misappropriation, decided that the name

right of 余進華 may be damaged, and the name rights of others are already infringed.

The decision of our Office according to Sections 31 and 33 of the "China Trademark Law" is as follows: The opposition of the opponent establishes, thereby the registration of Trademark No.3266232 "余進華 YUJINHUA" shall not be permitted. According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision, the party concerned can apply for a retrial against this decision to the Trademark Appeal Board within 15 days of this decision.

(5) Figure Trademark No.3308372 opposition issue:



特納期娛樂 Service Company employing Beijing 正理 Trademark Office Inc. as an agent (hereinafter referred to as opponent) opposed to 羅偉烈 employing Beijing 万慧達知識產權 Agency Inc. as an agent (hereinafter referred to as respondent), against Figure Trademark No.3308372, which passed the initial examination of our Office and appeared in the "trademark bulletin" No.913. Our Office accepted the opposition according to Section 30 of the "China Trademark Law."

The respondent by committing Beijing 諾孚爾 Intellectual Property Agency Inc. has answered to it within a set time limit. The opinion of our Office after deliberation is as follows: The shape of figure expression of the figure trademark under opposition is same as the shape of the expression of a figure of which right and copy right are previously held by the opponent, and sources of evidence provided by the opponent can also prove that the opponent had already held the right of the trademark under opposition earlier than the respondent.

The decision of our Office according to Sections 31 and 33 of the "China Trademark Law" is as follows: The opposition of the opponent establishes, thereby the registration of Figure Trademark No.3308372 shall not be permitted. According to Section 33 of the "China Trademark Law," if being unsatisfied with this decision,

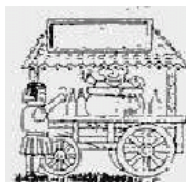
the party concerned can apply for a retrial against this decision to the Trademark Appeal Board within 15 days of this decision.

(6) Trademark No. 3517447 "易建联" disputed issue:

The disputed trademark was filed on April 8, 2003, registered on May 21, 2005, and goods such as shoes were designated. The opponent (易建聯) has applied to erase the registration of the disputed trademark since on March 24, 2006.

According to our Board's opinion, the opponent is a well-known basketball player of our country and already had some social name recognition before filing application of the disputed trademark. The respondent (易建联 Sporting Goods (China) Inc.) has not received the permission of the opponent. Filing application of characters as a trademark, which are the same as the name of the opponent infringes the name right of the opponent, thereby goes against the provision in Section 31 of the "Trademark Law."

The decision of our Board according to Sections 31, 41(2) and 43 of the "China Trademark Law" is as follows: The registration of the disputed trademark shall be erased.



(7) Figure Trademark No. 1004698 opposition retrial issue:

The disputed trademark was filed on September 4, 1995, designated for goods, such as drinks not including beer or alcohol, and registered on May 14, 1997. The opponent (VEDAN Enterprise Corporation) applied to erase the registration of the said trademark on November 25, 1997.

The claim of the opponent: The opponent is the creator and holder of the said Figure Trademark. The opponent is a Taiwanese food manufacturing company with 40 years' history, of which drinks, chemical seasonings and foods such as wheat flour are sold in countries all over the world including Mainland China.

A wax gourd tea is one of the many drinks manufactured by the applicant. The

design of a box packing them is filed an application in Mainland China on May 1, 1994, and the registration No. is 25875 and the validity is ten years. The disputed trademark is plagiarism of the packing's design of the wax gourd tea products, which is possessed by the opponent.

The figure of the disputed trademark is the reproduction of the other party's legal right thereby infringes it. The evidence filed proves that the opponent registered the design of the packing box of the wax gourd tea which was manufactured by the opponent on May 1, 1994. The registration No. is ZL 93 3 005349.5, and the right certificate No. is 25857.

The figure of the disputed trademark is very similar to the design right of Box No. ZL 93 3 005349.5. The two are very similar to each other in whole compositions, figure of a man and even the layouts of articles.

The disputed trademark of this issue and the figure of the precedent design of the opponent are very similar to each other in main bodies. The act for the respondent (Fujian 味全集团 Company) to filing an application to register the figure of the precedent design right as its own right goes against Section 31 of the current "Trademark Law" of our country, and the registration of the disputed trademark falls under the situation of the provision in Section 41(2) of the current "Trademark Law."

The decision of our Board according to Sections 31, 41(2) and 43 of the current "China Trademark Law" and Section 27 of the "Enforcement Regulations of the China Trademark Law" is as follows: The opposition against Figure Trademark No.1004698 registered by the respondent establishes, thereby the registration of Figure Trademark No.1004698 shall be erased.

EUIPO

See EUIPO guidelines for examples.

KIPO

- 「2NE1」 (Case No. 2012Hu1033)
- 「KT」 (Case No. 2009Heo1705)

USPTO

In re Richard M. Hoefflin, 97 USPQ2d 1174 (TTAB 2010). In this case, the applicant attempted to register the trademarks OBAMA BAHAMA PAJAMAS, OBAMA PAJAMA, and BARACK'S JOCKS DRESS TO THE LEFT for pajamas and briefs. The examiner issued a Section 2(c) refusal to register the mark, because the record did not include the written consent of President Barack Obama, the living individual allegedly identified in the marks. The applicant claimed that the terms "Barack" and "Obama" do not refer to any particular individual, and specifically not "the United States President Barack Hussein Obama II." The TTAB affirmed the Examiner's refusal.

In re Jackson Int'l Trading Co., 103 USPQ2d 1417(TTAB 2012). The TTAB affirmed the examiner's refusal under Section 2(a) to register the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrances, cosmetics, leather goods and clothing, finding that the mark falsely suggests a connection with the late composer and clarinetist Benny Goodman. The examiner cited various Internet websites and references, and argued that Benny Goodman "had a very long and successful career as a musician and bandleader, with a reputation that continues to this day." The TTAB noted that performers frequently license their names for collateral products, and therefore consumers would associate Applicant's goods with this "well-known bandleader, composer and clarinetist."

Q6. Any other views except for Q1- Q5

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

JPO

Nothing in particular.

CNIPA

N/A

EUIPO

No further observations.

KIPO

N/A

USPTO

N/A

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)? Please provide any provision(s) of the relevant laws or regulations (if not, such as the relevant website)

JPO

Information Provision System

Article 19(1) of the Regulation for Enforcement of the Trademark Act

Where an application for trademark registration has been filed, any person may provide the Commissioner of the Patent Office with information to the effect that the application for trademark registration is unregistrable pursuant to the provisions of Art. 3, Art. 4(1)(i), (vi) through (xi), or (xv) through (xix), Art. 7-2(1), or Art. 8(2) or (5) of the Trademark Act by submitting a publication, a copy of an application for trademark registration, or any other document with regard to said application for trademark registration. However, only those trademark applications pending before the JPO are subject to the offering of information.

CNIPA

The China Trademark Law has no provision with regard to providing information to the Trademark Office before publication of the initial examination of a trademark, that is, before the substantive examination. As the position of Governmental Organization, the public can reflect situation to the Trademark Office in writing so that the Office may use the information as reference, however, this kind of visiting is far from legal measures.

EUIPO

No. Bad faith is only an absolute ground for the invalidity of a registered CTM, to be relied on either before EUIPO or by means of a counterclaim in national infringement proceedings. Therefore, bad faith is not relevant in examination or opposition proceedings in relation to an EUTM application.

KIPO

Provision of information and opposition are available to countermeasure bad faith filings. Trademark Act, Article 49.

USPTO

Although third parties may not contact examiners directly, there is a mechanism—a “letter of protest”—by which third parties may submit certain evidence to the Commissioner’s Office for consideration. If accepted, the evidence would then be forwarded to the Examiner for consideration.

- If a third party provides such information to examiners, how will examiners/offices deal with such information?

JPO

The examiner notifies the reason for refusal when he/she could determine that the application for trademark registration contains a reason for refusal as a result of the examination of the submitted documents, etc.

CNIPA

Information provided by a third party may trigger ex officio examination on bad faith applications not intended for use or constitute a factor to be considered when determining a bad faith application not intended for use under Article 4.1 of the Trademark Law.

EUIPO

They cannot deal with them. It will be for the interested party to wait until the mark is registered and then file an invalidity request

KIPO

The examiner considers such information in deciding according to the law and

examination guidelines. If such information is acceptable, the application in bad-faith will be rejected and the results of providing information will be also notified to the person and/or company who provide an information with the KIPO.

USPTO

A letter of protest is an informal procedure created by and existing at the discretion of the USPTO, in which third parties may bring to the attention of the USPTO evidence bearing on the registrability of a mark. When a letter of protest is filed with the Commissioner's Office, the Commissioner's Office accepts or denies the letter within approximately 30 days from filing. If accepted, the evidence, but not the letter of protest, is forwarded to the examiner for consideration. However, the evidence must relate to issues that can be prosecuted to its legal conclusion by the examiner in the course of *ex parte* examination. The evidence usually relates to a likelihood of confusion, descriptiveness or a pending litigation. Even though bad faith or fraud are not independent grounds for refusal or letter of protest, depending on the nature of the evidence it may be relevant to other grounds of refusal.

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?

JPO

Yes.

[Opposition]

(Joint or separate conduct of oppositions)

Trademark Act Article 43-10 Where two or more oppositions to registration are filed in relation to the same trademark right, unless special circumstances exist, the examinations thereof shall be conducted jointly.

The following are excerpts from the 66-05 session of the "Manual for Trial and Appeal Proceedings (19th edition)" of the JPO:

(A) Basic principles of consolidating appeal/trial examinations

Where multiple oppositions to registration are filed for the same registration, since the proceedings should be consolidated for legitimate oppositions, the proceedings for these oppositions shall be consolidated unless there are special circumstances, regardless of whether the designated goods or designated services for the oppositions, or the reasons for the oppositions or the evidences thereof, are the same or different.

(B) Special circumstances

"Special circumstances" means cases where it is deemed that the consolidation of proceedings make the proceedings procedures rather complicated, thus making the progress difficult.

An example of such cases is when the written opposition for one of the multiple oppositions to registration is dismissed, and an action is filed against the said decision.

(C) Effect of consolidating appeal/trial examinations

(1) Proceedings after consolidation

When appeal/trial examinations are consolidated, all procedures regarding decisions, such as notifications of reasons for cancellations, submission of written opinion, appeal/trial decisions on oppositions to registrations, are consolidated.

(2) Effective use of submitted documents and means of proof, etc.

In cases when appeal/trial examinations are consolidated, the means of proof, etc. having been presented or submitted in the respective opposition to registration may be used in the proceedings on all the oppositions to registration having been consolidated.

(D) Procedures for consolidating appeal/trial examinations

(1) Where multiple oppositions to registration are filed, their proceedings shall be consolidated in principle; thus, no notice shall be made to the effect that the proceedings will be consolidated.

(2) Procedures for cases in which appeal/trial examinations are not consolidated

Where multiple oppositions to registration are lawfully filed, and if the proceedings are

to be conducted without consolidating a part of the oppositions to registration, notice stating thereof shall be made to the holder of trademark right, the opponent, and any party concerned.

<Trials>

Article 154, Paragraph (1) of the Patent Act will apply mutatis mutandis under Article 56, Paragraph (1) of the Trademark Act

(Joint or separate conduct of proceedings)

Article 154 (1) Where one or both parties to two or more trials are identical, the proceedings may be jointly conducted.

The following are excerpts from section 30-03 of “Manual for Trial and Appeal Proceedings (19th edition)” of the JPO

- Requirement for Consolidation of Appeal/Trial Examinations

(1) Both parties concerned are the same or one of the parties concerned is the same
Proceedings may be consolidated for either ex parte trial cases or inter partes trial cases if “both parties concerned” or “one of the parties concerned” are the same.

(2) Two or More Appeal/Trial Examination Cases

The “two or more appeal/trial examinations cases” that could be consolidated must be those of the same type.

(3) Necessity of Consolidation of Appeal/Trial Examinations

It is necessary to be judged to expect achievement of the purpose of consolidation of proceedings by consolidating the proceedings.

It is considered that the followings may be expected to achieve the purpose of consolidation:

- (i) Cases calling for similar examinations of evidence.
- (ii) Cases with common technical basis for the inventions involved.
- (iii) Cases with common cited reference and means of proof.
- (iv) Two or more trials for invalidation against the same right.

(4) Timing of Consolidation

Consolidation of cases shall take place before conclusion of examination.

- Procedures for Consolidation of Appeal/Trial Examinations

- (1) Determination by administrative judges (a panel)

A panel has authorization to determine whether the proceedings shall be consolidated, and a panel may decide ex officio at the discretion of the determination.

- (2) Notice of consolidation of proceedings

A chief administrative judge shall notify parties concerned of consolidation of the proceedings.

- Effect of Consolidation of Appeal/Trial Examinations

- (1) Appeal/trial decisions can be made at the same time with a single decision, for the number of cases that have been consolidated.

- (2) Utilization of Submitted Documents and Means of Proof, etc.

When two or more proceedings of trials/appeals are consolidated, documents and other materials submitted or presented at each trial case before consolidation, and means of evidence, etc. obtained at the proceedings of each trial case before consolidation may use for the consolidated trial/appeal cases.

CNIPA

There are proceedings for consolidated procedures.

EUIPO

Where several invalidity actions on the basis of bad faith are introduced by the same invalidity applicant against several registered EUTMs, or several appeals raised against several invalidity decisions, the cases can, depending on the circumstances, be treated as ‘related cases’ both by the first instance and by the Boards of Appeal. However, even for related cases, there will be, in practice, one invalidity/appeal decision for each of the individual invalidity/appeal actions, not one decision covering all related cases. Evidence introduced by the parties in the first of those invalidity/appeal actions can, under certain circumstances, be relied upon in the following related cases by introducing a clear and precise cross reference to it in the submissions for each individual case.

KIPO

TMA Article 117(1)(i), 119(1)(iii) and (5) stipulates that the examiner in the IPT may conduct trial proceedings or make trial decisions, jointly or separately, with regard to two or more trial proceedings where one or both parties thereto are the same.

USPTO

Both the courts and the TTAB have a procedure in place to consolidate several trials. Under the Federal Rules of Civil Procedure 42 (a), when cases involving common questions of law or fact are pending before the Board or a court, they may order the consolidation of the cases. In determining whether to consolidate proceedings, the Board or a court will weigh the savings in time, effort, and expense which may be gained from consolidation against any prejudice or inconvenience that may be caused thereby.

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.

JPO

Nothing in particular.

CNIPA

According to Paragraph 1 of Article 63 of the Trademark Law, the amount of damages for malicious infringement with an existence of serious circumstances had been increased from 1-3 times to 1-5 times the amount of the actual losses of the right owner, the profits of the infringer or the licensing royalty for the trademark right. Paragraph 3 of Article 63, the highest statutory damages is increased from no more than RMB 3 million to RMB 5 million.

EUIPO

No further observations.

KIPO

N/A

USPTO

Default Judgment

Default judgment helps eliminates unnecessary delays in resolving an opposition or cancellation if filed against a bad faith application. If a defendant fails to file an answer to a complaint during the time allowed, the TTAB may issue a notice of default. The notice states that neither an answer nor any extension of time to answer has been filed; that notice of default under Fed. R. Civ. P. 55(a) is entered; and that defendant is allowed 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response that does not show good cause, default judgment may be entered against it. See Trademark Trial and Appeal Board Manual of Procedure § 312.01, and 37 CFR § 2.106(a) and 37 CFR § 2.114(a).

Suspension of Pending Applications

If an applicant has opposed or petitioned to cancel a prior application or registration of a “bad faith” party, USPTO will suspend action on its trademark application pending resolution of the opposition or registration. Action by the USPTO may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant’s mark will be considered prima facie good and sufficient cause. The examining attorney should suspend the later-filed application until the mark in the earlier-filed application is registered or the earlier-filed application is abandoned. 37 C.F.R. § 2.83(c). *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm’r Pats. 1993). This procedure helps eliminate unnecessary costs and actions in situations where a party’s application has been refused on the basis of a “bad faith” application or registration which it is in the process of opposing or cancelling.