

TM5

Trade Mark Protection
in Opposition and Appeal

Opposition: Legal system information



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Foreword

The TM5 “Trademark Protection in Opposition and Appeal (Review) Procedure” project was adopted in November 2021 with the aim to help Partner Offices and their users understand the different legal systems, legal application, examination and practices for trademark opposition and appeal (review), for the benefit of the users to protect their legitimate rights and interests more effectively in the trademark opposition and appeal (review) procedures before TM5 Partner Offices.

This questionnaire compiles information about the legal systems in the Partner Offices linked to opposition (Phase 1).

1 Opposition proceedings

- 1) Does your Office carry out *ex officio* examination of earlier rights when reviewing an application? *If yes, please, specify what rights are examined (trade mark applications, trade mark registrations, company names, etc.)*

- ☐ yes
☐ no

[EUIPO](#)

- ☐ yes
☒ no

EUIPO does not refuse *ex officio* EUTM applications based on potential conflict with existing earlier rights.

[CNIPA](#)

- ☒ yes
☐ no

We will examine the registered trademark and on-going trademark applications.

[JPO](#)

- ☒ yes
☐ no

In principle, the proceedings for an opposition are conducted based on the reasons pleaded and the evidence presented by the opponent. For prior rights subject to *ex officio* examination, however, Please refer to the answer to Question 41.

[KIPO](#)

- ☒ yes
☐ no

[USPTO](#)

☒ **yes**

☐ **no**

The earlier rights that are cited during the ex officio examination are:

I. Earlier filed trade mark applications

II. Trade mark registrations

that are active in the USPTO records.

2) Does your Office advise **existing rights holders of potential conflicts presented by an application**? *If yes, please specify the holders of which rights (trade mark applications, trade mark registrations, company names, etc.) your Office advises.*

☐ **yes**

☐ **no**

[EUIPO](#)

☒ **yes**

☐ **no**

Please provide details (means, procedure):

Two types of communications are sent by the Office:

1. Search reports are sent to applicants identifying earlier EUTMs/applications/international registrations designating the EU that could conflict with their EUTM application. They are included in the application fee but must be requested at the time of filing the application or, for international applications, within 1 month after transmission of the file from WIPO to the EUIPO. In addition, national search reports can be requested from 5 national offices of the EU (the Czech Republic, Denmark, Hungary, Romania and Slovakia) for an extra fee.

They are for information purposes only and to give the applicant the option of withdrawing the EUTM application before it is published.

2. Surveillance letters are sent to the proprietors of earlier EU trade marks or EU trade mark applications about similar new EUTM applications that could potentially be conflicting with their rights. Proprietors receive it automatically unless they opt out from receiving this information.

These letters are purely informative and they may not be deemed to be a finding that a conflict actually exists or that the marks and goods and services involved are indeed identical or similar. Such a finding may only be adopted in a final decision in opposition or cancellation proceedings within the EUIPO.

In addition, an alert can be created within the User Area, which can notify the owner of similar trade marks being filed.

The applicants can also minimise the risk of opposition by using one of the EUIPO's tools and [searching](#) for potential conflicts before they apply.

[CNIPA](#)

- ☐ yes
☒ no

[JPO](#)

- ☐ yes
☒ no

[KIPO](#)

- ☐ yes
☒ no

[USPTO](#)

- ☐ yes
☒ no

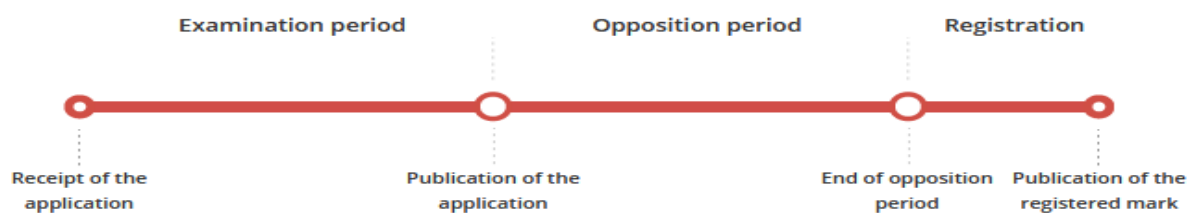
The USPTO does not notify existing rights holders (for example, registrants, applicants with earlier filing dates) about potentially conflicting later-filed applications during ex-officio examination.

3) At which stage in the registration process can a trade mark be opposed?

[EUIPO](#)

Following the publication of the EU trade mark application, upon finding that the application fulfils all the acceptance conditions. The date of publication is the date on which the application is published in Part A1 of the European Union Trade Marks Bulletin. A notice of opposition may be filed within a period of 3 months following this date.

The stages of the registration process are shown in the timeline below:



[CNIPA](#)

Within three months from the date of publication.

[JPO](#)

Within two months counting from the day following the date of publication of the trademark bulletin to the effect that the trademark has been registered (Article 43-2 of the Trademark Act). Please also refer to the answer to Question 25.

[KIPO](#)

Within two months from the date of publication of the application (Article 60 of the Trademark Act)

[USPTO](#)

Within 30 days of its date of publication in the USPTO's Official Gazette, or within an extension period that has been granted by the USPTO's Trademark Trial and Appeal Board (TTAB), but no later than 180 days following publication.

4) Means to file an opposition. ☐ electronically ☐ on paper

Please provide details on the requirements:

[EUIPO](#)

- ☒ electronically
- ☒ on paper

The notice of opposition has to be received by EUIPO in written form.

A notice of opposition may be filed: (1) by using the electronic form available in the User Area of the Office's website (2) by post or courier.

[CNIPA](#)

- ☒ electronically
- ☒ on paper

Filing an opposition on paper and electronically are both available.

[JPO](#)

- ☐ electronically
- ☒ on paper

[KIPO](#)

- ☒ electronically
- ☒ on paper

An opposition can be filed both online and offline.

[USPTO](#)

- ☒ electronically
- ☒ on paper

An opposition to an application based on Section 1 or Section 44 of the Trademark Act must be filed through the TTAB Electronic System for Trademark Trials and Appeals (ESTTA). If the system is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition may be filed in paper form. Paper filings must be accompanied by a written explanation of the technical problem or extraordinary circumstance, and in some instances, a Petition to the Director with an appropriate petition fee.

In cases in which an extension of time to oppose or an opposition is filed against an application based on Section 66(a) (i.e. international filing under the Madrid Protocol), the extension or opposition must be filed through the TTAB's Electronic System for Trademark Trials and Appeals (ESTTA). Paper filings are not allowed for Section 66(a) applicants. [TMEP Section 1503.01;TBMP Section 110.01(a)]

5) **If applicable, does the electronic filing system generate electronic acceptance of the opposition?**

☐ yes ☐ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☐ yes ☐ no
- b. Whether the opposition is timely? ☐ yes ☐ no

[EUIPO](#)

☒ yes ☐ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☐ yes ☒ no
- b. Whether the opposition is timely? ☐ yes ☒ no

The electronic filing system issues the receipt but this does not amount to the acceptance within the meaning of admissibility.

Even if there is no express request from the opponent, the existence of a current account will be sufficient for the account to be debited.

[CNIPA](#)

☒ yes ☐ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☐ yes ☒ no
- b. Whether the opposition is timely? ☒ yes ☐ no

The system will automatically refuse the out-of-time opposition filing.

[JPO](#)

☐ yes ☒ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☐ yes ☐ no
- b. Whether the opposition is timely? ☐ yes ☐ no

As of April 2023 the electronic filing system does not generate electronic acceptance of the opposition at the moment, but is scheduled to begin doing so by March 2024.

[KIPO](#)

☐ yes ☒ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☐ yes ☐ no
- b. Whether the opposition is timely? ☐ yes ☐ no

[USPTO](#)

☒ yes ☐ no

Does the system determine automatically:

- a. Whether the correct fee has been paid? ☒ yes ☐ no
- b. Whether the opposition is timely? ☒ yes ☐ no

6) Are the documents filed in opposition proceedings viewable online? ☐ yes ☐ no

[EUIPO](#)

☒ yes ☐ no

All documents and correspondence can be viewed in the eSearch plus database unless they are marked by the parties as confidential, which needs to be duly justified. This part of the database can only be accessed upon prior registration, but anyone can register.

[CNIPA](#)

☐ yes ☒ no

The documents filed in opposition proceedings are not available online to the public. But the examiners can view part of the documents in the system (e.g. the opposition application and evidence list, etc)

[JPO](#)

☐ yes ☒ no

[KIPO](#)

☐ yes ☒ no

[USPTO](#)

☒ yes ☐ no

Unless the filer checks a box to designate that the documents contain confidential information. Typically, a pleading is not submitted as confidential. There is a standard protective order that may be used in proceedings that defines the tiers of confidentiality. Documents tagged as confidential are not viewable.

7) Who can file an opposition? ☐ owner of earlier right ☐ licensee ☐ other

Please provide details on the requirements / evidence on the entitlement to file an opposition:

[EUIPO](#)

☒ owner of earlier right ☒ licensee ☒ other

1. Owner + authorized licensee: oppositions based on Articles 8(1) and (5) EUTMR (double identity, likelihood of confusion, earlier registered trade mark with reputation)
2. Only owner: opposition based on Article 8(3) based on unauthorised filing by agents of the TM proprietor
3. Owner + persons authorised by the applicable law to exercise the relevant rights: oppositions based on Article 8(4) EUTMR based on non-registered trade mark or another sign used in the course of trade of more than mere local significance
4. Any person authorised under the applicable law to exercise the rights arising from a designation of origin or a geographical indication: Article 8(6) EUTMR based on designation of origin or a geographical indication.

[CNIPA](#)

☒ owner of earlier right ☒ licensee ☒ other

If the opposition is filed on relative grounds, it is limited to the prior right holder or interested party; any subject may file an opposition on absolute grounds.

[JPO](#)

☒ owner of earlier right ☒ licensee ☒ other

Any person may file an opposition to registration (Article 43-2 of the Trademark Act).

However, in principle, it is limited to natural persons and corporations, and there is a provision stipulating that foreign nationals and others who are not domiciled or resident in Japan are restricted in the ability to carry out procedures. (Article 3, paragraph (2) and Article 35, paragraph (2) of the Civil Code are in principle, but Article 25-1. 2. 3 of the Patent Act applied mutatis mutandis under Article 77, paragraph (3) of the Trademark Act, and Article 6, Article 7, paragraphs (1) and (2), and Article 8, paragraph (1) of the Patent Act applied mutatis mutandis under Article 77, paragraph (2) of the Trademark Act).

[KIPO](#)

☒ owner of earlier right ☒ licensee ☒ other

Anyone (Article 60(1) of the Trademark Act) may oppose a trademark application and an unincorporated association or foundation may become an opposer if a representative or a manager is assigned.

[USPTO](#)

☒ owner of earlier right ☒ licensee ☒ other

Any person who believes they would be damaged by the registration of a trade mark on the Principal Register, and whose belief of damage is reasonable may oppose including owners of earlier rights, licensees, and others. [TMEP Section 1503.01; TBMP Section 309.03(b)] Opposers can base their claims on assertions of a superior right to a mark, but also can oppose even without a mark, when the basis for the opposition is that the applicant's mark must be left free for others to use.

8) **Are there any requirements relating to legal standing to file an opposition?**

Please provide details on the requirements / evidence on the entitlement to file an opposition:

[EUIPO](#)

The information required to identify a party is:

- name;
- address;
- the country of domicile if a natural person, or the country in which it is domiciled or has its seat or an establishment if a legal entity.

If the opponent has designated a representative, it must provide the name and business address of the representative.

The opponent does not have to indicate its entitlement if it is the **owner** of the earlier mark or right on which the opposition is based. If the opponent is an **authorised licensee** or a **person authorised under the applicable law** they must submit a **statement** to that effect and **specify the basis of their entitlement** (for example, licence agreement, specific authorisation from the proprietor, specific provision of the applicable law).

[CNIPA](#)

If the opposition is filed on relative grounds, it is limited to the prior right holder or interested party; any subject may file an opposition on absolute grounds.

[JPO](#)

Any person may file an opposition to registration (Article 43-2 of the Trademark Act).

However, in principle, it is limited to natural persons and corporations, and there is a provision stipulating that foreign nationals and others who are not domiciled or resident in Japan are restricted in the ability to carry out procedures. (Article 3, paragraph (2) and Article 35, paragraph (2) of the Civil Code are in principle, but Article 25-1. 2. 3 of the Patent Act applied mutatis mutandis under Article 77, paragraph (3) of the Trademark Act, and Article 6, Article 7, paragraphs (1) and (2), and Article 8, paragraph (1) of the Patent Act applied mutatis mutandis under Article 77, paragraph (2) of the Trademark Act).

In particular, when a person who is not domiciled or resident (or, in the case of a corporation, with a place of business) in Japan files an opposition, it is required to appoint a patent administrator domiciled or resident in Japan. (Article 8 of the Patent Act applied mutatis mutandis under Article 77, paragraph (2) of the Trademark Act) (Please refer to the answer to Question 12.)

[KIPO](#)

Anyone (Article 60(1) of the Trademark Act) may oppose a trademark application and an unincorporated association or foundation may become an opponent if a representative or a manager is assigned

[USPTO](#)

No other requirements are needed other than those cited in Question 5 above. To show entitlement, the opposer must show that its claims are within the “zone of interests” protected by the Trademark Act (has a “real interest” in opposing), and would be damaged by registration of the mark (has a “reasonable basis” for its belief in damage). TBMP Section 303.03

9) **What are the fees payable to your Office to file an opposition?**

[EUIPO](#)

The opposition fee is EUR 320.

The Office has to receive the full amount of the opposition fee within the opposition period. If the opposition fee was not received within the opposition period, the notice of opposition is deemed not to have been entered.

Payments by bank transfer received after the opposition period are considered to be made within the opposition period if the opponent

(i) files evidence showing that it gave the transfer order to a banking establishment within the opposition period and

(ii) pays a surcharge of 10 % of the opposition fee.

The surcharge does not have to be paid if the evidence shows that the order to the bank was given no less than 10 days before the expiry of the opposition period.

[CNIPA](#)

RMB 500

[JPO](#)

¥ 3,000 + ¥ 8,000 per class

[KIPO](#)

50,000 KRW per class

[USPTO](#)

Fees payable to the USPTO in relation to oppositions are as follows:

Notice of Opposition (per class): 600 USD (electronic); 700 USD (paper)

First 90-day or second 60-day request for extension of time to file a notice of opposition: 200 USD (electronic); 400 USD (paper)

Final 60-day request for an extension of time to file a notice of opposition: 400 USD (electronic); 500 (paper)

Request for an oral hearing in relation to an opposition: 500 USD (electronic).

[37 C.F.R. Section 2.6(a)]

10) **Costs related to filing an opposition payable to the office (other than those specified in 9., excluding appeal fees):**

[EUIPO](#)

No further fees payable to the Office.

In case the winning party has appointed a professional representative (not applicable to employee representatives), it is entitled to the representation costs, this amount being limited to EUR 300.

[CNIPA](#)

No other related costs.

[JPO](#)

There is no fee payable other than that described in the answer to Question 9.

[KIPO](#)

No other cost than the fee specified in the answer to Q9

[USPTO](#)

Additional costs associated with filing an opposition vary and would be assessed on a case-by case basis. Costs might be incurred for investigations, lawyer fees, and other activities in preparing to file an opposition. During the opposition, there may be additional costs associated with discovery review, evidence, witnesses, surveys and other activities similar to those associated with a trial. Parties can minimize extra costs by entering into stipulations (agreements) regarding the facts or evidence that will be considered, or stipulations that only specified and efficient or less-costly procedures will be utilized.

11) When is the payment due, what are the effects of late payment and how can they be remedied:

[EUIPO](#)

The Office has to receive the full amount of the opposition fee within the opposition period. If the opposition fee was not received within the opposition period, the notice of opposition is deemed not to have been filed.

Payments by bank transfer received after the opposition period are considered to be made within the opposition period if the opponent

(i) files evidence showing that it gave the transfer order to a banking establishment within the opposition period and

(ii) pays a surcharge of 10 % of the opposition fee.

[CNIPA](#)

Payment shall be completed within 7 days after receiving the payment notice. If the payment is not completed on time, the application will not be accepted and the date of application will not be reserved.

[JPO](#)

The payment due is the same time as filing an opposition to registration. If the payment is not made, making the payment will be ordered within 30 days, otherwise it will be dismissed. (Article 133, paragraph (2), item (3), and paragraph (3) of the Patent Act applied mutatis mutandis under Article 43-15 of the Trademark Act and Article 56, paragraph (1) of the Trademark Act).

[KIPO](#)

If the payment is not made in due time, the opponent will be requested to make that payment. And if the payment is made, the opposition filing will be admitted and if not, the opposition filing will be deemed to be invalid.

[USPTO](#)

A timely opposition will not be accepted unless it is accompanied by a fee that is sufficient to pay, in full, for each named party opposer. If no fee is paid, or the provided fee is insufficient to pay for at least one person to oppose in at least one class, then the opposition will be rejected. [TBMP Section 308.01(b)]

12) Does your Office require professional representation to file an opposition?

- ☐ yes
☐ no
☐ it depends (*e.g. on nationality/domicile/principal place of business*)

Please provide details on the requirements / evidence on the entitlement to file an opposition:

[EUIPO](#)

- ☐ yes
☐ no
☒ it depends (*e.g. on nationality/domicile/principal place of business*)

In principle, no person shall be compelled to be represented before the Office.

Applicants who do not have their domicile, principal place of business or real and effective commercial establishment within the EEA ([European Economic Area](#)), i.e. the EU Member States and Norway, Iceland and Lichtenstein, are required to be represented before the Office. In all other cases representation is optional.

[CNIPA](#)

- ☐ yes
☐ no
☒ it depends (*e.g. on nationality/domicile/principal place of business*)

An applicant may file an opposition by itself or authorize a trademark agency to handle the related trademark matters. Any foreigners or foreign enterprises handle trademark matters in China, they shall authorize a legally established trademark agency.

[JPO](#)

- ☐ yes
☒ no
☐ it depends (*e.g. on nationality/domicile/principal place of business*)

When a person who is not domiciled or resident (or, in the case of a corporation, with a place of business) in Japan files an opposition, it is required to appoint a patent administrator domiciled or resident in Japan (Article 8 of the Patent Act applied mutatis mutandis under Article 77, paragraph (2) of the Trademark Act). However, since a patent administrator does not necessarily have to be a professional representative, our Office has no requirement in this regard.

[KIPO](#)

- ☐ yes
☒ no
☐ it depends (*e.g. on nationality/domicile/principal place of business*)

[USPTO](#)

- ☐ yes
☐ no
☒ it depends (*e.g. on nationality/domicile/principal place of business*)

An applicant, registrant or party to a Trademark Trial and Appeal Board proceeding whose domicile is not located within the United States or its territories must be represented by an attorney licensed to practice law in the United States. Trademark Rule 2.11, 37 C.F.R. 2.11. [TBMP Sections 114.01 and 114.03]

13) What is the time limit to file an opposition?

[EUIPO](#)

A notice of opposition may be filed within a period of 3 months following the publication of the EU trade mark application. The date of publication is the date on which the application is published in Part A1 of the European Union Trade Marks Bulletin.

[CNIPA](#)

Within three months from the date of publication.

[JPO](#)

Within two months counting from the day following the date of publication of the trademark bulletin to the effect that the trademark has been registered (Article 43-2 of the Trademark Act).
 However, if the last day of the submission period falls on Saturday, Sunday, a national holiday, or other days when our Office is closed, the time limit will be the next working day (Article 3 of the Patent Act applied mutatis mutandis under Article 77, paragraph (1) of the Trademark Act).

[KIPO](#)

Within two months from the date of publication of the application (Article 60 of the Trademark Act)

[USPTO](#)

Within 30-days of the publication of the trade mark in the Official Gazette of the USPTO or no later than the end of any extensions of time to oppose are filed by a potential opposer and granted by the TTAB. Extensions of time to oppose are granted only to individual parties, and an extension obtained by one party does not extend the time for other parties to file an opposition. No extension will be granted that would run beyond 180 days from publication of the mark.

14) Does your office provide for extensions of time to file the opposition (allowing an opposer to submit a placeholder during the opposition period that allows the opposer to file the actual opposition after the opposition period has run)? ☐ yes ☐ no

[EUIPO](#)

- ☐ yes ☒ no

b. If not, is your opposition period longer than 30 days to ensure that interested third parties have appropriate time to prepare and file the opposition after publication? ☒ yes ☐ no

[CNIPA](#)

☐ yes ☒ no

b. If not, is your opposition period longer than 30 days to ensure that interested third parties have appropriate time to prepare and file the opposition after publication? ☒ yes ☐ no

[JPO](#)

☐ yes ☒ no

b. If not, is your opposition period longer than 30 days to ensure that interested third parties have appropriate time to prepare and file the opposition after publication? ☒ yes ☐ no

[KIPO](#)

☐ yes ☒ no

b. If not, is your opposition period longer than 30 days to ensure that interested third parties have appropriate time to prepare and file the opposition after publication? ☒ yes ☐ no

[USPTO](#)

☐ yes ☒ no

b. If not, is your opposition period longer than 30 days to ensure that interested third parties have appropriate time to prepare and file the opposition after publication? ☒ yes ☒ no

The original opposition period is set by the Trademark Act at 30 days. A 30-day extension may be obtained without cost. Extensions beyond 60 days from publication of the mark for opposition incur fees. No extension will be granted beyond 180 days from publication. A party that does not file a timely opposition usually will be able to file a petition to cancel, after a registration issues.

15) Is the applicant required to answer the opposition? ☐ yes ☐ no

[EUIPO](#)

☐ yes ☒ no

[CNIPA](#)

☒ yes ☐ no

The opposed party needs to respond to the opposition reasons of the opposing party.

[JPO](#)

☐ yes ☒ no

As a premise, the main purpose of the opposition to registration of trademark system in Japan is not to solve specific disputes between parties. The system was introduced to achieve the purposes of public interests of

increasing the public's confidence in the registration by giving extensive opportunities to a third party to request for revocation of the registration of trademark for a certain period after the registration of establishment of the trademark right, so that in the event of opposition to registration, the JPO examines whether or not its decision of registration was appropriate, and remedies any defects that may be discovered.

Due to the purpose of this system, an applicant is not required to answer all cases of oppositions. Where the chief administrative judge intends to render a ruling to cancel, the chief administrative judge must notify the holder of trademark right of the reasons for cancel of the trademark registration and give those parties an opportunity to submit a written opinion (Article 43-12 of the Trademark Act).

[KIPO](#)

☐ yes ☒ no

The chief examiner must serve a copy of an opposition application on the owner of the opposed application and provide him or her one-month period for response (the period can be extended by one month). However, it is not mandatory for him or her to submit a written opinion.

[USPTO](#)

☒ yes ☐ no

If the applicant does not file a response to the opposition, a notice of default will be issued noting the failure to answer and that a default judgment sustaining the opposition may be granted. If the applicant does not establish why a late answer should be accepted, then a default judgment will be entered. An applicant responding to a notice of default must explain the reason why the answer was not filed before the deadline.

16) Are there any language requirements in your Office when filing an opposition?

[EUIPO](#)

The notice of opposition may only be filed in one of five languages of the EUIPO, English, French, German, Italian and Spanish, and the language must also coincide with one of the two languages chosen by the applicant for the European Union trade mark.

This language will then be used throughout the opposition proceedings.

[CNIPA](#)

The documents submitted to file an opposition must be written in Chinese.

[JPO](#)

In principle, documents pertaining to oppositions must be written in Japanese (Article 2, paragraph (1) of the Regulation for Enforcement of the Patent Act applied mutatis mutandis under Article 22, paragraph (1) of the Regulation for Enforcement of the Trademark Act).

A power of attorney, a certificate of nationality, and other documents written in a foreign language must include an attached translation in accordance with Article 2, paragraph (2) of the Regulation for Enforcement of the Patent Act applied mutatis mutandis under Article 22, paragraph (1) of the Regulation for Enforcement of the Trademark Act.

[KIPO](#)

Opposition documents should be written in Korean.

[USPTO](#)

The USPTO requires that all correspondence with the USPTO be in English [37 C.F.R. Section 7.3].

17) What are the main stages of the opposition procedure (please provide details, e.g. notice of opposition, cooling-off period, adversarial stage):

[EUIPO](#)

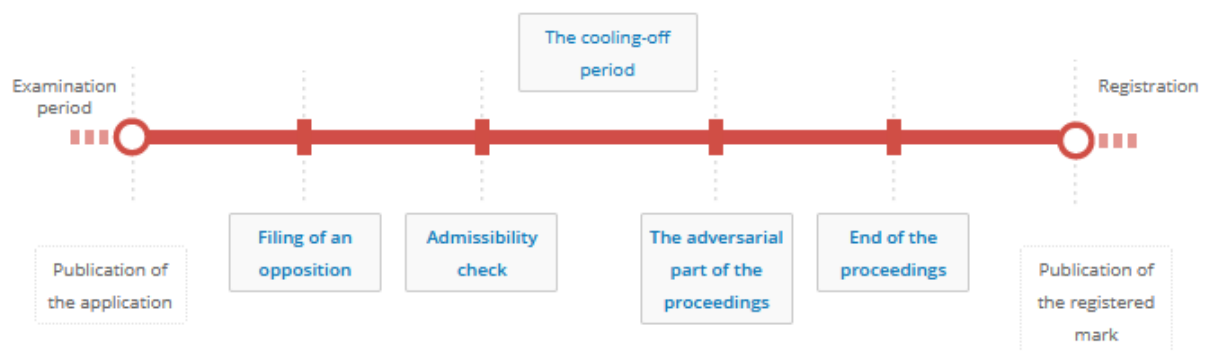
Opposition period: 3 months from publication of the application during which time the notice of opposition may be filed.

Cooling-off period: 2 months after parties receive notification from EUIPO that the opposition has been found admissible, also informing the parties that the adversarial part of the proceedings is deemed to commence 2 months after receipt of the notification. This period can be extended to a total of 24 months.

Adversarial stage (the time-limits may be extended):

- 2 months given to the opponent to substantiate the opposition
- 2 months given to the applicant to reply to the opposition (including giving him the possibility to submit a request proof of use, i.e. requiring the opponent to prove that any earlier marks registered for more than 5 years have been used)
- 2 months given to the opponent to comment on the applicant's submissions and after these exchanges the opposition is normally ready for decision. If the applicant has not filed any observations, the case is sent to decision.

In some cases (complex cases, new point raised) it may be necessary or useful to have another exchange of observations.



[CNIPA](#)

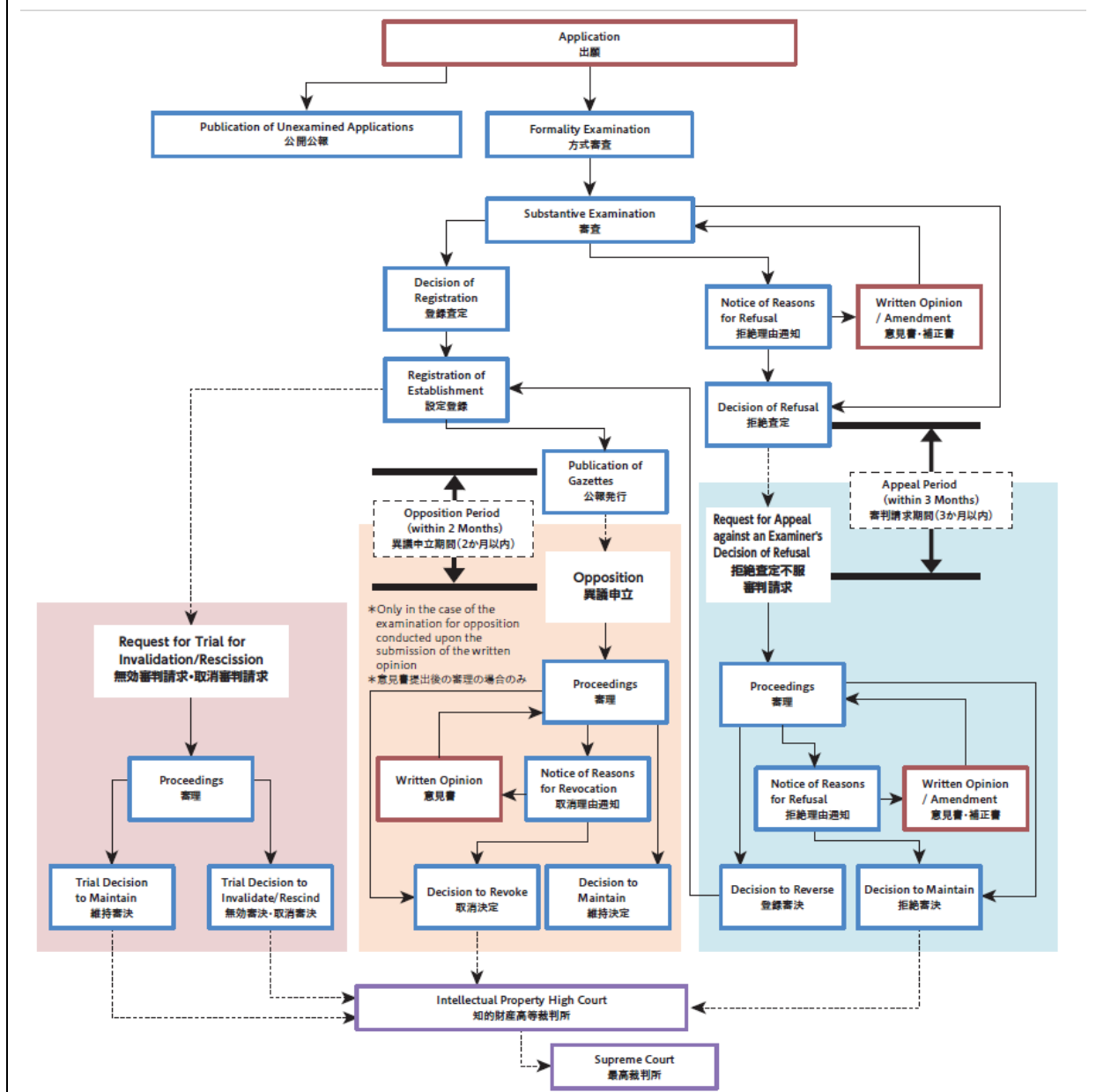
Formal examination-Opposition notice-Adversarial stage-Opposition decision

The opposition procedure includes opposition formal examination and substantive examination. The opposed party will be delivered the opposition filing documents and informed the time-limit of response. After the time-limit, the application will be allocated for examination.

When an opposition to a trademark registration is filed, a formality search is conducted to see if there are any deficiencies with respect to formality. In addition, a statement to the effect that the opposition has been filed is registered in the Trademark Register, and administrative judges are designated. A duplicate of the written opposition is then sent to the holder of the trademark right, and an examination proceeding is conducted. If a reason for revocation of the trademark registration is applicable, the holder of the trademark right is notified of the reason therefor, and is given an opportunity to submit a written opinion. A decision will be rendered in the following cases: wherein no reason for revocation is applicable; wherein there is a reason for revocation and a written opinion is not submitted; and wherein a written opinion does not resolve the reason for revocation.

Right holders may institute action with the Intellectual Property High Court against the decision to revoke.

(Please refer to the flow chart, which outlines the opposition to trademark system registration at the JPO.)



KIPO

First, the opponent files an opposition application with the information including his or her name and address in accordance with the requirements of Article 60(2), attached with necessary evidence. The second process is to correct the opposition grounds and evidence. Next, the owner of the opposed application will be served a copy of an opposition application with a timetable to submit a written opinion. And then, the opposition will be reviewed to make a decision.

USPTO

Following publication, the main stages of an opposition procedure are as follows:

The Pleadings Phase

- Filing of a Notice of Opposition by opposer
- Applicant's Answer with affirmative defenses and/or counterclaims
- Opposer's answers to any counterclaim

Discovery/Settlement Conference

- Parties must conference and discuss the nature and basis for claims and defenses
- Possibilities for settlement
- Arrangements for required disclosures and discovery
- Potential use of Accelerated Case Resolution (ACR) or stipulations to use more efficient procedures for trial and briefing of the case

Initial Disclosures

- Provide contact information for persons likely to have discoverable information
- Copies of documents that may be used to support claims or defenses
- Provide information about parties who may be called as witnesses
- Provide information about documents, electronically stored information relevant to the case

Expert Disclosures

- Provide information about experts and proposed testimony

General Discovery

During the discovery phase the parties can request and receive relevant information from each other to evaluate their claims and defenses. Tools such as "written interrogatories", "requests for production of documents", "depositions", and "requests for admissions" can be utilized during this phase.

Trial Testimony Phase

During this phase, evidence is introduced. The parties each have an assigned time for presenting evidence. Before the parties' time period begins, it must serve disclosures on the other parties, to reveal the type of evidence it will present, to allow the other parties to prepare for trial. Testimony depositions may be taken by or on behalf of a party. Testimony depositions are taken before a court reporter who records the questions and answers. Depositions are not taken at the USPTO, but in the location where the witness lives or works. Evidence may be introduced in the form of testimony declarations, to avoid the need for using a court reporter. Rebuttal testimony may also be provided.

Opposer's Brief/Applicant's Brief

The opposer files its brief addressing the evidence and law. The applicant files a response brief and, if the applicant filed a counterclaim attacking a registration of the opposer, then the applicant's brief also must address

the counterclaim. The opposer may file a reply (rebuttal) brief. An applicant who filed a counterclaim may file a reply brief to support the counterclaim.

Oral Hearing – an oral hearing is held only if requested by a party to the proceeding,

Decision/Termination of Proceedings

Judges of the TTAB consider the pleadings and evidence and issue a decision

- 18) What is the result if the owner of the opposed application does not respond to the opposition?
Does the office offer default judgment (or the equivalent), for example a notice of default or a binding ruling by the board in favor of the plaintiff? ☐ yes ☐ no

[EUIPO](#)

☐ yes ☒ no

The office takes a decision based on the facts of the case as presented by the opponent.

[CNIPA](#)

☐ yes ☒ no

It will not affect the examination of the case.

[JPO](#)

☐ yes ☒ no

As stated in Question 15, the main purpose of the opposition to registration of the trademark system in Japan is not to solve specific disputes between parties.

In the event of opposition to registration, the JPO examines whether or not its decision of registration was appropriate, only when the chief administrative judge intends to make a decision to cancel a registration, the chief administrative judge notifies the holder of trademark right of the reasons for cancel of the trademark registration and gives the holder an opportunity to submit a written opinion (Article 43-12 of the Trademark Act).

Additionally, there is no default judgment or equivalent system.

[KIPO](#)

☐ yes ☒ no

As mentioned above, regardless of response from the owner of the opposed application, the opposition process will be carried on.

USPTO

As noted in the response to Question 15, if the applicant files no response to the opposition, the applicant may lose the case by default judgment. However, an applicant may request an extension of the due date for the answer to allow for settlement discussions with the opposer. Often, such extensions are agreed to by the opposer. The extension must be requested and approved by the TTAB, otherwise the time for filing an answer will continue to run.

An opposition may be settled at any time before a decision issues. A substantial percentage of oppositions are eventually settled and the TTAB encourages settlement at the earliest opportunity. Very often, these extensions are sought before an answer is filed. Proceedings may be suspended or the parties may request extensions of time for reasonable times while parties negotiate settlement. [TBMP Section 605]

The TTAB may suspend proceedings for a period of up to 6 months, either upon request or sua sponte, subject to the right of either party to request resumption at any time prior to the expiration of the suspension period. The suspension period may be further extended upon request, or upon written notification to the TTAB that the parties are still seeking to settle. Once proceedings have been suspended for over a year, the TTAB may require the submission of a status report to show good cause for continued suspension.

As for timing, the TTAB generally will not find good cause to suspend proceedings to seek a settlement after an answer is filed but before the scheduled settlement and discovery planning conference takes place (even upon stipulation or consent, as the discovery conference provides parties with the opportunity to discuss settlement). The parties may agree to an extension or suspension to allow for continued settlement talks during the conference and file a consented (agreed) motion or stipulation, to be reviewed and approved by the TTAB.

19) Does your Office encourage or provide mediation services or other means of amicable settlement? At which stage of the proceedings?

Please provide details.

EUIPO

1. Alternative Dispute Resolution Services

The legal framework of the Office sets the basis and encourages amicable settlement of disputes (Preamble 35 EUTMR, Article 47(4) EUTMR, Article 64(4) EUTMR, Article 31(5) CDR...). It moreover includes mediation in the tasks of the Office (Article 151(3) EUTMR) and caters for the establishment of a Mediation Centre (Article 170 EUTMR).

2.- Mediation. The Alternative Dispute Resolution Service (ADRS), operating under the auspices of the EUIPO Boards of Appeal, offers alternative dispute resolution services such as **mediation** for *inter partes* proceedings, in particular during the appeal proceedings (which are suspended for the duration of the mediation process), allowing the parties to reach an amicable settlement agreement.

During the COVID pandemic, a pilot service addressed to SMEs extended the scope of the proceedings in which mediation could be requested and made these services also available in first instance proceedings, such as EUTM opposition and cancellation and RCD invalidity proceedings.

3. Friendly settlement The Office shall facilitate the amicable settlement of disputes relating to EUTMs and RCDs on the basis of a mutual agreement. The Office, as well as the parties, may therefore initiate a settlement procedure that in the Boards of Appeal is called Conciliation. The rapporteur, member of the Boards of Appeal to whom the appeal file is assigned can facilitate amicable settlement of the dispute through **conciliation**. In this case, the conciliator will help the parties reach an agreement by proposing substantive solutions, that the parties will discuss, finetune and use to reach an agreement.

[CNIPA](#)

CNIPA has no encourage or provides mediation services to applicants. The related parties may settle the dispute by themselves and withdraw the opposition filing.
We are considering provide unofficial amicable settlement advice before adversarial stage.

[JPO](#)

Our Office does not encourage or provide this.

[KIPO](#)

N/A

[USPTO](#)

The TTAB provides the parties with general information about such services on its website and at the time of institution. Any party may request that a TTAB judge or attorney participate in the settlement and discovery planning conference. The participating judge or attorney does not suggest possible settlement arrangements particular to the parties, but may provide general information about typical approaches to settlement. Examples of means to settle a case could include a consent agreement between the parties, an assignment of a mark from one party to another, entry into a licensing agreement, or amendment or restriction of an application or registration.

20) Does your Office indirectly encourage amicable resolution of the proceedings?

[EUIPO](#)

The opposition fee is refunded if, before or during the cooling-off period, the opposition is withdrawn, e.g. due to a settlement between the parties, applicant withdrawing its EUTM application or withdrawing all those goods and services against which the opposition is directed.

For mediation in inter partes appeal proceedings, once the appeal fee has been paid, the parties may request mediation with no additional charge (administration charge or mediator fee). If the mediations are held at the EUIPO Alicante premises or online, and if the parties chose an EUIPO internal mediator. When the parties decide to hold the mediation in the EUIPO Brussels premises, a one-off fee of EUR 750 is charged to cover the travel and accommodation expenses of the EUIPO mediator. In the case that mediation does not result in a settlement agreement, the appeal proceedings will resume, but the parties do not have to pay any extra charge.

[CNIPA](#)

No.

[JPO](#)

Our Office does not encourage this.

[KIPO](#)

N/A

[USPTO](#)

The TTAB encourages amicable resolution by liberally providing extensions or suspensions to accommodate settlement talks.

21) **Is there a specific period to allow for amicable settlements, e.g. during the pre-adversarial period or during the opposition?**

Please provide details and possible impact on fees.

[EUIPO](#)

The parties are free to decide on the measure that brings the opposition proceedings to a conclusion. Amicable settlements are allowed anytime during the opposition proceedings.

The opposition fee is only refunded if the opposition is withdrawn during the cooling off period (or before) and the withdrawal is a result of the applicant's deletion or limitation of the contested goods and services.

The parties may negotiate during cooling-off period, initially set for two months and may be extended up to 24 months on request by both parties.

If the parties need further time to negotiate, they may jointly request suspension of the proceedings. Suspension is granted for a period of 6 months. The maximum duration of the suspension is limited to 2 years.

Parties may decide to request mediation or a friendly settlement at any stage of the appeal proceedings, although it is recommended that they consider this option at the earliest stage of the conflict.

[CNIPA](#)

No.

[JPO](#)

There are no such periods or fees.

[KIPO](#)

N/A

[USPTO](#)

The TTAB does not charge fees for extensions or suspensions that are sought to accommodate settlement talks. The parties may incur fees from their attorneys. Parties are free to discuss settlement at any time prior to issuance of a decision. The TTAB will extend deadlines or suspend proceedings to accommodate settlement discussions, so long as the extension or suspension is sought before an answer is filed or after the settlement and discovery planning conference has been held. The TTAB may require parties to provide status reports on the progress of settlement talks, as a condition for an extension or suspension. If a party seeks an extension or suspension for settlement talks but the other party disputes the request, the TTAB generally will not grant the extension or suspension. In the absence of an extension or suspension approved by the TTAB, the proceeding

schedule continues to run and a party will not be heard to argue that it did not take a required action by a particular deadline because it hoped to settle the case.

22) **Does your office provide a forum for resolving disputes concerning trade mark registrability? If yes, what is the policy rationale for doing so?**

[EUIPO](#)

Mediation can take place only in “*inter partes*” disputes, that is between two or more parties, not including the Office. Hence, there can be no mediation in cases of a disagreement of a user with an absolute grounds decision taken by the Office for example.

EUIPO does not refuse *ex officio* EUTM applications based on potential conflict with existing earlier rights.

[CNIPA](#)

No.

[JPO](#)

Our Office does not provide this.

[KIPO](#)

N/A

[USPTO](#)

The USPTO’s TTAB encourages alternative dispute resolution as a means of settling issues raised in an opposition but does not provide mediation services. Also see Question 14 above.

23) **Does your Office have procedures relating to discovery and stipulated disclosures?**

Please provide details.

[EUIPO](#)

N/A

[CNIPA](#)

We disclose all opposition decision documents online and hide on request.

[JPO](#)

Any person may file a request for inspection of documents to the Commissioner of the Patent Office. However, if the Commissioner of the Patent Office considers it necessary to keep certain documents confidential, it is not applicable to this case (Article 72, paragraph (1) of the Trademark Act).

[KIPO](#)

No

[USPTO](#)

Procedures related to TTAB oppositions can be found in the Trademark Trial and Appeal Board Manual (TBMP) on the USPTO website.

Except as otherwise provided by the Trademark Rules in Title 37 of the U.S. Code of Federal Regulations (CFR), the Federal Rules of Civil Procedure (FRCP) govern TTAB proceedings. The discovery phase is limited to 180 days, unless extended by the parties. The interaction of the CFR, FRCP and relevant decisional law from the federal courts is discussed in the TBMP.

The requirements for the settlement and discovery planning conference are identified by Federal Rule of Civil Procedure 26(f). The Discovery period begins 30 days after an Answer is filed. The parties have 30 days from the start of the Discovery period to make initial disclosures. The parties are obligated to serve Initial Disclosures under FRCP 26(a)(1)(A) before serving any discovery requests.

Witnesses may be called as well as demands made for documents and other evidence.

See Question 17 regarding discovery and disclosures.

24) Does your office allow opponents to withdraw their opposition filings independently? ☐ yes ☐ no

[EUIPO](#)

☒ yes ☐ no

The opposition fee is only refunded if the opposition is withdrawn during the cooling off period (or before) and the withdrawal is a result of the applicant's deletion or limitation of the contested goods and services.

[CNIPA](#)

☒ yes ☐ no

N/A

[JPO](#)

☒ yes ☐ no

The opposition may be withdrawn.

However, the opposition may not be withdrawn after the notification of reasons for revocation of the trademark registration is served (Article 43-11 of the Trademark Act).

[KIPO](#)

☒ yes ☐ no

Yes. An admitted opposition can be withdrawn.

USPTO

☒ yes ☒ no

An opposer may “withdraw” the notice of opposition without prejudice any time prior to the filing of an answer by the applicant, without need to obtain consent to withdrawal from the applicant. After an answer has been filed, the opposer is not permitted to withdraw the opposition without prejudice except with the written consent of the applicant. A withdrawal does not result in removal of the actual opposition filing from the TTAB’s file for the case, but only in closure of the case, upon the terms specified in the CFR, depending on the terms of the withdrawal or upon any terms the parties may stipulate to in accordance with the FRCP rule governing stipulations. See TBMP Section 501 for information on stipulations, TBMP Section 601 for information on withdrawal by an opposer.

25) **Are there any applicable time-limits to provide evidence? Is there any possibility of filing ‘belated evidence’? If yes, under which conditions?**

EU IPO

1. Time limit for substantiation. All facts and evidence on which the opponent bases its opposition have to be submitted within the substantiation time limit established in Article 7(1) EUTMDR (2 months following the end of the cooling off period, may be extended). Any fact or evidence submitted after the substantiation time limit is, therefore, late.

Nevertheless, if the opponent submits facts or evidence to substantiate the opposition after the substantiation time limit, the Office may take into account such facts or evidence in exercise of its discretionary power pursuant to Article 95(2) EUTMR, subject to the conditions of Article 8(5) EUTMDR.

In that context, it must be assessed first, whether the Office can exercise any discretionary power and, second, if so, how to exercise it, that is, whether to admit or reject such late facts or evidence.

2. Time limit to submit proof of use. If the request for proof of use is admissible, the Office will invite the opponent to submit proof of use, ensuring that it always has at least 2 months to do so. This time limit may be extended.

3. ‘General remedial proceedings’ can also be used to resume proceedings if the opposition is refused due to unobserved deadline. These remedies have specific conditions and can be used in specific circumstances. They are not primarily aimed at belated evidence. They cannot be relied on when missing the opposition period.

- Continuation of proceedings is possible within two months of the expiry of the unobserved time limit (provided special fee of EUR 400 has been paid)
- Restitutio in integrum is possible within two months of the removal of the obstacle to comply with the time limit

CNIPA

There is a time-limit.

If the evidence is not be submitted on time, it can be accepted when it meets the following conditions: 1. The newly generated evidence after the expiration of the supplementary evidence period; 2. The evidence that the parties fail to submit before the expiration of the supplementary evidence period with justifiable reasons; 3. Other evidences that have a significant impact on the case examination decision.

JPO

While, in principle, supporting evidence must be submitted at the same time as filing the written opposition (Article 43-4, paragraph (1), item (3) of the Trademark Act), supporting grounds and evidence may be submitted

only no later than thirty days from the lapse of the term (during which an opposition may be filed) provided in Article 43-2 of the Trademark Act (Article 43-4, paragraph (2) of the Trademark Act).

[KIPO](#)

In principle, the evidence should be submitted within two months from the date of the application's publication. Even if this period has elapsed, however, the grounds for opposition and the evidence can be submitted within 30 days from the period's expiration.

[USPTO](#)

Trial evidence is introduced during the parties' respective assigned testimony periods. The opposer has a 30-day testimony period in which to submit its trial evidence; the applicant then has a 30-day testimony period to submit its evidence; and the opposer has a 15-day testimony period to submit rebuttal evidence. If the applicant filed a counterclaim, then an additional rebuttal testimony period will be provided. Testimony periods may be extended by stipulation of the parties approved by the TTAB, or may be extended upon motion granted by the TTAB, or by order of the TTAB. A motion to extend time must set forth facts outlining good cause for the requested extension. After the time for taking a particular action or meeting a particular deadline has passed, an extension is no longer available and the party must seek to "reopen" the time period. A motion to reopen time filed after the expiration of a deadline must show that the moving party's failure to act during the time allowed was the result of excusable neglect.

26) Does your Office provide for the opportunity of an oral hearing in opposition procedures?

Please provide details.

[EUIPO](#)

The Office will hold oral proceedings either on its own initiative or at the request of any party to the proceedings only when it considers these to be absolutely necessary. This will be at the Office's discretion. In the vast majority of cases, it will be sufficient for the parties to present their observations in writing.

[CNIPA](#)

Not for now. We are considering imply hearing procedure.

[JPO](#)

In principle, documentary examinations are conducted. However, oral proceedings may be conducted (Article 43-6, paragraph (1) of the Trademark Act).

[KIPO](#)

N/A

[USPTO](#)

Yes, the USPTO's TTAB provides the opportunity to have an oral hearing in an opposition. This is not a requirement however. If a party wishes to have an oral hearing the party must make this request via a separate

notice filed not later than 10 days after the due date for the filing of the last reply brief. Oral arguments are limited to 30 minutes for each party. A party may also reserve part of the time allowed for oral argument to present a rebuttal argument. Hearings may be conducted in person at the USPTO, or by video. Some hearings will be hybrid and may have some participants in a hearing room at the USPTO, while others appear by video connection.

27) Does your Office allow for third parties to make observations in opposition procedures?

Please provide details.

[EUIPO](#)

Anybody can submit third-party observations explaining why the EUTM application should not be registered under Article 5 EUTMR or on the basis of one of the absolute grounds of Article 7 EUTMR. The Office will consider if the observations raise serious doubts as to the registrability of the EUTM application, in such a case the Office must suspend the opposition proceedings until a decision on the observations is taken.

[CNIPA](#)

No.

[JPO](#)

In examination proceedings to render a decision on an opposition to registration, a right holder and any other person who has an interest in the trademark right may intervene in the examination proceedings in order to assist the holder of trademark right until the ruling on opposition to registration is rendered (Article 43-7 of the Trademark Act).

[KIPO](#)

N/A

[USPTO](#)

No. The USPTO TTAB does not allow for third parties to make observations in opposition procedures. The Board is free to seek amicus briefs from third parties, but has rarely done so.

28) If motions are filed by the parties, who in the forum is tasked with the responsibility to decide the motions?

[EUIPO](#)

- The decisions of the Opposition Divisions shall be taken by three-member groups. At least one member must be legally qualified.
- Decisions relating to costs or to procedures shall be taken by a single member.

[CNIPA](#)

No motion-related regulations in current law system.

[JPO](#)

As stated in Question 15, the main purpose of the opposition to registration of the trademark system in Japan is not to solve specific disputes between parties.

Therefore, there is no system under which motions are filed by the parties in the case of opposition proceedings.

[KIPO](#)

N/A

[USPTO](#)

The TTAB has paralegals and attorneys that review and decide any motions that cannot be automatically granted by the TTAB's electronic filing system (ESTTA). ESTTA can approve certain types of consented motions that are filed with clear information about the agreement of the parties. Paralegals issue most decisions on motions which are consented to by the parties but cannot be approved by ESTTA, and on motions which are neither consented nor contested (they are "uncontested" motions). Attorneys decide some of the consented motions, which paralegals cannot decide, and decide all contested motions.

29) **How many decision takers make up the panel deciding on the substance of opposition?**

[EUIPO](#)

The Opposition Division is made up of three members, at least one of them is legally qualified.

[CNIPA](#)

One person examination or one examination and one approval.

[JPO](#)

While the law (Article 43-3, paragraph (1) of the Trademark Act) stipulates that examination proceedings and ruling on opposition to registration is to be conducted by a panel consisting of three or five administrative judges (decision takers), it is normally conducted by a panel consisting of three administrative judges.

[KIPO](#)

The decision on the opposition will be made by a panel of three examiners. (Article 62 of the Trademark Act)

[USPTO](#)

Final decisions on the merits of an opposition must be the product of a panel of at least three TTAB judges. Also, panels of three judges will work with a TTAB attorney on decisions that dispose of an opposition as the result of a contested motion.

30) Is it for the same decision taker within your office to decide non-final (procedural) motions, or is there another forum responsible?

[EUIPO](#)

Decisions relating to costs or to procedures are taken by a single member. Usually, this decision taker is not from the same group as the members of three-member opposition divisions, although that is also possible.

[CNIPA](#)

No related situation.

[JPO](#)

Basically, It is the same decision maker (the chief administrative judge). (Examples: Article 133, paragraphs (1) and (2) and Article 134, paragraph (4) of the Patent Act applied mutatis mutandis under Article 43-15 of the Trademark Act, and Article 145, paragraph (6) of the Patent Act applied mutatis mutandis under Article 43-6, paragraph (2) of the Trademark Act)

[KIPO](#)

Examiners dedicated to opposition requests in the Trademark and Design Examination Bureau make a decision on an opposition.

[USPTO](#)

See the response to Question 28 for information on deciding motions. Generally, the same attorney will handle most motions that arise in a proceeding, but it is not unusual for multiple attorneys to work on motions in a single case when the motions arise at different times in the proceeding.

31) Is it the responsibility of the office (not the parties) to raise the issues of whether or not:

[EUIPO](#)

- a. the opposer has standing; ☒ yes ☐ no
- b. the forum has jurisdiction, or ☒ yes ☐ no
- c. a ground for opposition has been claimed ☒ yes ☐ no

[CNIPA](#)

- a. the opposer has standing; ☐ yes ☒ no
- b. the forum has jurisdiction, or ☐ yes ☒ no
- c. a ground for opposition has been claimed ☐ yes ☒ no

JPO

- a. the opposer has standing; ☒ **yes** ☐ **no**
- b. the forum has jurisdiction, or ☐ **yes** ☒ **no**
- c. a ground for opposition has been claimed ☒ **yes** ☐ **no**

KIPO

- a. the opposer has standing; ☐ **yes** ☐ **no**
- b. the forum has jurisdiction, or ☐ **yes** ☐ **no**
- c. a ground for opposition has been claimed ☐ **yes** ☐ **no**

An additional check is required.

USPTO

- a. the opposer has standing; ☒ **yes** ☒ **no**
- b. the forum has jurisdiction, or ☒ **yes** ☒ **no**
- c. a ground for opposition has been claimed ☒ **yes** ☒ **no**

An applicant may raise these issues by filing a motion to dismiss instead of an answer. See FRCP 12. A TTAB attorney or judge may raise these issues when participating in the parties' settlement and discovery planning conference. The parties may address these issues when briefing various motions, such as a motion for summary judgment. See FRCP 56. A panel of judges considering a motion for summary judgment or the merits of an opposition after it has been tried and briefed (at "final hearing"), may address these issues. An opposer's standing is an element of the case for the opposer and must always be proven, if not admitted by the applicant.

32) **Is your office required to issue a well-reasoned decision in writing?**

EUIPO

Yes. EUIPO's Office decisions are in writing and will state the reasons on which they are based.

CNIPA

Yes.

JPO

That decision must be issued in writing (Article 43-13 of the Trademark Act).

KIPO

A decision on an opposition should be issued in writing.

USPTO

The TTAB always issues well-reasoned decisions. All decisions are issued in writing.

33) What is the average length of time for a decision?

[EUIPO](#)

2.97 months

[CNIPA](#)

About 11 months.

[JPO](#)

The average length of time for a decision is 7.9 months (cited from the JPO Annual Report 2022).

[KIPO](#)

An addition check is required.

[USPTO](#)

An TTAB reports on its webpage the average time to issuance of a decision in its trial cases (oppositions and cancellations) from the time the cases are determined to be “ready for decision” (RFD). A trial case is ready for decision once briefing has been completed and there is no request for an oral hearing, or after the hearing. See:

<https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/ttab-filing-and-pendency-statistics>

The TTAB also reports the average length of time to decision, as measured from the commencement of trial cases.

34) During the proceeding, do your practices allow the parties to request suspension pending the results of another proceeding or for settlement discussions?

[EUIPO](#)

Yes, at the reasoned request of one of the parties where a suspension is appropriate under the circumstances of the case, considering the interests of the parties and the stage of the proceedings.

If both parties request the suspension of the proceedings (after expiry of the cooling-off period), the suspension will be granted without any need for the request to be justified. The first suspension will be granted for a period of 6 months, with the parties being given the possibility of opting out. Joint extensions are granted for a maximum of 2 years in total.

A joint request for suspension will not be granted if it is received within the cooling-off period, because the purpose of the cooling-off period is to set a time frame for negotiations before the adversarial stage begins.

[CNIPA](#)

No suspension pending related regulation in current trade mark law system.

[JPO](#)

As stated in Question 15, the main purpose of the opposition to registration of the trade mark system in Japan is not to solve specific disputes between parties. Therefore, there is no proceeding under which the parties may request a suspension of the proceeding.

In cases where the opposition and invalidation trial proceedings are pending at the same time, the proceedings for the opposition to registration has priority over those for trial for invalidation in principle. However, in cases such as those where an invalidation trial is in progress and possible to render a decision on the trial for invalidation at an early stage, it can be examined on a priority basis if the panel deems appropriate.

In this case, at the discretion of administrative judges, the opposition proceedings are suspended (Article 168 of the Patent Act applied mutatis mutandis under Article 56, paragraph (1) of the Trademark Act applied mutatis mutandis under Article 43-15 of the Trademark Act).

[KIPO](#)

N/A

[USPTO](#)

Yes. See prior questions for information on suspension to accommodate settlement talks. The TTAB may also suspend a proceeding, upon motion of a party, consented motion of all parties, or upon the TTAB's own initiative, pending completion of another TTAB proceeding or a court proceeding.

35) **When no facts are in dispute, do your practices permit the parties to request a summary judgment decision, thus avoiding final decision on the substance?**

[EUIPO](#)

No.

[CNIPA](#)

No related regulation in current trade mark law system.

[JPO](#)

As stated in Question 15, the main purpose of the opposition to registration of the trade mark system in Japan is not to solve specific disputes between parties. Therefore, there is no system under which the parties may request a summary judgment decision, even when no facts are in dispute.

[KIPO](#)

N/A

[USPTO](#)

Yes.

36) **Do you decide which party pays the costs of the proceeding? If yes, how is this calculated? How much time is spent determining costs?**

[EUIPO](#)

The general rule is that the losing party or the party that terminates the proceedings, whether by withdrawing the EUTM application (wholly or partially) or by withdrawing the opposition, will bear the fees incurred by the other party as well as all costs incurred by it that are essential to the proceedings.

If both parties lose in part, a 'different apportionment' has to be decided. As a general rule, each party bears its own costs.

A different apportionment of costs can, however, be justified for reasons of equity (for example, if the application was restricted only to a very small extent).

Where the parties conclude a settlement of costs differing from the general rule set in Article 109(1)-(5), the department deciding on the costs has to take note of that agreement.

The implementing Regulation sets down the maximum rates for costs to be borne by the losing party in Article 18.

[CNIPA](#)

The opposing party will pay the cost and the fee is the same for each case.

[JPO](#)

The law stipulates that the opponent pays the costs of the proceeding (Article 169, paragraph (3) of the Patent Act applied mutatis mutandis under Article 43-15 of the Trademark Act).

The amount is ¥3,000 + ¥8,000 per class, as answered in Question 9.

(Please refer to Question 15 for the statement that the main purpose of the opposition to registration of the trademark system in Japan is not to solve specific disputes between parties.)

[KIPO](#)

50,000 KRW per class

[USPTO](#)

No. Please see the fee schedule described in the reply to Question 9.

37) **Can the decision of the tribunal be appealed? How many stages of appeal are available?**

[EUIPO](#)

After the contested decision has been notified, the parties have two months to file the notice of appeal. Additionally, the appeal fee of EUR 720 must be paid and received by the Office within that two-month time-limit.

Decisions of the Board of Appeal can be appealed at the General Court within two months.

The decisions of the General Court may, within two months, be subject to an appeal before the Court of Justice, limited to points of law.

[CNIPA](#)

If the opposing party is dissatisfied with the decision of approval, it may file a request for invalidation of the registered trademark.

If the opposed party is dissatisfied with the decision of disapproval, it may apply for review. And if the opposed party is dissatisfied with the decision of review, it may institute legal proceedings to the court.

[JPO](#)

As a result of the opposition, the holder of trademark right or others may institute an action to the Intellectual Property High Court only when a decision is made to revoke registration (Article 63 of the Trademark Act). If the holder of a trademark right (or another person) is dissatisfied with the decision of the Intellectual Property High Court, they may appeal to the Supreme Court. A request for a trial to invalidate the trademark registration may be filed by an interested person when a ruling is made to the effect that the trademark registration is to be maintained (Article 46 of the Trademark Act).

[KIPO](#)

(1) In case grounds for opposition are accepted

Upon deciding that the opposition grounds are acceptable, the contested trade mark application will be rejected. The owner of the opposed application may not appeal such decision but may request a trial against the decision.

(2) In case grounds for opposition are dismissed

Upon deciding that the opposition grounds are not acceptable, the contested trade mark will be granted registration. In this case, the opponent may not appeal such decision but if the opponent is a stakeholder or a right holder in a state party to the treaty, she or he may file a trial for invalidation or cancellation of trade mark registration.

[USPTO](#)

TTAB final decisions can be appealed by the dissatisfied party to the U.S. Court of Appeals for the Federal Circuit (CAFC). Appeals to the CAFC involve review of the record before the TTAB and the correctness of the TTAB decision based on that record. No new evidence is presented to the CAFC.

As an alternative to an appeal to the CAFC, a dissatisfied party can seek review in a U.S. federal district court. This is known as a “de novo” appeal and allows the party to raise additional claims and present evidence that was not before the TTAB. A district court’s decision can be appealed to the U.S. circuit court of appeals in which the district court is located.

A party dissatisfied with a decision of the CAFC or another circuit court of appeals may seek review from the U.S. Supreme Court.

38) Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☐ yes ☐ no

☐

[EUIPO](#)

Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☒ yes ☐ no

Can the appeal forum board make such decisions on its own motion? ☐ yes ☒ no

Counterclaims are possible, as provided for in Article 128 EUTMR. They are defense claims made by a defendant that is being sued for the infringement of an EUTM. By way of such a counterclaim, the defendant asks the European Union trade mark court (EUTM court) to declare the revocation or invalidity of the EUTM. The counterclaim is filed to the EUTM court and the court or the interested party must inform the Office before the EUTM court may proceed with the examination of the counterclaim.

The Office records the filing and the final judgment on the counterclaim in the Office Register. The Office implements the final judgments, in particular those that declare the total or partial revocation or invalidity of an EUTM.

The Office will notify the EUTM proprietor and the EUTM court that the counterclaim has been entered in the Register. If the request was made by the other party to the counterclaim proceedings, the Office will also inform this party.

[CNIPA](#)

Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☐ yes ☒ no

Can the appeal forum board make such decisions on its own motion? ☐ yes ☒ no

The opposition divisions will make decisions based on the opposition reasons and the evidence documents submitted by the related parties.

[JPO](#)

Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☐ yes ☒ no

Can the appeal forum board make such decisions on its own motion? ☐ yes ☒ no

As stated in Question 15, the main purpose of the opposition to registration of the trademark system in Japan is not to solve specific disputes between parties.

[KIPO](#)

Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☐ yes ☒ no

Can the appeal forum board make such decisions on its own motion? ☐ yes ☒ no

[USPTO](#)

Can the applicant file counterclaims against the opponent to cancel the registration upon which the opposition is based? ☒ yes ☐ no

Can the appeal forum board make such decisions on its own motion? ☐ yes ☒ no

An applicant may assert a counterclaim for cancellation or restriction of the opposer's registration.

39) Please provide the references of applicable law (i.e. legal act(s) and specific provisions applicable to opposition proceedings):

[EUIPO](#)

[European Union trade mark regulation](#) (EUTMR)

[European Union trade mark delegated regulation](#) (EUTMDR)

[European Union trade mark implementing regulation](#) (EUTMIR)

[CNIPA](#)

The main related provisions are the Article 13, paragraphs 2 and 3, Article 15, Article 16 paragraph 1, Article 30, Article 31, Article 32, Article 4, Article 10, Article 11, Article 12 and Article 19 paragraph 4 of the Trademark Law.

[JPO](#)

The main laws and provisions are Articles 43-2 to 43-15 of the Trademark Act.

[KIPO](#)

Please see Article 60 of the Trademark Act

[USPTO](#)

Trademark Act section 18, 15 U.S.C. § 1068 and Trademark Act section 13, 15 U.S.C. § 1063. are statutory provisions pertaining to opposition proceedings. The Federal Rules of Civil Procedure 28 U.S.C. §351 also apply to opposition proceedings.

2 Substantive provisions

40) Please list the types of earlier rights upon which an opposition can be based before your Office:

EUIPO

- | |
|--|
| <ul style="list-style-type: none"> a. Registered trade mark (EUTM, national TMs registered in an EU Member State and international registrations with an effect in EU or a Member State) b. applications for the trade marks referred to in point (a), subject to their registration c. Non-registered trade marks and other signs used in the course of trade of more than mere local significance d. Well known trade marks (Article 6bis Paris Convention) – well known in a Member State e. If an application is filed by an agent or representative of the proprietor of the earlier mark, the trade mark on which the opposition is based can be registered also outside EU (in other words, there is no territorial limitation for the earlier mark under this ground) f. Trade marks with reputation g. Protected geographical indications h. Copyright (rights to be invoked <i>inter partes</i> but only in cancellation proceedings of a registered mark) i. Right to a name /right of personal portrayal (rights to be invoked <i>inter partes</i> but only in cancellation proceedings of a registered mark) j. Other industrial property rights (rights to be invoked <i>inter partes</i> but only in cancellation proceedings of a registered mark) |
|--|

CNIPA

Trademark right, copyright, right to name, right to firm name, design patent right, geographical indication right, portrait right, etc.

JPO

For specific types, please refer to Q41.
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KIPO

Please see the answer to Q41.

USPTO

An opposition can be based on the following earlier rights –
--

- | |
|--|
| <ul style="list-style-type: none"> - An active trade mark registration; - A prior-used trade name (not abandoned); - A prior-used common law (non-registered) trade mark (not abandoned); |
|--|

Please note: dilution of an earlier trade mark is considered a basis for opposition (but the opposer must show that its mark was famous prior to the earliest date on which the applicant can rely for purposes of priority). This does not appear to be an “earlier right” (as noted in the question) [TBMP 309.03(c)(1)]
--

41) Please provide further details on the earlier rights, selected from the below list, which can be invoked in opposition procedures.

[EUIPO](#)

a. Registered trade mark

An earlier European trade mark registration or application, or an earlier trade mark registration or application in one of the EU Member States can be relied on when invoking the grounds (Article 8(1) and (5) EUTMR).

b. Non-registered trade mark rights and other signs used in the course of trade

Under Article 8(4) EUTMR the opponent can rely on earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance protected under EU legislation or Member State laws that confer on their proprietor the right to prohibit the unauthorised use of a subsequent trade mark.

The opponent must prove that:

(1) it acquired the right invoked, which may be use or registration based, before the application date or, as the case may be, before the priority date of the contested mark, in accordance with the conditions of protection of the applicable law (copy of national law must be furnished or referred to from online database, together with translation).

(2) In addition, the opponent must also prove use in trade of more than mere local significance of such a right before the date of priority of the contested mark.

c. Well known trade marks (Article 6bis Paris Convention)

Earlier well-known marks can be relied on to file an opposition in the following instances:

(1) If a well-known mark is not registered it can only be protected against **identical or similar goods** (the grounds for an opposition under Article 8(2)(c) EUTMR are (solely) Article 8(1)(a) or (b) EUTMR.)

The opponent needs to submit evidence that shows that earlier non-registered well-known mark is known by a significant part of the public concerned.

(2) If it is registered, also Article (5) EUTMR (earlier reputed mark) can be relied on. The threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same.

d. Trade marks with reputation

Either as registered EUTMs or as national marks in one of the Member States, they **can be invoked under Article 8(5) EUTMR**.

If the opposition is successful, the contested application may also be refused for dissimilar goods or services.

The following conditions need to be met for Article 8(5) EUTMR to apply (and the opponent must furnish evidence of all these in order to be successful):

- earlier registered mark with reputation in the relevant territory (evidence that shows that earlier mark is known by a significant part of the public concerned);
- identity or similarity between the contested EUTM application and the earlier mark;
- use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark (cogent line of arguments for unfair advantage, tarnishment or dilution must be provided);
- such use must be without due cause (this is usually the case but the applicant may rebut).

These conditions are cumulative and failure to satisfy any one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 30; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 34; 16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41).

e. Protected geographical indications

[Article 8\(6\) EUTMR](#) is the ground for opposition based on designations of origin or geographical indications protected under EU legislation or Member State laws that confer on the person authorised under such laws the right to prohibit the use of a subsequent trade mark.

The opponent must also prove that the application for the designation of origin or geographical indication invoked was submitted prior to the date of application or, as the case may be, the priority date of the contested mark.

f. Copyright

These are rights to be invoked *inter partes* but only in cancellation proceedings for declaration of invalidity of an already registered mark (Article 60(2) EUTMR), not in opposition proceedings.

The invalidity applicant will have to (1) provide the necessary national legislation in force and (2) put forward a cogent line of arguments as to why it would succeed under the specific national law in preventing the use of the contested mark.

g. Design rights

Other industrial property rights and prior works at national or EU level, such as a registered Community design (RCD), may be invoked. These are rights to be invoked *inter partes* but only in cancellation proceedings for declaration of invalidity of an already registered mark (Article 60(2) EUTMR) not in opposition proceedings.

The invalidity applicant will have to (1) provide the necessary national legislation in force and (2) put forward a cogent line of arguments as to why it would succeed under the specific national law in preventing the use of the contested mark.

In the case of an RCD there is no need to prove what protection is given under the law. The Cancellation Division will apply the standards of the applicable design law of the EU.

h. Right to a name

These are rights to be invoked *inter partes* but only in cancellation proceedings for declaration of invalidity of an already registered mark (Article 60(2) EUTMR), not in opposition proceedings.

This right can only be invoked if the national law of the EU Member State protects the right to a person's name or portrayal.

The invalidity applicant will have to (1) provide the necessary national legislation in force and (2) put forward a cogent line of arguments.

i. Other

Relative Grounds for Invalidity based Article 60(1) EUTMR against already registered marks.

In cancellation proceedings the same earlier rights can be relied on as in opposition proceedings (points a. - e. above, plus i. - j)

[CNIPA](#)

a. Registered trade mark

According to Article 30 of the Trademark Law, it is identical with or similar to a registered trademark used in connection with the same or similar goods.

b. Non-registered trade mark rights and other signs used in the course of trade

According to Article 15 of the Trademark Law, 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.

Where a trademark used on an identical or similar product that is considered for registration and that is the same or similar to a prior user of an unregistered trademark, the registrant, where no prior contractual agreement or business relationship exists between the registrant and prior user, may not register its trademark where the prior user's mark is clearly in use and an opposition to the trademark's registration has been filed.

According to Article 32 of the Trademark Law, no trademark application shall infringe upon another party's existing prior rights. Nor shall an applicant rush to register in an unfair manner a mark that is already in use by another party and enjoys substantial influence.

c. Well known trade marks (Article 6bis Paris Convention)

According to Article 13 of the Trademark Law, where a mark is a reproduction, imitation, or translation of a third-party's famous trademark which has not been registered in China and where the goods are identical or similar, which may cause public confusion and damage the interests of the registrant of the famous mark, no registration shall be granted and the use of the mark shall be prohibited.

Where a mark is a reproduction, imitation, or translation of a third-party's famous trademark which has been registered in China and where the goods are not identical or dissimilar, which may mislead the public and cause injury to the interests of the registrant of the famous trademark, no registration shall be granted and the use of the mark shall be prohibited.

d. Trade marks with reputation

N/A

e. Protected geographical indications

According to Article 16 of the Trademark Law, where a trademark includes a geographical sign that does not describe the location or the origin of the goods in question, the term causes confusion among members of the public and shall be refused registration. Its use as a trademark also shall be prohibited.

f. Copyright

Requirements: the right holder has the copyright which is within the protection period; the disputed trademark is substantially similar to the works of others; possibility of contact; without the permission of the copyright owner

g. Design rights

Requirements: the right holder has the prior design patent right which is within the protection period; the use of the opposed trademark is likely to cause public confusion; without the permission of the patentee.

h. Right to a name

Requirements: the name has a certain popularity and establish a stable corresponding relationship with natural persons; the registration of the opposed trademark may cause damage to the name rights of others.

i. Other

The rights and interests of the name of the work and the name of the role are required to have high visibility, and the use of the opposed trademark is easy to lead to misrecognition by the relevant public.

JPO

a. Registered trade mark

Registered trademarks can be invoked.

Since a trademark which is identical with or similar to another person's registered trademark and whose designated goods or services is identical with or similar to ones of another person's registered trademark may not be registered (Article 4, paragraph (1), item (11) of the Trademark Act), this will be a reason for revocation.

The similarity of trademarks is determined by comprehensively observing impressions, memories, associations, etc. given to consumers by appearance, sound, concept, etc., and then considering whether or not there is a likelihood of confusion between the cited trademark and the origin.

The similarity of goods and services is determined based on whether or not there is a relationship under which the goods or services are likely to cause misleading as the goods or services that is manufactured, sold, or offered by the same business entity due to circumstances such as the goods or services is normally manufactured, sold or provided by the same business entity, and it should not be determined based on whether the goods or services themselves are likely to cause misleading or confusion in transactions.

b. Non-registered trade mark rights and other signs used in the course of trade

Due to the adoption of the registration principle in Japan, registered trademarks are invoked in the reasons for revocation under Article 4, paragraph (1), item (11) of the Trademark Act.

However, trademarks can be invoked in reasons for revocation other than those of this item, even if they are not registered, if they are well-known and famous.

For example, no trademark may be registered if 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 the trademark is used in connection with the goods or services or goods or services similar thereto (Article 4, paragraph (1), item (10) of the Trademark Act); and if the trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person (Article 4, paragraph (1), item (15) of the trademark Act), which will be reasons for revocation.

In addition, there is a provision stipulating that a trademark which is identical with, or similar to, another person's well-known trademark if the trademark is used for unfair purposes may not be registered. This will be a reason for revocation as well.

With regard to the degree of being well-known under Article 4, paragraph (1), item (10) of the Trademark Act, this is determined in principle by taking into consideration the use result in Japan. In the case of a trademark that is mainly used in foreign countries, this is determined by taking into consideration the use result in those countries as well, from the perspective of protecting well-known overseas trademarks.

The guideline for determination on the similarity of trademarks is as answered in the previous Question "a".

With regard to the likelihood of causing confusion under Article 4, paragraph (1), item (15) of the Trademark Act, it is comprehensively determined whether or not there is a likelihood of causing misleading that the goods are ones pertaining to the business of a person who has some kind of economic or organizational relationship with other persons and of causing confusion to consumers of the goods or services about the origin thereof.

Article 4, paragraph (1), item (19) of the Trademark Act applies to a trademark even if it is well known only in a foreign country and not in Japan. In order for this item to apply, a trademark must fall under all of followings. (1) another person's trademark must be well known in Japan or abroad, (2) the other person's well-known trademark and the filed trademark must be the identical or similar, and (3) the trademark must be used for unfair purposes.

The guideline for determination on the similarity of trademarks is as answered in the previous Question "a".

c. Well known trade marks (Article 6bis Paris Convention)

Well known trademarks can be invoked.

As mentioned in Question "b", trademarks that are well-known can be invoked.

No trademark may be registered if 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 the trademark is used in connection with the goods or services or goods or services similar thereto (Article 4, paragraph (1), item (10) of the Trademark Act).

No trademark may be registered if the trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person (Article 4, paragraph (1), item (15) of the Trademark Act).

In addition, no trademark may be registered if the trademark is identical with, or similar to, another person's well-known trademark, if the trademark is used for unfair purposes (Article 4, paragraph (1), item (19) of the Trademark Act).

A trademark can be revoked if it falls under the above provisions.

The relevant steps of assessment are as answered in the previous Question "b".

d. Trade marks with reputation

Trademarks with a reputation can be invoked.

As mentioned in Question "b", trademarks with a reputation can be invoked.

No trademark may be registered if 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 the trademark is used in connection with the goods or services or goods or services similar thereto (Article 4, paragraph (1), item (10) of the Trademark Act).

No trademark may be registered if the trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person (Article 4, paragraph (1), item (15) of the Trademark Act).

In addition, no trademark may be registered if the trademark is identical with, or similar to, another person's well-known trademark, if the trademark is used for unfair purposes (Article 4, paragraph (1), item (19) of the Trademark Act).

A trademark can be revoked if it falls under the above provisions.

The relevant steps of assessment are as answered in the previous Question "b".

e. Protected geographical indications

Geographical indications can be invoked.

No trademark may be registered if the trademark consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, or in the case of services, the location of provision, quality (Article 3, paragraph (1), item (3) of the Trademark Act).

No trademark may be registered if the trademark is likely to mislead as to the quality of the goods or services (Article 4, paragraph (1), item (16) of the Trademark Act).

No trademark may be registered if the trademark is comprised of a mark indicating specific places of origin of wines or spirits, and if such a trademark is used in connection with wines or spirits originating from the region other than such specific places (Article 4, paragraph (1), item (17) of the Trademark Act).

If a trademark falls under the above provisions, it will be a reason for revocation.

With regard to whether a trademark falls under, in the case of goods, the "place of origin", "place of sale", or in the case of services, the "location of provision" in Article 3, paragraph (1), item (3), with respect to a geographical name in Japan and overseas, determination is made based on whether or not it is generally recognized that designated goods will be produced or sold, or designated services will be provided at the place indicated by the geographical name.

The qualities of the goods or services in Article 4, paragraph (1), item (16) is the quality indicated by the "characteristics, etc. of goods or services" stipulated in Article 3, paragraph (1), item (3), and the determination guideline is the same as one in Article 3, paragraph (1), item (3).

The provision in Article 4, paragraph (1), item (17) stipulates that no trademark may be registered if the trademark is comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by those members from being used on wines or spirits not originating from the region of those members, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of those members. Determination is made based on the materials including list of indication of places of origin protected by WTO members.

f. CopyrightCopyright

N/A

g. Design rights

N/A

h. Right to a name

Names are protected as part of the right to personalities in Japan.

There is a provision (Article 4, paragraph (1), item (8) of the Trademark Act) stipulating that no trademark may be registered if the trademark contains the name of another person, which will be a reason for revocation.

"Another person" means a person who actually exists other than the applicant him/herself and

includes natural persons (including foreigners) and corporations, etc.

[The answer is as of April 2023.](#)

i. Other

There are reasons for revocation in relation to earlier rights other than those selected above.

A trademark which is identical with a registered defensive mark of another person (referring to a mark registered as a defensive mark; the same applies hereinafter), if the trademark is used in connection with designated goods or designated services relating to the defensive mark. (Article 4, paragraph (1), item (12) of the Trademark Act)

The defensive mark registration system is a system in which, regarding famous registered trademarks, the scope of likelihood of confusion as to the origin of goods and services can be clarified in advance in the form of defensive mark registration. The scope of not being similar to goods and services of famous registered trademarks—that is, the scope beyond its prohibitive effect—can be registered as a defensive mark.

[KIPO](#)

a. Registered trade mark

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

7. Any trademark used for goods identical or similar to the designated goods, which is identical or similar to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;

b. Non-registered trade mark rights and other signs used in the course of trade

c. Well known trade marks

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

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

d. Trade marks with reputation

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

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

e. Protected geographical indications

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

8. Any trademark used on goods recognized as identical to the designated goods, which is identical or similar to a registered collective mark with geographical indication of another person based on first to file;

f. Copyright

N/A

g. Design rights

N/A

h. Right to a name

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

i. Other

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

1. Any of the following trademarks, which is a national flag of a country, an insignia of an international organization, etc.:

(a) Any trademark identical or similar to the national flag, the national emblem, the colors, medals, decorations or insignias of the Republic of Korea, or seals or signs used for supervision or certification by the Republic of Korea or public institutions;

(b) Any trademark identical or similar to any national flag of a country of the Union to the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "Paris Convention"), of a member of the World Trade Organization, or of a Contracting Party to the Trademark Law Treaty (hereafter in this paragraph, referred to as "countries of the Union, etc.");

(c) Any trademark identical or similar to the title, abbreviated title, or mark of the Red Cross, the International Olympic Committee, or a renowned international organization: Provided, That where such organization has applied for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;

(d) Any trademark identical or similar to coats of arms, flags, medals, decorations or badges of the countries of the Union, etc. designated by the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention, or titles, abbreviated titles, coats of arms, flags, medals, decorations or badges of inter-governmental international organizations which countries of the Union, etc. have joined: Provided, That where an inter-governmental international organization which the countries of the Union, etc. have joined applies for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;

(e) Any trademark identical or similar to seals or signs used for supervision or certification by countries of the Union, etc. designated by the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention or their public organizations, which is used for the goods identical or similar to those for which such seals or signs are used;

2. Any trademark which falsely indicates a relationship with a state, race, ethnic group, public organization, religion, or famous deceased person, or which slanders, insults, or is likely to defame any of them;

3. Any trademark identical or similar to a famous mark, which is a mark indicating nonprofit business or public service of a state, public organization, or any of its agencies and a non-profit corporation: Provided, That where such state, etc. has applied for trademark registration of its mark, trademark registration may be obtained;

4. Any trademark whose meaning, content, etc. conveyed to consumers is likely to harm public order, such as being contrary to moral norms, the prevailing moral sense of ordinary people, where the trademark itself is used or the trademark is used for goods;

5. Any trademark consisting of a mark identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the approval of the Government of the Republic of Korea or at an exhibition held by or with the approval of the government of a foreign country: Provided, That where a person who has been

awarded at such exhibition uses such mark as part of the trademark for the awarded goods, trademark registration may be obtained;

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

7. Any trademark used for goods identical or similar to the designated goods, which is identical or similar to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;

8. Any trademark used on goods recognized as identical to the designated goods, which is identical or similar to a registered collective mark with geographical indication of another person based on first to file;

9. Any trademark identical or similar to a trademark (excluding a geographical indication) widely recognized by consumers as indicating the goods of another person, which is used on goods identical or similar to the goods of another person;

10. Any trademark identical or similar to a geographical indication of another person widely recognized by consumers as indicating the goods of a specific region, which is used on goods recognized as identical to the goods using such geographical indication;

11. Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation;

12. Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers;

13. 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 Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

14. Any trademark which is identical or similar to a geographical indication recognized as indicating the goods of a specific region by customers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on any legitimate users of such geographical indication;

15. Any trademark consisting solely of the three-dimensional shape, color, combination of colors, sound, or smell, which is essential (in cases of services, referring to cases essential for the use and purpose thereof) to secure the function of goods intended to obtain trademark registration or of the package of such goods;

16. Any trademark intended to be used on wine or distilled beverages, which consists of a geographical indication of the place of production of wine or distilled beverages or contains such geographical indication in a member of the World Trade Organization: Provided, That where a legitimate user of the geographical indication applies for registration of a collective mark with geographical indication under Article 36 (5) by designating the relevant goods as the designated goods, he or she may obtain trademark registration;

17. Any trademark which is identical or similar to the name of a variety registered pursuant to Article 109 of the Act on the Protection of New Varieties of Plants, which is used for goods identical or similar to the name of such variety;

18. Any trademark which is identical or similar to a geographical indication of another person registered pursuant to Article 32 of the Agricultural and Fishery Products Quality Control Act, which is used on goods recognized as identical to the goods using such geographical indication;

19. Any trademark which is identical or similar to a geographical indication of another person protected in accordance with a bilateral or multilateral free trade agreement which has come into effect, concluded by the Republic of Korea with a foreign country or foreign countries, or which consists of or contains such geographical indication, used on goods deemed identical to the goods using such geographical indication;

20. Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he or she is aware that another person uses or intends to use the trademark through a contractual relationship, such as partnership or employment, or business transactional relationship, or any other relationship;

21. Any trademark for the registration of which any person who has or had a contractual relationship, such as partnership or employment, business contractual relationship, or any other relationship with a person who holds the right to the trademark registered, which is identical or similar to the trademark registered in a State party to

the treaty, applies on goods by designating goods identical or similar to the goods on which the trademark is designated as the designated goods without the consent of the person who holds the right to the trademark.

(2) Whether paragraph (1) and an applicant for trademark registration (hereinafter referred to as "applicant") correspond to another person under the relevant provision shall be determined based on the time a decision corresponding to any of the following is made (hereinafter referred to as "decision on whether to grant trademark registration"): Provided, That in cases falling under paragraph (1) 11, 13, 124, 20 and 21, whether an applicant corresponds to another person under the relevant provision shall be determined based on the time an application for trademark registration is filed:

1. Decision to reject trademark registration under Article 54;
2. Decision to grant trademark registration under Article 68.

(3) Where a trial to revoke trademark registration is requested because a trademark right holder or a person who uses a trademark of such trademark right holder falls under Article 119 (1) 1 through 3 and 5 through 9, and he or she falls under any of the following after the date such lawsuit is commenced, he or she may obtain trademark registration only where he or she applies for registration of a trademark identical or similar to such trademark (limited to where he or she intends to obtain trademark registration again by designating identical or similar goods (in cases of a collective mark with geographical indication, referring to goods deemed identical) as the designated goods) after three years from the date he or she falls under any of the following:

1. Where trademark rights are extinguished upon expiry;
2. Where a trademark right holder relinquishes trademark rights or abandons some of the designated goods;
3. Where a trial decision to revoke trademark registration is final and conclusive.

(4) None of the provisions of paragraph (1) 8 and 10 shall apply to homonymous collective marks with a geographical indication

[USPTO](#)

a. Registered trade mark

In order to invoke an earlier right associated with a registered trade mark, the holder of the rights must provide the following: prior U.S. trademark registration(s). Proof of the ownership of the registration and that it is valid (not abandoned) must be provided either with the notice of opposition or during the trial period for the opposition proceeding. Copies of USPTO records may be used or, during trial, a witness can testify to these matters.

b. Non-registered trade mark rights and other signs used in the course of trade

Evidence of a prior-pending application for federal registration with a constructive filing date that pre-dates any use upon which the applicant may rely.

Evidence of prior and continuous use of the common law trademark (or analogous use) in the United States that predates the applicant's filing date.

Evidence proving these matters would be provided during the trial phase of the opposition proceeding.

c. Well known trade marks (Article 6bis Paris Convention)

Please see answers to Question 39.

d. Trade marks with reputation

Please see answers to Questions 21 and 22. Trade marks with reputation are considered well-known marks.

e. Protected geographical indications

Please see answers to Questions 21 and 22. Geographical indications are protected as trademarks or certification marks.

f. Copyright

Opposition N/proceedings before the TTAB do not consider copyright.

g. Design rights

Please see answers to Questions 21 and 22. Certain types of trade marks may consist of designs or include design features.

h. Right to a name

If by name, a “trade name” is meant, the same requirements as noted for common law trademarks apply.

If by name, “surname” is meant, the same requirements as noted for registered, earlier filed pending federal applications, and common law trade marks apply.

i. Other

42) Please list all the grounds which can be invoked in opposition proceedings before your Office:

[EUIPO](#)

Article 8(1)(a) EUTMR – double identity

Article 8(1)(b) EUTMR – likelihood of confusion

Article 8(3) EUTMR - Unauthorised filing by agents of the TM proprietor

Article 8(4) EUTMR - Non-registered trade marks and other signs used in the course of trade

Article 8(5) EUTMR - Trade marks with reputation

Article 8(6) EUTMR - Geographical Indications

[CNIPA](#)

The main grounds are Article 13 paragraphs 2 and 3, Article 15, Article 16 paragraph 1, Article 30, Article 31, Article 32; Article 4, Article 10, Article 11, Article 12, Article 19 paragraph 4 of the Trademark Law.

[JPO](#)

All reasons for revocation are listed in Article 43-2 of the Trademark Act.

1. where the trademark registration has been made in violation of Article 3, Article 4, paragraph (1), Article 7-2, paragraph (1), Article 8, paragraphs (1), (2) and (5), Article 51, paragraph (2) (including its mutatis mutandis application under Article 52-2, paragraph (2)), Article 53, paragraph (2) of this Act or Article 25 of the Patent Act

as applied mutatis mutandis under Article 77, paragraph (3) of this Act; and 2. where the trademark registration has been made in violation of a treaty; or 3. where the trademark registration has been made for an application for trademark registration not satisfying the requirements under Article 5, paragraph (5).

With regard to the above Article 43-2, paragraph (1) of the Trademark Act;
Article 3 is a provision on Distinctiveness, and Article 4 is a provision on Unregistrable Trademarks, which includes the perspective of protection with regard to both public and private interests.

Article 7-2 paragraph (1) is a provision on Regional Collective Trademarks, and is a provision that relaxes the registration requirements for character trademarks (word marks) consisting of the name of the region and the name of the goods (services), etc., from the perspective of appropriately protecting regional brands.

Article 8 is a provision on how to determine which is the prior application when a trademark application and another person's application, which are in conflict with each other and relate to identical or similar goods or services, are filed on the same date.

Article 51 is a provision on acts of confusion of origin and misleading of quality by a holder of a trademark right. Article 53 is a provision of acts of confusion of origin and misleading of quality by a holder of a non-exclusive right and its members.

With regard to the above Article 43-2, paragraph (3) of the Trademark Act;
Article 5, paragraph (5) is a provision stipulating that the detailed description, etc. of the trademark stated in the application must be clear when seeking to register a non-traditional trademark.

[KIPO](#)

Please see the answer to Q43.

[USPTO](#)

A list of all grounds which can be invoked in opposition proceedings before the TTAB is shown below:

Likelihood of Confusion (15 U.S.C. § 1052(d))

- The applicant's mark so resembles a prior registered trade mark or trade name, previously used in the United States by another (and not abandoned) as to be likely, when used on or in connection with goods or services of applicant to cause confusion, or to cause mistake or to deceive

Descriptiveness/Genericness (15 U.S.C. § 1052(e))

- The applicant's mark, when used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them,

The applicant's mark is primarily geographically descriptive or primarily geographically deceptively misdescriptive of them,

The applicant's mark is primarily merely a surname

The applicant's mark comprises matter that, as a whole, is functional

Deceptiveness and False Suggestion of Connection (15 U.S.C. § 1052(a))

The applicant's mark falsely suggests a connection with opposer's name or identity

The applicant's mark is geographically deceptive

The applicant's mark is a geographical indication, which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods (and was first used on or in connection with wines or spirits by the applicant on or after January 1, 1996)

Lack of Bona Fide Intent (15 U.S.C. § 1051(a) and (b))

The applicant had no bona fide intent to use the mark in connection with identified goods/services as of the filing date of the application

The applicant had no bona fide use of applicant's mark in commerce prior to the filing of the use-based application for its registration under Trademark Act § 1(a).

Functionality

The applicant's mark comprising a product or service's 'trade dress' is functional; the applied-for mark product or service feature is essential to the use or purpose of the article or affects the cost or utility of the article.

Other Grounds

The applicant's mark is mere background design that does not function as a mark separate and apart from the words displayed thereon

The applicant is not and was not at the time of filing of its application, the rightful owner of the mark;

The applicant's mark, consisting of a particular color combination, is not inherently distinctive and has not acquired distinctiveness;

The applicant's mark, consisting of a particular sound, is not inherently distinctive and has not acquired distinctiveness;

The applicant's mark, consisting of trade dress, product design or packaging, is not inherently distinctive and has not acquired distinctiveness;

The applicant's mark has not been used as a trade mark or service mark;

The applicant's mark represents multiple marks in a single application ("phantom mark")

The applicant's mark consists of or comprises the name of a particular living individual without the individual's consent

The applicant's mark consists of a product design that is generic;

The applicant's mark would dilute the distinctive quality of opposer's famous mark;
The applicant committed fraud during the prosecution of its application
The applicant's mark interferes with the registration of a foreign owner's mark under Article 8 of the Pan American Convention;
The applicant's mark is the title of a single creative work and is not a trade mark;
The applicant's mark is prohibited as the mark is "the flag or coat of arms or other insignia of the United States, or of any State or municipality"
The applicant has not established a commercial presence in the country from which its underlying foreign registration issued when such foreign registration forms the basis of the U.S. application;
The intent-to-use application was assigned or transferred in contravention of Trademark Act Section 10;
The applicant's mark is not in lawful use in commerce where the provision of the identified goods/services is unlawful under federal law
[TBMP Section 309.03(c)(1)]

43) Please provide further details on the grounds selected from the below list which can be invoked in opposition procedures.

[EUIPO](#)

☒ **Identity of trade marks AND identity of goods and/or services**

Article 8(1)(a) EUTMR clearly requires identity between both the signs concerned and the goods/services in question. This situation is referred to as 'double identity'.
Where there is double identity, there is no need to carry out an evaluation of the likelihood of confusion, and the opposition will be upheld by EUIPO.
The EUIPO makes an overall assessment whether all the above conditions are fulfilled and issues a decision.

☒ **Likelihood of confusion**

Under Article 8(1)(b) an EUTM application will not be registered if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
The likelihood of confusion is assessed in the following steps, taking into account multiple factors:

- comparison of goods and services;
- relevant public and degree of attention;
- comparison of signs;
- distinctiveness of the earlier mark;
- any other factors;
- global assessment of the likelihood of confusion.

The EUIPO makes an overall assessment whether all the above conditions are fulfilled and issues a decision.

☒ **Unfair advantage, tarnishment or dilution**

Article 8(5) EUTMR - Trade marks with reputation

Article 8(5) EUTMR grants protection for registered trade marks not only as regards identical/similar goods/services but also in relation to dissimilar goods/services without requiring a likelihood of confusion, provided

- the signs are identical or similar,
- the earlier mark enjoys a reputation,
- and the use without due cause of the trade mark applied for would take **unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.**

1. Taking unfair advantage of distinctiveness or repute: By riding on the coat-tails of the reputed mark, the applicant benefits from the power of attraction, reputation and prestige of the reputed mark. It is not required from the opponent to show bad faith or actual detriment.

2. Detriment to the distinctiveness occurs where use of a later similar mark reduces the distinctive quality of the earlier reputed mark. The following two autonomous conditions must be substantiated by the opponent and reasoned by the Office.

- Dispersion of the reputed mark's image and identity in the relevant public's perception (subjective condition).
- A change in the economic behaviour of this public (objective condition).

3. Detriment to repute occurs when the application is reproduced in an obscene, degrading or inappropriate context, or in a context that is not inherently unpleasant but that proves to be incompatible with a particular image the earlier trade mark has acquired in the eyes of the public due to the promotional efforts of its owner.

The EUIPO makes an overall assessment whether all the above conditions under the respective scenario are fulfilled and issues a decision. It is sufficient that one of the scenario under the points 1-3 is fulfilled.

☒ **Bad faith**

The EUTMR does not specify bad faith as a ground for opposition, only as absolute ground for cancellation, i.e. declaration of invalidity of an already registered mark (Article 59(1)(a) EUTMR).

However, Article 8(3) "unauthorised filing by an agent of the TM proprietor" may be invoked in certain specific conducts that may be regarded as indications of bad faith.

☒ **Unauthorised filing by an agent of the TM proprietor or other ownership issues**

According to Article 8(3) EUTMR, upon opposition by the proprietor of an earlier trade mark, a trade mark will 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 8(3) EUTMR entitles trade mark proprietors to oppose the registration of their marks as EUTMs, provided the following substantive cumulative requirements are met:

- The applicant is or was an agent or representative of the proprietor of the mark.
- The application is in the name of the agent or representative.
- The application was filed without the proprietor's consent.
- The agent or representative fails to justify its acts.

- The signs and the goods and services are identical or closely related (likelihood of confusion is not a condition, the degree of similarity between the marks and the goods or services should be such so as to guarantee that the purpose of Article 8(3) EUTMR is met, namely to prevent the misappropriation of the mark by the proprietor's agent (11/11/2020, [C-809/18 P](#), MINERAL MAGIC, EU:C:2020:902, § 72).

The EUIPO makes an overall assessment whether all the above conditions are fulfilled and issues a decision.

☒ Other grounds

1. Article 8(4) EUTMR - Non-registered trade marks and other signs used in the course of trade

[Article 8\(4\) EUTMR](#) is the ground for opposition against an EUTM application based on an earlier non-registered trade mark or other sign used in the course of trade of more than mere local significance protected under EU law or the laws of the Member States, subject to the conditions of that provision.

The opponent must demonstrate to the EUIPO the following conditions for successfully invoking Article 8(4) EUTMR:

- the opponent must be the proprietor of a non-registered trade mark or of another sign used in the course of trade or a person authorised under the applicable law to exercise such a right;
- use in the course of trade of more than mere local significance;
- acquisition prior to the EUTM application under the applicable law governing that sign;
- right to prohibit the use of a subsequent trade mark under the applicable law governing that sign.

The EUIPO makes an overall assessment whether all the above conditions are fulfilled and issues a decision.

2. Article 8(6) EUTMR - Geographical Indications

Article 8(6) EUTMR is a framework provision - it is the applicable EU legislation, Member State law or international agreement that determines the conditions of acquisition and scope of protection of the GI invoked.

Under this ground, upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

- based on earlier application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, subject to its subsequent registration;
- that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

[CNIPA](#)

☒ Identity of trade marks AND identity of goods and services

The opposed trademark is identical with or similar to a registered trademark or a prior applied trademark which is used in connection with the same or similar goods.

☒ Likelihood of confusion

The likelihood of confusion should be considered when judging the similarity of trademarks.

☒ Unfair advantage, tarnishment or dilution

Registering the trademark of others with certain influence or impairs the prior rights of others.

☒ **Bad faith**

The Trademark Law Article 4, a trademark application that is malicious and not for the purpose of use shall be refused.
The Trademark Law Article 7, any application or usage of a trademark shall abide by principles of good faith.
The Trademark Law Article 32 and 35 both consider the subjective malice.

☒ **Unauthorised filing by an agent of the TM proprietor or other ownership issues**

According to Article 15 of the Trademark Law, 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.

☒ **Other grounds**

N/A

[JPO](#)

☒ **Identity of trade marks AND identity of goods and services**

Since a trademark which is identical with or similar to another person's registered trademark and whose designated goods or services is identical with or similar to ones of another person's registered trademark may not be registered (Article 4, paragraph (1), item (11) of the Trademark Act), this will be a reason for revocation.

The specific relevant steps of assessment are as answered in Question 41-a.

☒ **Likelihood of confusion**

The relevant provisions are as follows:

A trademark which 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 the trademark is used in connection with the goods or services or goods or services similar thereto (Article 4, paragraph (1), item (10) of the Trademark Act).

A trademark which is identical with or similar to another person's registered trademark and whose designated goods or services is identical with or similar to ones of another person's registered trademark (Article 4, paragraph (1), item (11) of the Trademark Act).

A trademark which is identical with a registered defensive mark of another person (referring to a mark registered as a defensive mark; the same applies hereinafter), if the trademark is used in connection with designated goods or designated services relating to the defensive mark (Article 4, paragraph (1), item (12) of the Trademark Act).

A trademark which is likely to cause confusion in connection with the goods or services pertaining to a business of another person (Article 4, paragraph (1), item (15) of the Trademark Act).

Trademarks that fall under these provisions will be reasons for revocation, since they may not be registered.

☒ **Unfair advantage, tarnishment or dilution**

The relevant provisions are as follows.

A trademark which is likely to negatively affect public policy (Article 4, paragraph (1), item (7) of the Trademark Act);

Five cases of trademarks that fall under this provision are exemplified in the Examination Guidelines for Trademarks.

- (1) Trademarks which are, in composition per se, are unethical, obscene, discriminative, outrageous, or unpleasant to people.
- (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.

A trademark which is identical with, or similar to, another person's well-known trademark, if the trademark is used for unfair purposes (Article 4, paragraph (1), item (19) of the Trademark Act).

In order for this item to apply, a trademark must fall under all of followings. (1) another person's trademark must be well known in Japan or abroad, (2) the other person's well-known trademark and the filed trademark must be the same or similar, and (3) the trademark must be used for unfair purposes. If another person's trademark is well known abroad, it does not matter whether it is well known in Japan.

Trademarks that fall under these provisions will be reasons for revocation, since they may not be registered.

☒ **Bad faith**

The relevant provisions are mainly as follows:

A trademark which is likely to negatively affect public policy (Article 4, paragraph (1), item (7) of the Trademark Act);

A trademark which is identical with, or similar to, another person's well-known trademark, if the trademark is used for unfair purposes (Article 4, paragraph (1), item (19) of the Trademark Act).

Details are as answered in the "Unfair advantage, tarnishment or dilution" section.

In addition, the following provisions may apply:

A trademark that is not recognized as being used in connection with goods or services pertaining to the business of an applicant. (Main Paragraph of Article 3, paragraph (1) of the Trademark Act).

"Use" in this provision includes not only cases where the applicant or any person who is substantially recognized as being under control thereof (hereinafter referred to as "the applicant, etc.") are actually using the filed trademark in connection with the designated goods or services, but also those cases where the applicant, etc. has the intention to use the filed trademark in the future. However, if the following conditions set forth in (a) and (b) are met, the trademark is determined to violate the main paragraph of Article 3, paragraph (1) of the Trademark Act on the grounds that there is extremely low probability of using the trademark in connection with goods or services pertaining to the business of an applicant, and there are reasonable doubts about the use of and intention to use the trademark.

(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 pertaining to his/her own business 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.).

Trademarks that fall under these provisions will be reasons for revocation, since they may not be registered.

☒ **Unauthorised filing by an agent of the TM proprietor or other ownership issues**

The relevant provision is as follow.

A trademark which is likely to negatively affect public policy (Article 4, paragraph (1), item (7) of the Trademark Act).

Details are as answered in the "Unfair advantage, tarnishment or dilution" section.

A Trademark that falls under this provision will be a reason for revocation, since it may not be registered.

☒ Other grounds

For details, please refer to the description regarding the provision of Article 43-2 of the Trademark Act in the answer to Question 42.

[KIPO](#)

☒ Identity of trade marks AND identity of goods and services

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

7. Any trademark used for goods identical or similar to the designated goods, which is identical or similar to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;

☒ Likelihood of confusion

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

11. Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation;

12. Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers;

☒ Unfair advantage, tarnishment or dilution

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

2. Any trademark which falsely indicates a relationship with a state, race, ethnic group, public organization, religion, or famous deceased person, or which slanders, insults, or is likely to defame any of them;

☒ Bad faith

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

20. Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he or she is aware that another person uses or intends to use the trademark through a contractual relationship, such as partnership or employment, or business transactional relationship, or any other relationship;

☒ Unauthorised filing by an agent of the TM proprietor

Article 34 (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

20. Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he or she is aware that another person uses or intends to use the trademark through a contractual relationship, such as partnership or employment, or business transactional relationship, or any other relationship;

☒ **Other grounds**

Please see the answer to Q42.

[USPTO](#)

☐ **Double Identity (Identity of trade marks + identity of goods and services)**

Meaning of “double identity” is unclear.

☒ **Likelihood of confusion**

Requirements to invoke this ground are noted in Question 22(a). As to the relevant steps of assessment carried out by the USPTO required to take a decision, the TTAB in making an assessment will look at a number of factors including but not limited to— similarity of the marks, similarity of the goods/services, similarity of trade channels, evidence of actual confusion, number of other similar marks in use on similar goods/services, conditions under which purchases are made. Any one or more factor(s) may take on more weight in the analysis depending on the facts of the case.

☒ **Unfair advantage, tarnishment or dilution**

Requirements for claiming this ground are set out in the answer to Question 21. Relevant steps of assessment carried out by the TTAB include but are not limited to – consideration of consumer recognition of the opposer’s mark in almost any context, the duration, extent, and geographic reach of advertising and publicity of the opposer’s mark; the amount, volume, and geographic extent of sales of goods or services offered under the mark of the opposer; the extent of actual recognition of the opposer’s mark.

In addition to the possible use of the aforementioned factors, the opposer’s mark must have become famous prior to any use the applicant may claim in its mark. Therefore, any evidence must emanate from the relevant time period.

☐ **Bad faith**

N/A as a specific ground for opposition

☒ **Unauthorised filing by an agent of the TM proprietor or other ownership issues**

Lack of ownership is a ground for opposition.

- 44) **Can a party oppose on all the grounds that were available for refusing registration during examination?**
Can a party oppose on additional grounds? *Please explain.*

[EUIPO](#)

Ex officio examination before the EUIPO covers only absolute grounds for refusal, and not “*inter partes*” disputes, that is between two or more parties. The opposition cannot be based on these grounds.

Opposition can be filed based on the grounds listed in the EUTMR as relative grounds:

Article 8(1)(a) EUTMR – double identity

Article 8(1)(b) EUTMR – likelihood of confusion

Article 8(3) EUTMR - Unauthorised filing by agents of the TM proprietor

Article 8(4) EUTMR - Non-registered trade marks and other signs used in the course of trade

Article 8(5) EUTMR - Trade marks with reputation

Article 8(6) EUTMR - Geographical Indications

The grounds for refusing registration during examination (EUTM registered contrary to Article 7 EUTMR) can only be invoked in cancellation/invalidity proceedings, once the EUTM is registered Article 59(1)(a) EUTMR. The grounds under Article 7 EUTMR can be invoked, e.g. for trade marks that are non-distinctive, deceptive, deceptive, customary, shapes necessary for technical result, contrary to public policy, deceptive, contrary to 6ter Paris Convention, in conflict with geographical indications, traditional terms, traditional specialities guaranteed, plant varieties.

[CNIPA](#)

If the opposing party files an opposition according to the Trademark Law Article 33 on the basis of relative grounds, the opposing party needs to have the subject qualification of the right holder or interested party. This provision defines the grounds for opposition. In principle, opposition cannot be filed according to other legal provisions.

[JPO](#)

A party cannot oppose on all the grounds (reasons) that were available for refusing registration during examination.

Reasons for refusal that can be applied in opposition proceedings are listed in Article 43-2 of the Trademark Act. For details, please refer to the description regarding the provision of Article 43-2 of the Trademark Act in the answer to Question 42.

For example, among the reasons for refusal applied during examination, oppositions may not be filed with respect to the provision of Article 6 of the Trademark Act, which refers to the clarity of the indication of designated goods and services.

In addition, adding reasons for opposition constitutes changing the outline of a written opposition to registration. Therefore, reasons for opposition may not be added by amendment after submitting a written opposition (Article 43-4, paragraph (2) of the Trademark Act). However, evidence may be submitted (added) no later than thirty days from the lapse of the term (during which an opposition may be filed) provided in Article 43-2 of the Trademark Act (Article 43-4, paragraph (2) of the Trademark Act).

[KIPO](#)

A party can oppose the application on all the grounds available for refusing registration during examination. (Article 54 of the Trademark Act)

[USPTO](#)

Yes. All grounds that could have supported a refusal can also support an opposition. Many other grounds are not used to support refusals, but can be used for opposition. Examples include dilution, fraud and non-ownership.

3 Assessment – the most common aspects

45) Likelihood of confusion

Does your Office assess distinctiveness of the earlier mark in opposition proceedings? ☐ yes ☐ no

If you answered yes please answer to the questions below:

[EUIPO](#)

☒ yes ☐ no

1. Please explain how your Office carries out the assessment of the distinctiveness of the earlier mark

The distinctiveness of the earlier mark as a whole is assessed, taking into account that a certain degree of distinctiveness needs to be acknowledged. The degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion.

(i) The more distinctive the earlier mark, the greater will be the likelihood of confusion, and (ii) earlier marks with a higher distinctive character acquired by the use or a highly distinctive character because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. Consequently, the distinctive character of the earlier mark as a whole determines the strength and breadth of its protection and must be taken into consideration for the purposes of assessing the likelihood of confusion.

When assessing the distinctiveness of the marks, the same criteria that are used to determine distinctiveness in absolute grounds apply. However, in relative grounds, these criteria are used not only to determine whether a minimum threshold of distinctiveness is met but also to consider the varying degrees of distinctiveness.

A sign is deemed to possess a 'normal' degree of inherent distinctiveness if there is no indication for a limitation thereof (e.g. due to a descriptive character, laudatory meaning, etc.). This means that the sign in question is fully distinctive, in the sense that its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired. Any higher degree of distinctiveness acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, and any degree of reputation have to be proven by its proprietor by submitting appropriate evidence.

In any event, earlier registered trade marks are presumed to have **at least a minimum degree** of inherent distinctiveness (24/05/2012, [C-196/11](#), F1-Live, EU:C:2012:314),



2. Please describe the impact of common components if they are distinctive only to a low degree. Can there be likelihood of confusion?

The EUIPO follows the principles established by the Common Practice 5 of the European Union Intellectual Property Network (Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)).

A coincidence in an element with a low degree of distinctiveness **will not normally on its own lead to likelihood of confusion**. However, there may be likelihood of confusion if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

3. Please provide two examples (earlier right – contested mark) where the low degree of distinctiveness of the common component has been sufficient to refuse the application/ revoke the registration.

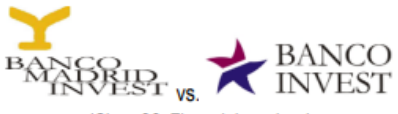

EUIPO example:

NO LOC	LOC
<p>MORELUX vs. INLUX</p> <p>(Class 44: Beauty treatments)</p>	<p>COSMEGLOW vs. COSMESHOW</p> <p>(Class 3: Cosmetics)</p>
 <p>(Class 9: Credit cards)</p>	 <p>(Class 43: Holiday accommodation services)</p>

4. Please describe the impact of common components if they are not distinctive. Can there be likelihood of confusion?

If the signs overlap exclusively in an element that is descriptive or non-distinctive for the relevant goods and services in all parts of the relevant territory, and both contain other distinctive element(s) capable of differentiating between the signs, they can be considered dissimilar (i.e. there will be no likelihood of confusion). However, when marks also contain other figurative and/or word elements that are similar, there may be likelihood of confusion depending on the global assessment of all the factors.

5. If you answered yes, please provide two examples (earlier right – contested mark) where a non-distinctive common component has been sufficient to refuse the application/ revoke the registration

NO LOC	LOC
<p>BUILDGRO vs. BUILDFLUX</p> <p>(Class 19: Building materials Class 37: Construction services)</p>	<p>TRADENERGY vs. TRACENERGY</p> <p>(Class 9: Solar energy collectors for electricity generation)</p>
 <p>(Class 36: Financial services)</p>	 <p>(Class 9: Solar energy collectors for electricity generation)</p>

6. According to your system, can a contested application/registration be refused/revoked for only part of the contested goods or services? If yes, please explain how you deal with the goods/services for which the contested application/registration has been refused/revoked.

In opposition or declaration of invalidity based on an earlier identical or similar mark under the ground likelihood of confusion the contested application or registration will only be refused for identical or similar goods and services. The application may be refused also for goods/services that are similar only to a low degree.

Once the decision is final, the refused goods/services are removed from the register.

7. Within the opposition proceedings, do you accept specifications and/or amendments in the list of the goods/services? If yes, please also specify the consequences for the opposition proceedings.

Yes, it is communicated to the opponent as it may lead to the withdrawal of the opposition.

CNIPA

Does your Office assess distinctiveness of the earlier mark in opposition proceedings?

☒ yes ☐ no

1. Please explain how your Office carries out the assessment of the distinctiveness of the earlier mark

According to Article 11 of the Trademark Law, evaluate whether the mark can play the role of mutual marking the source of goods.

2. Please describe the impact of common components if they are distinctive only to a low degree. Can there be likelihood of confusion?

We mainly compare the main identification parts. It will cause confusion if the main identification parts are similar.

3. Please provide two examples (earlier right – contested mark) where the low degree of distinctiveness of the common component has been sufficient to refuse the application/ revoke the registration.

CNIPA example:

LOC



Class: 25 clothing

NO LOC

PINCTONBOY



Class: 25 clothing

4. Please describe the impact of common components if they are not distinctive. Can there be likelihood of confusion?

We mainly compare the main identification parts. It will cause confusion if the main identification parts are similar.

5. If you answered yes, please provide two examples (earlier right – contested mark) where a non-distinctive common component has been sufficient to refuse the application/ revoke the registration

CNIPA example:

LOC



Class: 25 clothing

UN LOC



Class: 5 medicines for human purposes

LOC



Class: 5 medicines for human purposes

6. According to your system, can a contested application/registration be refused/revoked for only part of the contested goods or services? If yes, please explain how you deal with the goods/services for which the contested application/registration has been refused/revoked.

If the grounds of the opposing party are partially established, the opposed trademark may be partially approved.

7. Within the opposition proceedings, do you accept specifications and/or amendments in the list of the goods/services? If yes, please also specify the consequences for the opposition proceedings.

Unacceptable.

[JPO](#)

Does your Office assess distinctiveness of the earlier mark in opposition proceedings?

☒ yes ☐ no

1. Please explain how your Office carries out the assessment of the distinctiveness of the earlier mark

Judgment on the similarity of trademarks is made by observing in whole the trademark as applied and the earlier trademark. However, if the trademark structure includes a part that is indistinctive, the judgement is based on the part which can serve the function as a sign to independently distinguish its goods and services from those of others (hereinafter referred to as the "primary part"), excluding such indistinctive part.

2. Please describe the impact of common components if they are distinctive only to a low degree. Can there be likelihood of confusion?

The judgement on the similarity of trademarks is based on the part which can serve the function as a sign to independently distinguish its goods and services from those of others (hereinafter referred to as the "primary part"), excluding such indistinctive part.

In determining whether there is a likelihood of confusion in connection with the goods or services pertaining to a business of another person, factors other than the degree of similarity (whether the mark of another person consists of a coined word, has a distinctive feature in its composition, or is well known, etc.) will be taken into consideration in a comprehensive manner.

3. Please provide two examples (earlier right – contested mark) where the low degree of distinctiveness of the common component has been sufficient to refuse the application/ revoke the registration.

Although no relevant examples were found, the following example in which registration was maintained due to no likelihood of confusion of origin is listed for reference.

LOC

NO LOC





4. Please describe the impact of common components if they are not distinctive. Can there be likelihood of confusion?

Judgement on the similarity of trademarks is based on the part which can serve the function as a sign to independently distinguish its goods and services from those of others (the "primary part"), excluding such indistinctive part.

In determining whether there is a likelihood of confusion in connection with the goods or services pertaining to a business of another person, factors other than the degree of similarity (whether the mark of another person consists of a coined word, has a distinctive feature in its composition, or is well known, etc.) will be taken into consideration in a comprehensive manner.

5. If you answered yes, please provide two examples (earlier right – contested mark) where a non-distinctive common component has been sufficient to refuse the application/ revoke the registration

Although no relevant cases were found, the following case in which registration was maintained due to no likelihood of confusion of origin is listed for reference.

LOC



1. 6. According to your system, can a contested application/registration be refused/revoked for only part of the contested goods or services? If yes, please explain how you deal with the goods/services for which the contested application/registration has been refused/revoked.

An opposition can be filed to some designated goods and services. As a result, the registration of only some of the designated goods and services may be revoked (Article 43-2 of the Trademark Act). In addition, even if an

opposition is filed to all designated goods and services, the registration of some designated goods and services may be revoked as a result of the examination proceedings.

2. **7. Within the opposition proceedings, do you accept specifications and/or amendments in the list of the goods/services? If yes, please also specify the consequences for the opposition proceedings.**

While partial waiver on designated goods and services is possible in opposition proceedings, the effect of the waiver is not retroactive (Article 98, paragraph (1) of the Patent Act applied mutatis mutandis under Article 35 of the Trademark Act) and determination is made based on the timing of an examiner's decision of trademark registration.

[KIPO](#)

Does your Office assess distinctiveness of the earlier mark in opposition proceedings?

☒ yes ☐ no

1. **Please provide two examples (earlier right – contested mark) where the low degree of distinctiveness of the common component has been sufficient to refuse the application/ revoke the registration.**

example:

2. **If you answered yes, please provide two examples (earlier right – contested mark) where a non-distinctive common component has been sufficient to refuse the application/ revoke the registration**

example:

3. **Within the opposition proceedings, do you accept specifications and/or amendments in the list of the goods/services? If yes, please also specify the consequences for the opposition proceedings.**

N/A

[USPTO](#)

Does your Office assess distinctiveness of the earlier mark in opposition proceedings? ☒ yes ☐ no

1. **Please explain how your Office carries out the assessment of the distinctiveness of the earlier mark**

In comparing marks to evaluate a likelihood of consumer confusion, the TTAB will compare the marks in their entirety. Marks that are more distinctive are given greater weight in the comparison and are considered stronger marks. Any one of the factors in a likelihood of confusion analysis may be given more weight and entitle the trade mark owner to a broader scope of protection against the applicant's use or intent to use. In evaluating whether a mark is distinctive, the TTAB may evaluate whether the mark is arbitrary or fanciful, whether the mark has any meaning as associated with the goods/services associated with the mark, among other factors.

If the opposer's mark is registered and on the USPTO's Principal Register without reliance on a claim of acquired distinctiveness, then the opposer's mark will be presumed to be inherently distinctive and strong, but its weakness could be shown by the applicant's introduction of evidence of use or registration of third-party marks similar to the opposer's mark.

2. Please describe the impact of common components if they are distinctive only to a low degree. Can there be likelihood of confusion?

Non-distinctive common elements (typically descriptive or generic components or common geometric shapes or designs that serve only as a background for a design or work mark) are given less weight in a likelihood of confusion analysis.

In analyzing a likelihood of confusion, marks are considered in their entirety. However, certain components of a mark may be given less weight in the comparison. Descriptive or generic terms that have been disclaimed will be given less weight. The number of third-party uses of a common component in a mark will also mean that the component should be given less weight in comparing marks in a likelihood of confusion analysis. Each case is decided based on the particular facts involved and evidence presented.

3. Please provide two examples (earlier right – contested mark) where the low degree of distinctiveness of the common component has been sufficient to refuse the application/ revoke the registration.

USPTO example:

In re Detroit Athletic Co., 128 USPQ2d 1047 (Fed. Cir 2018): Board's decision upheld refusal to register the mark **DETROIT ATHLETIC CO** for sports apparel retail services (ATHLETIC CO disclaimed) based on earlier registered mark **DETROIT ATHLETIC CLUB** for various clothing items (ATHLETIC CLUB disclaimed).

In re National Data Corp., 222 USPQ 515 (1984): Registration of mark **THE CASH MANAGEMENT EXCHANGE** refused based on earlier registration for **CASH MANAGEMENT ACCOUNT** both used in connection with financial services.

4. Please describe the impact of common components if they are not distinctive. Can there be likelihood of confusion?

Marks are compared in their entirety. Generally, non-distinctive common components in a mark are given less weight in a comparison to evaluate a likelihood of confusion. The analysis would be made on a case by case basis and would depend on the nature of the common component and level of distinctiveness.

5. If you answered yes, please provide two examples (earlier right – contested mark) where a non-distinctive common component has been sufficient to refuse the application/ revoke the registration

6. According to your system, can a contested application/registration be refused/revoked for only part of the contested goods or services? If yes, please explain how you deal with the goods/services for which the contested application/registration has been refused/revoked.

Yes. In an opposition, the opposition may be limited to certain goods/services in the opposed application. If the opposer prevails, the application would proceed after the contested goods/services are removed from the identification of goods/services.

An applicant may assert a counterclaim for cancellation or restriction of the opposer's registration. If the applicant is successful, it may be able to obtain registration of its mark. Section 18 of the U.S. Trademark Act also allows either an opposer or an applicant to argue that no confusion will exist if one or both parties' application or registration are restricted as to particular goods or services. This may be utilized when the mark is registered or applied-for for goods or services broader in scope than the actual use in commerce.

7. Within the opposition proceedings, do you accept specifications and/or amendments in the list of the goods/services? If yes, please also specify the consequences for the opposition proceedings.

Yes, amendments to the goods/services may be accepted under certain circumstances if the amendment resolves the dispute between the parties. In such a case, if the TTAB approves the amendment as agreed to by the parties, the amendment is entered in the application database, the opposition dismissed, and the application as amended would proceed to issuance of a registration.

46) Evidence of use required by the office in opposition proceedings

[EUIPO](#)

1. Does your Office require the opponent to submit evidence of use of the earlier marks in opposition proceedings? ☒ yes ☐ no

European Union trade marks must be put into genuine use within a period of 5 years following its registration ([Article 18\(1\) EUTMR](#)). However, the owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use and the mere formal registration gives the mark full protection. Once this period lapses, the owner may be required **to prove genuine use** of the earlier mark.

The Office does not inquire *ex officio* whether the earlier mark has been used. In the opposition proceedings it is the applicant of the contested mark that may challenge use of the earlier mark. In accordance with Article 10(5) EUTMDR, a request for proof of use may be submitted at the same time as observations on the grounds on which the opposition is based.

Following the five year grace period, if genuine use is requested in opposition proceedings, the opponent can only reply on earlier marks and the goods and services they cover insofar as it can demonstrate they have been genuinely put to use in the territory where it is protected.

If no evidence is submitted until the deadline set by the Office (2 months), the opposition is rejected insofar as based on the earlier right.

The indications and evidence required in order to provide proof of use must concern the:

- 1.place,
- 2.time,
- 3.extent and
- 4.nature of use of the opponent's trade mark for the relevant goods and services.

These requirements are cumulative and subject to an overall assessment carried out by the Office.

If the Office finds the evidence insufficient to establish genuine use, and the earlier mark relied on has been registered for more the 5 years, the opposition is refused.

2. Is the evidence dependent upon geographic coverage? For example, is use only in part of the territory sufficient? If yes, under which conditions?

If the earlier mark is an EUTM, the territorial borders of the Member States should be disregarded when assessing whether an EUTM has been put to 'genuine use' in the European Union. An EUTM need not be used in an extensive geographic area for use to be deemed genuine, use in one Member State may be sufficient (recent case law of the General Court confirmed the established practice - T-316/21, 01/06/2022, Superior manufacturing).

National trade marks should be used in the territory where they are protected (again, substantial part of it will be sufficient).

3. Does your Office accept evidence of use in differing forms to the one registered? How much difference between the form proved and the form registered is acceptable?

The difference in the mark as used must be assessed in order to determine whether it alters the distinctive character of the mark as registered. Distinctive additions or omissions will alter the distinctive character of the mark and could lead to the evidence being refused, while non-distinctive or weak additions/omissions are usually accepted.



Further examples can be found in [the guidelines](#) and in [CP8](#)

4. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused with an additional element in actual use:

EUIPO example accepted:



Sign as registered	Sign as used
GERIVAN	<div style="font-size: 2em; font-weight: bold; margin-bottom: 5px;">BIO</div> <div style="font-weight: bold;">GERIVAN</div>

EUIPO example refused:



Sign as registered	Sign as used
	

5. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused where part of the mark was omitted in actual use:

EUIPO example accepted:

Sign as registered	Sign as used
	

EUIPO example refused:

Sign as registered	Sign as used
	

6. Please describe the extent of use (volume, geographical extent, period) required by the office to prove use of the earlier mark in opposition proceedings.

The office will assess whether **the owner has seriously tried to acquire a commercial position in the relevant market**

Account will be taken, in particular, of the

- **commercial volume** of all the acts of use on the one hand and
- the **duration** of the period in which those acts of use occurred
- the **frequency** of those acts.

The assessment is not intended to measure commercial success. Exact **threshold** proving genuine use cannot be laid down, the circumstances of each case must be considered. For example, in case of highly specialized goods, even rather low sales can show a serious attempt to create and maintain an outlet / market share for the relevant goods (considering the nature and the considerably high price of the goods, § 62-65 of T-316/21, 01/06/2022, Superior manufacturing). Genuine use cannot be excluded only because all use involves the same customer.

Use also does not need to be continuous throughout the relevant period of the 5 years.

[CNIPA](#)

1. Does your Office require the opponent to submit evidence of use of the earlier marks in opposition proceedings? ☐ yes ☒ no

No related situation.

2. Is the evidence dependent upon geographic coverage? For example, is use only in part of the territory sufficient? If yes, under which conditions?

No related situation.

3. Does your Office accept evidence of use in differing forms to the one registered? How much difference between the form proved and the form registered is acceptable?

No related situation.

4. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused with an additional element in actual use:

No related situation.

5. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused where part of the mark was omitted in actual use:

CNIPA has no related example.

6. Please describe the extent of use (volume, geographical extent, period) required by the office to prove use of the earlier mark in opposition proceedings.

CNIPA has no related example.

[JPO](#)

1. Does your Office require the opponent to submit evidence of use of the earlier marks in opposition proceedings? ☐ yes ☒ no

N/A

2. Is the evidence dependent upon geographic coverage? For example, is use only in part of the territory sufficient? If yes, under which conditions?

N/A

3. Does your Office accept evidence of use in differing forms to the one registered? How much difference between the form proved and the form registered is acceptable?

N/A

4. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused with an additional element in actual use:

N/A

5. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused where part of the mark was omitted in actual use:

N/A

6. Please describe the extent of use (volume, geographical extent, period) required by the office to prove use of the earlier mark in opposition proceedings.

N/A

[KIPO](#)

1. Does your Office require the opponent to submit evidence of use of the earlier marks in opposition proceedings? ☒ yes ☐ no

Along with the required evidence when filing an opposition.

2. Is the evidence dependent upon geographic coverage? For example, is use only in part of the territory sufficient? If yes, under which conditions?

N/A

3. Does your Office accept evidence of use in differing forms to the one registered? How much difference between the form proved and the form registered is acceptable?

It will be determined individually depending on the case.

4. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused with an additional element in actual use:

5. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused where part of the mark was omitted in actual use:

6. Please describe the extent of use (volume, geographical extent, period) required by the office to prove use of the earlier mark in opposition proceedings.

It will be determined individually depending on the case.

[USPTO](#)

1. Does your Office require the opponent to submit evidence of use of the earlier marks in opposition proceedings? ☒ yes ☐ no

Yes, if common law trade mark rights are claimed. If an earlier federal registration is provided to support an opposition, certain presumptions of ownership and use apply. If an applicant believes an opposer's registered

mark has been abandoned and is no longer in use, it may file a counterclaim to cancel the opposer's registration. To defeat the counterclaim, the opposer would have to present evidence of use or excusable non-use.

2. Is the evidence dependent upon geographic coverage? For example, is use only in part of the territory sufficient? If yes, under which conditions?

Maybe. Common law rights generally will be limited to the territory where the mark is used but may be sufficient in scope to oppose a pending application. A federal registration provides constructive nationwide rights in a mark. Depending on the facts of a case, the parties may file a separate concurrent use proceeding, an inter partes proceeding in which the TTAB determines whether one or more applicants are entitled to a concurrent registration, that is, a restricted registration with conditions and limitations on use and territory fixed by the TTAB. Though concurrent use cases can be tried as oppositions are, it is much more likely that they are settled by the parties, who agree to relevant restrictions to allow both parties' marks to be registered.

3. Does your Office accept evidence of use in differing forms to the one registered? How much difference between the form proved and the form registered is acceptable?

Evidence must show use of the mark in the form registered. Minor differences in appearance may be acceptable (for example, use of a word mark in plural versus singular form) but any material alteration of registered mark or addition of new components to the mark would not be acceptable.

4. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused with an additional element in actual use:

USPTO Example Accepted: *In re Innovative Cos., LLC*, 88 USPQ2d 1095 (TTAB 2008) amendment from "FREEDOMSTONE" to "FREEDOM STONE" allowed

USPTO Example Refused: *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (TTAB 2000) proposed amendment from "TACILESENSE" to "TACTILESENSE" rejected

5. Please provide two examples (mark as registered – mark as used) where use in a differing form was accepted / was refused where part of the mark was omitted in actual use:

USPTO example accepted: *In re Larios, S.A.*, 35 USPQ2d 1214 (TTAB 1995) (finding "VINO DE MALAGA LARIOS" an acceptable amendment of "GRAN VINO MALAGA LARIOS" with similar design)

Original mark:



Amended mark:



USPTO example not accepted: See *In re Dillard Dep't Stores, Inc.*, 33 USPQ2d 1052 (Comm'r Pats. 1993) (proposed deletion of highly stylized display features of mark "IN•VEST•MENTS" rejected:



Mark as Registered



Proposed Amended Mark

6. Please describe the extent of use (volume, geographical extent, period) required by the office to prove use of the earlier mark in opposition proceedings.

Use generally must be in interstate commerce, commerce between the U.S. and foreign countries, or in commerce in the United States that affects commerce that the U.S. congress can regulate and comply with the use requirements outlined in the Trademark Act (**15 U.S.C. §1051(a)**).

See also **37 C.F.R. §§2.2(k)(1), 2.34(a)(1)(i)**

Proof of any use that would be sufficient to bar the applicant from use in any part of the U.S. would be a bar to a registration nationwide in scope. Concurrent use would be an option.

47) Reputation / well known character

EUIPO

1. Does your Office require a trade mark to be registered before it can establish reputed character (i.e. unregistered trade marks cannot be considered reputed)? ☒ yes ☐ no
2. What type evidence may serve to prove reputation / well known character and do you, in principle, attach different probative value to the various types of evidence?

In order to ascertain the reputation of an earlier mark, all the relevant facts must be considered when assessing the reputation of the earlier mark, 'in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of investment made by the undertaking in promoting it' (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 25, 27).

The opponent may avail itself of all the means of evidence listed under Article 97(1) EUTMR. In any event, the opponent is free to choose the form of evidence which it considers useful to submit (26/06/2019, [T-651/18](#), HAWKERS (fig.) / HAWKERS (fig.) et al., EU: T:2019:444 § 35).

The following means of evidence can be pertinent to prove reputation (this list does not reflect their relative importance or probative value, that is assessed on case by case basis):

- sworn or affirmed statements
- decisions of courts or administrative authorities
- decisions of the Office
- opinion polls and market surveys
- audits and inspections
- certification and awards
- articles in the press or in specialised publications
- annual reports on economic results and company profiles
- invoices and other commercial documents
- advertising and promotional material
- evidence of a presence and activity on the Internet

3. Is there a language requirement regarding the submitted evidence? Is a translation required if the evidence is not in the language of the proceedings? Does your Office require the translation to be certified?

The notice of opposition may only be filed in one of five languages of the EUIPO, English, French, German, Italian and Spanish, and the language must also coincide with one of the two languages chosen by the applicant for the European Union trade mark.

This language will then be used throughout the opposition proceedings.

It is not necessary to provide a certified translation.

Where the evidence submitted to show use or reputation of an earlier mark, it is left to the discretion of the Office whether the opponent has to submit a translation of the evidence or an explanation of the meaning of the evidence in another language is sufficient, balancing the interests of both parties.

4. Is the evidence dependent upon geographic coverage? For example, is reputation only in part of the territory sufficient? If yes, under which conditions?

Yes and yes.

The earlier mark must have a reputation in the territory where it is registered – EUTM in EU, national mark in the Member State. It is sufficient if reputation exists in a substantial part of that territory (which may be for example a single Member State in case of EUTM).

The evidence submitted must specifically concern the relevant territory. E.g., figures concerning sales in the EU as a whole, or worldwide sales, are not appropriate for showing reputation in a specific Member State, if the relevant data are not broken down by territory. In other words, a ‘wider’ reputation must also be specifically proven for the relevant territory if it is to be taken into account.

According to your system, can a contested application/registration in conflict with a reputed mark be refused/revoked for part of the contested goods or services?

It is possible, if the opposition only aims at or is only successful in establishing a link with part of the goods or services.

Once the decision is final, the refused goods/services are removed from the register.

5. If detriment is a condition, what kind of evidence or argument do you accept to prove that actual or future use causes, or is likely to cause, detriment to the earlier reputed mark? E.g. do you require the opponent to furnish evidence of a ‘change in the economic behaviour’ of the average consumer?

Detriment to distinctiveness:

The Court insists on a ‘higher standard’ for establishing dilution. The following two autonomous conditions must be substantiated by the opponent:

- Dispersion of the reputed mark’s image and identity in the relevant public’s perception (subjective condition).
- A change in the economic behaviour of this public (objective condition).

While the opponent does not need to submit evidence of actual detriment, it must convince the Office by adducing evidence of a serious future risk — which is not merely hypothetical — of detriment. The opponent may do this by submitting evidence that proves a likelihood of detriment on the basis of logical deductions made from an analysis of the probabilities (and not mere suppositions), and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case.

Detriment to repute:

In order to establish detriment to the repute of an earlier mark, besides the connection in the mind of the consumer between the marks, either the signs or the goods/services covered by the later mark must provoke a negative or detrimental impact when associated with the reputed mark. The harmful effects of use of the contested sign in connection with the goods and services applied for must derive from the nature and usual characteristics of the goods at issue in general (not their quality).

[CNIPA](#)

1. **Does your Office require a trade mark to be registered before it can establish reputed character (i.e. unregistered trade marks cannot be considered reputed)?** ☐ yes ☒ no
2. **What type evidence may serve to prove reputation / well known character and do you, in principle, attach different probative value to the various types of evidence?**

The following evidences prove the popularity of the trademark from different angles: invoice for sales, contract, advertising and magazine reports, award certificate, the figures of sales and advertising investment, participation in the exhibition, etc.

3. **Is there a language requirement regarding the submitted evidence? Is a translation required if the evidence is not in the language of the proceedings? Does your Office require the translation to be certified?**

If the evidence documents submitted are in foreign language, they shall be accompanied by a Chinese translation. If no Chinese translation documents are accompanied, the evidence shall be deemed not to be submitted.

4. **Is the evidence dependent upon geographic coverage? For example, is reputation only in part of the territory sufficient? If yes, under which conditions?**

In principle, the evidence shall be used within the territory of China.
If the applicant request for a well-known trademark protection, the region scope of use should be very wide. If Article 32 of the Trademark Law is applicable to the case of "an applicant rush to register in an unfair manner a mark that is already in use by another party and enjoys substantial influence", it is required that the geographical scope of the prior trademark shall be extended to the opposed party.

5. **According to your system, can a contested application/registration in conflict with a reputed mark be refused/revoked for part of the contested goods or services?**

In case of a contested application/registration in conflict for part of the goods or services, the application of the conflict goods and services will be refused and the rest of the goods or services can be approved.

6. **If detriment is a condition, what kind of evidence or argument do you accept to prove that actual or future use causes, or is likely to cause, detriment to the earlier reputed mark? E.g. do you require the opponent to furnish evidence of a 'change in the economic behaviour' of the average consumer?**

At present, we do not make it clear that what kind of evidence can prove the occurrence of the damage. And we do not require the applicant to prove that.

[JPO](#)

1. Does your Office require a trade mark to be registered before it can establish reputed character (i.e. unregistered trade marks cannot be considered reputed)? ☐ yes ☒ no
2. What type evidence may serve to prove reputation / well known character and do you, in principle, attach different probative value to the various types of evidence?
- 3.

In approving the degree of being famous or well known, the question of whether or not the trademark is widely recognized among consumers is comprehensively determined, in principle, based on various materials such as newspapers, magazines, books, and Internet articles.

4. Is there a language requirement regarding the submitted evidence? Is a translation required if the evidence is not in the language of the proceedings? Does your Office require the translation to be certified?

In principle, documents pertaining to oppositions must be written in Japanese (Article 2, paragraph (1) of the Regulation for Enforcement of the Patent Act applied mutatis mutandis under Article 22, paragraph (1) of the Enforcement Regulations of the Trademark Act).

A power of attorney, a certificate of nationality, or other document written in a foreign language needs to be attached a translation thereof to. (Article 2, paragraph (2) of the Enforcement Regulations of the Patent Act applied mutatis mutandis under Article 22, paragraph (1) of the Enforcement Regulations of the Trademark Act).

Our Office does not require translations to be certified.

5. Is the evidence dependent upon geographic coverage? For example, is reputation only in part of the territory sufficient? If yes, under which conditions?

Famous and well-known trademarks considered under each item of Article 4 of the Trademark Act include well-known and famous trademarks not only throughout Japan but also only in a certain area.

In addition, in making a determination under Article 4, paragraph (1), item (15) of the Trademark Act, if a mark famous in a foreign country is well known by Japanese consumers, a determination is made by sufficiently taking into consideration such facts.

In making a determination under Article 4, paragraph (1), item (19) of the Trademark Act, if a trademark is mainly well known abroad, the fact as to whether or not the trademark is well known in Japan is disregarded.

In addition, Article 3, paragraph (2) of the Trademark Act stipulates that a trademark that does not have distinctiveness and falls under Article 3, paragraph (1), items (3) to (5) of the Trademark Act may be registered if, as a result of the use of the trademark, it is well known.

Well-known in this case means that a trademark that may not be registered in principle due to lack of distinctiveness is exceptionally allowed to be registered because of the acquisition of distinctiveness by its use. Therefore, the trademark is required to prove that the trademark is well known and famous throughout Japan.

6. According to your system, can a contested application/registration in conflict with a reputed mark be refused/revoked for part of the contested goods or services?

An opposition can be filed to some designated goods and services, regardless of whether the registered trademark against which the opposition is filed is famous or not. As a result, the registration of only some of the designated goods and services may be revoked (Article 43-2 of the Trademark Act). In addition, even if an opposition is filed to all designated goods and services, the registration of some designated goods and services may be revoked as a result of the examination proceedings.

7. If detriment is a condition, what kind of evidence or argument do you accept to prove that actual or future use causes, or is likely to cause, detriment to the earlier reputed mark? E.g. do you require the opponent to furnish evidence of a 'change in the economic behaviour' of the average consumer?

As stated in Question 15, the main purpose of the opposition to registration of the trademark system in Japan is not to solve specific disputes between parties.
Therefore, detriment to a famous trademark is not a condition.

KIPO

1. Does your Office require a trade mark to be registered before it can establish reputed character (i.e. unregistered trade marks cannot be considered reputed)? ☐ yes ☒ no
2. What type evidence may serve to prove reputation / well known character and do you, in principle, attach different probative value to the various types of evidence?

Whether or not a certain trademark is widely known among consumers or traders as a source identification of goods/services will be the criteria for determination. To this end, diverse methods such as a survey can be considered.

3. Is there a language requirement regarding the submitted evidence? Is a translation required if the evidence is not in the language of the proceedings? Does your Office require the translation to be certified?

Basically, all the procedures will be conducted in Korean.

4. Is the evidence dependent upon geographic coverage? For example, is reputation only in part of the territory sufficient? If yes, under which conditions?

N/A

5. According to your system, can a contested application/registration in conflict with a reputed mark be refused/revoked for part of the contested goods or services?

The contested application/registration can be revoked for some of the contested goods/services.

6. If detriment is a condition, what kind of evidence or argument do you accept to prove that actual or future use causes, or is likely to cause, detriment to the earlier reputed mark? E.g. do you require the opponent to furnish evidence of a 'change in the economic behaviour' of the average consumer?

N/A

USPTO

1. Does your Office require a trade mark to be registered before it can establish reputed character (i.e. unregistered trade marks cannot be considered reputed)? ☐ yes ☒ no

2. What type evidence may serve to prove reputation / well known character and do you, in principle, attach different probative value to the various types of evidence?

Concrete evidence that the proposed mark is perceived as a mark for the relevant goods or services is required to establish distinctiveness. The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. Examples of types of evidence considered include length of time the mark has been in use in commerce, advertising expenditures, affidavits or declarations asserting recognition of the mark as a source indicator, survey evidence, market research, consumer reaction studies.

3. Is there a language requirement regarding the submitted evidence? Is a translation required if the evidence is not in the language of the proceedings? Does your Office require the translation to be certified?

Submissions must be in English.

4. Is the evidence dependent upon geographic coverage? For example, is reputation only in part of the territory sufficient? If yes, under which conditions?

Not necessarily. Reputation in parts of the United States may be sufficient. The amount and type of evidence provided would be analyzed on a case by case basis.

Proof of any use that would be sufficient to bar the applicant from use in any part of the U.S. would be a bar to a registration nationwide in scope. Concurrent use would be an option.

5. According to your system, can a contested application/registration in conflict with a reputed mark be refused/revoked for part of the contested goods or services?

Yes, a mark may be opposed as to certain contested goods or services. In the case of a mark that is considered famous and the fame has been supported by appropriate evidence, goods or services listed in a contested application could not be limited. If the opposer prevails in a dilution claim, the contested goods/services could not be limited. Dilution differs from a likelihood of confusion because dilution may occur even if consumers are not confused or misled.

6. If detriment is a condition, what kind of evidence or argument do you accept to prove that actual or future use causes, or is likely to cause, detriment to the earlier reputed mark? E.g. do you require the opponent to furnish evidence of a 'change in the economic behavior' of the average consumer?

Dilution can only be proven by evidence of actual harm to the famous mark—for example, survey evidence or other direct proof that shows that consumers perceive the famous mark less favorably. The type and amount of evidence depends on the case.

In connection with a likelihood of confusion claim, detriment (or potential detriment) could be shown based on evidence the potential for lost market share, evidence of actual marketplace confusion, and other evidence that would vary depending on the facts of the case.

48) Please provide the references of applicable law on the substantive provisions [and specify the relevant legal provision for each ground for refusal]:

[EUIPO](#)

[European Union trade mark regulation](#) (EUTMR), in particular Article 8.

[European Union trade mark delegated regulation](#) (EUTMDR)

[European Union trade mark implementing regulation](#) (EUTMIR)

[CNIPA](#)

Well know trademarks-Article 13 paragraph 2 and 3 of the Trademark Law;
 Unauthorised filing by an agent of the TM proprietor or other ownership issues-Article 15 of the Trademark Law;
 Protected geographical indications-Article 16 paragraph 1 of the Trademark Law;
 Registered trademark/Identity of trademarks and identity of goods and/or services-Article 30 and 31 of the Trademark Law;
 Bad-faith trademark application which is not for the purpose of use-Article 4 of the Trademark Law;
 Absolute grounds of prohibition provisions-Article 10 of the Trademark Law;
 Absolute grounds of significance provisions-Article 11 and 12 of the Trademark Law;
 Pre-emptive registration by an agent-Article 19 paragraph 4 of the Trademark Law;
 Pre-emptive registration concerning the unregistered mark which is prior use and infringe upon another party's existing prior rights-Article 32 of the Trademark Law.

[JPO](#)

Please refer to the answer to Question 42.

[KIPO](#)

Please see the answer to Q42.

[USPTO](#)

See response to Question 23 above with citations.

49) Are you contemplating any changes in your opposition practice? If so, what are they?

[EUIPO](#)

The [Guidelines](#) are updated in a cyclical and open process, involving national offices and user associations, mainly based on the development of the case law.

The legal framework is unlikely to change in the coming years.

[CNIPA](#)

We are considering amending the Trademark Law, optimizing the opposition procedure and keep combatting the bad-faith filing.

[JPO](#)

Our Office has no plan for such changes.

[KIPO](#)

No plan to change at this moment.

[USPTO](#)

The USPTO's Trademark Trial and Appeal Board (TTAB) will conduct pilot programs to experiment with new procedures from time to time. Also, the TTAB will from time to time amend the rules governing its procedures. There are no pending, proposed rule changes. The TTAB is considering a pilot program that would require parties in particular cases to engage with a TTAB attorney and judge prior to going to trial, to increase the likelihood the trial will be conducted efficiently and effectively.

In April 2023, the TTAB will begin a final pretrial conference pilot program. The goals of the program are to save the parties and the TTAB time and resources and foster the effective and efficient presentation of evidence.

<https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/final-pretrial-conference-pilot>