

TM5 Bad-Faith Trademark Project

24 January, 2024

IPVN-JETRO Workshop on Countermeasures Against
Bad Faith Trademark Applications with TM5

Japan Patent Office



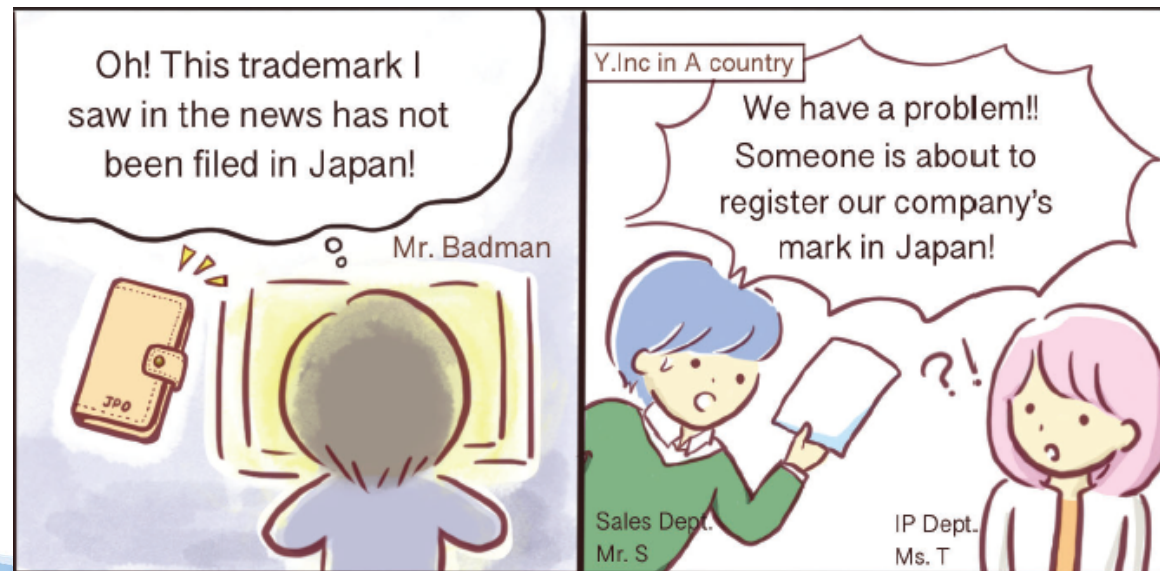
1 Overview of the Project

2 Outcomes/Deliverables

1. Overview of the Project

Background

- Since a trademark right is obtained and thus effective in each country/region, business operators often register their trademarks **only in countries/regions where they operate businesses.**
- Generally, “Bad-faith trademark filings” are filings by **third parties to fraudulently register trademarks that are identical with, or similar to, trademarks of other business operators** by, for example, taking advantage of the fact that these trademarks remain unregistered in some countries/regions.



1. Overview of the Project

Project History/Objectives

- The issue of bad-faith trademark filings is a common problem throughout the world. In order to take measures against bad-faith trademark filings, the JPO, the OHIM (now called EUIPO) and the USPTO, in collaboration with the SAIC (now called CNIPA), **began holding seminars and exchanging information in 2010 and 2011.**
- At the 2012 mid-term meeting, we, the TM5 offices, agreed to **approve activities for bad-faith trademark filings as a TM5 cooperative project.** Since then, we have been working to achieve the objectives as shown below:

Foster better understanding of problems and their solutions

- ✓ TM5 offices **share information on laws and regulations, examination practices, and other issues** regarding bad-faith filings by conducting studies and holding seminars on related topics.
- ✓ TM5 conducts a **comparative analysis of the laws, regulations and practices**, which it utilizes in order to take effective measures against bad-faith filings in each office.

Raise user awareness and publish knowledge about bad-faith filings

- ✓ TM5 provides information on measures against bad-faith filings **by publishing deliverables** on the TM5 website such as a comparative analysis report and case examples of bad-faith filings, as well as **holding seminars for IP offices other than TM5 and trademark users,**

2. Outcomes/Deliverables

TM5 Seminar on Bad-Faith Trademark Filings

First seminar held in Tokyo (in 2013)
Second seminar held at INTA annual meeting in Hong Kong (in 2014)

- Held by TM5, trademark users, such as companies and trademark attorneys, attended from each TM5 country/region.
- Focused on each TM5 office's laws/regulations and practices regarding bad-faith filings, followed by a panel discussion on the theme of "how TM5 offices identify bad faith in the examination procedure," etc.



Deliverables available at TM5 website

<http://tmfive.org/continuationexpansion-of-bad-faith-project-2-2/>

TM5

Five Trademark Offices

About TM5

Project:

Bad Faith Trademark

Date: 2023-03-14 By: mo_tmfive

Leading Office

JPO

1. Description of project

The issue of "bad-faith trademark filings" is a common problem in the world. "B third parties to register the identical or similar trademarks of others in order to have not registered them. In order to take measures against these bad-faith trademarks, the Office (JPO), the Office for Harmonization in the Internal Market (EUIPO) and the collaboration with the State Administration for Industry and Commerce of the PRC. At these past two seminars, the Trilateral Offices and the SAIC exchanged information on bad faith trademark filings. They also exchanged information on operational practices of Bad Faith Project".

3. Report

(1) Upgraded Report on "Laws and Examination Guidelines/Practices of the TM5 Offices against Bad-Faith Trademark Filings"(2022)

[Chapter1-3] PDF

- Chapter 1 : Outline of Systems and Practices of the TM5 Offices against Bad-faith Trademark Filings
- Chapter 2 : Extracts of Related Articles of the TM5 Offices against Bad-faith Trademark Filings
- Chapter 3 : Comparison Tables

[Appendix]

- Questionnaire on TM5 Bad Faith Filing Project PDF
- Responses of each Office to the Questionnaire PDF

(2) Report on "Laws and Examination Guidelines/Practices of the TM5 Offices against Bad-Faith Trademark Filings"(2015)

[Chapter1-3] PDF

- Chapter 1 : Outline of Systems and Practices of the TM5 Offices against Bad-faith Trademark Filings
- Chapter 2 : Comparison and Summary on Systems and Practices of the TM5 Offices
- Chapter 3 : Comparison Tables

[Appendix]

- Questionnaire on TM5 Bad Faith Filing Project PDF
- Responses of each Office to the Questionnaire PDF

4. Case Examples

(1) Digest version of Case Examples PDF

TM5 has created a digest version of the Upgraded Case Examples of Bad-Faith Trademark Filings. This version summarizes some of the cases collected in full cooperation with the TM5 Offices and the International Trademark Association (INTA). Herein, you can learn more easily about case examples of bad-faith trademark filings. (Some data will be added later)

(2) Upgraded Case Examples of Bad-Faith Trademark Filings PDF

I. Introduction

II. Case Examples

III. APPENDIX

- List of the Contributors
- Bad Faith Case Summaries of Other Countries/Regions

The previous Case Examples consisted of 10 cases each from the TM5 offices, for a total of 50 cases. In this version, five more cases each from the TM5 offices have been added. These are listed as examples No.11 to 15 in each office's section in Chapter II. In addition, cases from other countries and regions were collected from Asia, North America, Central and South America, Europe, and Africa, in full cooperation with the International Trademark Association (INTA). In this version, 93 additional cases were selected and listed.

5. TM5 Manga Booklet For Counter Measures Against Bad-Faith Trademark Filings

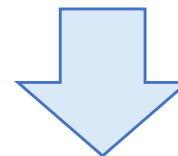
PDF

TM5 has published Manga Booklet to disseminate countermeasures against bad-faith trademark filings. You can learn useful systems of each TM5 office that can be utilized when you try to counter bad-faith trademark application or try to invalidate those already registered.

6. Seminars

- October 2013 : The first seminar on bad-faith trademark filings (Tokyo)
- May 2014 : The second seminar on bad-faith trademark filings (Hong Kong)
- March 2016 : The third seminar on bad-faith trademark filings (Tokyo)
- January 2022 : TM5 Online Workshop with the DGIP on Bad Faith
- February 2023 : TM5 Workshop with the JPOPHL on Bad Faith

Deliverables are introduced in the following slides.



2. Outcomes/Deliverables

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

- TM5 conducted studies and a comparative analysis and compiled a report in 2015.
- An upgraded version of the report was published in 2022.

[Contents]

Chapter 1: Outline of systems and practices of the TM5 offices

Chapter 2: Extracts of related articles of the TM5 offices against bad-faith trademark filings

Chapter 3: Comparison tables
- Tables summarizing comparisons of systems and practices in each Office

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

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.

o 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)(ix))	✓	✓	✓	-
Continuation over the source of goods and services (Article 4(1)(xv))	✓	✓	✓	-
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))	✓	✓	✓	-

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 of use 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)
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)






2. Outcomes/Deliverables

Case Examples of Bad-Faith Trademark Filings

- First compiled 50 cases of bad-faith filings in the TM5 offices' jurisdictions in 2017.
- Updated in 2019 in cooperation with INTA, adding 25 cases from TM5 and 93 cases from other countries/regions in Asia, North America, Central and South America, Europe, and Africa.
- 2 cases in Vietnam additionally listed.

1	ARGENTINA	4	15	HONG KONG	1	29	PHILIPPINES	5
2	ARMENIA	1	16	HUNGARY	2	30	RUSSIA	2
3	Australia	5	17	INDIA	5	31	SERBIA	2
4	AUSTRIA	2	18	IRELAND	1	32	SINGAPORE	3
5	BRAZIL	4	19	ISRAEL	1	33	SPAIN	4
6	CANADA	2	20	ITALY	2	34	SWEDEN	4
7	CHILE	1	21	KENYA	1	35	TAIWAN	1
8	COLOMBIA	3	22	LATVIA	1	36	THAILAND	1
9	COSTA RICA	2	23	MALAYSIA	1	37	UK	5
10	CUBA	1	24	MYANMAR	3	38	UKRAINE	1
11	ECUADOR	1	25	New Zealand	6	39	URUGUAY	1
12	FINLAND	1	26	PAKISTAN	1	40	VIETNAM	2
13	FRANCE	3	27	PARAGUAY	1			
14	GERMANY	3	28	PERU	3			

· [JPO-15]  v.   [1]

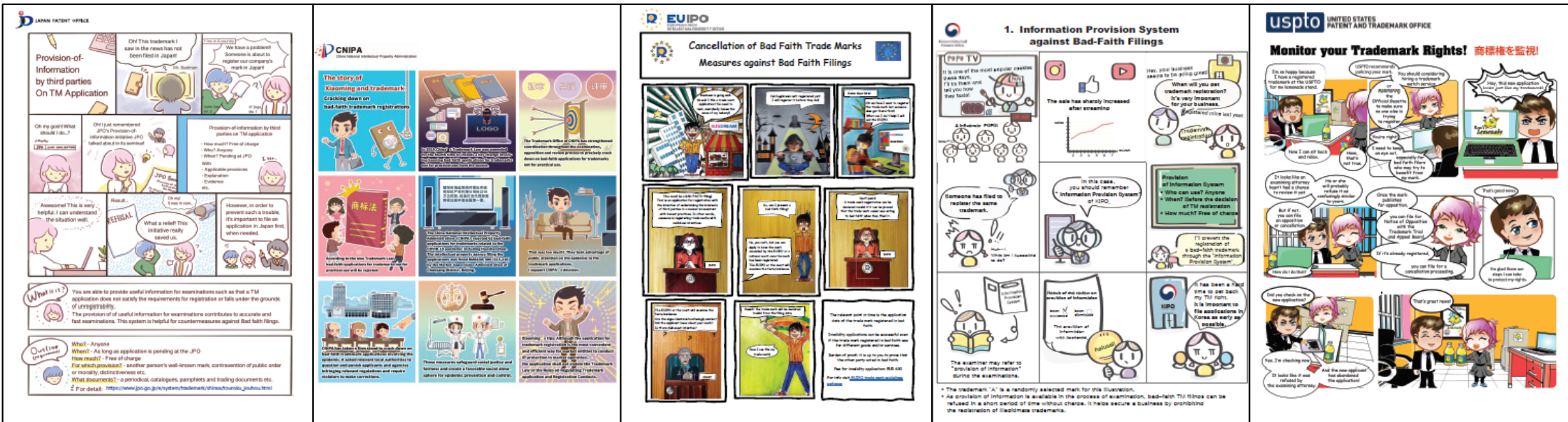
1. Title	 v. 																	
2. Country	Japan																	
3. Court	Intellectual Property High Court																	
4. Case No.	2017(Gyo-ke)10080																	
5. Date of the judgment	2017/12/25																	
6. Parties : Plaintiff	Red Bull Aktiengesellschaft																	
Defendant	Bison Co., Ltd.																	
7. Mark	Plaintiff (cited trademark = trademark in Use 2 (above), trademark in Use 1(below))	Defendant (disputed trademark)																
																		
																		
8. Outline of the case	In the trial for invalidation, it was decided that the disputed trademark does not fall into the category which is likely to cause confusion in connection with the goods or services pertaining to a business of another person, and so the plaintiff filed suit against decision of trial for invalidation. The request was granted.																	
9. Summary of the judgment	Company Red Bull (which is the inclusive name of Red Bull GmbH (headquarters), Red Bull Japan (the subsidiary in Japan) and those affiliated companies) uses the trademark in use 1 (herein after called 'trademark 1') etc. both on the surface of canned energy drink 'Red Bull' and for its advertisement; the design of the surface has not changed from the start of its sales until now. When looking at the overall structural outline, the basic composition of the defendant's trademark and the cited trademark is almost similar and partially identical, so both trademarks are confusingly similar in their appearance. Also, they share almost identical concept, therefore, it can be confirmed that both trademarks share relatively high similarities.																	
10. Tags	<table border="1"> <tbody> <tr><td>①Type of trial</td><td>Suit against decision of trial for invalidation</td></tr> <tr><td>②Decision</td><td>Invalidation</td></tr> <tr><td>③Type of bad faith</td><td></td></tr> <tr><td>Free Ride</td><td>✓</td></tr> <tr><td>Imitation by agents or people who have a prior relationship</td><td></td></tr> <tr><td>Interference by a competing company</td><td></td></tr> <tr><td>Lack of intention to use</td><td></td></tr> <tr><td>Others</td><td></td></tr> </tbody> </table>		①Type of trial	Suit against decision of trial for invalidation	②Decision	Invalidation	③Type of bad faith		Free Ride	✓	Imitation by agents or people who have a prior relationship		Interference by a competing company		Lack of intention to use		Others	
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Others																		

- [1] Bad-Faith Indicator
This indicates that bad faith was found in disputed trademarks.
- [2] Disputed trademark
This means that a mark which was disputed in a case is shown below.
- [3] Category
In this compilation, cases examples are categorized according to the following five types:
- Free Ride
 - Imitation by agents or people who have a prior relationship
 - Interference by a competing company
 - Lack of intention to use
 - Others

[3]

2. Outcomes/Deliverables

TM5 Manga Booklet for Countermeasures Against Bad-Faith Trademark Filings

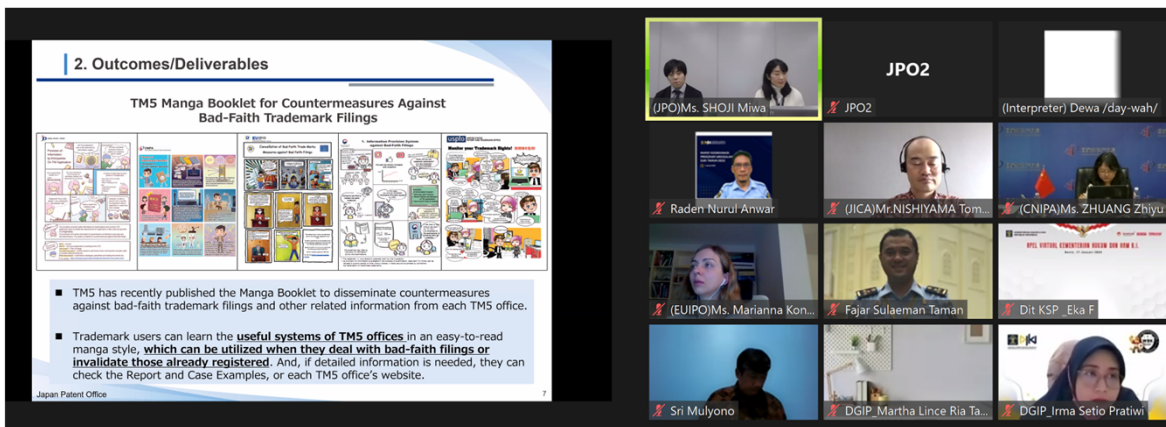


- TM5 published the Manga Booklet to disseminate countermeasures against bad-faith trademark filings and other related information from each TM5 office in 2021.
- Trademark users can learn the **useful systems of TM5 offices** in an easy-to-read manga style, **which can be utilized when they deal with bad-faith filings or invalidate those already registered**. And, if detailed information is needed, they can check the Report and Case Examples, or each TM5 office's website.

2. Outcomes/Deliverables

TM5 Bad-Faith Trademark Workshop

- TM5 has been holding regular workshops since 2022.
- The aim is to raise awareness of bad-faith trademarks by sharing TM5's efforts in this regard.



Workshop for DGIP in 2022



Workshop for IPOPHL in 2023

Inviting other IP offices to participate

- TM5 seeks opportunities to disseminate our activities not only to trademark users, but also to other IP offices.
- We hope that other IP offices can provide information on laws/regulations and examination practices regarding bad-faith filings, as well as case examples (and we also hope they can create manga content 😊).
- If IPVN is interested in our activities, please let us know.

Thank You!

