

Report on “Laws and Examination Guidelines/Practices of the TM5 Offices against Bad-Faith Trademark Filings”



Revision History

Version	Date	Description
1.0	April 2015	First Edition
1.1	June 2015	First Edition (Rev.)
2.0	Oct.2022	Second Edition

TABLE OF CONTENTS

CHAPTER 1:	OUTLINE OF SYSTEMS AND PRACTICES OF THE TM5 OFFICES AGAINST BAD-FAITH TRADEMARK FILINGS.....	1
CHAPTER 2:	EXTRACTS OF RELATED ARTICLES OF THE TM5 OFFICES AGAINST BAD-FAITH TRADEMARK FILINGS.....	25
CHAPTER 3:	COMPARISON TABLES - TABLES SUMMARIZING COMPARISONS OF SYSTEMS AND PRACTICES IN EACH OFFICE.....	43

Chapter 1:

Outline of Systems and Practices of the TM5 Offices against Bad-faith Trademark Filings

Tackling Bad-Faith Trademark Filings in Japan

1. Tackling Bad-Faith Trademark Filings under the Trademark Act

(1) Bad-Faith Trademark Filings

There is no definition in the Trademark Act about so-called *bad-faith* trademark filings. In general, bad-faith trademark filings refer to an act in which a trademark is filed for unfair purposes by taking advantage of another person's trademark that has not been registered in the country/region concerned.

(2) Related Provisions under the Trademark Act

In Japan, the following legal grounds are used against bad-faith trademark filings: First, main paragraph of Article 3(1) requires applicants to have an intention to use the mark.

Second, Article 4(1)(vii) does not allow trademarks being likely to cause damage to public order or morality to be registered.

Third, Article 4(1)(viii) does not allow trademarks containing a name, etc., of another person to be registered (except those the registration of which has been approved by the person concerned.)

Fourth: Article 4(1)(x) does not allow trademarks identical with or similar to another person's well-known trademarks to be registered.

Fifth: Article 4(1)(xv) does not allow trademarks to be registered that are likely to cause confusions in connection with the goods or services pertaining to a business of another person.

Sixth: Article 4(1)(xix) does not allow trademarks to be registered that are identical with or similar to another person's well-known trademarks and used for unfair purposes.

Seventh: Article 53bis, which corresponds to Article 6septies of the Paris Convention, provides for trials for cancellation of counterfeiting registration by agents.

As explained above, there are several articles which can be applied to bad-faith trademark filings. Among them, Article 4(1)(vii) and Article 4(1)(xix) are mainly used to tackle bad-faith trademark filings. In addition, the main paragraph of Article 3(1) can be used for the purpose of *intention to use*.

In particular, the Japan Patent Office sets forth in the Trademark Examination Guidelines and other regulations how to apply Article 4(1)(xix) which specifies unfair

purposes as legal requirements.

(3) Article 4(1)(xix): Trademarks Identical with or Similar to Another Person's Well-Known Trademark and Used for Unfair Purposes

(a) The provision of Article 4(1)(xix) of the Japanese Trademark Act was introduced in response to the 1996 revision.

There are three requirements for applying this provision. The first requirement is that another person's trademark (cited trademark) is well-known in Japan or abroad. The second requirement is that applied trademark and another person's well-known trademark (cited trademark) are identical or similar. The third requirement is that the applied trademark is used for unfair purposes.

(b) Trademark Applications that Falls under Article 4(1)(xix) of the Japanese Trademark Act

The followings cases are adopted in the Trademark Examination Guidelines as applications that fall under Article 4(1)(xix).

For example, in cases where trademarks well known abroad are not registered in Japan, (i) applications filed for the purpose of making the owner of the well-known trademark purchase the trademark rights for an unreasonable sum; (ii) applications filed for the purpose of preventing the owner of the well-known trademark from entering the Japanese market; and (iii) applications filed for the purpose of forcing the owner of the well-known trademark to conclude an agent contract, fall under Article 4(1)(xix).

Moreover, even in cases where there is no likelihood of confusion between another person's trademark well known throughout Japan and the applied trademark identical with or similar to the said trademark; (i) applications filed to dilute the function of indicating the origin and (ii) applications filed to impair the reputation of the well-known trademark fall under Article 4(1)(xix).

(c) Determining "Unfair Purposes" under Article 4(1)(xix)

If materials that demonstrate the facts listed below are available, the JPO conducts an examination taking them into consideration in order to determine if the intent is for *unfair purposes*.

For example (i) when another person's trademark is well known among consumers; (ii) the well-known trademark consists of coined words or has highly distinctive features in composition; (iii) the owner of the well-known trademark has a

concrete plan to enter the Japanese market; (iv) the owner of the well-known trademark has a plan to expand business in the near future; (v) demands from the applicant forcing the owner of the well-known trademark to buy the trademark rights or to conclude an agent contract or a fact that the applicant is seeking to prevent foreign right holders from entering the Japanese market; and (vi) risks of damaging credibility, reputation and consumers-attractiveness accumulated by the well-known trademark if the applicant uses the trademark.

(d) Presumption of “Unfair Purposes” under Article 4(1)(xix)

Even if materials to prove facts listed in (c) above are not found in determining unfair purposes, a trademark application that meets both of the following requirements is presumed as having an intention to use *another person’s well-known trademarks* for unfair purposes because it is highly unlikely that the trademark coincides with the well-known trademark purely by accident.

(i) The trademark filed is identical with or remarkably similar to the well-known trademark in one or more foreign countries or that is well known throughout Japan.

(ii) Another person’s well-known trademark consists of coined words, is creative or has highly distinctive features in composition

(4) Article 4(1)(vii): Trademarks Being Likely to Cause Damage to Public Order or Morality

Article 4(1)(vii) states that a trademark that is likely to cause damage to public order or morality cannot be registered.

The Trademark Examination Guidelines state, in regard to bad-faith trademark filings, “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” fall under Article 4(1)(vii). If the background to the filing lacks social reasonableness, for example, those filings are rejected. Article 4(1)(vii) does not necessarily require whether the trademark is well known in Japan or abroad.

(5) Main paragraph of Article 3(1): Intention to Use the Trademark

Main paragraph of Article 3(1) states that any trademark used in connection with goods or services pertaining to the business of an applicant may be registered.

Therefore, for example, in the case where the designated goods and services within one class in a trademark application covers a wide range, there is a reasonable doubt

regarding the use of the trademark and the intention to use it and confirms the use or intention to use by sending a notification of reasons for refusal.

However, the Trademark Examination Manual provides that even when the applicant has submitted a document certifying their intention to use the trademark, it is obvious that the applicant will not use the trademark for the goods or services and thus, the reasonable doubts will not be resolved, if the following conditions set forth in (i) and (ii) below are met:

(i) 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 their own business in consideration of the past number of applications filed by the applicant (not less than 1,000 applications per year).

(ii) 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.).

In one court case, a defendant filed and registered more than 40 applications in a short period of time; however, use of the trademarks by the defendant cannot be confirmed, and 30 of them are irrelevant trademarks or trade names. Therefore, the defendant's use of the trademarks or intention to use the trademarks has not been confirmed and therefore the defendant's trademarks were judged to violate the main paragraph of Article 3 (1). (「RC TAVERN」 Intellectual Property High Court, 2012 (Gyo Ke) No. 10019 [Upgraded Case Examples of Bad-Faith Trademark Filings JPO-10])

2. Scheme for Tackling Bad-Faith Filings in Japan

Bad-faith trademark filings can be refused in the course of JPO examinations under the Trademark Act. In addition, if bad-faith trademark filings are registered, it is allowed to request opposition to the grant of trademark registrations and an invalidation trial. Depending on the applicable provisions, bad-faith trademark filings can be invalidated at any time.

3. Information Provision System

Anyone can provide information that pending applications at the JPO should not be registered and materials that provide grounds for that purpose.

Information provided is used as a reference for examinations. The information provision system is very important to tackle bad-faith trademark filings, because users do not need to subsequently request unnecessary opposition and invalidation trials and

the JPO improves the accuracy and expeditiousness of examinations which, as a result, prevents defective trademark rights from being registered.

4. Summary

The following table summarizes the means available for bad-faith trademark filings in Japan.

The JPO can refuse bad-faith trademark filings during examinations under the Trademark Act. Moreover, the provision of information can be an effective means to prevent registration of bad-faith trademark filings in the examination process.

In addition, if bad-faith trademark filings are registered, opposition requests can be submitted as can requests for invalidation trials. Depending on the applicable provisions, bad-faith trademark filings can be invalidated at any time.

○Summary of Applicable Provisions

Articles of the Trademark Act	Information Provision (examination stage)	Oppositions	Trials for invalidation	Trials for Rescission
Lack of Intention to Use (Main paragraph of Article 3(1))	✓	✓	✓	—
Contravention of public order or morality (Article 4(1) (vii))	✓	✓	✓	—
Name of another person (Article 4(1)(viii))	✓	✓	✓	—
Well-known trademark of another person (Article 4(1)(x))	✓	✓	✓	—
Confusion over the source of goods and services (Article 4(1)(xv))	✓	✓	✓	—

Articles of the Trademark Act	Information Provision (examination stage)	Oppositions	Trials for invalidation	Trials for Rescission
Trademark identical with or similar to another person's well-known trademark which is used by the applicant for an unfair intention (Article 4(1)(xix))	✓	✓	✓	—
Rescission of fraudulent registration by agent etc. (Article 53-2)	—	—	—	✓

○Details of the measures available to the JPO for the above provisions for bad-faith trademark filings

Measures	Target Trademark	Request Period	Demandant	Procedure
Information Provision (examination stage) (Regulation for Enforcement of the Trademark Act, Article 19)	Trademark application which is pending in the JPO	Trademark application which is pending in the JPO (Excluding (i) application for which decisions of refusal becomes final, (ii) after the registration of establishment of the trademark right, and (iii) application which is withdrawn)	Any person	Paper documents
Opposition (Article 43-2)	Registered trademark	Within two months from the day following the date of publication of the	Any person	Paper documents

		bulletin containing the trademark		
Trials for Invalidation (Article 46)	Registered trademark	<p>Article 4(1)(vii), (xix)4: No time limit</p> <p>Main paragraph of Article 3(1), Article 4(1)(viii), (x),(xv): There is period of exclusion (lapse of five years from the date of registration of the establishment of the trademark right)</p> <p>However, Article 4(1)(x) (if registered for the purpose of unfair competition) and 4(1)(xv) (if registered for unfair purpose) have no time limit.</p>	Any interested person	Paper documents
Trials for Rescission (Article 53-2 [Rescission of fraudulent registration by agent etc.])	Registered trademark	There is period of exclusion (lapse of five years from the date of registration of the establishment of the trademark right)	Any person who has the right to the trademark	Paper documents

Chinese Legal System of Coping with Bad-faith Filing of Trademark

I. What kind of trademark application might be termed as “bad-faith filing”?

There’s no clear definition of bad-faith application in the laws on trademarks. However, bad-faith application of trademark usually refers to the act of application for trademark registration that is against the principle of good faith, for the purpose of grabbing or unfairly exploiting the goodwill of another party’s trademark(s), infringing another party’s prior rights, or encroaching public resources.

According to the latest revised *Trademark Law*, a trademark application that is malicious and not for the purpose of use shall be refused.

II. Common types of bad-faith filing and the related provisions in the *Trademark Law*

In China, the prohibition of bad-faith application is mainly carried out by the Trademark Office through opposition procedure, and the Trademark Review and Adjudication Board through invalidation procedure, and the court through law suit.

Common types of bad-faith application include the following situations:

1. Reproducing, imitating, or translating another party’s well-known trademark

According to Article 13 of the *Trademark Law*, both unregistered and registered well-known trademarks might be protected in China.

Paragraph 2 of Article 13 provides that: "A trademark that is applied for registration in identical or similar goods shall not be registered and its use shall be prohibited, if it is a reproduction, an imitation or a translation, of another party’s well-known mark that is not registered in China and it is liable to create confusion." This provides protection on identical or similar goods/services for well-known trademarks that have not been registered in China.

Paragraph 3 of Article 13 provides that: "A trademark that is applied for registration in non-identical or dissimilar goods shall not be registered and its use shall be prohibited, if it is a reproduction, an imitation or a translation, of a well-known mark which is registered in China, misleads the public, and the interests of the registrant of the well-known mark are likely to be damaged by such use." This provides expanded protection on non-identical or dissimilar goods/services for well-known trademarks that have already been registered in China.

2. Applying in unfair means for the registration of a trademark that is already in use by another party and has certain influence.

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

The requisite conditions for a prior used unregistered trademark to prevent posterior trademark registration include:

- 1) the other party's trademark is already in use and has acquired certain influence before the application of the disputed trademark;
- 2) the disputed trademark is identical with or similar to the other party's trademark;
- 3) the designated goods/services of the disputed trademark are identical with or similar to the related goods/services of other party's trademark in principle;
- 4) the applicant of the disputed trademark bears bad faith.

3. Applying for the registration of a trademark that infringes another party's prior rights

According to Article 32 of the *Trademark Law*, no trademark application shall infringe upon another party's existing prior rights, which mainly include intellectual property rights other than trademark right (such as trade name right, copyright and design etc.) and personal right (including portraiture right and right of name).

4. The agent or representative of a person who is the owner of a trademark applying in bad faith for the registration of the mark in his own name

According to paragraph 1 of Article 15 of the *Trademark Law*, where the agent or representative of a person who is the owner of a mark applies, without such owner's authorization, for the registration of the mark in his own name, if the owner opposes the registration applied for, the application shall be refused and the use of the mark shall be prohibited.

5. An application for trademark registration that is malicious and is not filed for the purpose of use.

6. A trademark registration was acquired by fraud or any other improper means

According to paragraph 1 of Article 44 of the *Trademark Law*, where the registration of a trademark was acquired by fraud or any other improper means, the Trademark Office

shall invalidate the registration at issue. Any organization or individual may request that the Trademark Review and Adjudication Board make a ruling to invalidate such a registered trademark.

7. A trademark application violates the principles of good faith, socialist morals or customs, or having other unhealthy influences.

According to (8) paragraph 2 of Article 10 of the *Trademark Law*, The following words or devices shall not be used as trademarks: (8)Those detrimental to socialist moals or customs, or having other unhealthy influences.

III. New amendments in the Trademark Law against bad-faith filing

The Trademark Law was revised on 23rd April,2019 and had entered into force on 1st November,2019. The focus of this revision is to crack down on bad-faith filing, specifically as follows:

1. Adding the provisions of crack down on bad-faith filing

In the General Provisions (Paragraph 1 of Article 4), add the provision of “**A trademark application that is malicious and not for the purpose of use shall be refused.**”

2. Increasing the punishment of infringement of the exclusive to use a registered trademark.

According to Paragraph 1 of Article 63 of the *Trademark Law*, the amount of damages for malicious infringement with an existence of serious circumstances had been increased from 1-3 times to 1-5 times the amount of the actual losses of the right owner, the profits of the infringer or the licensing royalty for the trademark right. Paragraph 3 of Article 63, the highest statutory damages is increased from no more than RMB 3 million to RMB 5 million.

【EUIPO】

EUIPO: Please see attached pdf document

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



bad faith.pdf

[Summary of the KIPO system and practice in dealing with bad-faith marks]

Related Provisions under the Trademark Act

1. **Article 34(1)(xi)**: Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation;
2. **Article 34(1)(xii)**: Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers;
3. **Article 34(1)(xiii)**: Any trademark which is identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;
4. **Article 34(1)(xx)**: Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he/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.

Among the above provisions, bad faith filings are often subject and Article 34(1)(xiii); in particular, Article 34(1)(xiii) is also applicable to trademarks that are well-known abroad.

I. Article 34(1)(xiii), Korean Trademark Act

Requirements and Court Decisions

Article 34(1)(xiii) of the Korean Trademark Act stipulates that trademarks, which are identical or similar to a trademark recognized by consumers inside or outside the Republic of Korea as indicating the goods of a particular person, and are used to obtain unjust profits or to inflict harm on a particular person, cannot be registered.

This article was revised in 2007 (by deleting a word of “remarkably”), mitigating the required level of well-knownness of prior used and/or prior registered trademarks.

The regulation is to refuse or prohibit the registration of bad faith filings such as a trademark application which constitutes an imitation or is filed by a third party, who is not a legitimate user, with his/her intention to obtain registration of the mark in a dishonest manner, thereby shutting down the opportunity for a legitimate user to use the trademark or trying to gain unjust profits by exploiting the fact that the trademark is not yet registered in Korea.


The findings on unjustified purpose will be made by comprehensively considering originality and well-knownness of the prior mark in question; i.e., the application may be considered to be filed in anticipation of unjust gains where (1) there is a close relationship between the goods or services designated by the filed mark and the prior mark, and (2) there is a history of imitating the prior mark in the past.


Related Court Case

Supreme Court Decision | 2017Hu752 Decided August 14, 2019

Registered Mark (Bullson Co., Ltd.)	Prior Mark (Red Bull AG)
	

Holdings: : (a) RED BULL AG, the right holder of the prior use trademark/service

mark “  ” filed a petition for a trial for revocation of registration against

Bullson Co.,Ltd, the applicant of the registered mark/service mark “  ”

arguing that the said registered mark/service mark met the requirements under Article 34(1)13 of the Trademark Act, a case holding that: (a) at the time of the filing of the registered mark/service mark, the prior use trademark/service mark was acknowledged as a particular person’s service mark, at least among foreign customers, with respect to the relevant services industry; (b) Bullson Co.,Ltd, obviously emulated the prior use trademark/service mark and filed the registered mark/service mark with an illegal intent to cause damage to RED BULL AG, the right holder;

II. Other Trademark Act Articles related to deal with bad-faith marks

1. **Article 34(1)(xii): Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers is ineligible for trademark registration.**

- **Related examination guidelines currently effective:**

This applies to a case that causes domestic consumers to misunderstand or confuse the trademark recognized as a particular person's mark and its source. In order to be acknowledged as the particular person's mark, it does not necessarily have to be well known; however, in general domestic transactions of goods, (1) the product or the trademark must be known to the consumer or trader as that it belongs to a specific person, and (2) there must be a generally accepted relationship in which materials, uses, appearance, manufacturing methods, and sales systems are common.

2. **Article 34(1)(xx): Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he/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 is ineligible for trademark registration. [This provision came into effect on June 11, 2014]**

Where the trademark registered in a State party to the treaty, it cannot be registered under the Article 34(1)(xxi)—Trademarks Ineligible for Trademark Registration: 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.

3. **Article 3 of the Korean Trademark Act**

The article stipulates that any person who uses or intends to use a trademark in the Republic of Korea may be entitled to have his/her trademark registered.

- **Related examination guidelines currently effective:**

In this regard, the Trademark Examination Guideline stipulates that when a KIPO examiner has a doubt that the applicant files a trademark application for the purpose of prior occupation and/or interfering with a third party's trademark registration without the intention of use, the examiner can issue a provisional refusal.

In this case, the examiner can presume the subjective intention such as prior occupation by referring to not only the pertinent application, but also the history of the applicant's present and/or past trademark applications and/or registration and/or the scope of the applicant's current business. Further, if the applicant files a mark of celebrities' names, TV Program titles and titles of famous characters on more than two non-similar goods/services or a certain mark and/or a large number of marks on a large number of goods/services, the examiner can issue a provisional refusal based on Article 3.

Handling Bad Faith Filings in the United States

The principle tools used in the United States to tackle bad faith filings are (1) a statutory duty of good faith filings at the United States Patent and Trademark Office (USPTO), with penalties for fraudulent statements; (2) requirement for proof of use of, or a sworn statement of bona fide intent to use, the mark in commerce; (3) a duty of professional conduct for attorneys practicing before the USPTO; and (4) consideration of bad faith as a factor in a likelihood of confusion and dilution analysis. Bad faith may also be addressed through challenges on the grounds of misrepresentation of source under Trademark Act Section 14(3), and refusals or challenges on the basis of a false suggestion of a connection under Trademark Act Section 2(a). Finally, the USPTO has a variety of procedural mechanisms to help fight against registration of bad faith applications, as well as tools to streamline oppositions and cancellations in the event a challenge is filed.

In the application process, trademark applicants are required to provide verified statements, under penalty of perjury, that to the best of the verifier's knowledge and belief the facts recited in the application are accurate, that the verifier believes the applicant to be the owner of the mark (or if based on an intent to use, believes the applicant to be entitled to use the mark in commerce), and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. Where an applicant knowingly makes a false, material representation with the intent to deceive the USPTO, the applicant's application may be challenged on the basis of fraud and the applicant may be subject to possible criminal penalties.

In the United States, a trademark applicant must either show "use in commerce" or have a "bona fide intention to use" the mark in commerce. Section 45 of the Trademark Act defines "use in commerce" to mean "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." A bona fide intention means that an applicant has a "good faith" intention to use the mark in commerce. Thus, either method of registration requires good faith. Requirements of use or intention to use are designed to create more economic efficiencies for consumers and businesses by preventing applicants from unfairly reserving a large number of potential

marks with no real intention to use them. Evidence of actual use, in the form of examples of the mark used on or in connection with the goods or services must be submitted, or alternatively, a sworn statement of bona fide intent to use. An examiner will not evaluate the good faith of an applicant during examination and will not make an inquiry unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce. A third party may challenge an applicant's intention to use. If challenged by a third party, a bona fide intention to use can be established by providing a business plan, sample products, market research, manufacturing activities, promotional activities, steps to acquire distributors, or performing other initial business activities.

In trademark litigation both in federal courts and before the USPTO's Trademark Trial and Appeal Board (TTAB), the U.S. Federal Rules of Civil Procedure (FRCP) impose an ethical duty of candor and reasonable inquiry for those parties or attorneys filing documents to the federal courts, including in trademark cases. The Rules governing registration practice before the USPTO contain similar requirements. If an attorney or unrepresented person files a document with a federal court or the TTAB, that person is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances: 1) that the filings aren't presented for an improper purpose, 2) that the contentions in the filing are warranted by existing facts or circumstances and are non-frivolous, 3) that the contentions have or are likely to have evidentiary support, and 4) that any denials are reasonably based on lack of information or belief. If the ethical duty is violated, the attorney may be subject to monetary sanctions in a federal court. And as previously mentioned, the USPTO has additional rules for professional conduct for attorneys practicing before the office. The USPTO's Office of Enrollment and Discipline administers the various penalties if an attorney is found to have violated the rules of conduct.

Although bad faith does not by itself constitute an independent basis upon which to oppose or cancel a registration before the TTAB, bad faith form a key part of opposition or cancellation proceedings based upon allegations of fraud, false association, misrepresentation of source. If alleged, bad faith may also be a key factor in TTAB proceedings claiming a likelihood of confusion or dilution. It plays a similar role as well in court litigation concerning likelihood of confusion or dilution under sections 32 (infringement of a registered mark), 43(a)(1)(A) (infringement of an unregistered mark), 43(c) (dilution), and 43(d) (cybersquatting) of the U.S. Trademark Act. The burden of proof to establish these claims, and any related assertion of bad faith, is on the party asserting the claim. While there is no defined list of conditions that determine bad faith,

bad faith may be inferred from circumstantial evidence. Courts and the TTAB draw inferences from all of the surrounding circumstances, such as, but not limited to, whether the defendant was aware of the plaintiff's mark when it selected its mark; the degree of similarity of the respective marks; evidence of any copying or imitation of the plaintiff's mark, packaging formats or design elements; any prior business or employment relationship with the plaintiff; and the credibility of the defendant's explanation of the resemblances in the marks or packaging.

In a likelihood of confusion or dilution analysis, the TTAB or a court will weigh a number of factors, including the bad faith intent, fame (how well-known the mark is in the United States to the relevant sector of the public), and similarities of the marks and goods or services. A finding of bad faith intent is given great weight. Some courts have held that a finding of bad faith creates a "presumption" that confusion is likely, i.e., it is presumed that the applicant or registrant intended to cause confusion and that they were successful. Other courts have held that intent creates an "inference" that consumers are likely to be confused, and still others will simply give this factor great weight in a likelihood of confusion analysis. The flexibility in having a non-exhaustive list of factors for likelihood of confusion allows the Board or court to balance the factors and use a sliding scale in application: for example, the more evidence of bad faith, the less evidence is needed for establishing similarities in the goods or services and the fame of a mark. In any event, as a practical matter, evidence of bad faith requires the accused party to produce more persuasive evidence than ordinarily would be required to prove that confusion is unlikely.

Bad faith may also be addressed through challenges on the grounds of misrepresentation of source under section 14(3) of the U.S. Trademark Act, and refusals or challenges on the basis of a false suggestion of a connection under section 2(a) of the Act. In order to challenge on the grounds of misrepresentation of source, a party may petition to cancel a registration of a mark if the mark is being used by, or with the permission of, the respondent so as to misrepresent the source of the goods or services on or in connection with which the mark is used, regardless of whether the petitioner has used its mark in the United States. The petitioner must show that respondent took steps to deliberately pass off its goods as those of petitioner. E.g., *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1632 (TTAB 2014)

A mark may be refused by the USPTO or challenged under the U.S. Trademark Act on

the basis that the mark falsely suggests a connection with a person, living or dead, or institutions. To establish a false connection, it must be proven that (1) the mark sought is the same as or a close approximation of the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and (4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its good and/or services. E.g., *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985)

Finally, the USPTO has the following procedural mechanisms used to help identify and refuse applications made in bad faith, as well as tools to streamline oppositions and cancellations in the event a challenge is filed:

Requirement of a showing of bona fide use in commerce to maintain registration: A registrant must file specimens showing use of a mark in commerce by the sixth year of registration, and at every ten years following registration. If a registrant cannot demonstrate use in commerce, the registration will be cancelled.

Requirement for consent of a living individual in order to register his or her name: The USPTO requires the written consent of a living individual to the registration of his or her name, signature or portrait. This protects persons from the bad faith registration of the designations that identify him or her by unauthorized parties, and protects the rights of privacy and publicity that living persons have in their names, signatures, and portraits.

Suspension of the application process based on a pending relevant TTAB or court proceeding: The USPTO allows for suspension of a pending application based on a pending relevant TTAB or court proceeding. This process allows a good faith applicant to initiate a proceeding against a bad faith blocking application or registration without losing the priority date associated with its application. It prevents the "true owner" from having to appeal a refusal before the proceeding against the bad faith party has been resolved. It also increases judicial efficiency since the issues will be tried only once.

Default judgments: Default judgments are issued when no answer is filed in response to notice of a suit within the specified time. Default judgments prevent bad faith filers from avoiding the legal consequences of their actions by simply refusing to participate in a legal proceeding, and expedite termination of proceedings, thereby conserving judicial resources and reducing costs for parties.

Consolidation of cases in TTAB and court proceedings: The TTAB may consolidate multiple related opposition and/or cancellation proceedings into a single proceeding. U.S. courts have a similar power to consolidate related court cases. This procedure may be used when cases involve a common question of law or fact because it increases the efficiency of the courts and significantly lowers the legal costs of the parties, including parties fighting multiple bad faith filings.

Application of a market-based analysis by examiners and judges to determine the relatedness of goods or services in a likelihood of confusion analysis: A market-based analysis of the goods or services considers evidence of the trade channels, marketing practices, and target consumers of the respective goods or services to determine whether there is a likelihood of confusion. Use of a market-based analysis of the goods or services in a likelihood of confusion action helps to control bad faith registrations by preventing a competitor from filing a blocking registration in a directly competing product line as well as in a product line within a competitor’s logical field of expansion.

Letter of Protest Filed with the USPTO: A letter of protest is an informal procedure, in which third parties may bring to the attention of the USPTO evidence bearing on the registrability of a mark prior to registration. If accepted, the evidence is forwarded to the examiner for consideration. The evidence must relate to issues that can be prosecuted to a legal conclusion by the examiner in the course of ex parte examination. Even though bad faith or fraud are not independent grounds for refusal or letter of protest, depending on the nature of the evidence it may be relevant to other grounds of refusal.

○Summary of Applicable Provisions

Articles of the U.S. Trademark Act	Information provision (examination stage)	Oppositions	Trials for invalidation	Trials for rescission [no comparable proceeding or
------------------------------------	---	-------------	-------------------------	--

				cause of action in USPTO]
Lack of Intention to Use (Sections 1051(a) and 1052(b)(1); Section 1126(e); Section 1141f(a))	—	✓	✓	
False suggestion of a connection to a person or institution (Section 1052(a))	✓	✓	✓	
Name, signature or likeness of a living individual (Section 1052(c))	✓	✓	✓	
Likelihood of confusion (Section 1052(d))	✓	✓	✓	
Misrepresentation of source (Section 1064(3))	—	—	✓	
Dilution (Section 1125(c))	—	✓	✓	
Expungement; Reexamination (Sections 1064(6), 1066a and 1066b)			✓	Ex parte expungement and reexamination; Examiner decision appealable to TTAB

○Details of the measures available at the USPTO for the above provisions for bad-faith trademark filings

Measures	Target Trademark	Request Period	Demandant	Procedure
Information provision (examination stage) (Section 1051(f) – Letter of Protest)	Trademark application which is pending in the USPTO	No more than 30 days after publication for opposition, except in extraordinary circumstances.	Any person	Submit evidence through Trademark Electronic Application System (TEAS)
Opposition (Section 1063)	Trademark application published for opposition.	Within 30 days of the date of publication, or within any granted extension of time to file an opposition.	Any person who believes that he or she would be damaged by the registration of the mark.	File notice of opposition through the Electronic System for Trademark Trials and Appeals (ESTTA)
Trials for invalidation (Section 1064)	Registered trademark	Within five years from the date of registration of the mark or at any time if the registered mark becomes the generic name for the goods or services, or is functional, or has been abandoned, or	Any person who believes that he or she is or will be damaged by the registration of the mark.	File petition for cancellation through the Electronic System for Trademark Trials and Appeals (ESTTA)

		the registration was obtained fraudulently or contrary to the provisions of section 1054 or of subsections (a), (b), or (c) of section 1052, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services.		
Ex Parte Expungement (Section 1066a)	Registered trademark	Between the third and tenth year from registration date	Any party; Director of Trademarks	File petition with the Director of Trademarks; or Director of Trademarks may initiate
Ex Parte Reexamination (Section 1066b)	Registered use-based trademark	Filing date of averment of use	Any party; Director of Trademarks	File petition with the Director of Trademarks; or Director of Trademarks may initiate

Chapter 2:

Extracts of Related Articles of the TM5 Offices against Bad-faith Trademark Filings

[JPO]

Trademark Act (Extract)

(Requirements for trademark registration)

Article 3 (1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

(Unregistrable trademarks)

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

- (vii) is likely to cause damage to public policy;
- (viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);
- (x) is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;
- (xv) is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);
- (xix) is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding Items);

(Trial for rescission of trademark registration)

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

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

Trademark Law

(English version from WIPO Lex website, only for reference)

Article 4 Any natural person, legal person, or other organization desirous of acquiring the exclusive right to use a trademark for the goods produced, or services and activities offered by it or him shall file an application for the registration of the goods or services mark with the Trademark Office. A trademark application that is malicious and not for the purpose of use shall be refused.

Article 7 (a)The principle of good faith shall be upheld in the application for trademark registration and in the use of trademarks.

Article 10 (a)None of the following signs may be used as trademarks:

(8)Those detrimental to socialist ethics or customs, or having other unwholesome influences.

Article 13 A holder of a trademark that is well known by the relevant public may, if he holds that his rights have been infringed upon, request for well-known trademark protection in accordance with this Law.

Where the trademark of an identical or similar kind of goods is a reproduction, imitation, or translation of another person's well-known trademark not registered in China and is liable to cause public confusion, no application for its registration may be granted and its use shall be prohibited.

Where the trademark of a different or dissimilar kind of goods is a reproduction, imitation, or translation of another person's well-known trademark not registered in China and it misleads the public so that the interests of the owner of the registered well-known trademark are likely to be impaired, no application for its registration may be granted and its use shall be prohibited.

Article 15 Where an agent or representative, without authorization of the client, seeks to register in its own name the client's trademark and the client objects, the trademark shall not be registered and its use shall be prohibited.

An application for registering a trademark for the same kind of goods, or similar goods shall not be approved if the trademark under application is identical with or similar to an unregistered trademark already used by another party, the applicant is clearly aware of

the existence of the trademark of such another party due to contractual, business or other relationships with the latter other than those prescribed in the preceding paragraph, and such another party raises objections to the trademark registration application in question.

Article 16 (a) Where a trademark bears a geographical indication of the goods when the place indicated is not the origin of the goods in question, thus misleading the public, the trademark shall not be registered and its use shall be prohibited. However, where the registration is obtained in goodwill, it shall remain valid.

Article 19 (c) Where a trademark agency knows or should know that a trademark registration applied for by the principle violates the provisions of Article 4., Article 15 and Article 32 of this law, the trademark agency shall not act as an agent for said principle in application for the registration of that trademark.

Article 19 (d) Except for applying the use of one's own trademark, a trademark agency shall not register other trademark.

Article 30 Where a trademark, for the registration of which an application is made, that does not conform to the relevant provisions of this Law or that is identical with or similar to the trademark already registered by another person or is given preliminary examination and approval for use on the same kind of goods or similar goods, the trademark office shall reject the application and shall not announce that trademark.

Article 32 No applicant for trademark application may infringe upon another person's existing prior rights, nor may he, by illegitimate means, rush to register a trademark that is already in use by another person and has certain influence.

Article 33 Any holder of prior rights, or interested party may, within three months from the date of publication, in violation of the provisions of Article 13 Paragraph 2, Article 13 Paragraph 3, Article 15, Article 16 Paragraph 1, Article 30, Article 31, or Article 32, or any person may, in violation of the provisions of Article 4, Article 10, Article 11, or Article 12, file to oppose a trademark application that has been published after a preliminary examination and approval. Where no opposition is filed after three months, the application shall be approved for registration, certificate of registration shall issue, and the mark shall be published.

Article 44 (a) A registered trademark shall be declared invalid by the trademark office if it is in violation of Article 4, Article 10, Article 11, Article 12, Article 19 Paragraph 4 of this Law, or its registration is obtained by fraudulent or other illegitimate means. Other entities or individuals may request the trademark review and adjudication board to declare the aforesaid registered trademark invalid.

Article 45 (a) Where a registered trademark is in violation of the second and third paragraph of Article 13, Article 15, the first paragraph of Article 16, Article 30, Article 31 or Article 32 of this Law, the holder of prior rights or an interested party may, within five years upon the registration of the trademark, request the trademark review and adjudication board to declare the registered trademark invalid. Where the aforesaid registration is obtained mala fide, the owner of a well-known trademark is not bound by the five-year restriction.

【EUIPO】

European Union:

- Art. 59.1.b) of European Union Trade Mark Regulation (EUTMR): an EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the applicant was acting in bad faith when he filed the application for the trade mark.
- Art.8.3 EUTMR: upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his actions.

The concept of bad faith is not defined in the legislation, but the Court of Justice and the General Court of the European Union have provided guidance in their case-law.

The ground of bad faith applies where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark filed its application for registration not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin (12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 46).

In order to find out whether the owner of an EUTM had been acting in bad faith at the time of filing the application, an overall assessment must be made in which all the relevant factors of the individual case must be taken into account.

Case-law shows three factors (non exhaustive list) to be particularly relevant to indicate the existence of bad faith:

1. **Identity/confusing similarity of the signs:** the fact that the EUTM allegedly registered in bad faith is identical or confusingly similar to a sign to which the invalidity applicant refers may be a significant element for a finding of bad faith. Although in many cases where bad faith is found there is identity or confusing similarity with an earlier sign, likelihood

of confusion is not a prerequisite of bad faith (12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 51)..

2. **Knowledge of the use of an identical or confusingly similar sign:** the fact that the EUTM owner knew or should have known about the use of an identical or confusingly similar sign by a third party for identical or similar products or services may also be a significant element.
3. **Dishonest intention on the part of the EUTM owner:** This is a subjective factor that has to be determined by reference to objective circumstances

For further information, please see EUIPO Guidelines, Part D Cancellation, Section 2 Substantive Provisions, https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/02-part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf

TRADEMARK ACT (Extract)

Article 3 (Persons Entitled to Registration of Trademark) (1) Any person who uses or intends to use a trademark in the Republic of Korea may obtain registration of his/her trademark: Provided, That no employee of the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board shall obtain registration of a trademark while he/she is in office, except by inheritance or bequest.

Article 54 (Decision to Reject Trademark Registration) Where an application for trademark registration falls under any of the following, an examiner shall decide to reject trademark registration: (3) Where a trademark cannot be registered pursuant to Articles 3, 27, 33 through 35, 38 (1), the latter part of Article 48 (2), paragraph (4) or (6) through (8) of the aforesaid Article;

Article 117 (Trial to Invalidate Trademark Registration) (1) Where trademark registration or registration of additional designated goods falls under any of the following, an interested party or an examiner may request a trial to invalidate such trademark registration. In such cases, where at least two designated goods bearing the registered trademark exist, he/she may request a trial to invalidate the relevant trademark registration for each of the designated goods:

(i) Where trademark registration or registration of additional designated goods violates Articles 3, 27, 33 through 35, the latter part of Article 48 (2), Article 48 (4) and (6) through (8), and subparagraphs 1, 2 and 4 through 7 of Article 54;

Article 119 (Trial to Revoke Trademark Registration) (1) Where a registered trademark falls under any of the followings, a trial to revoke the trademark registration may be requested:

(iii) Where none of a trademark right holder, an exclusive licensee or a non-exclusive licensee has used the registered trademark on the designated goods in the Republic of Korea for at least three consecutive years without justifiable grounds before a trial to revoke the registered trademark is requested;

(5) Any person may request a trial to revoke trademark registration under paragraph (1): Provided, That a trial to revoke trademark registration on the grounds that the registered trademark falls under paragraph (1) 4 and 6 may be requested by an interested person only.

Article 34 (Trademarks Ineligible for Trademark Registration) (1) Notwithstanding Article 33, none of the following trademarks shall be registered:

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

(xi) Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation

(xii) Any trademark which is likely to mislead consumers about the quality of goods or device consumers

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

(xx) Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he/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;

(xxi) 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.

Article 92 (Relationship to Design Rights, etc. of Other Persons) (1) Where a trademark right holder, an exclusive licensee or a non-exclusive licensee uses his/her registered trademark, in which case his/her use of the registered trademark is in conflict with another person's patent right, utility model right or design right for which the application was filed prior to the filing date of an application for such trademark registration or another person's copyright created prior to the filing date of an application for such trademark registration depending on how the trademark is used, he/she shall not use the registered trademark on designated goods in conflict with the

relevant rights of others without the consent of the patentee, the holder of the utility model right, the holder of design right, or the holder of the copyright, respectively.

Trademark Act §1 (15 U.S.C. §1051) (Extract)

(a)

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be

prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b)

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein

Trademark Act §2 (15 U.S.C. §1052) (Extract)

No trademark by which the goods of the applicant may be distinguished from the goods

of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or 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 is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a 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 the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of

the mark or the goods on or in connection with which such mark is registered to the respective persons.

Trademark Act §14 (15 U.S.C. §1064) (Extract)

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such said prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark ! shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

Trademark Act §43 (15 U.S.C. §1125) (Extract)

(c) Dilution by Blurring; Dilution by Tarnishment.--

(1) Injunctive relief.--Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness,

shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions.

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), 'dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

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

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), 'dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions.--The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with--

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof.--In a civil action for trade dress dilution under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that--

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies.--In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 34. The owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity if--

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after the date of enactment of the Trademark Dilution Revision Act of 2006; and

(B) in a claim arising under this subsection--

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action.--The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this Act shall be a complete bar to an action against that person, with respect to that mark, that--

(A) is brought by another person under the common law or a statute of a State; and

(B)

(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause.--Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

Chapter 3:

Comparison Tables

- Tables summarizing comparisons of systems and practices in each Office**

Comparison Tables

Each office's system and practice concerning bad faith filings was compared and summarized in a table.

Note : “[Office-X](ex. [JPO-6])” in the item of judgment example etc. indicates the case number of “Upgraded Case Examples of Bad-Faith Trademark Filings”.

TM5 website (<http://tmfive.org/continuationexpansion-of-bad-faith-project-2-2-2-2/?red=>)

I. General					
	EUIPO	JPO	KIPO	CNIPA	USPTO
1. Definition of bad faith under the legal system	European Court of Justice: Bad faith is found where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark filed its application for registration not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining,	No definition	No definition	No definition	No definition

	EUIPO	JPO	KIPO	CNIPA	USPTO
	without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin (12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, ,§ 46).				
2. Timing when bad faith is taken up (applicable provisions)	<p>①Cancellation after registration: Art. 59(1)(b) EUTMR</p> <p>② Counterclaim in national infringement case: Art. 124 and 128 EUTMR</p>	<p>①Examination (by ex officio) § 3(1) § 4(1) (vii), (viii) , (x), (xv), (xix)</p> <p>②Opposition, trial (post registration) § 3(1) , § 4(1) (vii), (viii), (x), (xv), (xix)</p> <p>§ 53-2</p> <p>③Counterclaim in national</p>	<p>①Examination (by ex officio) § 34(1)(xi), (xii), (xiii), (xx)</p> <p>②Opposition, trial § 60(opposition) § 119(Trial to Revoke Trademark Registration)</p>	<p>① Examination (by ex officio), opposition, trial (invalidation) Articles4.1,13,15,32, 44.1</p>	<p>①Examination (by ex officio) § § 1052(a),(c),(d)</p> <p>②Opposition, § 1063(a) trial (cancellation), § 1064</p> <p>③ Civil action trial § § 1125 (a), (c)</p>

	EUIPO	JPO	KIPO	CNIPA	USPTO
		infringement case			
3.(1). The earliest stage when bad faith is taken up (applicable provisions)	After registration of mark: Art. 59(1)(b) EUTMR, Art. 124 and 128 EUTMR	Stage of examination § 3(1) § 4(1) (vii), (viii), (x), (xv), (xix)	Stage of examination § 34(1)(xi), (xii), (xiii), (xx)	Stage of examination	Stage of examination § 1062 Opposition § 1063
(2). Is there any time limit to claim bad faith? (applicable provisions)	No time limit	No time limit § 4(1) (vii), (xix)	No time limit	Where a registered trademark stands in violation of the provisions of Article 13 paragraph two and three, Article 15, Article 16 paragraph one, Article 30, Article 31, or Article 32 of this Law, the earlier right owners or any interested party may, within five years from the date of registration, request the Trademark Review and Adjudication Board to	Within 5 years, from the date of registration, but there is no time limit for a claim brought on fraud, false suggestion of a connection (“false association”), misrepresentation of source, or that the mark consists of the name, portrait or signature of a living individual. § 1064(1),(3)

	EUIPO	JPO	KIPO	CNIPA	USPTO
				declare the registered trademark invalid. Where the registration has been made in bad faith, the owner of a well-known trademark shall not be bound by the five-year time limit. If a bad faith is applied under Article 4.1 there is no time limit.	
4. What is an important time point when bad faith is legally identified?	At time of application	At time of application (also necessary at decision)	At time of application	At time of application	At time of filing the application, or at time of adoption of mark
5. Does a subjective element that applicant has an awareness of bad faith relate to judgment?	It does	It does	It does	It does	It does
6. Rules on burden of proof					
(1). Who bears	Cancellation applicant Demandant	Opponent Demandant	Opponent Demandant	Opponent Demandant	Opponent Demandant
(2). Presumption	Good faith is presumed unless cancellation applicant/demandant demonstrates bad faith.	It is inferred in consideration of circumstantial evidence.	It is inferred in consideration of circumstantial evidence.	Bad faith is inferred in consideration of some factual actions and circumstantial evidence.	Bad faith may be inferred by circumstantial evidence.

	EUIPO	JPO	KIPO	CNIPA	USPTO
7. Existence of checklist for establishing bad faith	Not exist (there is relevant case-law, referred to in Section 1 of this Appendix and further explained in EUIPO Guidelines)	Not exist	Not exist (There are a certain guidelines.)	Not exist (There are relevant articles for reference in the Trademark Trial Standard)	Not exist

II. Details

	EUIPO	JPO	KIPO	CNIPA	USPTO
1. From The View of “Intent to Use”					
Does lack of intention of use become a reason for rejection or invalidation?	No, unless specific factors concur (see below)	Yes It is possible to refuse or invalidate regardless of bad faith if there is no intention of use.	Yes It is possible to refuse or invalidate regardless of bad faith if there is no intention of use.	After amendment of Trademark Law in 2019 according to Article 4.1, an application which is not for the purpose of use may be determined to be bad faith. Where a registered trademark has not been used for an uninterrupted period of three years without justified reasons, any entity or individual may request the Trademark Office to cancel the registered trademark.	Yes A verified statement of bona fide intent to use must be filed. Examiner will not evaluate intent and will not make an inquiry unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce. May be challenged by third party in opposition or cancellation.
i) Text	Article 59(1)(b)	Main Paragraph of Article 3(1)	Article 3(1) [Examination] Article 54(3) [Examination] Article 117(1)(i) [trial] Article 119(1)(iii) and (5) [trial]	Paragraph 2 of Article 49 Paragraph 1 of Article 4	Section 1051 (b) Section 1126(e) Section 1141f (a)

	EUIPO	JPO	KIPO	CNIPA	USPTO
ii)At time of judgment standard	Assessment whether bad faith was present at the time when the registered mark was applied for	At time of decision	At time of decision	At time of application	At time of application
iii)Examination by ex officio or opposition, trial	(1) Cancellation (invalidity) trial (2) Counterclaim in national infringement proceedings (trial)	(1) Examination (by ex officio) (2) Opposition, trial	(1) Examination (by ex officio) (2) Cancellation (invalidity) trial	(1) Examination (by ex officio) (2) Opposition, Cancellation(invalidity) trial	(1) Examination (by ex officio) when no verified statement of intention to use is filed (2) Opposition, trial (cancellation)
iv)Burden of proof	Party claiming that other side was in bad faith, i.e. invalidity applicant or the defendant in national infringement proceedings (counterclaim)	(1)(2) Applicant, right owner	(1)(2) Applicant, right owner	(1) Applicant of Opposition and Cancellation (invalidity) should prove the trademark owner(applicant) is lack of intention of use. (2) The owner (applicant) of trademark should submit evidence of use.	(1) Prior to registration, Section 1 applicants must prove good faith by submitting specimens of use for the goods/services in the application. (2) Opponent, Petitioner
v)Examination standard	Guidelines for examination, Part D, Section 2, Sub-heading 3.3	Trademark Examination Guideline, Main Paragraph of Article 3(1) The Trademark Examination Manual	Trademark Examination Guideline Section 2.2	Trademark Trial Standards Part 7(5)	Trademark Manual of Examination Procedure (TMEP) § 818 (Section 1051 (b) or Section 1126(e)) TMEP §

	EUIPO	JPO	KIPO	CNIPA	USPTO
		41.100.03			1904.01(c) (Section 1141f (a))
vi) Specific judgment method					
(1) Factors to be considered in determining the lack of intention to use	Lack of intention to use could be an indication of dishonest intention and bad faith if it becomes apparent subsequently that the owner's sole objective was to prevent a third party from entering the market (11/06/2009, C 529/07, Lindt Goldhase, EU:C:2009:361 § 44) and/or to obtain economic advantages (07/07/2016, T-82/14, LUCEO, EU:T:2016:396, § 126). [EUIPO-7]	If the following conditions set forth in (a) and (b) below are met, the examiner determines that the application is in violation of the main paragraph of Article 3(1) on the grounds that there is an extremely low probability for the applicant to use the trademark and there are reasonable doubts as to whether or not the applicant uses or has the intention to use the trademark. In addition, when the following conditions are	Trademark Examination Guidelines The following are cases in which there is a reasonable doubt whether the applicant is willing to use it. a) Where an individual designates goods or services requiring large-scale capital, facilities, etc.; b) In the case of designating multiple types of unrelated goods/services are claimed irrespective of number of classes;	According to Regulations on Regulating Trademark Application for Registration, when judging whether an application is in violation of Article 4 of the Trademark Law, the Trademark Office may comprehensively consider the following factors: (1) The number of trademarks applications, the designated classification, trademark transactions, etc. of the applicant or the related natural person, legal person and other organization, etc;	The evidentiary bar for showing bona fide intent to use is not high, but more is required than "a mere subjective belief." The objective evidence must indicate an intention to use the mark that is "firm" and "demonstrable." The absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce establishes a prima facie case that an

	EUIPO	JPO	KIPO	CNIPA	USPTO
		<p>met, even when the applicant has submitted a document certifying his/her intention to use the trademark, it is obvious that the applicant will not use the trademark, thus, the reasonable doubts will not be resolved.</p> <p>(a) The applicant has filed an unconceivably high number of applications for a trademark to be used by a single applicant for the goods or services in consideration of the past number of applications filed by the applicant (not less than 1,000 applications per year).</p> <p>(b) The applicant's use or intention of use of the</p>	<p>c) Where an individual designates two or more goods/services that are not connected with a product or service that requires certain qualifications, etc. under the law;</p> <p>d) If there is a doubt that an applicant is filing a mark without intention to use it, but only as a bid to preoccupy the mark, or to exclude anyone else from registering the mark.</p>	<p>(2) The industry and business status of the applicant, etc.;</p> <p>(3) The applicant has been identified that he has engaged in malicious trademark registration or infringement, etc. by an effective administrative decision, ruling or judgment;</p> <p>(4) The trademark applied for registration is same as or similar to the trademark well-known to the public;</p> <p>(5) The trademark applied for registration is same as or similar to the name of a well-known person or enterprise, abbreviation of enterprise name or other</p>	<p>applicant lacks such intention as required by law.</p> <p>Factors to be considered include documentary or other evidence to show any concrete steps taken or plans made to actually use a mark contemporaneous with filing an application, such as manufacturing, licensing or marketing efforts, a functioning website, correspondence with potential licensees, marketing plans, business plans, or the creation of labels or promotional materials.</p> <p>The U.S. Trademark Act does not expressly impose any specific</p>

	EUIPO	JPO	KIPO	CNIPA	USPTO
		<p>trademark cannot be confirmed from the applicant's website or news report, 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.).</p> <p>The Trademark Examination Manual 41.100.03 “Regarding the Operation for the Examination for Confirming the Applicant's Use or Intention of Use of a Trademark” 4. When the examiner has reasonable doubts as to whether the applicant uses or has the intention to use the trademark due to the number of applications</p>		<p>commercial marks;</p> <p>(6) Any other factors the Trademark Office believe should be considered.</p>	<p>requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record.</p>

	EUIPO	JPO	KIPO	CNIPA	USPTO
		filed by the applicant in the past			
(2) Others	<p>Repetition of application of the same mark to prevent cancellation for non-use may suggest dishonest intention and therefore bad faith of the EUTM owner. On the other hand, if there is commercial logic to the filing of the EUTM and it can be assumed that the owner intended to use the sign, this would indicate that there was no dishonest intention. For example, when the owner had a commercial incentive to protect its national mark at EU level due to the expansion of its business (14/02/2012, T-33/11, Bigab, EU:T:2012:77 §</p>	Nothing, in particular	Nothing, in particular	(1)-(6) are totally considered together with other elements to identify bad-faith	Each case is fact specific, and the trier of fact would weigh evidence carefully.

	EUIPO	JPO	KIPO	CNIPA	USPTO
	20, 23).				
vii)Examination example, decision example, judgment example	<p>No examination examples. Decisions referred in the summaries. Examples of judgments:</p> <ul style="list-style-type: none"> • 「Lindt Goldhase」 (CJ judgment of 11/06/2009, C-529/07) • 「BIGAB」 (GC judgment of 14/02/2012, T-33/11) • 「Pelikan」 (GC judgment of 13/02/2012, T-136/11) • 「Luceo」 (GC judgment of 07/07/2016, T-82/14) [EUIPO-7] • 「Neymar」 (GC judgment of 14/05/2019, T-795/17) • 「Stylo & Koton」 (ECJ judgment of 12/09/2019, C-104/18 P) 	<p>There is the following judgement.</p> <ul style="list-style-type: none"> • 「RC TAVERN」 (Intellectual Property High Court, 2012 (Gyo Ke) No. 10019). [JPO-10] 	<p>istar logitics case (Case No. 2010Heo4397, rendered by the Patent Court on Oct. 7, 2010)</p>	—	<p>The following are some examples of judgments.</p> <ul style="list-style-type: none"> • M.Z. Berger & Co. v. Swatch AG, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015) • A&G Sportswear Co., Inc. v. William W. Yedor, 2019 USPQ2d 111513 (TTAB 2019) • Honda Motor Co. , Ltd. v. Friedrich Winkelmann, 90USPQ2d1660 (TTAB2009)

	EUIPO	JPO	KIPO	CNIPA	USPTO
2. From The View of “Unfair Intention”.					
Is there any legislation for refusing an application (or invalidating the registration) on the basis of unfair intention?	Not for refusing an application, only for invalidating a registration. Dishonest intention of EUTM owner is an element of particular relevance in the assessment of bad faith. No legislation, but clear indications in case-law, namely in the definition of bad faith provided by the European Court of Justice in 12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 46 (see above, point I.1.) .	Yes	Yes	Yes	Yes. Also, consideration of intentions of applicant indicated in case-law. Bad faith is an element to consider in a likelihood of confusion analysis. Bad faith may also be considered in a claim of misrepresentation of source claim under Section 14(3).
i) Text	Article 59(1)(b)	Article 4(1)(vii) Article 4(1)(xix)	Article 34(1)(xiii) Article 34(1)(xx) Article 34(1)(xxi)	Article 32	Section 1051(b)(1) (“A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request

	EUIPO	JPO	KIPO	CNIPA	USPTO
					registration[.]” Case law: In re E.I.DuPont DeNemours & Co., 476 F.2d 1357 (CCPA 1973); Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961))
ii)At time of judgment standard	Assessment whether bad faith was present back when registered mark was applied for	At time of decision (Article 4(1)(vii)) At time of application and decision (Article 4(1)(xix))	At time of application [Article 34(1)(xiii) and Article 34(1)(xx) and Article 34(1)(xxi)]	At time of application	At time of application
iii)Examination by ex officio or opposition, trial	(1) Cancellation (invalidity) trial (2) Counterclaim in national infringement proceedings (trial)	(1) Examination (by ex officio) (2) Opposition, trial	Examination (by ex officio)	Opposition, trial	(1) Examination (by ex-officio) (2) Opposition, trial for cancellation
iv)Burden of proof	Party claiming that other side was in bad faith, i.e. invalidity applicant or defendant in national infringement proceedings (counterclaim)	Burden of proof is on the side who insist on unfair purpose.	Burden of proof is on the side to insist on unfair purpose.	Burden of proof is on the side who insist on unfair purpose.	Party claiming bad faith Once burden established, shifts to Applicant or registrant.

	EUIPO	JPO	KIPO	CNIPA	USPTO
v)Examination standard	Guidelines for examination, Part D, Section 2, Sub-heading 3.3	Trademark Examination Guideline, Article 4(1)(vii) and (xix)	There are some standards. . (Trademark Examination Guideline 5.13. and 5.20. and 5.21.)	There are some standards.	Although the application will not be specifically examined for intent of applicant, any evidence of unfair intention can be considered in examining likelihood of confusion.
vi)Specific judgment method					
Whether the following facts and situations ((1)~(5)) may be taken into consideration to judge unfair intension of trademark					
(1) Business cooperation and some relations such as purchase request	A relationship between the parties before application is one relevant element when assessing bad faith. Compensation request, in combination with other factors, may also serve to establish bad faith.	This is taken into consideration when unfair intension is identified.	A relation between applicant and trademark right owner is one element to identify bad faith.	This is one element to identify a bad faith.	This is taken into consideration when assessing bad faith.

	EUIPO	JPO	KIPO	CNIPA	USPTO
(2) Applicant designates a broad range of goods and services.	In principle, bad faith is not found on the basis of the length of the list of goods and services designated. As a rule, it is legitimate for an undertaking to seek registration of a mark not only for the categories of goods and services that it markets at the time of filing the application but also for other categories of goods and services that it intends to market in the future (14/02/2012, T-33/11, Bigab, § 25). Nevertheless, the registration of a trade mark by an applicant without any intention to use it for the goods and services covered by that registration may constitute bad faith where there is no rationale for the	This is taken into consideration when unfair intension is identified.	One element to identify a bad faith according to the judgment (Case No. 2007Heo2626)	This may be one element to identify bad faith.	This may be evidence of bad faith or lack of bona fide intent to use.

	EUIPO	JPO	KIPO	CNIPA	USPTO
	application for registration (29/01/2020, C-371/18, SKY, § 77).				
(3) Applicant applied for a large number of unregistered trademarks of other person.	A large number of applications for trade marks of others can be a strong indication that owner of registered EUTM had dishonest intention when applying for it.	This is taken into consideration when unfair intension is identified.	This may be one element when the Patent Court identifies a bad faith.	This is one element to identify a bad faith.	This may be evidence of bad faith.
(4) Is any relationship between the original owner of the trademark and applicant required?	This is not a condition for a finding of bad faith, but a relevant factor to be taken into consideration in the assessment	This is not essential, but taken into consideration when unfair intention is identified.	This is not necessary, but if there's any relation between the both, a bad faith may be highly recognized.	One factor to identify a bad faith.	This is not a requirement, but may be a factor to consider in determining bad faith.
(5) Others	<ul style="list-style-type: none"> - Repetition of application of same mark to prevent cancellation for non-use may suggest dishonest intention of EUTM owner. - when the purpose of the EUTM applicant is to 'free-ride' on the reputation of the invalidity applicant 	<p>Article 4(1)(vii)</p> <ul style="list-style-type: none"> • Whether its registration is contrary to the order predetermined under the Trademark Act. For example, whether it is utterly unacceptable for lack of social reasonableness in the 	<ul style="list-style-type: none"> • Famousness of well-known and famous trademark • Creativity of well-known trademark • Preparation state of business of applicant • Whether designated goods and services are same or 	<p>(1) Whether the common area of the applicant of the pending trademark and the holder of the trademark or the goods/services of the both sides are within the same sales route and range or not;</p> <p>(2) Whether another</p>	The TTAB or a court has broad discretion to consider any number of factors that could provide circumstantial evidence of bad faith, such as bad faith in disclosure of evidence during discovery.

	EUIPO	JPO	KIPO	CNIPA	USPTO
	<p>(14/05/2019, T-795/17, NEYMAR, § 51) or on its registered marks and to take advantage of that reputation (08/05/2014, T-327/12, Simca, § 56), even if those marks have lapsed</p> <p>A request for financial compensation made by the EUTM owner to the invalidity applicant may lead to a finding of bad faith if there is evidence that the EUTM owner knew of the existence of the earlier identical or similar sign and expected to receive a proposal for financial compensation from the invalidity applicant (08/05/2014, T-327/12, Simca, § 72).</p>	<p>background to the filing of an application for trademark registration.</p> <p>Article 4(1)(xix)</p> <ul style="list-style-type: none"> • Well-Known of other person’s trademark • Creativity of well-known trademark • Preparation state of business of well-known trademark owner • Prevention of the market entry of foreign right holder of trademark • Concern to impair credibility, reputation and customer attraction of well-known trademark 	<p>similar, or presence/absence of economic relation</p>	<p>conflict has been present between the applicant of the pending trademark and the holder of the trademark or not, and whether the both sides knew trademark of a prior user or not;</p> <p>(3) Whether intercommunication between the applicant of the pending trademark and the members of the holder (organization) of the trademark has been made or not;</p> <p>(4) Whether the applicant of the pending trademark intends to gain unfair profits after registration or not, and whether the applicant of the pending trademark conducts misleading advertisement, enforces dealing and</p>	

	EUIPO	JPO	KIPO	CNIPA	USPTO
	[EUIPO-9]			<p>partnering (on a trademark) to the prior user, releases the trademark to the prior users or other persons at a high price, and charges them a license fee or compensation of infringement of right by utilizing a certain good fame and impact of the trademark possessed by the trademark holder, or not;</p> <p>(5) Whether the trademark has more significant originality than trademarks of other persons or not; and</p> <p>(6) cases considered as maliciousness.</p>	

	EUIPO	JPO	KIPO	CNIPA	USPTO
vii)Examination example, decision example, judgment example	<p>Apart from those quoted in the summaries, there are, inter alia, the following judgments.</p> <ul style="list-style-type: none"> • 「Lindt Goldhase」 (CJ judgment of 11/06/2009, C-529/07) • 「BIGAB」 (GC judgment of 14/02/2012, T-33/11) • 「Pelikan」 (GC judgment of 13/02/2012, T-136/11) • 「SKY」 (ECJ judgment of 29/01/2020, C-371/18. • 「NEYMAR」 (GC judgment of 14/05/2019, T-795/17, • 「Simca」 (GC judgment of 08/05/2014, T-327/12 [EUIPO-9]) 	<p>There are the following judgments.</p> <ul style="list-style-type: none"> • 「Asrock」 (Intellectual Property High Court, 2009 (Gyo Ke) No. 10297 [JPO-2]) • 「KYOKUSHIN」 (Intellectual Property High Court, 2005 (Gyo Ke) No. 10032) • 「DUCERAM」 (Tokyo High Court, 1998 (Gyo Ke) No. 185) • 「Kranzle」 (Intellectual Property High Court, 2005 (Gyo Ke) No. 10668) 	<p>There is the following judgment.</p> <ul style="list-style-type: none"> • 「TOM & JERRY」 (Case No. 2007Heo2626) • 「LVY」 (Case No. 2013Hu2484) • 「BarbieQueen」 (Case No. 2013Hu1986) 	<p>There are some examples.</p> <ol style="list-style-type: none"> ①「黑面蔡」 Trademark opposition case (No. 1611206) ②KUREYON Shinchan Figure trademark dispute case (No. 1033444) ③「ERE」 Trademark opposition case (No. 4809737) 	<p>There are the following examples:</p> <ul style="list-style-type: none"> • Estrada v. Telefonos de Mexico, 447F.App'x197 (Fed. Cir. 2011) • Edom Laboratories, Inc. v. Glenn Lither, 102 USPQ2d 1546 (TTAB 2012) • L'Oreal S.A. and L'Oreal USA, Inc. v. Robert Victor Marcon, 102 USPQ2d 1434 (TTAB 2012)

	EUIPO	JPO	KIPO	CNIPA	USPTO
3. From The View of “Protecting Well-Known/Famous”					
Are trademark application in bad faith rejected or invalidate by protection of well-known and famous trademarks?	There is no separate law. But, level of distinctiveness, reputation of mark of cancellation (invalidity) applicant and EUTM right owner is taken into consideration when bad faith is identified.	Yes	Yes	Yes	Yes
i)Text	Article 59 (1)(b)	Article 4(1)(x) Article 4(1)(xv) Article 4(1)(xix)	Article 34(1)(xiii)	Article 13	False Association : Section 1052(a) and Section 1125 (a) Likelihood of confusion : Section 1052(d) Dilution : Section 1125 (c) Misrepresentation of Source Section 1064 (3)
ii)At time of judgment standard	Assessment whether bad faith was present at the time when registered mark was applied for	At time of application and decision	At time of application	At time of application	At time of application
iii)Examination by ex officio or opposition, trial	Cancellation (invalidity) trial	(1) Examination (by ex officio)	(1) Examination (by ex officio)	Opposition, trial	(1) Examination (by ex officio) (False association)

	EUIPO	JPO	KIPO	CNIPA	USPTO
	Counterclaim in national infringement proceedings	(2) Opposition, trial	(2) Opposition, trial		-§ 1052(a) and likelihood of confusion -§ 1052(d)) (2) Trial for opposition and cancellation
iv)Burden of proof	Party claiming that other side was in bad faith, i.e. invalidity applicant or defendant in national infringement proceedings.	Burden of proof is on the side to claim that the application falls under Article 4(1)(x), (xv) or (xix).	Burden of proof is on the right owner of well-known and famous trademark.	Burden of proof is on the owner of well-known trademark.	Opposer/Demandant (i.e., party claiming bad faith)
v)Examination standard	Guidelines for examination, Part D, Section 2, Sub-heading 3.3	Trademark Examination Guideline, Article 4(1)(x), (xv) and (xix).	There are some standards. (Trademark Examination Guideline 5.13.)	Trademark Law, Article 13, Article 14 Regulations for the Implementation of the Trademark Law, Article 3	TMEP Sections 1207 Likelihood of confusion and 1203.03(c) False Association
vi)Specific judgment method					
Whether the following facts and situations ((1)~(11)) are taken into consideration in judging elements of well-known and famous trademarks.					
(1) Definitions of “well-known”, “famous”	• “Well-known” (EUTMR 8(2)(c)) is same as in	• No definition of each phrase	• No definition of each phrase	It is stipulated that facts of advertisement activities	• “Well-known” is identified when likelihood

	EUIPO	JPO	KIPO	CNIPA	USPTO
and “reputation” Standard and evidence of well-known famousness	<p>Article 6 bis of the Paris Convention.</p> <p>"Reputation" (Article 8(5) EUTMR).</p> <ul style="list-style-type: none"> • Kindred notions. <p>Threshold for establishing "well-known character" or "reputation" is, in practical terms, usually the same.</p> <ul style="list-style-type: none"> • Level of distinctiveness or reputation is taken into consideration when bad faith is assessed, but it is not a prerequisite for a finding of bad faith. 	<ul style="list-style-type: none"> • For “well-known” and “famous”, facts of advertisement activities and trademark use period are totally taken into consideration. 	<ul style="list-style-type: none"> • For “well-known” and “famous”, facts of advertisement activities and trademark use period are totally taken into consideration. 	<p>and trademark use period are totally taken into consideration on examination standard.</p>	<p>of confusion is judged.</p> <p>“Famous” for dilution purposes is identified when dilution is judged (widely recognized by general consuming public).</p> <ul style="list-style-type: none"> • There’s no specific standard for “reputation” • For “well-known”, among other factors, advertisement activities and trademark use duration are taken into consideration

	EUIPO	JPO	KIPO	CNIPA	USPTO
(2) If well-known trademark is registered in areas where application in bad faith is made, but is not used for some periods, are some provisions of bad faith applied?	Potentially yes; see GC judgment of 8 May 2014, T 327/12, Simca, EU:T:2014:240 (the well-known mark was registered but had not been used for a certain time; it was still protected against a bad faith registration) [EUIPO-9]	May be refused due to similarity with original trademark.	May be refused due to similarity with original trademark.	May be refused due to similarity with original trademark. However, where a registered trademark has not been used for an uninterrupted period of three years without justified reasons, any entity or individual may request the Trademark Office to cancel the registered trademark.	If any mark is registered with the USPTO and not used for three years in the United States, there is a rebuttable presumption that the mark has been abandoned; therefore, the registration may be subject to cancellation on grounds of abandonment due to non-use. However, in certain limited circumstances where a mark retains “residual” goodwill after non-use, courts are unlikely to find in favor of a new user whose intent was to confuse consumers by capitalizing on the previous owner’s reputation.
(3) Laws for trademarks which are well-known and famous only in foreign	No specific law for foreign famous marks, but nothing prevents that they are also	Article 4(1)(xix)	Article 34(1)(xiii)	No laws	No law

	EUIPO	JPO	KIPO	CNIPA	USPTO
countries	protected against a bad faith registration.				
(4) Judgment and evidence of “Well-known” and “famous” of trademarks which are well-known and famous only in foreign countries	It is necessary for cancellation (invalidity) applicant to demonstrate that EUTM owner knew or must have known about the existence of the cancellation applicant's mark outside the EU. "Well-known" character may help to establish this, depending on the specific circumstances of the case.	Trademark Examination Guideline, Article 4(1)(xix)	Article 34(1)(xiii) was revised (“easily” is deleted) and the standard of famousness was relaxed. • There’ s a decision by Supreme Court that judgment to recognize famousness of trademark in foreign country should be respected (case No. 2008Hu3131)	No laws	No law
(5) Do well-known and famous trademarks protect up to non-similar goods and services?	The extent of a declaration of invalidity based on bad faith will be determined on the basis of the evidence and arguments provided by the invalidity applicant and will depend on the nature of the specific behaviour constituting bad faith.	They are protected if any likelihood of confusion (Article 4(1)(xv)) or unfair purpose (Article 4(1)(xix)) are recognized.	There are some cases in which well-known and famous trademarks are protected up to non-similar goods and services, such as 「LVY」 (Case No. 2013Hu2484) or 「BarbieQueen」 (Case No. 2013Hu1986)	Yes. Paragraph 3 of Article 13 provides protection on non-identical or dissimilar goods/services for well-known trademarks that are registered in China.	Under § 1052(d), protected if there is a likelihood of confusion. The higher the fame, the lesser degree of similarity between goods/services is required to find likelihood of confusion. Under §1125(c) (dilution), there

	EUIPO	JPO	KIPO	CNIPA	USPTO
	<p>For example:</p> <ul style="list-style-type: none"> • where the contested EUTM was filed with the deliberate purpose of creating an association with the invalidity applicant (14/05/2019, T-795/17, NEYMAR, § 55), the EUTM will normally be declared invalid in its entirety; • where bad faith is found because of the absence of any intention to use the trade mark, the EUTM may be declared only partially invalid if the invalidity applicant cannot adequately establish that such bad faith applies to all the goods and services (29/01/2020, C-371/18, SKY, § 81). 				<p>may be tarnishment or dilution if no similarity of goods or services.</p>

	EUIPO	JPO	KIPO	CNIPA	USPTO
(6) Co-relation between extent of recognition of trademark and burden of proof in bad faith	Extent of recognition of mark is just one element in the assessment. Proving recognition does not relieve the cancellation (invalidity) applicant of his burden of proof as regards bad faith in general.	<ul style="list-style-type: none"> • Bad faith unnecessary (Article 4(1)(x),(xv)) • There's any relation between well-known and unfair purpose (necessary to prove unfair purpose) (Article 4(1)(xix)) 	Extent of famousness of trademark is one element to evaluate bad faith.	<p>Together with other elements, depending on the claim</p> <p>The burden of proof can be reduced correspondingly, according to extent of famousness of trademark</p>	<p>To determine likelihood of confusion, bad faith or fame is not necessary.</p> <p>But if present, both are factors the trier of fact will weigh in a likelihood of confusion analysis.</p>
(7) Level of distinctive character of trademark (such as coined word)	One element in the evaluation of bad faith.	One element to take into consideration when likelihood of confusion or bad faith is judged	One element to evaluate a bad faith	One element to consider	Taken in consideration when the likelihood of confusion is determined, and becomes circumstantial evidence when judging bad faith.
(8) When identical or similar to house mark of other person	One element to take into consideration in the evaluation of bad faith.	This is one element to take into consideration when bad faith is identified.	This is one element to take into consideration when bad faith is identified.	This may be one element to identify bad faith.	Possible to be an element of consideration when determining bad faith.
(9) Presence/absence of exclusion period to claim bad faith	No period	No period	No period	5 years, but no time restriction for well-known trademark.	A likelihood of confusion claim, with an assertion of bad faith, may be brought within 5 years of registration. There is no time limit for a claim brought on fraud, false

	EUIPO	JPO	KIPO	CNIPA	USPTO
					association, misrepresentation of source, or that the mark consists of the name, portrait or signature of a living individual.
(10) If a mark which is claimed to be applied in a bad faith acquires well-known characteristic or reputation, is there any relation?	No	No Time of judgment standard is time of decision or trial decision, therefore, if well-known or reputation is later acquired, there's no relation with invalidation trial request.	No	No. Commonly, the fame of the trademark that is alleged to have been filed in bad faith is not relevant.	No, the fame of the trademark that is alleged to have been filed in bad faith is not relevant.
(11) Other reasons	No reason	No reason	No reason	No reason	Fame of prior trademark plays a dominant role in a case of likelihood of confusion.
vii) Examination example, decision example, judgment example	There are, inter alia, the following judgments. • 「Lindt Goldhase」 (ECJ judgment C-529/07 of June 11, 2009) • 「Simca」 (GC judgement,	There are the following judgments. 4-1-10 case example • 「Computer world」 (Tokyo High Court, 1991 (Gyo Ke) No. 29)	There is the following judgment. • 「TOM & JERRY」 (Case No. 2007Heo2626) • 「LVY」 (Case No. 2013Hu2484)	There are some examples. ① 「金灶」 (金竈) Trademark opposition case (No. 4481864) ② 「雅虎 YAHOO」 Trademark opposition	Example of affirmed examination rejection: In re West L.A. Corp. d/b/a California Beemers, 2019 WL 5079823 (Serial No. 87-354651) [not

	EUIPO	JPO	KIPO	CNIPA	USPTO
	<p>T-327/12, of 08/05/2014) [EUIPO-9],</p> <p>Bad faith in relation to a mark registered in a non-EU country:</p> <ul style="list-style-type: none"> • 「DoggiS」 (GC judgement, T-327/12 of 28/01/2016) [EUIPO-4] 	<p>4-1-15 case example</p> <ul style="list-style-type: none"> • 「L’Air du Temps」 (Supreme Court, 1998 (Gyo Hi) No. 85) [JPO-6] <p>4-1-19 case example</p> <ul style="list-style-type: none"> • 「iOffice 2000」 (Tokyo High Court, 2001 (Gyo Ke) No. 205) • 「S (design)」 (Intellectual High Court, 2009 (Gyo Ke) No. 10220) • 「MARIE FRANCE」 trial decision (1995 Trial No. 25958) [JPO-7] • 「M.A.C • MAKEUP ART COLLECTION」 Opposition decision (1998 Opposition No. 92239) [JPO-8] 	<ul style="list-style-type: none"> • 「BarbieQueen」 (Case No. 2013Hu1986) 	<p>re-examination (rejection decision dissatisfaction trial) case (No. 1649903)</p> <p>③“神州三号”Trademark opposition case (No. 3217926)</p>	<p>precedential]</p> <p>The following are opposition examples:</p> <ul style="list-style-type: none"> • L’Oreal S.A. v. Marcon, 102 USPQ2d 1434 (TTAB 2012) Allergan, Inc. v. Gems Style Inc., 2020 WL 6581861 (TTAB 2020) [not precedential]

	EUIPO	JPO	KIPO	CNIPA	USPTO
4. Unfair Application filed by Agent or Representative					
Is there any legislation for refusing an unfair application (or invalidating the registration) filed by agent or representative (related to Article 6 section of the Paris convention)	Yes	Yes	KIPO has no such a law. However, if such an application is considered to be filed under the bad-faith, such as free-ride on the fame of a third party, the application can be rejected.	Yes	No specific legislation referencing agents or representatives, however if such an application is filed without required good faith on part of applicant, the application can be opposed.
i)Text	Article 8 (3) EUTMR Article 60(1)(b) EUTMR	Article 53 -2		Article 15	Section 1051(a)(1), Section 1051 (b), Section 1126, Regulation governing good faith dealings with USPTO by all parties: 37 C.F.R. Section 11.18
ii)At time of judgment standard	At time of application	At time of application and decision		At time of application	Application date
iii)Examination by ex officio or opposition, trial	①Opposition against application (Article 8 (3) EUTMR) ②Cancellation/Invalidity or counterclaim against	Cancellation trial	—	Opposition or trial	①Examination (ex parte) if evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark.

	EUIPO	JPO	KIPO	CNIPA	USPTO
	registered mark (Article 8 (3) EUTMR and Article 60(1)(b) EUTMR)				②Opposition or cancellation
iv)Burden of proof	Opponent or invalidity applicant. But for "negative facts", burden of proof reversed, e.g. agent to prove that he had owner's consent	Burden of proof is in principle on demandant.	—	Burden of proof is on the owner of trademark. (Opponent, demandant)	Opponent, demandant
v)Examination standard	Guidelines for examination, Part C, Section 3 Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR). For bad faith, see above	No standard	—	Trademark Trial standards Part 2	TMEP § 1201.06(a)
vi)Specific judgment method	See EUIPO Guidelines for examination, Part C, Section 3 Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)	See vii)	—	Refer to the Trademark Trial standards in v)	See TMEP § 1201.06(a)

	EUIPO	JPO	KIPO	CNIPA	USPTO
vii)Examination example, decision example, judgment example	<p><u>EUIPO Boards of Appeal:</u> - 19/05/2011, R 85/2010-4, LINGHAMS’S (fig.) / LINGHAMS’S (fig.), § 14; - 03/08/2010, R 1231/2009-2, BERIK (fig.) / BERIK et al., § 24; - 30/09/2009, R 1547/2006-4, POWERBALL / POWERBALL, § 17</p> <p><u>General Court:</u> 6/09/2006, T-6/05, First Defense Aerosol Pepper Projector, EU:T:2006:241, § 38;</p>	<p>There is the following judgment.</p> <ul style="list-style-type: none"> • 「Chromax」 (Intellectual High Court, 2011 (Gyo Ke) No. 10194) [JPO-11] 	—	<p>There are some examples.</p> <p>① 「BRUNO MANETTI」 Trademark opposition case (No. 3083605)</p> <p>②“头包西灵 Toubaoxilin” Trademark opposition case (No. 3304260)</p> <p>③“安盟 SecurID” Trademark opposition re-examination (No. 3514462)</p>	<p>The following is one example.</p> <ul style="list-style-type: none"> • Lipman v. Dickinson, 174 F.3d 1363,1372 (Fed. Cir. 1999)

	EUIPO	JPO	KIPO	CNIPA	USPTO
5. From The View of The Relationship with Other Rights					
Is there any legislation for refusing an application (or invalidating the registration) as bad-faith on the basis of certain factors? (such as copyright)	<ul style="list-style-type: none"> • Copyright as a ground for invalidity/cancellation (EUTMR 60(2)) • Different invalidity ground from that of bad faith (EUTMR 59(1)(b)) 	<ul style="list-style-type: none"> • Name of other person 	Yes, but it is not considered bad faith.	Yes	<p>Copyright or right of publicity: not a ground for opposition or cancellation at the USPTO; party may file a civil lawsuit on grounds of copyright infringement or right of publicity;</p> <p>Trade name: possible to file an opposition, cancellation, or civil lawsuit; Right to a name or likeness (false association): ex parte, opposition, cancellation.</p> <p>Refusal ex parte if name of a living individual and no consent provided.</p>
i)Text	Article 60 (2) EUTMR	Article 4(1)(viii) (Reference) Article 29	Article 34(1)(vi) Article 92(1)	Article 32	<p>Section 1052(a) (false association)</p> <p>Section 1052(c) (name, signature or likeness of living individual)</p>

	EUIPO	JPO	KIPO	CNIPA	USPTO
ii)At time of judgment standard	In principle, any time after registration of the EUTM.	At time of application and decision	At time of decision	At time of application	Application date
iii)Examination by ex officio or opposition, trial	Invalidity/cancellation action; counterclaim in national infringement proceedings	(1)Examination (by ex officio) (2)Opposition, trial	(1)Examination (by ex officio) (2)Opposition, trial	Opposition, trial	(1)Examination (ex parte) (2)Opposition, cancellation
iv)Burden of proof	Invalidity applicant; defendant in infringement proceedings.	Burden of proof is on the side who claims that the application falls under the Article 4(1)(viii).	Burden of proof is on the rightful owner of well-known and famous works of copyright, person's name and trade name	Burden of proof is on the side of Opposition applicant or Invalidation applicant.	(1)Examiner (2)Demandant
v)Examination standard	Guidelines for examination, Part D, Section 2, Sub-heading 4.3 Grounds under Article 60(2) EUTMR — other earlier right	Trademark Examination Guideline, Article 4(1)(viii)	Trademark Examination Guideline 5.6.	Trademark Trial Standards Part 4.	TMEP Section 813, TMEP Section 1203.03(c).
vi)Specific judgment method	Guidelines for examination, Part D, Section 2, Sub-heading 4.3 Grounds under Article 60(2) EUTMR — other earlier rights	See v)	Same as above	See the answer in v)	Same as above

	EUIPO	JPO	KIPO	CNIPA	USPTO
vii)Examination example, decision example, judgment example	Guidelines for examination, Part D, Section 2, Sub-heading 4.3 Grounds under Article 60(2) EUTMR — other earlier right	There is the following judgment. • 「SONYAN」 (Tokyo High Court, 1977 (Gyo Ke) No. 133) [JPO-9]	There is the following judgment. • 「2NE1」 (Case No. 2012Hu1033) • 「KT」 (Case No. 2009Heo1705)	There are some examples. ① 「季世家 1915」 Figure Trademark opposition case (No. 7968391) ② “Figure” Trademark opposition case (No. 1563706) ③ 「洪河」 Trademark opposition case (No. 1965652) ④ 「余進華 Y U J I N H U A」 Trademark opposition case (No. 3266232) ⑤ Figure Trademark opposition case (No. 3308372) ⑥ 「易建联」 商標係争案 件 (No. 3517447) ⑦ Figure 商標異議復審案 件 (No. 1004698)	The following are examination rejections case examples. • In re Richard M. Hoefflin, 97 USPQ2d 1174 (TTAB 2010) • In re Jackson Int’l Trading Co., 103 USPQ2d 1417 (TTAB 2012) The following are opposition examples: AT&T Mobility LLC v. Mark Thomann and Dormitus Brands LLC, 2020 USPQ2d 43785 (TTAB 2020) United States Olympic Committee v. Tempting Brands Netherlands B.V., 2021 USPQ2d 164 (TTAB 2021)

	EUIPO	JPO	KIPO	CNIPA	USPTO
6. Any other views except for 1.- 5.					
Viewpoints other than the above	None	None	—	None	None

III. Procedures

	EUIPO	JPO	KIPO	CNIPA	USPTO
1. Information submission system					
i) Means that any person other than an applicant offers information to an examiner	Bad faith is a reason for invalidity and not related to procedure for examination or opposition (except for specific opposition rules against mark registered by an agent of the owner without owner's consent, Article 8(3) EUTMR).	Information provision system	Allowed to offer information and oppose.	There's no provision for other person to offer information to an examiner. However, it is allowed to submit documents to Trademark Office.	"Letter of protest" may be submitted. If accepted, it will be forwarded to examiner.
ii) Provision(s) of the relevant laws or regulations (if not, such as the relevant website)		Regulation for Enforcement of the Trademark Act, Article 19 The Trademark Examination Manual 89.01	Trademark Act, Article 49		Trademark Act Section 1051(f); 37 C.F.R. §2.149
iii) Handling of Information by an examiner	Same as above	Reasons for refusal may be noticed based on information providing fact.	Reasons for refusal may be noticed based on information offering fact. Further, KIPO has strengthened its efforts to prevent the bad-faith filing	It can be referred as work of the Trademark office, however, reception of this kind of document is not a legal procedure.	In cases where evidence is submitted prior to publication for opposition, it may be taken into consideration at discretion of examiner.

	EUIPO	JPO	KIPO	CNIPA	USPTO
			application from being registered since August 2013, indicating that the bad-faith filing application could be rejected by ex officio examination even without information provided by a third party.		In cases where evidence is submitted on or after date of publication and is accepted, the examiner must make relevant refusal or requirement on grounds raised in letter.
2. Integration of procedures in opposition, trial	They may be treated as related cases.	Same types of procedures may be integrated (Opposition: Article 43-10(1), Trial: Patent Act, Article 154(1) shall apply to Trademark Act, Article 56(1)) However, procedures for oppositions and trials cannot be integrated.	They are integrated (Article 54(3)[Examination] Article 117(1)(i) [trial] Article 119(1)(iii) and (5) [trial])	They are integrated.	Opposition trials are within the jurisdiction of the Trademark Trial and Appeal Board. If the letter of protest is granted in an application subject to an opposition, jurisdiction over the application will be restored to the examiner to take appropriate action. Trademark Trial and Appeal Board Manual of Procedure (TBMP) Section 215

IV. Others

	EUIPO	JPO	KIPO	CNIPA	USPTO
Other special instructions	No other special instruction	No other special instruction	No answer	No other special instruction	<ul style="list-style-type: none"> • Judgment by default Refer to TBMP Section 312.01 • Suspension of application pending resolution of opposition or cancellation. 37C.F.R. Section 2.83(c).In re Direct Access Communications(M.C.G) Inc. 30 USPQ2d 1393 (Comm’r Pats. 1993)