

TM5 Bad Faith Project

Case Examples of Bad-Faith Trademark Filings

May 21, 2017





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
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- Related Articles of each countries
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Note : In this compilation, the cases are categorized according to the following three types.

(i)Free Ride (*Trademarks that take advantage of the reputation and credit of another person's trademarks, including the use of trademarks similar with another person's trademark and the use of trademarks which is likely to cause confusion with the business of another person.*)

(ii)Immoral (*Trademarks which are contrary to public policy or to accepted principles of morality and trademarks filing for the purpose of plagiarism taking advantage of the fact that another person's trademark is not registered.*)

(iii)Lack of intention to use

I . Introduction

There has been a common global issue of the so-called “bad faith trademark filings” (hereinafter referred to as Bad Faith) in which a trademark is filed for unfair purposes, such as taking advantage of the fact that another person’s trademark is not registered in the country/region concerned.

In order to take measures against these Bad Faith, the Five Trademark Offices (the European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Administration for Industry and Commerce of the People’s Republic of China (SAIC) and the United States Patent and Trademark Office (USPTO)) cooperate under the TM5 Fora on “the Bad Faith Project” led by the JPO.

The first seminar on Bad Faith was held in Tokyo in 2013 and the second one in Hong Kong in 2014. In December of the same year, we compiled laws and examination guidelines/practices of the Five Trademark Offices in a report and published it in order to cope with Bad Faith.

We agreed on compiling “the Case Examples of Bad-Faith Trademark Filings” (hereinafter referred to as the Case Examples) at the fourth TM5 Annual meeting, held in December 2015. In addition, we agreed on holding a seminar to introduce the cases of Bad Faith to broadly share the information with users.

Based on this agreement, the third seminar on Bad Faith was held in Tokyo in March 2016 with the aim of introducing the cases of Bad Faith. In October 2016, the TM5 Partners held a symposium on the “Effectively Restrain Bad-Faith Registration of Trademark” in Kunshan, China. We have therefore steadily promoted relevant initiatives in this field to eventually publish the Case Examples.

The Case Examples is a successful outcome of the initiatives that we have promoted in terms of Bad Faith. We regard the publication of the Case Examples as one of the milestones, and we will continue strengthening our cooperation for further initiatives in this field.

The Case Examples including significant cases that were carefully selected by each Office is unprecedented in the past. The Case Examples would be useful for deepening users' understanding of cases of Bad Faith and the respective responses by the Five Trademark Offices, advancing the formulation of trademark strategies.

the European Union Intellectual Property Office

the Japan Patent Office

the Korean Intellectual Property Office

the State Administration for Industry and Commerce of the People's Republic of China

the United States Patent and Trademark Office

May 21, 2017

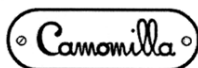


II. Case Examples

Case Examples of EUIPO

【EUIPO-1】

1. Title	BALBCARE v. BALBCARE	
2. Country	European Union	
3. Court	Cancellation Division (EUIPO first instance)	
4. Case No.	9805 C	
5. Date of the judgment	2015/9/14	
6. Parties:	Balbpharm Industria de Cosméticos Ltda.	
Plaintiff	3B.Solutions	
Defendant		
7. Mark	Plaintiff	Defendant
	BALBCARE	BALBCARE
8. Outline of the case		
The Cancellation Division (CD) declared invalid the registration of the EUTM as it was applied for in bad faith. No appeal was filed before EUIPO Boards of Appeal		
9. Summary of the judgment		
The Invalidity applicant is the owner of the Brazilian TM BALBCARE for nail care products in Class 3. It exported its products to the EU since 2011.		
In 2011 it signed a distribution agreement in the EU with the (future) EUTM proprietor, who applied for a FR mark BALBCARE in July 2011 and an EUTM in 2014.		
By late 2011, the distribution agreement was suspended.		
The owner of the Brazilian TM requested the invalidity of the EUTM because it was registered in bad faith. The Cancellation Division declared that the invalidity applicant cannot be expected to prove a negative fact, such as the absence of consent. A mere statement that the filing was made without its consent is generally sufficient.		
It is the EUTM proprietor who has to prove that the filing was authorized.		
The finding of bad faith does not require a contractual relationship at the time of filing. A direct or indirect relationship between the parties prior to the filing may be enough.		
The Cancellation Division declared the mark invalid. No appeal was filed.		
10.Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride	✓	
Immoral		
Lack of intention to use		

【EUIPO-2】

1. Title	Camomilla v. CAMOMILLA	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	Joint cases T-98/13 and T-99/13	
5. Date of the judgment	2015/7/9	
6. Parties: Plaintiff Defendant	C.M.T. - Compagnia Manifatture Tessili S.r.l. EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor	Invalidity applicant
		
		
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade marks above had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark Regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>The Court confirmed that the three factors set out in the judgment C-529/07, Chocoladefabriken Lindt & Sprüng (identity/confusing similarity of the signs; knowledge of the use of an identical or confusingly similar sign, and dishonest intention on the part of the EU trade mark proprietor) are only examples drawn from a number of factors which can be taken into account in order to decide whether the EU trade mark proprietor was acting in bad faith at the time of filing the application.</p> <p>For example, account may also be taken of the commercial logic underlying the filing of the EUTM application and the chronology of events relating to the filing (paras. 37-42).</p> <p>The Court recalled that the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the EU trade mark proprietor was acting in bad faith. In order to determine whether there was bad faith, consideration must be given to the EU trade mark proprietor's intention at the time when of filing of the EUTM application. It is a subjective factor which must be determined by reference to the objective circumstances of the particular case. However, the invalidity applicant only argued that the disputes between the parties proved the conscious and deliberate intention of the EU trade mark proprietor to appropriate the Camomilla mark, previously used and register by the invalidity applicant.</p> <p>The Court found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as an EU trade mark acted in bad faith. It also found that there was no evidence</p>		

showing that the invalidity applicant had the intention to exploit its national mark in in the market sectors at issue, nor that the EU trade mark proprietor knew about that intention at the relevant time (paras. 46-50). Good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the EU trade mark proprietor at the time of filing. Consequently, the invalidity applicant's observations, devoid of any evidence to support them, are not sufficient for proving bad faith from the EU trade mark proprietor (para. 51).

10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance of the trademark registration
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【EUIPO-3】




1. Title	COLOURBLIND v. COLOURBLIND	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-257/11	
5. Date of the judgment	2015/2/26	
6. Parties: Plaintiff	Pangyrus Ltd.	
Defendant	EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor	Invalidity applicant
	COLOURBLIND	
8. Outline of the case		
An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark COLOURBLIND had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark Regulation. The Court dismissed the appeal.		
9. Summary of the judgment		
The ‘COLOURBLIND’ product (consisting of an “experimental learning” toolbox) was invented in 1991 by a physical person, a Mr C. (main shareholder and director of the EU trade mark proprietor at the time of the invalidity application), who in 1993 had set up the invalidity applicant’s company, Mr C. holding 99% of the latter’s shares. Although Mr. C. was closely and continuously involved, from 1991 until 2003, in activities leading to the use of ‘COLOURBLIND’ by the invalidity applicant first and later by another connected company, and was therefore necessarily aware of that use, the Court noted that such awareness on his part was not sufficient, in itself, to establish that the EU trade mark proprietor (whom Mr. C. controlled) acted in bad faith. The Court dismissed the invalidity applicant’s argument that Mr C.’s aim in filing the application for registration of the contested trade mark was to ‘lay his hands’ on the trade mark of a third party which he had had contractual or pre-contractual relations with. In that respect, the Court held that, due to the connections between Mr C. and the invalidity applicant (the former holding in the early 90’s 99% shares of the latter), the invalidity applicant could not be described as a third party in relation to Mr C. The Court also found that the main item of evidence relied upon by the invalidity applicant (a share purchase agreement) in order to argue that the rights in the contested mark had been assigned to it by Mr. C. only contained a generic reference to ‘warranties’ and ‘intellectual property’ and that there was no mention of ‘COLOURBLIND’ in that agreement. The Court went on to note that, even assuming that the sign ‘COLOURBLIND’ was covered by that agreement, all that was mentioned with regard to the invalidity applicant was its being the beneficial owner of rights in that sign, not that it had legal title to those rights [‘beneficial owner’ is a legal term from English law used to indicate where specific property rights in equity belong to a person even		

though the legal title of the property belongs to another person]. The Court added that, if there was an agreement between Mr C. and the invalidity applicant concerning the use of ‘COLOURBLIND’, it is possible that, owing to its implied or informal nature, it was not mentioned in the mentioned share purchase agreement. The Court held that, in the light of the evidence produced, it could not be excluded that Mr C. considered himself to have rights in the sign ‘COLOURBLIND’ up until the moment of its transfer to the EU trade mark holder and that both the invalidity applicant and a third, connected company that had later made use of the sign were acting under an implied or informal agreement on the part of Mr C (paras. 78-135).


10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance of the trademark registration
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【EUIPO-4】

1. Title	Doggis v. Doggis	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-335/14	
5. Date of the judgment	2016/1/28	
6. Parties: Plaintiff	Mr. Davo Lledo	
Defendant	EUIPO	
7. Mark	Plaintiff	Defendant
		
		
8. Outline of the case		
The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.		
9. Summary of the judgment		
The invalidity applicants invoked a number of earlier marks DOGGIS that they had registered in Chile and Uruguay. When they tried to register the mark DOGGIS in Spain, they found that it had been registered for the same services and with identical graphic element in Spain, in the EU, and also as an International Registration. They claimed that the EU mark had been applied for in bad faith. The Cancellation Division rejected the invalidity application, but the Board of Appeal declared the registration invalid. It found that, at the time of the EUTM application, the EUTM applicant was aware of the existence of the earlier figurative Chilean marks, identical to the sign applied for. The Board found that such a coincidence could not be the result of a fortuitous identity. The General Court confirms the findings of the Board of Appeal.		
✂The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.		
10.Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride	✓	
Immoral		
Lack of intention to use		

【EUIPO-5】

1. Title	GUGLER v. GUGLER	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T 674/13	
5. Date of the judgment	2016/1/28	
6. Parties: Plaintiff Defendant	Gugler France OHIM	
7. Mark	EU trade mark proprietor	Invalidity applicant
		GUGLER
8. Outline of the case		
An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark above had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court did not examine the bad faith issue. The decision of the Board of Appeal denying that the EUTM was registered in bad faith remains valid.		
9. Summary of the judgment		
According to the Board of Appeal of the EUIPO, nothing in the facts of the case showed that Gugler GmbH filed the contested EUTM in bad faith, even though there had been previous business relations between the parties. The Board noted that in 2003, Gugler GmbH had already been producing and exporting the relevant products ‘under the name GUGLER’ for many years. Therefore, applying for an EUTM was an obvious and completely justified action which did not reveal bad faith.		
10.Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Maintenance of the trademark registration	
③ Type of bad faith		
Free Ride	✓	
Immoral		
Lack of intention to use		

【EUIPO-6】

1. Title	LLRG5 v. LLRG5	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-306/13	
5. Date of the judgment	2015/6/16	
6. Parties: Plaintiff Defendant	Silicium España Laboratorios, SL EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor	Invalidity applicant
	LLRG5	
8. Outline of the case		
An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark LLRG5 had been registered in bad faith. After EUIPO upheld the invalidity application, the EU trade mark proprietor brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.		
9. Summary of the judgment		
Mr. I had sought to register the word sign LLRG5 as an EU trade mark, acting as an intermediary of Mr. R, one of the shareholders of the invalidity applicant. Before the mark was granted, the intermediary requested EUIPO to register the assignment of the EU trade mark application to Mr. R. The change of proprietor was registered and published. Mr. R. and the invalidity applicant concluded an agreement that would confer to the latter an exclusive license which stated, inter alia, that Mr. R. would not authorize others to use the names “LLRG5” or “G5”. After Mr. R’s death, the invalidity applicant filed with EUIPO an application for registration of the transfer of the EU trade mark LLRG5, based on said agreement. The application was refused on the ground that the agreement did not state that Mr. R had actually transferred the contested mark to the invalidity applicant. Said EU trade mark had meanwhile been transferred to the EU trade mark proprietor MR C. The Board of Appeal found that Mr R, as beneficial applicant, had acted in bad faith when instructing an intermediary to file an application for registration of the contested trade mark. Before the General Court, the actual EUTM proprietor, Mr. C., put forward that Mr. R. had a legitimate interest in applying for the registration of that mark and disputed the probative value of matters that were taken into consideration by EUIPO when it concluded that the mark had been registered in bad faith (para. 40). The Court rejected this argument since the invalidity applicant produced a formal statement by its representative, made before a solicitor, as well as a set of documents which contained his opinion that the application for registration of the EU trade mark was made in bad faith due to the fact that the filing was made without the knowledge of the invalidity applicant (paras. 42-43). With regard to the probative value of the		

statement, the Court pointed out that, although it did not fall within the category of self-supporting evidence, it was substantiated by the documents that were submitted to EUIPO (para. 46). The Court found that it was apparent from the case file that Mr. R. could not have been unaware that the invalidity applicant used the sign LLRG5 as its company name (para. 47). Furthermore, although it was not possible to establish with certainty what was the common intention between the parties with regard to the sign, no evidence was provided that could lead to the conclusion that Mr. R. had reserved rights to himself over that name (para. 52). Therefore, the EU trade mark proprietor did not prove the existence of the exclusive rights it alleged (Para. 58). The Court stated that Mr. R. did not give the invalidity applicant the possibility of considering whether it was appropriate to oppose the application for registration of the sign at issue, which led to the finding that the application could be held to be a “concealed act”, carried out through an intermediary, with the intention of preventing the invalidity applicant from being able to use the sign (para. 71). In this light, the application for registration of the contested mark was made in bad faith (para. 73).

10.Tags





① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【EUIPO-7】

1. Title	LUCEO v. LUCEA LED	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T825/14	
5. Date of the judgment	2016/7/7	
6. Parties: Plaintiff Defendant	Copernicus-Trademarks Ltd. EUIPO	
7. Mark	Plaintiff	Intervener
	LUCEO	LUCEA LED
8. Outline of the case		
The Cancellation Division (CD) and the Board of Appeal (BoA) declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.		
9. Summary of the judgment		
<p>Copernicus, represented by Mr A., filed an application for registration of the word mark LUCEO (Class 10, 12, 28) in September 2009. It claimed priority from an Austrian application for the word mark LUCEO filed in March 2009 for the same goods. Two months later it filed an opposition against the application for registration of the EUTM LUCEA LED (applied for by the intervener or invalidity applicant).</p> <p>The EUTM LUCEO was registered in October 2010. Subsequently, the intervener (who applied for the registration of the EUTM LUCEA LED) requested that the LUCEO EUTM be declared invalid, as Copernicus had acted in bad faith. Both the CD and the BoA found that the mark had been applied for in bad faith.</p> <p>The General Court (GC) confirms the findings of the Board of Appeal.</p> <p>Copernicus and Mr A. pursued an unlawful filing strategy, consisting in successively chaining together applications for registration of national trade marks in Austria and Germany seeking to claim priority for an application of an EUTM and to grant a blocking position to Mr A. in order to oppose applications for registration of EUTM filed by third parties (p. 35-39 of the judgment).</p> <p>The GC found this filing strategy incompatible with the objectives of the EUTM Regulation and qualified it as an abuse of law (p. 52). It also noted that Mr A. stated that he did not intend to use the mark at issue and was unable to indicate the name of the clients who expressed an interest in that mark and requested payment of 75 000 € from the intervener. Bad faith exists inter alia where trade mark applications are diverted from their initial purpose and filed speculatively or solely with a view to obtain financial compensation (p. 145).</p> <p><i>✂The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.</i></p>		

10.Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	✓

【EUIPO-8】

1. Title	 v. 	
2. Country	European Union	
3. Court	Cancellation Division (EUIPO first instance)	
4. Case No.	9634 C	
5. Date of the judgment	2015/9/9	
6. Parties: Plaintiff Defendant	Thierry Khayat Sandys S.r.l.	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
The Cancellation Division (CD) declares invalid the registration of the EUTM as it was applied for in bad faith. An appeal is pending before EUIPO Boards of Appeal		
9. Summary of the judgment		
<p>In May 2008, Mr. A.T., vice president of the bankrupt Tacchini Group, assigned the French mark VdeV reproduced above to H4T S.r.l. In December 2008, Ms. G.T. applied for registration of the VdeV mark in Italy. In June 2009 Ms. G.T. filed for a EUTM, with priority based on the Italian application.</p> <p>In 2012, Ms. G.T. transferred the Italian and the EU marks VdeV to SANDYS S.r.l., whose CEO is Mr. A. Tacchini., represented by a law firm where one of the partners is Ms. G.T.'s husband. Ms. G.T. worked with that law firm since 2010.</p> <p>The Cancellation Division had to establish two questions: (1) whether the current owner, SANDYS, is a bona fide owner, (2) whether Ms. G.T. applied for the EUTM independently and in good faith or whether she did so on behalf of the current owner.</p> <p>CD: it is strongly against honest commercial practice that a person who led a company into insolvency and had to sell its TMs, would acquire the same (with geographically extended protection) just by creating a new company. In view of all the circumstances taken together, the current owner SANDYS (whose CEO is Mr. A. Tacchini) should be considered to be the real applicant for the contested EUTM. Bad faith implies proving that at the time of filing, the EUTM owner was aware that it was causing harm to the invalidity applicant and that this harm was a consequence of its reproachable conduct from a moral o commercial point of view.</p> <p>Mr. A. Tacchini, CEO of the EUTM owner, must have been aware that it is ethically unacceptable and contrary to honest and fair commercial practices for his new company to own the CTM identical to the national marks that he transferred to a third party when his other company was insolvent.</p>		

✕The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.

10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【EUIPO-9】

1. Title	SIMCA v. SIMCA	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-327/12	
5. Date of the judgment	2014/5/8	
6. Parties: Plaintiff Defendant	Simca Europe Ltd. EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor	Invalidity applicant
	<h1>SIMCA</h1>	
8. Outline of the case		
An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark SIMCA had been registered in bad faith. After EUIPO upheld the invalidity application, the EU trade mark proprietor brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.		
9. Summary of the judgment		
<p>According to the General Court, in order to establish bad faith account may be taken of the origin of the word or the sign which forms the mark at issue and of the earlier use of that word or sign in business as a mark, in particular by competing undertakings, and of the commercial logic underlying the filing of the application for registration of that word or that sign as an EU trade mark (para. 38 and 39). The mark SIMCA has been used for cars since 1930 and the invalidity applicant has trademark protection for SIMCA in different Member States as France, Germany, Spain etc. for goods in class 12. However, the mark has not been used since 1980 (para. 42). At the date of filing of the EUTM, the mark still had a certain degree of reputation among the public interested in cars. The EU trade mark proprietor knew this residual reputation of the SIMCA marks and was looking for an appropriate mark which was no longer used and which accordingly had no legal protection (paras. 45 - 53).</p> <p>The Court finally concluded that the real purpose of the EU trade mark proprietor was to ‘free-ride’ on the reputation of the invalidity applicant’s registered marks and to take advantage of that reputation (para 56). The judgement emphasizes that the clear and evident intention to take advantage of the residual reputation of the sign SIMCA on the motor vehicle market, to create an association with the earlier marks and to compete with those earlier marks if they were re-used by the invalidity applicant is to be considered as bad faith in the sense of Article 52 (1) (b) of the EU trade mark Regulation (para 63). This conclusion is not based on the “offer of compensation” to the invalidity applicant (para. 70). The fact that the EU trade mark proprietor had started the use of the registered SIMCA mark is not relevant (para. 74). Also the fact, that the EU trade mark proprietor worked in the past for the invalidity applicant is not decisive for the outcome (para. 79).</p>		

10.Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	



【EUIPO-10】

1. Title	URB v. URB	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-506/13	
5. Date of the judgment	2014/11/7	
6. Parties: Plaintiff Defendant	Urb Rulmenti Suceava SA EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor	Invalidity applicant
	URB	
8. Outline of the case		
An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark URB had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.		
9. Summary of the judgment		
<p>The General Court recalled that, in assessing whether a mark has been registered in bad faith, account may also be taken of the commercial logic underlying the filing of the application for registration of an EU trade mark. Even in circumstances where several producers were using, on the market identical or similar signs for identical or similar products, capable of being confused with the sign for which registration was sought, the EU trade mark proprietor's registration of the sign may still be in pursuit of a legitimate objective (para. 35).</p> <p>The Court held that it was understandable from a commercial point of view that the EU trade mark proprietor wished to extend the protection of the URB trade mark by registering it as an EU trade mark. In that respect, the evidence on file showed that, during the period which preceded the filing, the EU trade mark proprietor used the trade mark, through a connected company, and generated turnover from goods marketed under the trade mark in several Member States, which was a plausible incentive for filing an application for the registration of an EU trade mark (para. 41). The invalidity applicant did not establish that it was the EU trade mark proprietor's intention to exclude it from the market (para. 44). The fact that the EU trade mark proprietor knew or should have known that a third party (i.e. the invalidity applicant in this case) has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the EU trade mark proprietor was acting in bad faith when filing the application (para. 47).</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	

② Decision	Maintenance of the trademark registration
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

Case Examples of JPO

【JPO-1】



1. Title	KUMA v. PUMA	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2012(Gyo-Ke)10454	
5. Date of the judgment	2013/6/27	
6. Parties: Plaintiff Defendant	Hokkaido Design Kabushiki Kaisha Puma SE	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the plaintiff's registered trademark is determined as having been obtained contrary to ethics of business and being liable to cause confusion with goods connected with another person's business.		
9. Summary of the judgment		
<p>The defendant's trademark had become a well-known, famous trademark widely recognized by traders and consumers in Japan as a trademark affixed to the defendant's sports shoes, clothing, bags, etc. The defendant's trademark may be recognized to have maintained such recognition as of the time of examination for registration of the trademark and thereafter.</p> <p>The defendant is a famous multinational company engaged in the global manufacturing and sale of sports shoes, clothing, bags, etc., that the defendant's trademark has been widely recognized among traders and consumers as a distinctive trademark that indicates the goods pertaining to the business of the defendant, that some of the designated goods of the plaintiff's trademark overlap with the goods for which the defendant's trademark has been used.</p> <p>Based on a comprehensive evaluation of these facts, it may be recognized that the applicant, which was aware that the defendant's trademark is famous, created the plaintiff's trademark consisting of four alphabetic characters "KUMA" intentionally written in almost the same manner as the defendant's trademark and a figure of a bear as a replacement of the puma used for the defendant's trademark in order to ensure that the overall configuration of the plaintiff's trademark looks extremely similar to that of the defendant's trademark so that traders and consumers who come across the plaintiff's trademark would associate the Trademark with the defendant's Trademark. The</p>		

applicant created the Trademark, filed an application for registration of the trademark, and had it registered for the illicit purpose of free-riding the reputation, honor, and customer appeal embodied by the defendant's trademark.

10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【JPO-2】

1. Title	ASRock v. Asrock	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2009(Gyo-Ke)10297	
5. Date of the judgment	2010/8/19	
6. Parties: Plaintiff Defendant	Kabushiki Kaisha Unister Y	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the defendant's trademark to be a filing for the purpose of plagiarism is considered to have fallen under a trademark which is likely to cause damage to public policy.		
9. Summary of the judgment		
<p>The application for registration of the defendant trademark was concluded to be filed for the purpose of gaining unfair profit from assignment of trademark right or causing damages to ASRock Inc. and its dealers for the reasons that</p> <p>(i) It cannot be considered, or at least the possibility is extremely low, that the defendant has an intention to engage in business in Japan in the near future in relation to the designated goods pertaining to the Trademark.</p> <p>(ii) The defendant, although not substantially engaged in any business activities, has filed a large number of trademark applications relating to electronic equipment. Some of these applications are considered to be the intentional applications of the trademarks identical with, or similar to, the trademarks to be used by other companies in foreign countries.</p> <p>(iii) After the registration of the defendant's trademark, the defendant, although not doing business in Japan, sent a large number of warning letters to distributors of ASRock products bearing the plaintiff's trademark, including the plaintiff, requesting them to cease import and sale of the products and warning them that it may institute a criminal prosecution or an action seeking claim for damages unless they follow the request.</p> <p>As mentioned above, the court finds the defendant's trademark to be a filing for the purpose of plagiarism, with an unfair intention of registering the trademarks to be potentially used and filed for trademark registration in Japan by ASRock, Inc. as their respective trademarks. Even under the Japanese legal framework which adopts the first-to-file system for the trademark registration application without a requirement of actual use at the time of filing, such applications are unacceptable from the standpoint of the rule of reason, considering the commonsense understanding of the general public when seeking justice. In addition, such applications are considered as being</p>		

detrimental to the fairness in trademark order. Accordingly, the defendant's trademark is considered to have fallen under a trademark which is 'likely to cause damage to public policy,' without regard to whether the plaintiff's trademark and the mark 'ASRock' were well-known or famous, at the time of the filing thereof.

10.Tags



① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【JPO-3】

1. Title	COMEX v. comex	
2. Country	Japan	
3. Court	Tokyo High Court	
4. Case No.	2004(Gyo-Ke)219	
5. Date of the judgment	2005/1/31	
6. Parties: Plaintiff Defendant	Kentrading Brain Kabushiki Kaisha ROLEX societe anonyme COMEX societe anonyme	
7. Mark	Plaintiff	Defendant
	COMEX	comex
		COMEX
8. Outline of the case		
A case in which the plaintiff’s trademark to be a filing for the purpose of plagiarism is considered to have fallen under a trademark which is likely to cause damage to public order or morals.		
9. Summary of the judgment		
The trademark “COMEX” filed by the plaintiff, when considering the background of filing the application and activities of the plaintiff after registration of the trademark, was made ahead seeking for benefit by taking the opportunity that the “COMEX” has not been registered in Japan designating goods of ‘watches, parts and accessories of watches’ in Japan, knowing the popularity of the “ROLEX/comex double named” watch made by ROLEX company, i.e., the defendant, and proof of high performance and confidence of the ROLEX diver’s watches being embodied in the trademarks of “comex” and “COMEX”, and thus it is clear, if the trademark “COMEX” is used for watches sold by the plaintiff, such a use will cause misleading of consumers as well as causing damages of the reputation embodied in the trademarks of “comex” and “COMEX” of ROLEX company through such a free riding activity, and further, if the trademark “COMEX” is used for relatively inexpensive diver’s watches sold by the plaintiff, such a use will cause dilution of the trademarks of “comex” and “COMEX” of which rarity and fame are maintained by the use only by very few Submariner and Sea-Dweller.		
In the light of the above described circumstances, continued registration of the trademark “COMEX” shall be contrary to the order scheduled in the Trademark Act. From such an aspect, the trademark “COMEX” must be invalidated for the reason “the trademark is likely to cause damage to public policy”.		
10.Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	

③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【JPO-4】





1. Title	LAMBORGHINI v. Lamborghini	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2011(Gyo-Ke)10426	
5. Date of the judgment	2012/5/31	
6. Parties: Plaintiff Defendant	Automobili Lamborghini S.p.A Kabushiki Kaisha Liberty Walk	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the defendant's trademark is determined as being obtained the purpose of gaining unfair profit, causing damage to another person, or other unfair purposes because the defendant filed the defendant's trademark while knowing that the plaintiff's trademark is well known among consumers, and also knowing that the defendant's trademark is similar to the plaintiff's trademark.		
9. Summary of the judgment		
<p>The plaintiff is a car maker established in Italy in 1962. It is famous on a global level mainly for the high-end sports cars that it makes and sells. In Japan as well, the cars made by the plaintiff, such as "Countach," were called "supercars" and became popular in the 1970s. The plaintiff's trademark, "LAMBORGHINI," which represents part of the plaintiff's name, has been regarded as an indication of the plaintiff or the goods pertaining to the plaintiff's business and well known among car dealers and fans in Japan.</p> <p>Comparing the plaintiff's trademark and the defendant's trademark, nine out of the ten alphabetical characters forming the character part of the defendant's trademark are also used in the plaintiff's trademark. These trademarks are also similar in terms of sound because their sounds are different for only one sound element and the different sound elements between them are in the same vowel structure and therefore close to each other. In appearance, these trademarks are similar in whole, although they have a slight difference. Taking these matters into consideration as well as the actual conditions of trading including how the plaintiff and the defendant have used their trademarks, the plaintiff's trademark and the defendant's trademark are similar to each other.</p> <p>It is found that the defendant filed the application for registration of the defendant's trademark with respect to cars, etc. as the designated goods, while knowing that the plaintiff is a globally famous car maker and the plaintiff's</p>		

trademark is well known among consumers as indicating the goods pertaining to the plaintiff's business, and also knowing that the defendant's trademark is similar to the plaintiff's trademark, and the defendant has actually been making and selling custom buggies that resemble the cars made and sold by the plaintiff, while using trademarks such as "Lamborghini". Thus, it is found that the defendant uses the defendant's trademark for the purpose of gaining unfair profit, causing damage to the other person, or other unfair purposes.

10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【JPO-5】

1. Title	Manhattan passage v. ManhattanPortage		
2. Country	Japan		
3. Court	Tokyo High Court the 18th civil chamber		
4. Case No.	2002(Gyo-Ke)593		
5. Date of the judgment	2003/11/20		
6. Parties: Plaintiff Defendant	Leisure Products Kabushiki Kaisha Manhattan Portage Ltd.		
7. Mark	Plaintiff	Defendant (cited mark)	
	(trademark in question)		
			
	<i>(‘ManhattanPortage’ combined trademark in other case)</i> 	<i>(figure trademark in other case)</i> 	
8. Outline of the case			
A case in which the plaintiff’s trademark is determined as being filed for the unfair purposes such as to prevent the foreign well-known trademark proprietors from entering into Japan, have them buy out expensively or sign a domestic agency contract.			
9. Summary of the judgment			
The plaintiff’s trademark is constituted as illustrated upper left (see “trademark in question”), has registered as the trademark designating goods including ‘leather, skin, tanned leather, etc.’			
The cited trademark is constituted as illustrated upper right (see “cited mark”) and the defendant designed and used it for ‘messenger bags, softly-made hand bags, backpacks, etc.’ (hereinafter referred to as ‘the defendant’s goods’). The ‘ManhattanPortage’ combined trademark and the figure trademark in other cases are constituted as illustrated upper left. Their rights belong to ‘A’ who was the Representative Director of the plaintiff.			
The defendant started using its marks in the U.S. in April 1983 and obtained the U.S. trademark registrations in July 1997. The cited mark has been widely known at least in the field where bags are handled and among consumers of the goods in the U.S. before the application for registration of the plaintiff’s trademark was filed.			
The defendant and ‘A’ negotiated about transactions of the defendant’s goods. They basically agreed that A would			

purchase the defendant's goods. However, 'A' (or the plaintiff) and the defendant did not reach definitive agreement as to exclusive distributorship of the defendant's goods in Japan.

Further, it is presumed that 'A' sufficiently recognized the reputation of the defendant's goods, and the plaintiff had not notified the relevant parties of the defendant about the plaintiff's application for registration of trademark combined with Portage in other case and the device mark in other case, and furthermore the plaintiff's trademark. There was an unfair purpose in the behavior that 'A' filed the application for registration of the 'ManhattanPortage' combined trademark and the figure trademark in other case, since 'A' filed the application for registration of the plaintiff's trademark similar in appearance (also in sound for the application for registration of trademark combined with Portage in other case) in Japan, understanding that 'A' had no license to use these marks that had been well known in the U.S.

Further, when considering that the plaintiff's trademark closely resembles the 'ManhattanPortage' combined trademark and the figure trademark in other case, it should be concluded that there was an unfair purpose in filing the application for registration of the plaintiff's trademark as well as in filing the applications for registrations of the above mentioned two other trademarks.

Consequently, it shall be concluded that there is no error in the decision stating that filing of the application for registration of the plaintiff's trademark was made for the unfair purpose.

10.Tags

① Type of trial	Suit against trial decision of invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【JPO-6】

1. Title	L’AIR DU TEMPS v. レールデュタン	
2. Country	Japan	
3. Court	the 3rd petty bench of the Supreme Court	
4. Case No.	1998(Gyo-Hi)85	
5. Date of the judgment	2000/7/11	
6. Parties: Appellant Appellee	SARL parfum Nina Ricci madras Inc.	
7. Mark	Appellee (cited marks)	Appellant (Registered Trademark in question)
	(registered trademark) L’AIR DU TEMPS	レールデュタン
	(used trademarks) レール・デュ・タン	
	(used trademarks) L’Air du Temps	
8. Outline of the case		
Judgment upon case concerning the effect that ‘trademarks which are likely to cause confusion with goods or services connected with another person’s business’ as referred to in Article 4 (1) (xv) of the Trademark Act include trademarks that risk causing confusion in the broad sense of the term		
9. Summary of the judgment		
(1) It is legitimate to assume that ‘trademarks which are likely to cause confusion with goods or services connected with another person’s business’ as referred to in Article 4 (1) (xv) of the Trademark Act, when the trademark is used for its designated goods or services, not only trademarks which are likely to cause misunderstanding that the goods, etc. are connected with another person’s goods or services, but also trademarks which are likely to cause such misunderstanding that the goods, etc. are connected with business of a proprietor having a close business relationship with the above mentioned another person, i.e., the business relationship of parent company or subsidiary company, or belonging to a group producing goods to which the same indication is attached (hereinafter, referred to as ‘liable to cause confusion in a broad sense’).		
Whether it is ‘likely to cause confusion’ or not is to be determined totally referring to attentiveness to be generally paid by dealers and consumers of the designated goods, etc. to which the trademark is attached, in light of the degree of similarity between the trademark and another person’s indication, the degree of well-known fame or uniqueness of another person’s indication, the degree of relationship in terms of nature, use, or purpose between the designated goods, etc. of the trademark and goods, etc. connected with another person’s business, and commonality between dealers and consumers in terms of goods, etc. and actual circumstances of transaction.		

(2)The appellee’s registered trademark is identical at least to the trademark ‘レール・デュ・タン’ in sound among the trademarks in use, also resembles in appearance, and further, in view of the spelling itself and designated goods of the appellant’s trademark, sound of “re-e-ru-du-ta-n” in French in terms of the appellee’s trademark. Therefore, it is concluded that the appellee’s registered trademark is identical to the appellant’s trademark in sound. Further, each trademark in use and the appellant’s trademark are unique marks and are famous as indicating one of perfumes of the appellant to consumers who are interested in dealers of perfumes and high-grade perfumes. Still further, among the designated goods of the appellee’s registered trademark, ‘cosmetic utensils, ornaments, head accessories, bags, and pouches’ are closely related to the perfume mainly in the use for decorating woman and thus not a little number of consumers overlap between both goods.

As indicated above, if the appellee’s registered trademark is used for ‘cosmetic utensils, ornaments, head accessories, bags, and pouches’, such use shall be likely to cause confusion in broad sense among the dealers and consumers as if the above described goods are those connected with the business of the proprietor having a close relationship with the appellant as described above.

10.Tags



① Type of trial	Suit against appeal decision
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【JPO-7】

1. Title	MARIEFRANCE v. MARIE FRANCE	
2. Country	Japan	
3. Court	JPO trial and appeal department	
4. Case No.	Appeal No. 25958 (1995)	
5. Date of the judgment	1999/8/11	
6. Parties: Demandant	Zyasu International Kabushiki Kaisha	
7. Mark	Demandant (trademark in question)	Cited mark
	MARIEFRANCE	MARIE FRANCE
8. Outline of the case		
A case in which an application filed was appropriated a well-known trademark in France and applied as the use for unfair purpose		
9. Summary of the judgment		
<p>The demandant's trademark(trademark in question) is constituted of laterally written alphabet letters of 'MARIE FRANCE' and designates goods including 'clothing made in France, coat made in France' and the like. And the alphabet letters of 'MARIE FRANCE' was well-known and famous as a title of magazine in France as of filing the application for trademark registration.</p> <p>Meanwhile, order of letters of the demandant's trademark is completely identical to that of the title of the French magazine, i.e., 'MARIE FRANCE', and thus the both marks are deemed as identical to each other from common sense. Because it is deemed impossible that the demandant could independently or coincidentally select and file the letters arranged in the same order without knowing the 'MARIE FRANCE' magazine, it is reasonable to consider that the demandant used the title of the 'MARIE FRANCE' magazine almost as it is appropriated.</p> <p>The demandant's trademark designates goods of 'clothing, coat, sweaters, nightwear, underwear, swim wears for ladies' and the like, the 'MARIE FRANCE' magazine runs information, etc., as to ladies' fashion, and, when considering that French fashion draws high interest also in Japan. Therefore it is assumed that consumers of ladies' fashion magazine and consumers of the designated goods of the demandant's trademark shall overlap each other to some extent. If so, in a case where the right proprietor of the 'MARIE FRANCE' magazine or a person related to the proprietor attempts to enter into Japanese market, it would be likely to cause confusion of the indicating source with the demandant's trademark, which in turn results in preventing them from entering to Japanese market.</p> <p>When taking the above into consideration, the demandant's trademark was filed as to be appropriated on almost the same trademark that is well-known and famous in a foreign country, and thus the application must be filed with unfair purpose contrary to the fair and equitable principle.</p>		

10.Tags	
① Type of trial	Appeal against an examiner's decision of refusal
② Decision	Decision for refusal
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【JPO-8】

1. Title	M.A.C MAKEUP ART COLLECTION v. M.A.C	
2. Country	Japan	
3. Court	Opposition to the Registration (Trial / Appeal at JPO)	
4. Case No.	Appeal No. 92239 (1998)	
5. Date of the judgment	2000/3/28	
6. Parties:		
Owner of TM Rights	Kabushiki Kaisha Trysail	
Opponent	Make-up Art Cosmetics, Inc.	
7. Mark	Trademark in Question	Cited Trademark
		
8. Outline of the case		
<p>A case in which the trial examiners rendered a ruling that the trademark registration concerned in the opposition would be revoked. In this case, trial examiners admitted that the trademark in question had been used for unfair intension, namely intension to prevent the foreign well-known trademark proprietors from entering into Japan, to cause dilution of the trademark and to gain unfair profit, etc.</p>		
9. Summary of the judgment		
<p>The trademark in question is constituted of designed “M.A.C” and “MAKEUP ART COLLECTION” that are in two lines (see “Trademark in Question”) and designates goods including “bags, pouches, cosmetics bags, fittings for bags, opening fittings for wallets, horse-riding equipment” and the like. The cited trademark, referred by the opponent, is constituted of letters of “M.A.C” (see “Cited Trademark”) and designates goods including “fragrance, cosmetics, tooth paste”.</p>		
<p>The cited trademark of the opponent is used as the trademark for “make-up cosmetics”, etc., which has been worldwide popular products among Canada, America, etc.</p>		
<p>The alphabet letters of “MAC” constituting the trademark in question are perfectly identical to those of the cited trademark into detail in terms of the decoratively featured design. Further, the letters of “MAKEUP ART COLLECTION” written in the lower line is liable to cause consumers to recognize as if it has some relationship with the make-up cosmetics of the opponent’s business, and the designated goods of the trademark in question also includes cosmetic bags where cosmetic bags are also the goods that the opponent sells.</p>		
<p>Taking the above into consideration, it is hard to presume that the trademark in question accidentally coincides with the cited trademark. It is rather presumed that the owner of the trademark in question filed the application</p>		

and obtained the registration thereof for the purposes of preventing the foreign proprietor from entering to Japanese market, enforcing the foreign proprietor to make an agency agreement in Japan, gaining unfair profit by diluting, or free riding on the consumer attracting power of the cited trademark to gain unfair benefit. Therefore, the trademark in question must be considered as the trademark being used for the unfair purposes.

10.Tags


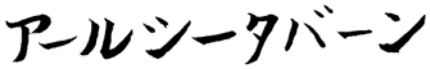
① Type of trial	Opposition to the Registration
② Decision	Ruling to revoke
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【JPO-9】

1. Title	SONY v. SONYAN	
2. Country	Japan	
3. Court	Tokyo High Court	
4. Case No.	1977 (Gyo-Ke) 133	
5. Date of the judgment	1978/4/26	
6. Parties: Plaintiff Defendant	SONY Corporation Y	
7. Mark	Plaintiff (cited mark)	Defendant (trademark in question)
	SONY	SONYAN
8. Outline of the case		
A case in which the trademark in question which contains therein another person's famous trademark as a main part thereof, was constituted to be invalid since it readily remind of and perceives another person's famous abbreviated name.		
9. Summary of the judgment		
<p>The trademark in question is constituted of letters of "SONYAN" (see "trademark in question) and designates goods including "woven fabric, knit fabric, and other fabrics including felt".</p> <p>Incidentally, an invented word mark constituted of alphabet letters of "SONY" and a mark constituted of katakana characters of "ソニー" representing sound of "SONY" have been remarkably famous both domestically and internationally as the trademark for "electrical equipment" such as "transistor radio, television, tape recorder", etc. of the business of the plaintiff. In other words, it is admitted that both the "SONY" and "ソニー" have been well-known and famous in the public not only as the trademark for goods produced and sold by the plaintiff but also as the abbreviated name of the plaintiff at the time when the trademark in question was filed. On the other hand, where a series of letters of "SONYAN" of the trademark in question has no remarkable feature in font design, the first four letters among all the six letters are coincide with the plaintiff's invented word "SONY" and the last two letters "AN" following the first four letters are frequently intuitively recognized as giving a meaning of "one's", "having the nature of", or "of a race of" in the light of the benchmark of the English knowledge in Japan.</p> <p>When taking the above into consideration, the trademark in question shall easily remind of and perceive the famous abbreviated name of "SONY" and shall highly possibly mislead the public to read the main portion as "SONY".</p> <p>Since the trademark in question shall be considered as a trademark containing another person's famous abbreviated name therein, and thus falls under Section 4 (1) (viii) of the Trademark Act, it should be constituted to be invalid.</p>		

10.Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【JPO-10】

1. Title	RC TAVERN / アールシータバーン v. アールシータバーン	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2012 (Gyo-ke) 10019	
5. Date of the judgment	2012/5/31	
6. Parties: Plaintiff Defendant	Dynac co.Ltd Y	
7. Mark	Plaintiff(plaintiff's trademark)	Defendant (trademark in question)
		
8. Outline of the case		
A case in which the trademark in question is not considered as the actually used trademark or the trademark that the proprietor has the intention to use in the future at the time when the trademark in question was decided to be registered		
9. Summary of the judgment		
<p>The trademark in use by the plaintiff is constituted as illustrated above (see “plaintiff’s trademark”) and the trademark in question, which designates services including “serving foods and drinks”, is constituted as illustrated above (see “trademark in question”).</p> <p>When taking account of the fact that trademark in question has a constitution identical to the plaintiff’s trademark in use except for the font design of the letters of ”アールシータバーン” and the sound of the trademark in question is identical to the plaintiff’s, i.e., sound of “a-a-ru-si-i-ta-ba-a-n”, it is admitted that the trademark in question is similar to the plaintiff’s trademark.</p> <p>In view of the facts that the plaintiff’s trademark is a coined phrase created by combining “RC” which is the initials of the name of the restaurant, “Rose & Crown”, operated by the plaintiff, with “Tavern,” which is an English word meaning a pub or bar, and it may be considered to be distinctive, and that the timing of advertisement and opening of the establishment is close to the date of filing an application for the trademark in question, the defendant may be considered to have filed an application for the trademark in question, which is similar to the plaintiff’s trademark in use, with the awareness of the existence of the plaintiff’s trademark in use.</p> <p>Where the defendant filed 44 applications for registration of trademarks in addition to the trademark in question in a short period and obtained decisions of registrations thereof, the defendant has not been using any of the</p>		

obtained registered trademarks for designated services or the other business to date, and the designated services expand in a wide range, has no consistency, and further, with respect to 30 trademarks among the registered trademarks not in use, there are shops/restaurants and companies using similar trademarks and marks irrelevant to the defendant, and still further, with respect to at least 10 trademarks among the registered trademarks not in use, the applications for trademark registration was filed by the defendant after start of the use of the other persons' similar trademarks or marks.

In sum, the defendant filed applications for trademark registration designating various services with respect to another persons' trademarks or marks in use only for the purpose of collecting the registered trademarks.

Consequently, the trademark in question is not considered as being the trademark in use that is used for goods or services connected with the defendant's business or the trademark that will be intentionally used for goods or services connected with the defendant's business in the future.

It is not admitted that filing of the trademark in question was made for "any trademark to be used in connection with goods or services pertaining to the defendant's business of an applicant", and thus was registered contrary to main paragraph of Section 3 (1) of the Trademark Act".

10.Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	
Lack of intention to use	✓

Case Examples of KIPO

【KIPO-1】

1. Title	ALPINESTARS v. ALPENSTER	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2012 (Heo) 2364	
5. Date of the judgment	2012/6/8	
6. Parties: Plaintiff Defendant	Alpinestars Research SRL Kolon Industries, Inc	
7. Mark	Plaintiff	Defendant
	ALPINESTARS	ALPENSTER
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognizing the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>The plaintiff has manufactured boots for motocross (A cross-country motorcycle race) and road racing since it was established as hiking and skiing boots manufacturer at the end of 1962 in Italy. The plaintiff has manufactured all kinds of technical protective gear for motorcycling including gloves, jacket and leather suit since 1990. Since then the plaintiff has diversified into action sports clothing and casual clothing. B) The plaintiff named the trademark ‘ALPINESTARS’, flower translated ‘Stella Alpina’(A star of Alps) in alpine region near the manufacturer into English, and has put the trademark on the product as prior use trademark.</p> <p>Determination of ‘unjust purpose’ should be judged by taking into account whether the goods of certain person is well known to, famous and creative, how similar or identical are the certain person’s trademark and registered one, whether the negotiation is done or what’s contained between applicant and certain person, other relationship between two parties, whether the applicant prepared detailed project plan, identity or similarity of the product and closer economic relation and business status under Article 7(1)(xii) of Trademark Act.(See 2010 Hu 807 decision sentenced on July 15 in 2010 by Supreme Court)</p> <p>Given that whether the prior use trademark on ‘motorcycle boots and action sports clothing’ were notably recognized in Italy on June 16 in 2008, the application date of the registered trademark, beyond recognition that consumers indicate them as goods of certain person, the registered trademark is similar to prior use trademark, whether ‘motorcycle athlete’s boots, sports shoes, clothing only for sports, socks and necktie, class of goods of the registered trademark are identical or similar to ‘motorcycle boots and action sports clothing’, goods with prior use trademark, and whether there is closer economic relation between them and the defendant was aware of the existence of prior use product as large scale action sports clothing manufacturer, it is judged that defendant intended to make unfair profit based on high quality image and attraction to customers of prior use trademark by copying prior use trademark, well known trademark, and filed an application and registered the trademark aiming</p>		





at damaging the plaintiff, user of the prior use trademark..	
10.Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-2】

1. Title	なかつたコトに！ v. なかつた コトに (Naghata gotoni)	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2015 (Heo) 185	
5. Date of the judgment	2015/9/4	
6. Parties: Plaintiff Defendant	Graphico Inc (Joint owner of the trademark) Cardland Inc Chungmook Kim	
7. Mark	Plaintiff	Defendant
	なかつたコトに！	なかつた コトに
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>TV Shopping laboratory, Japanese legal entity, decided to launch soybean protein based diet dietary supplement and named the product as ‘Naghata gotoni’, which refers to ‘forget everything that happened’ to emphasize the feature of the product so called ‘No matter how much you eat, you don't gain weight’. The laboratory filed an application of trademark registration for the prior use trademark ‘Naghata gotoni’, on June 5 in 2002 in Japan and registered the trademark on February 28 in 2003. And the entity has advertised and merchandised the supplement with prior use trademark through many home shopping channels across the nation since 2003.) Grapico, plaintiff, has developed and distributed products through pharmacy and general store since the Grapico was established on November 7 in 1996, Grapico has merchandised products with prior use through offline store and online store such as 「bibalmall.com」, 「www.jplug.com」 of Matsumotokiyoshi, pharmacy chain store, while promoting the products through various broadcasting media since it was received right of non-exclusive use of prior use trademark from TV Shopping laboratory on September 1 in 2008. Plaintiff signed an exclusive sales contract on the products with prior use trademark with Korean companies, Card land corporation and H&D corporation, on December 17 in 2013. Whether the applicant filed an application based on ‘unjust purpose’ should be judged by considering following situations. It is judged that the applicant filed and registered trademark to make unjust profit based on high quality image of prior use trademark and attraction to customers by copying prior use trademark and to damage plaintiff by diluting the value of the mark above. As shown above, the prior use trademark was well known to customers, as if they recognized ‘Grapico’, certain company, as the leading manufacturer of diet dietary supplement when the registered trademark was filed in Japan. It was not common for Korean company to file an application with only Japanese language trademark and the registered trademark, ‘Naghata gotoni’, which refers to ‘forget everything that happened’ was too similar to the prior use trademark despite the trademark’s creativity.</p>		


10.Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-3】

1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2013 (Heo)174	
5. Date of the judgment	2013/7/11	
6. Parties: Plaintiff Defendant	Guangzhou Nandadi Textile Garment Co., Ltd RCRV, Inc	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant claimed invalidation trial of registration to Intellectual Property Tribunal against plaintiff, holder of trademark right (Case 2011 Dang No.1555). It is judged that the registered trademark was identical or similar to the prior use trademark 1, 2, which were recognized as indicating the defendant's product in U.S and Germany at the time of filing the application and the plaintiff filed and registered trademark to make unjust profit or damage defendant. Defendant claimed that the registration shall be invalidated under the Article 71(1)(i), 71(xii) of the Trademark Act. The Intellectual Property Tribunal decided that the registration of registered trademark is invalid by accepting request for trial above as the registered trademark conforms Article 7(1) (xii) in connection with prior use trademark 1 and 2 on November 6 in 2012. Facts recognized with one consent, plaintiff's Exhibit No.1, 2, defendant's Exhibit No.2 or 24, intent of whole pleading. Plaintiff claimed that the registered trademark is irrelevant to prior use trademark, there is no unjust purpose on it and it is the changed one of the trademark which plaintiff has used before the application (hereafter called 'relevant trademark') According to 1 of defendant's exhibit No.6 or each record of No.18, it is acknowledged that plaintiff determined a mark as and clothing as class of goods, filed applications from November 14 in 2006 to June 4 in 2008 in China, Korea, Benelux, Japan and the U.K and plaintiff manufactured jean with relevant trademark. Therefore, the registered trademark seems to be a changed one of relevant trademark as its mark is too similar to relevant one. However, plaintiff filed initial application (November 14 in 2006) after the plaintiff manufactured and distributed jeans with prior use trademark, the relevant trademark was similar to the prior use trademark as well as the registered trademark. The facts above demonstrates that plaintiff has unjust purpose as plaintiff's relevant trademark which has been used by plaintiff since November of 2006, is similar to the registered trademark despite of many circumstances above. The plaintiff's claim above has no grounds.</p>		



10.Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-4】

1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2015 (Heo) 6343	
5. Date of the judgment	2016/5/13	
6. Parties: Plaintiff Defendant	Hongchul Kim Wonsuk Choi	
7. Mark	Plaintiff 	Defendant 
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>The plaintiff sold oriental medicine product at store called 'Noble Pharm' in 2002 and established ToPha Korea Inc on January 17 in 2007(since then the store name was changed into 'Dr. Pharm' on July 24 in 2009 and it was changed into 'Dr. Pharm. Inc Pharmaceuticals Inc' on March 31 in 2010, hereafter called Dr. Pharm Inc). The plaintiff has manufactured cosmetics such as BB cream, pore cleansing pack, iced snow skin toner with prior use trademark, which plaintiff and the company acquired, since the Dr. Pharm Inc was established. And has sold them on the internet shopping mall and exported through Noble Pharm or Dr. Pharm Inc. Defendant sold sunglasses at the store called 'Sampoong International' in duty free shop in October of 2005, merchandised cosmetics in duty free shop in March of 2009 and has established and run 'Sampoong International' which specializes in research, manufacturing, wholesale and retail and distribution since October 19 in 2011. Plaintiff or Dr. Pharm Inc provided cosmetics such BB cream with prior use trademark with defendant from March of 2009 to September of 2010 and allowed the defendant to sell them at defendant's own duty free shop. It is acknowledged that the registered trademark was identical or similar to prior use trademark, which was recognized as indicating product of plaintiff, Dr. Pharm Inc among customers home and abroad when the application is filed and defendant filed and registered the trademark based on unjust purpose to make unfair profit by go along with prior use trademark's credit, the registered trademark falls under Article 7(1) (xii) of the trademark Act.</p>		
10.Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	
② Decision	Cancellation	




③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-5】

1. Title	HUM v. Hum	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2016 (Heo) 1628	
5. Date of the judgment	2016/7/22	
6. Parties: Plaintiff Defendant	Jongsik Kim YK038 Co.,Ltd	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant has run textile, clothing and fashion business since it was established on September 24 in 1997 and the defendant has manufactured and merchandised coat, jumper, jacket, pants, skirts and shirt since clothing brand 'Hum' was launched on January 20 in 2003. Defendant has promoted the brand 'Hum' by naming top celebrities for advertisement from November 29 of 2002 to the date of the registered trademark application. The news that TV star Boolam,Choi worked as advertisement model at Hum launch show on November 29 in 2002 was reported on December 10 in 2002 in daily newspaper MunhwaIlbo and on December 16 in 2002 in International Textile News(ITN), news that TV star Eungyung Im worked as advertisement model exclusively for Hum was reported on June 16 in 2003 in ITN, news that TV star Donggeun Lee, who became popular after starring in the TV drama called 'lovers in Paris', worked as advertisement model exclusively for Hum was reported on July 25 in 2004 in sports news, news that TV star Ahra Go worked as a model exclusively for Hum was reported on Feb 17 in 2006 in Fashionbiz, on Feb 20 in 2006 in chosun.com and on Aug 7 in 2006 in ITN. Advertisement photos that TV star Donggeun Lee in Hum clothes were released in Hum catalogue in 2004, Advertisement photos that TV star Ahra Go in Hum clothes were released in Hum catalogue in 2006. The news that the brand 'Hum' supported drama 'Yurihwa' and intended to increase awareness of the brand by exposing its store and clothes were reported on November 15 in 2004 in Fashionbiz and on December 13 in 2004 in ITN. The prior use trademark is recognized as indicating the defendant's product, the clothing, by domestic consumers on December 4 in 2008, the date of the registered trademark application, it is acknowledged that the registered trademark 'HUM' was identical or similar to prior use trademark 'Hum'. It is judged that the applicant, Myungohk, Ahn filed and registered trademark to make unfair profit based on high quality image of prior use trademark and attraction to customers by copying prior use trademark and to damage defendant, the user of the prior use trademark, according to 1 of defendant's Exhibit</p>		

No.3 or 8 and intent of whole pleading.	
10.Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-6】





1. Title	LOOK v. LOOK	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 2276	
5. Date of the judgment	2014/9/25	
6. Parties: Plaintiff Defendant	LOOK CYCLE INTERNATIONAL, societe anonyme Junglan Lee	
7. Mark	Plaintiff	Defendant
		
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
Plaintiff manufactured ski equipment in 1951 in Nevers, France. Since then plaintiff has manufactured clipless pedal for bicycle by imitating skibinding since 1984 and carbon frame for bicycle since 1986. The company has manufactured bicycle and bicycle parts since the ski equipment manufacturing business was separated in 1994. Plaintiff has manufactured frame or pedal for bicycle with prior use trademark 1 and prior use trademark 2, in 1987 and 1991 respectively. News that FCU (France Cycling Union) signed exclusive use contract on clipless pedal with LOOK Cycle International, societe anonyme (hereafter called LOOK), the company (LOOK) signed various licensing contract based on source technology on safe pedal, exports 700,000 pedals, which accounts for 60% in domestic market, was (plaintiff’s Exhibit No.11) reported on March 8 in 1992 in Le MONDE, French daily newspaper. News that the frame created by LOOK/ will be connected to a fork, with the same material of it, /and French champions who will participate in Barcelona Olympic Games, will have bicycles equipped with the frame(plaintiff’s Exhibit No.12), was reported on June 10 in 1992. The newspaper on July 8 in 1997 said that ‘the revolution was broken out in 1984’ entitled ‘automated pedal’. LOOK and Bernard Hinault invented automated pedal, after Cinelli, Italian company, tried to invent it. And all professional players and some amateurs (road bicycle and mountain bike players) use this mechanic system to release their feet when falling off (plaintiff’s Exhibit No.13).’ The fact above demonstrates that the prior use trademarks were well known to customers for parts of bicycles in France, recognized as indicating the product of the certain person at the time when of filing of the application for the registered trademark, the registered trademarks were too similar to the prior use trademarks and class of goods of the registered trademarks, bicycle related items including bicycle, frame for bicycle and rim for		

bicycle, are all identical and the defendant was already aware of the existence of the prior use trademark as the defendant has merchandised and repaired bicycle. It is judged that defendant filed and registered trademark to make unfair profit based on business reputation of prior use trademark by copying the prior use trademark, well known to customers in France, and to damage plaintiff by diluting the trademark and interrupting plaintiff's business based on unfair purpose.

10.Tags




① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-7】

1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014(Heo) 6209	
5. Date of the judgment	2015/1/9	
6. Parties: Plaintiff Defendant	Vans, Inc Youngmi Kim	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Plaintiff has manufactured shoes, bags, wallet, belt, clothing, socks and hats with prior use trademark in U.S and Canada since 1971(plaintiff's Exhibit No.9 and 20)) The catalog, published by plaintiff in the fall of 2008, contains a variety of cases of shoes with VANS(trademark) and prior use trademark, as shown in the picture(plaintiff's Exhibit No.40). The catalog, published by plaintiff in spring of 2009, contains a variety of cases of shoes with VANS(trademark) and prior use trademark, as shown in the picture (plaintiff's Exhibit No.41). Articles from Korea media reported on prior use trademark and product with prior use trademark before the date of the application for registered trademark are as follows. Skateboarding shoes, which are mounted on skate board, were first manufactured by VANS in 1966. OLD SKOOL, world's first product, was manufactured by the company. The value of the skateboarding shoes has increased as shoes of VANS were distributed through ABC Mart, large shoes distributor, 4 years ago in Korea. VANS has been topped of 40 selling brands in ABC Mart (plaintiff's Exhibit No.53, Yonhap News reported on October 31 in 2005)). e registered trademark is very similar to prior use trademark, the prior use trademark was recognized as plaintiff's leading brand in Korea and had creativity with unique shape. And class of goods of the registered trademark contains footwear with prior use trademark. It is acknowledged that the registered trademark is a counterfeiting trademark of prior use trademark, recognized as indicating product of plaintiff and it was filed to damage plaintiff and make unjust profit by interrupting the conduct of business.</p>		
10.Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	
② Decision	Cancellation	

③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-8】





1. Title	ROLEX v. <i>POLEX</i>	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 7776	
5. Date of the judgment	2015/5/8	
6. Parties: Plaintiff Defendant	ROLEX SA EDAMIC Co.,Ltd.	
7. Mark	Plaintiff	Defendant
		
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
Montres Rolex SA, Plaintiff, has produced and merchandised high functioning and quality watch with prior use trademark since it was established in 1920 in Geneva, Switzerland. ㉞ The prior use trademark was voted as one of global top 100 brands by Interbrand, global brand consulting company, in 2000 to 2009, plaintiff has run official watch stores in 100 countries and merchandised watches with prior use trademark in department stores in major cities across the country. ㉟ Plaintiff made 78.1 billion 25.64 million in 2012 and 85.9 billion 48,74 million in 2013, news on the company and prior use trademark was frequently reported by Korea major media and internet site. ㊱ The prior use trademark is listed in ‘frequently pirated trademark information’ issued by KIPO and is frequently mentioned as an example to promote eradicating imitation of a well-known trademark ㊲ Brand awareness survey, plaintiff asked Korea Trademark & Design Association to conduct, showed that 94.2% of respondent said they have heard about watch trademark such as the prior use trademark. The registered trademark, such as, is alphabetical mark with somewhat designed last letter ‘X’, tilted slightly to the right, for example, the prior use trademark is general type alphabetical mark. However, 5 capital alphabets of both marks are arranged in order, first letter is ‘P’ and ‘R’ respectively, the rest letters ‘OLEX’ are identical. In particular, there is a stroke difference between letter ‘P’ and ‘R’. The grounds mentioned earlier and intent of whole pleading of plaintiff’s Exhibit No. 32-37 demonstrate that defendant filed trademark, similar to ' a watch brand, on May 31 in 2010, a year ago of application for the registered trademark and it had decision to reject the application. It is recognized that watch shops with prior use trademark have been in business in department stores in major cities in Korea and		

enjoyed high sales. It is judged that the defendant was well aware of constitution and awareness of application at the time when of filing of the application for the registered trademark and filed an application and registered the trademark aiming at launching the similar kinds of product to one of the prior use trademark. It is judged that the registered trademark is likely to make customers confused with the resources by easily associating with prior use trademark, notably recognized as indicating the plaintiff's product, product with prior use trademark and business. Thus, the registration shall be invalidated without any dispute over plaintiff's remaining claim as the registered trademark falls under Article 7(1)(x) of the trademark Act.

10.Tags



① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-9】

1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 1655	
5. Date of the judgment	2014/5/29	
6. Parties: Plaintiff Defendant	Sieun Ha Louis Vuitton Malletier	
7. Mark	Plaintiff 	Defendant 
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognizing the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>The grounds mentioned earlier and intent of whole pleading of defendant's Exhibit No. 1 or 9 demonstrates that defendant (Louis Vuitton Malletier) has manufactured and merchandised bags including handbag since it was established by a designer, Louis Vuitton, in 1854. The prior use trademark of defendant was well known and famous mark worldwide for bags including handbag. It is clearly obvious that it was listed as 'frequently pirated trademark home and abroad' in 'foreign trademark information' and 'frequently pirated trademark home and abroad', which were issued annually by KIPO, in 1988 to 2003, at the time of filing and application for the registered trademark. The gist of a claim of class of goods of the registered trademark has no closer economic relation to product with prior use trademark. Provided, the relation is just considerable factor to judge 'unfair purpose' under Article 7(1) (xii). Thus, the closer economic relation is not an important factor to determine whether the claimed trademark falls under the Article above. Given awareness, greatness and creativity of prior use trademark, plaintiff's trademark application history and that the registered trademark contains a large number of products, which have closer economic relation to product with prior use trademark, in addition to class of goods of gist of a claim products, plaintiff's unjust purpose is fully recognized. It is judged that the registered trademark falls under Article 7(1) (xii) of the trademark Act even if class of goods of gist of a claim has no closer economic relation to product with prior use trademark. Thus, plaintiff's claim above is not acceptable.</p>		
10.Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	
② Decision	Cancellation	

③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【KIPO-10】

1. Title	LOUIS CASTEL v. LOUIS CASTEL	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 1938	
5. Date of the judgment	2014/8/21	
6. Parties: Plaintiff Defendant	Deokbum Jung (Joint owner of the trademark) Younglak Choi Jaeyeop Lee	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant is a CEO of VL & CO Inc, established on March 2 in 2007, approved the company to use prior use trademark at the time. VL & CO Inc has manufactured and merchandised bags, hats, belts, key holder, necktie and socks including golf clothing with prior use trademark. VL & CO Inc has manufactured and merchandised products since the later half of 2007. The company made 6,288,818,576 won the second half of 2007 and 2,958,985,254 won the first half of 2008, golf clothing was a major contributor to its revenue. VL & CO Inc opened high end brand store, direct management store, in Yangjae-dong, Seoul in September 2007. It opened 20 stores in Seoul, Ilsan, Daegu, Busan, Gangneung, Donghae(East sea), Pohang and Jeju island by the end of 2007, most of which were more than 100 m² and located in major business districts.</p> <p>*Determination on whether the applicant of the registered trademark has unfair purpose</p> <p>The facts recognized above and fact recognized based on defendant's Exhibit No. 1, No.67 and 68 are as follows. Prior use trademark was well known to customers home and abroad indicating it as certain person's product as golf clothing at the time of filing the application for the registered trademark. Prior use trademark 1, 'LOUIS' in French (LOUIS gold coin, its denomination is 20 franc) and 'CASTEL' (castle) are combined, which is an inventive combination. It has relatively high creativity, the registered trademark has same combination as the prior use trademark. Sunglasses, sports goggles and golf clothing with prior use trademark, the class of goods, were manufactured and merchandised by a single manufacturer at the time of filing the application for the registered trademark. In other words, sunglasses, sports goggles with the registered trademark are likely to be recognized as using similar product to 'golf clothing' and can lead to misunderstanding as if they are used by holder of prior use trademark right. The fact demonstrates that the applicant, Taesoo Lee, filed and registered trademark to make unfair profit based on business reputation of prior use trademark 1 by copying the prior use trademark 1, well</p>		



known to customers, and to damage defendant by diluting the trademark and interrupting defendant's business based on unfair purpose.

10.Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

Case Examples of SAIC

【SAIC-1】

1. Title	 v. 惠尔康 (Protection of unregistered well-known trademark “惠尔康”)	
2. Country	China	
3. Court	Supreme People’s Court of the People's Republic of China	
4. Case No.	[2014] Zhi Xing Zi No.9	
5. Date of the judgment	2014/10/9	
6. Parties : Plaintiff Defendant	Fuzhou Weitalong Nutritious Food Co., Ltd. Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
Where a trademark for registration to be used on identical or similar goods is a copy, imitation, or translation of a well-known trademark of another party which has not been registered in China and may easily cause confusion, it shall not be registered and shall be prohibited from use.		
9. Summary of the judgment		
<p><u>Fact Finding</u></p> <p>According to the facts found out by the original court, the evidences provided by Xiamen Huierkang during trademark review can prove that this company has been using the trademark “惠尔康” for a long time and has made great efforts on promotion thereof. The trademark “惠尔康” had a high brand awareness prior to the date of application. What’s more, Xiamen Huierkang and its affiliates used the trademark “惠尔康” earlier than Tianjin Huierkang(assignor of Trademark No. 701244), and the date it registered phonetic alphabet and figure of the Trademark for production and operation of food & beverage was also earlier than the date of registration application for Trademark No. 701244. Thus, it is reasonable and legitimate for the Company to use the trademark “惠尔康” in Chinese on its food & beverage products. The fact that the application for registration of the Chinese trademark “惠尔康” was rejected shall not represent that the company has no right to use the trademark. Although there is similarity between the Chinese trademark “惠尔康” used by Xiamen Huierkang and Trademark No. 701244, there are also some sensible differences in the overall structure and the characteristics styles, therefore they are not the same trademark. Considering no evidence which can prove that Trademark No. 701244 has been</p>		

used really and continuously for a certain period and certain brand awareness, there is no subjective intention and objective fact for use by Xiamen Huierkang of the trademark “惠尔康” that Xiamen Huierkang desires to seek for unfair interests by means of use of other persons’ trademarks, and such use will not lead confusion or misunderstanding. Accordingly, the Chinese trademark “夏尔康” actually used by Xiamen Huierkang is not a similar trademark with Trademark No. 701244 to the extent of infringement of trademark right; the claim made by Weitalong(assignee of Trademark No. 701244) that use by Xiamen Huierkang of the unregistered trademark “惠尔康” constituted an infringement of the right to Trademark No. 70244 lacks of relevant facts and legal basis; in addition, the cause stated by Weitalong that the unregistered trademark “夏尔康” used by Xiamen Huierkang may not be recognized as a well-known trademark due to such reason may not be accepted and then rejected by the Court.

Opinions of the Court

The disputed trademark and Trademark 701244 are different and independent trademarks in the fields of marks and designated commodities, and there was no extension or transfer of business reputation between the two trademarks. It has no legal basis for the claim made by Weitalong that indicates that the disputed trademark was an application for renewal or extension of Trademark No.701244. Whether transfer of Trademark No. 701244 is valid and effective is not the cause for the Trademark Review and Adjudication Board and the original court to judge registration of the disputed trademark is unfair and is irrelevant to the Case. The essential attribute of a trademark is a mark by which an operator distinguishes its own commodities or services from others. An operator that applies for trademark registration shall have real use intention, respect any prior legal rights acquired by others and abide by the basic principle of good faith. The evidence submitted by Xiamen Huierkang during trademark review and legal proceedings can prove that Weitalong had performed a series of activities for trademark squatting against Xiamen Huierkang. Thus, it is improper for Weitalong to insist on registering the disputed trademark which is the same as the trademark “惠尔康” actually used by Xiamen Huierkang for the same or similar commodities. In fact, Trademark No. 701244 is not a trademark with certain goodwill through long-term use and promotion. After accepted by Weitalong, the Trademark No. 701244 was revoked for non-use in 3 consecutive years, and such transfer had been judged as invalid and null in another case. Therefore, the causes for retrial applied by Weitalong with respect to the trademark are rejected by the Court.




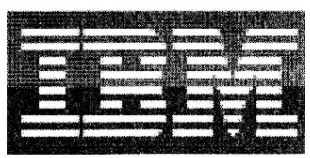
To sum up, the Trademark Review and Adjudication Board confirmed that the trademark “惠尔康” used by Xiamen Huierkang was a well-known trademark and it was the disputed trademark that copied and imitated the well-known trademark, based on which it decided to revoke the registration of the disputed trademark. Such ruling conforms to the Trademark Law; therefore, it is appropriate to maintain such ruling in the two original trials. Furthermore, the application submitted by Weitalong for retrial does not conform to the retrial conditions provided for in Article 63.2 of the Administrative Procedure Law of the People's Republic of China and Article 72 of the Interpretation of the Supreme People’s Court on Several Questions about Implementation of the Administrative Procedure Law of the People's Republic of China. Pursuant to Article 74 of the Interpretation of the Supreme People’s Court on Several Questions about Implementation of the Administrative Procedure Law of the People's

Republic of China, it is hereby ruled as follows: to reject the application for retrial submitted by Fuzhou Weitalong Nutrition Food Co., Ltd.

10.Tags

① Type of trial	Suit for the decision of trial
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【SAIC-2】

1. Title	 v. 	
2. Country	China	
3. Court	Trademark Office of the State Administration for Industry and Commerce	
4. Case No.	(2014) Shang Biao Yi Zi No. 00085	
5. Date of the judgment	2014/1/28	
6. Parties : Plaintiff Defendant	International Business Machines Corporation (IBM) Foshan Shunde Huineng Electromechanical Equipment Co., Ltd.	
7. Mark	Cited Trademark	Disputed Trademark
		
8. Outline of the case		
<p>The Trademark Office confirmed that the cited trademark was a well-known trademark for such commodities as “computer programs and software”. The disputed trademark was very similar visually with the cited trademark. Considering the originality and popularity of the Defendant’s trademark, the Trademark Office deemed that there was subjective intention of copy and imitation in the disputed trademark and that approval of the application for registration of the disputed trademark would mislead the consumers, which would further result in damage on the business reputation of the Plaintiff. Therefore, the Trademark Office refused the application for registration of the disputed trademark.</p>		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>Beijing Wan Hui Da Intellectual Property Agency, the agent of IBM (hereinafter referred to as the “Plaintiff”), challenges against Trademark No.9062752, “IBM 及图”, for which was applied by Guangzhou HuaQi Intellectual Property Deputize Ltd, the agent of Foshan Shunde Huineng Electromechanical Equipment Co., Ltd. (hereinafter referred to as the “Defendant”), and which was reviewed by the Trademark Office and publicized on the 1295th Trademark Announcement. The Trademark Office accepted the case pursuant to Article 30 of the Trademark Law of People’s Republic of China. The Defendant failed to reply within the required period.</p> <p><u>Opinions of the Trademark Office</u></p> <p>According to the facts and causes stated by the Parties, the Trademark Office deems that the Plaintiff, established in 1911 in the USA, is a world famous information technology and business solution company, consisting of such main departments as Global Technology Services Department, Global Business Consulting Service Department, Software Group, System and Technology Department and Global Financing Department. In 1979, Shenyang Blower Works Group Corporation imported IBM370/138 mainframe, which was the first computer sold by IBM</p>		

to Mainland China after the founding of New China. In 1992, ETC was established in Shanghai, mainly engaged in China General Spare Parts Center. In 2005, ISTC was established as the strategic base of IBM for order performance and manufacture. IBM had established 31 branches in China as of 2011, and at least 3 affiliates have the right to use the trademark “IBM”. As of September 30, 2011, IBM’s market value reaches up to USD214 billion and then became Top 2 technology company, surpassing the market value of Microsoft. The Plaintiff has successfully registered the trademark "IBM" for several kinds of commodities No. 9, 16, 37 and 42 and certain service items in China. The Plaintiff has made great efforts to publicize its trademark and products by means of magazines, newspaper, TV and other media. All such facts are supported by the copies of some advertisements, Annual Financial Statements and Audit Reports of IBM China from 2008 to 2010 which are provided by the Plaintiff. Trademark “IBM” owned by the Plaintiff has been widely known and enjoyed high reputation in China through long-term and wide promotion and use. Therefore, pursuant to Article 14 of the Trademark Law and the Provisions on the Recognition and Protection of Well-known Trademarks, the Trademark Office recognized the trademark “IBM” registered and used by the Plaintiff for such commodities as computer programs, computer software, computer hardware, computers and peripheral units as the well-known trademark.





The disputed trademark “IBM 及图” is more or less the same as Trademarks No. 1509898, No. 1767764 and No. 221321 in overall design and visual sense. Considering the originality and popularity of the Plaintiff’s trademark, the Trademark Office deemed that there was subjective intention of copy and imitation in the disputed trademark of which the Defendant applied for registration and that approval of the application for registration of the disputed trademark would mislead the consumers, which would further result in damage on the business reputation of the Plaintiff.

Pursuant to Articles 13.2 and 33 of the Trademark Law of the People’s Republic of China, the Trademark Office rules that the claims made by the Plaintiff are accepted and that the registration application for Trademark No.9062752, “IBM 及图” will not be approved.

10.Tags

① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【SAIC-3】

1. Title	 v.  (Protection of prior copyright “m”)	
2. Country	China	
3. Court	The High People’s Court of Beijing	
4. Case No.	Administrative Judgment (2015) Gao Xing (Zhi) Zhong Zi No. 3963	
5. Date of the judgment	2015/12/25	
6. Parties : Plaintiff Defendant	Ou Yongwei Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Mothercare Limited	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
<p>Mothercare Limited legally owns the copyright to the works it claims; the disputed trademark is basically the same as, even substantially approximate with, the works to which Mothercare has the copyright from such aspects as factors, visual effect and design style; the works claimed by Mothercare has been released in public through trademark application, actual use and publicity; it is quite possible for Ou Yongwei to access the works of Mothercare; registration of the disputed trademark prejudices the prior copyright owned by Mothercare and violates Article 31 of the Trademark Law.</p>		
9. Summary of the judgment		
<p><u>Facts Finding</u></p> <p>On May 8, 2008, Ou Yongwei applied for registration of Trademark No.6708636, “妈妈世界及图”, which was approved on March 28, 2010 for such commodities as Class 12 “baby carriages; baby cars; baby strollers”. Mothercare submitted relevant evidence to initial publication of its works, publicity evidence, sales contracts, invoices, certificate of honor and other supporting documents at the stage of trademark review and, during legal proceedings, the Testimony, as well as translations thereof, issued by Daniel Veale , the partner of Pentagram Design Limited London Office, concerning his design and completion of the works claimed by Mothercare as appointed, ideas for design and title ownership, and the notarized Affidavit, as well as translations thereof, which was issued by Schonen Kelly , a business lawyer, concerning early and continuous publication all over the world of the works claimed by Mothercare and the brand awareness. In 2012, Mothercare was issued the Certificate of Copyright Registration with respect to “MDolly 图形,” stating that the documents submitted by the Applicant Mother UK Limited met relevant requirements; with respect to “MDolly 图形” which was created by Pentagram</p>		

Design Limited on February 23, 2005 and initially published in the UK on April 28, 2005, the Applicant legally owned the copyright as the copyright owner of such works, with the registration number Guo Zuo Deng Zi-2012-F-00071979, and the date of registration was September 28, 2012. In 2012, Ou Yongwei was issued the Certificate of Copyright Registration with respect to “妈妈世界及图”, stating that the documents submitted by the Applicant Ou Yongwei (from Hong Kong, China) met relevant requirements; with respect to “妈妈世界及图” which Ou created on February 2, 2007, the Applicant legally owned the copyright as the author, with the registration number Guo Zuo Deng Zi-2012-F-00074290, and the date of registration was October 25, 2012.

Judgment of the Court

The works of Mothercare is composed of two parts, English letter “m” and “human figure”, in which letter “m” is the initial of “mother” and has similar sound with “mom”, and the “human figure” depicts a cute baby. Overall, the design carries a good idea that babies are in good care from moms and has high originality; therefore, it is the works as defined in the Copyright Law. Mothercare has submitted sufficient evidence at the stage of registration review and during legal proceedings, which form a completed evidence chain proving the copyright owned by Mothercare to the works concerned. The disputed trademark includes Chinese characters “妈妈世界” and relevant figure which is also composed of “m” and “human figure”. Compared with the works claimed by Mothercare, they are very similar in appearance, factors and detail design, without any obvious difference; in other words, the two trademarks are substantially similar for the purpose of the Copyright Law. The works claimed by Mothercare has been released in public through trademark application, actual use and publicity. It is quite possible for the owner of the disputed trademark to access the works of Mothercare. Considering the “registration on a voluntary basis” principle adopted in China for copyright registration, the copyright registry made a formal examination only at the time of copyright registration; however, the evidence such as the Certificate of Copyright Registration submitted by Ou Yongwei cannot fully prove his independent creation and ownership of the copyright due to the originality. Accordingly, registration of the disputed trademark prejudices the prior copyright owned by Mothercare to its works and violates Article 31 of the Trademark Law. Thus, the disputed trademark shall be revoked pursuant to law.

10.Tags

① Type of trial	Suit for the decision of TRAB (Trademark Review and Adjudication Board) of SAIC
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【SAIC-4】

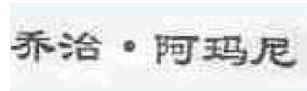
1. Title	EXPEDITORS v. EI Expeditors International (Protection of trade name right “EI Expeditors International”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	(2015) Shang Biao Yi Zi No. 0000055470	
5. Date of the judgment	2015/11/3	
6. Parties : Plaintiff Defendant	Expeditors International of Washington, Inc. Xiamen Anshitong International Express Logistics Co., Ltd.	
7. Mark	Plaintiff	Disputed trademark
		EI Expeditors International
8. Outline of the case		
The distinctive part of the disputed trademark is identical with that of the Plaintiff’s firm name. Therefore, application for registration of the disputed trademark for logistics service constitutes infringement of the Plaintiff’s right to firm name.		
9. Summary of the judgment		
<u>Basic Facts</u> <p>The Plaintiff, Expeditors International of Washington, Inc., put forward an objection to Trademark No.11876956, “EI EXPEDITORS INTERNATIONAL”, owned by Xiamen Anshitong International Express Logistics Co., Ltd., which was approved by the Trademark Office and publicized on the 1396th Trademark Announcement. The Trademark Office accepted the case in accordance with the Trademark Law. The Defendant replied within the designated period.</p>		
<u>Opinions of the Trademark Office</u> <p>The disputed trademark, “EI EXPEDITORS INTERNATIONAL”, is used for Class 39 “packing; marine transportation” and other services. The trademarks cited by the Plaintiff, No. 971630 “EXPEDITORS” and No.4600331 “EXPEDITORS TRADEFLOW”, which were registered early, are approved for Class 39 “freight broker” and Class 42 “interim use for the software unavailable online suitable for management of shipment, imports & exports and combined transportation”. Trademark “EXPEDITORS” is of a logo in foreign language without existing alphabetic combination and special meaning and has high originality. The evidence submitted by the Plaintiff shows that, as the trademark and main part of its firm name, “EXPEDITORS” has been known well in international logistics industry through publicity and use in several years. The Defendant that is engaged in the transportation business should be aware of the Plaintiff’s trademark and firm name. The “Marine Transportation; Vehicle Transportation” business to which the disputed trademark is applied is closely related with the services</p>		

supplied by the Plaintiff, and the distinctive part of the disputed trademark is identical with that of the Plaintiff's firm name; therefore, application for registration of the disputed trademark for logistics service constitutes infringement of the Plaintiff's right to firm name. In addition to the disputed trademark, the Plaintiff has applied for registration of several trademarks containing original logos and words identical with those early used by international famous logistics enterprises, but the Defendant fails to make a reasonable explanation about its originality for the disputed trademark during reply. Therefore, the Trademark Office deems that the Defendant's behavior constitutes intentional and obvious copy and cribbing of other party's trademark, violating of the principle of good faith and disturbs the fair order of market competition.

Pursuant to Articles 7, 30, 32 and 35 of the Trademark Law, the Trademark Office decides not to register Trademark No.11876956, "EI EXPEDITORS INTERNATIONAL".

10.Tags	
① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【SAIC-5】

1. Title	GIORGIO ARMANI (乔治·阿玛尼) v. 乔治·阿玛尼 (Protection of right of name “GIORGIO ARMANI”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	Shang Ping Zi (2009) No. 29925	
5. Date of the judgment	2009/11/3	
6. Parties : Plaintiff Defendant	GA Modelfine S.A. Hangzhou Xinchun Trading Co., Ltd.	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
The focus issue of the Case is whether registration of the disputed trademark prejudices the prior right of personal name owned by GIORGIO ARMANI (乔治·阿玛尼).		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>With respect to the disputed trademark, the applicant submitted an application for registration on February 3, 2000. It was on April 28, 2001 that the trademark was approved, applied to Class 3 “soaps, decontaminants, polishes, cosmetic spice, cosmetics and perfumes”.</p> <p>Identity certificate of Mr. GIORGIO ARMANI, the copy of the right declaration, the original of the notarial deed and Chinese versions thereof which are submitted the Applicant can prove the fact that Mr. GIORGIO ARMANI has authorized the Applicant to protect his right of personal name in China. The copies of such articles related in the publications collected by the National Library of Chinese, the Foreign Textile Technology (Issue 14 in 1991 and Issue 14 in 1992), the Economic Guide (Issue 4 in 1996), the Jiangsu Textile (Issue 10 in 1992 and Issue 10 in 1997), the Chinese New Era (Issue 1 in 1998), the Music World (Issue 4 in 1999), the International Talent Exchange (Issue 10 in 1999), the Art of Life (Issue 1 in 2000) as the Fashion Trends of Autumn & Winter Clothing 1992/1993, Italian Designer GIORGIO ARMANI, the Fashion Trends of Spring & Summer Clothing 1992, the Fashion Trends of Autumn & Winter Clothing 1992/1993, the Fashion Dream, On Trend of Feminization of Men's Clothing, the Flame under Iceberg: GIORGIO ARMANI - the Fashion Design Master in Milan, I Love Brands, To Visit Italy - the Fashion Empire and the Western Fashion on Eastern Faces, which are submitted by the Applicant, can prove a fact that Mr. GIORGIO ARMANI, born in 1934, established GIORGIO ARMANI S.P.A. In Italy in 1975. Mr. GIORGIO ARMANI, as a famous designer enjoying excellent reputation in the world fashion industry, is called “乔治·阿玛尼” in Chinese-speaking countries and regions.</p>		

Opinions of the Board

Relying on the awareness in the world fashion, Mr. GIORGIO ARMANI and his Chinese name have been popular in China before the application for registration of the disputed trademark was submitted. The Chinese characters and relevant design adopted by the disputed trademark are identical with well-known Chinese name of Mr. GIORGIO ARMANI. Obviously, the Defendant knowingly borrows the awareness of Mr. GIORGIO ARMANI in an inappropriate way, which violates the public standards of good faith, causes adverse effect on personal reputation of Mr. GIORGIO ARMANI and constitutes the infringement of the right to personal name of Mr. GIORGIO ARMANI. Although the Defendant claimed that the disputed trademark was not transliteration of the personal name “GIORGIO ARMANI” and was a coincidence even if they had similar pronunciation. However, the Defendant failed to make reasonable explanation which was known by relevant persons with respect to the originality of the disputed trademark. Thus, the Defendant’s defence cannot be supported. To sum up, registration of the disputed trademark violates the provisions of Article 31 of the Trademark Law in 2001 on “No application for trademark registration may infringe upon the existing prior rights of others”, and the Board hereby revokes the disputed trademark.

10.Tags

① Type of trial	Trademark dispute to the registration
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【SAIC-6】

1. Title	湘莲 XIANGLIAN v. XIANGLIAN (Protection of GI “湘莲 XIANGLIAN”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	Shang Ping Zi (2008) No. 06137	
5. Date of the judgment	2008/6/30	
6. Parties : Plaintiff Defendant	Xiangtan Xianglian Association Fujian Wenxin Lianye Food Co., Ltd.	
7. Mark	Plaintiff	Defendant
	湘莲 XIANGLIAN 及图	
8. Outline of the case		
<p>The Defendant, locating in Fujian, had made business transactions of XIANGLIAN with Hunan lotus seed merchants prior to the registration of the disputed trademark. However, even if the Defendant was aware that XIANGLIAN was the geographical indication of lotus seed commodities, it still registered it as a trademark other than collective marks and certification marks, causing the public mistaking the nature and source of the products under the trademark. It is prohibited by Article 16.1 of the Trademark Law. Therefore, it is claimed to revoke the registration of the disputed trademark for lotus seed and similar commodities.</p>		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>1. With respect to the disputed trademark, Jianning Wenxin Lianye Co., Ltd. submitted an application for registration on November 26, 2001, which was approved on January 7, 2003, applied to Class 29 “lotus seeds, jelly and meat”. With the approval of the Trademark Office, the registered owner was changed into the Defendant, Fujian Wenxin Lianye Co., Ltd. nominally.</p> <p>2. The Plaintiff, Xiangtan XIANGLIAN Association, established on December 8, 2000, is a non-profitable social legal entity coordinating the development of XIANGLIAN industry in Xiangtan.</p> <p>3. According to the History of Xiangtan, the Chinese Culture on Lotus and the Xiangtan Agricultural Regionalization Report Set, lotus seeds in Xiangtan are generally called as XIANGLIAN. In general, lotus seeds in Hunan may also be called XIANGLIAN, the best of which is lotus seeds in Xiangtan. The word “XIANGGLIAN” was first seen in the documents in the Southern Dynasties (420~589 A.D.). XIANGGLIAN had been designated as tribute until Daoguang Dynasty. The aforesaid documents also record the quality characteristic, technical essential in cultivation of XIANGGLIAN.</p>		

4. The comprehensive base for export of agricultural, sideline, local and livestock products (including XIANGLIAN) was put into operation in Xiangtan from 1976 to 1979. In 1982, Price Committee of Hunan Province issued documents to continue to implement the price subsidies for Hunan lotus seeds and other 3 exported commodities, and such commodities from Xiangtan, Hanshou and state-run provincial farms, as listed in the exhibit, may enjoy subsidies. In 1984, Wuhan Institute of Botany of Chinese Academy of Sciences issued the analysis report sheet for the elements contained in the XIANGLIAN products sent for inspection by Science Committee of Xiangtan, Hunan. In 1995, Xiangtan, a county of Hunan province, was named by the China naming, promotion and activity organization committee of the first batch of hundred hometowns of special products as “the Hometown of Chinese XIANGLIAN”. In 1996, Xiangtan People’s Government submitted a report on planning of XIANGLIAN industrial development project, subsidized interest and development of XIANGLIAN product series to the State Planning Commission (now the National Development and Reform Commission), SETC, the Ministry of Finance, the Finance Department of Hunan Province and Agricultural Bank of China.

5. There are 6 enterprises registered with Xiangtan Administration for Industry and Commerce Huashi Branch for XIANGLIAN process and sales on and prior to November 26, 2001(the registration date of the disputed trademark).

6. Before and after application for registration of the disputed trademark, the Defendant had made business transactions with Hunan lotus seed merchants.

7. According to the Chinese Local Products Dictionary published by the Commercial Press in March, 1991, XIANGLIAN spreads all over Hunan Province, especially the region of Dongting Lake. The Dictionary explains the quality characteristics, nutritious elements, cultivation characteristics and geographical scope of and with respect to XIANGLIAN.

Opinion of the Trademark Review and Adjudication Board

1. According to the evidence submitted by the Plaintiff and the Chinese Local Products Dictionary, XIANGLIAN spreads around Hunan, especially the region of Dongting Lake. The product has the characteristics of big seeds, white color, full flesh, cyan soap, strong fragrance, fresh taste and so on. The nutritious elements contained in it, including protein, fat and mineral substance, are different from the lotus seed produced in other regions. The above characteristics are mainly subject to the natural conditions (temperature, rainfall, humidity, sunshine, soil, water conservation, etc. in the living region) and the cultivation means. The title of “XIANGLIAN”, used since the Southern Dynasties, has already formed congruent relationship with its producing place Hunan. It satisfies the recognition condition of the geographic indication stipulated in Article 16.2 of the Trademark Law, and may be recognized as the geographic indication of lotus seed products. The disputed trademark is consisted of the characters “XIANGLIAN”, corresponding pronunciation and graph, and the characters “XIANGLIAN” is the major reading and calling part of this trademark. The Defendant, locating in Fujian, had business transactions with the lotus merchants of Hunan before application for the registration of this trademark. It was aware that

XIANGLIAN is the geographical indication of the lotus seed products, but it still registered it as the trademark other than the collective trademark and certification trademark. It is very easy to cause the public mistaking the product nature and source, falling into the scope of the prohibition in Article 16.1 of the Trademark Law. Therefore, the registration of the disputed trademark for lotus seeds and similar products shall be revoked.

2. Common name, including statutory and conventional generic name, is of standardized title generally accepted in the state or industry to reflect the fundamental difference between two categories of commodities. The evidence submitted by the Plaintiff cannot fully support that XIANGLIAN is the common name of lotus seeds generally accepted in the country or industry. Causes and evidence presented by the Plaintiff fails to prove that the dispute trademark infringes the existing prior rights as mentioned in Article 31 of the Trademark Law.

To sum up, pursuant to Articles 16 and 43 of the Trademark Law and Article 41 of the Implementing Regulations of the Trademark Law, the Trademark Review and Adjudication Board hereby revokes the registration of the disputed trademark for some commodities.

10.Tags

① Type of trial	Trademark dispute to the registration
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【SAIC-7】

1. Title	海棠湾 v. 海棠湾 (“海棠湾” trademark case)	
2. Country	China	
3. Court	The Supreme People’s Court	
4. Case No.	Administrative Ruling (2013) Zhi Xing Zi No. 41 issued by the Supreme People’s Court	
5. Date of the judgment	2013/8/12	
6. Parties : Plaintiff Defendant	Li Longfeng Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Sanya Haitang Bay Management Committee	
7. Mark	Plaintiff	Defendant
	“海棠湾”	
8. Outline of the case		
Li Longfeng, taking advantage of the huge influence from the government’s promotion of Haitang Bay Vacation Zone and the development program, applied for registration of many trademarks containing words “海棠湾” and registered a large amount of other trademarks without any reasonable grounds or intention of real use. It shall be identified as improper occupation of public resources and disturbance of the order of trademark registration due to lack of the legitimacy required for trademark registration. Therefore, it shall be revoked pursuant to Article 41.1 of the Trademark Law.		
9. Summary of the judgment		
<u>Basic Facts</u> <p>Before Li Longfeng applied for registration of the disputed trademarks, the logo “海棠湾” had been a well-known place name in Sanya tourism resort and a name contained in large comprehensive development projects under the government plans through long-term promotion by relevant government authorities of Hainan province, and it has clear meaning and indication. As an individual person, Li Longfeng has applied for registration of the disputed trademark not only for such services as lease and management of real estates involved in the Case but also for Class 43 “restaurants, hotels and other commodities or services”. Additionally, Li Longfeng has also registered more than 30 trademarks for many categories of products or services, such as “香水湾” and “椰林湾”, many of which concern place names and scenes of Hainan Island.</p> <u>Opinions of the Court</u> <p>The Supreme People's Court deems that, for the purpose of examination and judgment on whether the disputed trademark is “registered by other unfair means” provided in Article 41.1 of the Trademark Law, it is necessary to verify whether means other than cheat that are applied, including disturbance of the order of trademark registration,</p>		

damage on public interests or unfair occupation of public resources. Pursuant to Article 4 of the Trademark Law, a civil subject applying for registration of a trademark shall have a real intention of use in order to meet his own demands for trademark use and the application shall be reasonable or legitimate.

Li Longfeng, taking advantage of the huge influence from the government's promotion of Haitang Bay Vacation Zone and the development program, applied for registration of many trademarks containing words “海棠湾” and registered a large amount of other trademarks without any reasonable grounds or intention of real use. It shall be identified as improper occupation of public resources and disturbance of the order of trademark registration due to lack of the legitimacy required for trademark registration. Therefore, the registration shall be revoked pursuant to Article 41.1 of the Trademark Law.

10.Tags

① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	✓

【SAIC-8】

1. Title	WONDERWARE v. Wonderware	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	(2015) Shang Biao Yi Zi No. 0000007183	
5. Date of the judgment	2015/4/29	
6. Parties : Plaintiff Defendant	Invensys System Co., Ltd. Shenzhen Wondershare Information Technology Co., Ltd.	
7. Mark	Plaintiff	Disputed trademark
		
8. Outline of the case		
The Defendant's application for registration of the disputed trademark has constituted bad-faith registration by illicit means of a trademark with a certain reputation already used by another party. If successfully registered, the disputed trademark will cause relevant consumers mistaking the sources of the parties' products and services.		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>The Plaintiff, Invensys System Co., Ltd., put forward an objection to Trademark No. 10271361, "WONDERWARE" which is held by the Defendant, Shenzhen Wondershare Information Technology Co., Ltd. (formerly known as Shenzhen Fuxing Technology Co., Ltd.) and was reviewed by the Trademark Office and publicized on the 1335th Trademark Announcement. The Trademark Office accepted the Case in accordance with the Trademark Law. The Defendant replied within the designated period.</p> <p><u>Opinion of the Trademark Office</u></p> <p>The disputed trademark, "WONDERWARE", is approved to use for the services in Class 42 "computer programming; computer software design". Trademark No. 1747975 "WONDERWARE", early registered by the Plaintiff, is approved to use for the commodities in Class 9 "computer software (recorded)". The evidence submitted by the Plaintiff proves that the computer software products carrying the cited trademark have been actually used and have certain influence in relevant fields in China. In addition, the Plaintiff supplies relevant services together with the sold products. The disputed trademark contains identical words with those contained in the cited trademark, and the approved applicable services are closely related with the commodities of the Plaintiff. Therefore, the Defendant's application for registration of the disputed trademark has constituted bad-faith registration by illicit means of a trademark with a certain reputation already used by another party. If successfully registered, the disputed trademark will cause relevant consumers mistaking the sources of the parties' products and</p>		


services.

Pursuant to Articles 32 and 35 of the Trademark Law, the Trademark Office decides not to register Trademark No. 10271361, “WONDERWARE”.

10.Tags

① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【SAIC-9】

1. Title	MEGAPULSE v. MEGAPULSE (Bad-faith registration of “MEGAPULSE” concerning contractual relationship)	
2. Country	China	
3. Court	The High People’s Court of Beijing	
4. Case No.	Administrative Judgment (2015) Gao Xing (Zhi) Zhong Zi No. 3601	
5. Date of the judgment	2016/1/11	
6. Parties : Plaintiff Defendant	Yancheng Cross Electronics Co., Ltd. (hereinafter referred to as “Cross”) Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Shanghai Qinling Wine Co., Ltd. (hereinafter referred to as “Qinling Wine”)	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
Cross is aware of the trademark “MEGAPULSE” owned by Qinling Wine by means of indirect transactions with Qinling Wine. However, Cross applied for registration of the disputed trademark for the same or similar commodities as such trademark “MEGAPULSE” owned by Qinling Wine, violating Article 15.2 of the Trademark Law.		
9. Summary of the judgment		
<u>Facts Finding</u> Trademark No. 9928480 “MEGAPULSE” applied by Cross for registration on September 5th, 2011, was approved applicable to the commodities Class 9 “storage battery, battery cage and pulse activator”. Qinling Wine permits Jiangsu Xinyang No. 2 Electronic Elements Factory (“Xinyang No.2 Factory”) to manufacture and sell the pulse activator with the trademark “MEGAPULSE” which has been authorized by Qinling Wine. Xinyang No.2 Factory concluded a sales contract for pulse activator in electro mobiles with Cai Zhongliang, the legal representative of Cross without the consent of Qinling Wine. Cross submitted additional two copies of the “Power of Attorney” (both on September 28, 2009) during second instance, and the power of attorney bearing the official seal of Xinyang No.2 Factory indicates that “Mr. Cai Zhongliang is hereby authorized to sell pulse activator in electro mobiles manufactured by the Factory at the same price”. Thereafter, Qinling Wine further submitted one copy of the Certification issued by Xinyang No.2 Factory on November 10, 2015, indicating “On December 24, 2009, Xinyang No.2 Factory concluded a contract with Cai Zhongliang for sales of pulse activators in electro mobiles and mobiles with the trademark ‘MEGAPULSE’, which were manufactured by Xinyang No.2 Factory with		

Qinling Wine”.

Judgment of the Court





Pursuant to Article 15.2 of the Trademark Law in 2013, where an applicant for registration of a trademark identical with or similar to an unregistered trademark in prior use by another party on identical or similar goods has any contractual, business or other relationship except the relationship described in the preceding paragraph with the other party and knows the existence of the unregistered trademark, the trademark shall not be registered upon opposition from the other party. For the purpose of such paragraph, the applicant has created other legal relationship other than agency or representative with the other party prior to the date of application for the disputed trademark, through which the applicant knew about the other party's trademark and in bad faith registers the unregistered trademark in prior used by another party on identical or similar goods. The disputed trademark shall not be registered in such circumstance for violating the principle of good faith and constituting a registration in bad faith and hitchhiking.

The evidence submitted proves that, prior to the date of application for the disputed trademark, Qinling Wine authorized Xinyang No.2 Factory to manufacture and sell the pulse activators with the brand “MEGAPULSE”; thereafter, Xinyang No.2 Factory concluded a contract with Cai Zhongliang for sales of pulse activators in electro mobiles and mobiles under the trademark ‘MEGAPULSE’; however, Cross failed to explain clearly that it had reasonable ground to apply for the disputed trademark. Since the letters contained in the disputed trademark are identical with the trademark “MEGAPULSE”, a conclusion may be made that, prior to the date of application for the disputed trademark, Cross had been aware of the trademark “MEGAPULSE” from pulse activators on the basis of the legal relationship other than agency or representative. Considering the circumstance that storage batteries, pulse activators and other commodities to which the disputed trademark is applied constitute the same or similar commodities with the pulse activators under the trademark “MEGAPULSE” in prior use, application by Cross for registration of the disputed trademark has violated Article 15.2 of the Trademark Law in 2013. Although Cross submitted additional Power of Attorney during second instance, the Power of Attorney did not deny the fact that Xinyang No.2 Factory concluded a contract with Cai Zhongliang on December 24, 2009 for sales of pulse activators under the trademark “MEGAPULSE”. The Power of Attorney was issued on September 28, 2009, and Xinyang No.2 Factory had other contractual relationship with Cai Zhongliang after September 28, 2009, therefore, relevant claims made by Cross lack for basis in fact and are hereby rejected by the Court.

10.Tags

① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【SAIC-10】

1. Title	 v. 	
2. Country	China	
3. Court	The High People's Court of Beijing	
4. Case No.	Administrative Judgment (2016) Jing Xing Zhong Zi No. 1896	
5. Date of the judgment	2016/5/31	
6. Parties : Plaintiff Defendant	Jiangsu Xianghe International Investment Co., Ltd. ("Xianghe") Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Cölner Hofbräu P. Josef Früh KG("KG")	
7. Mark	Plaintiff 	Defendant 
8. Outline of the case		
Registration in bad faith by the agents of Xianghe and KG of the beer trademark "FRUH KOLSCH 及图" through collusion violates Article 15.1 of the Trademark Law.		
9. Summary of the judgment		
<p><u>Fact Finding</u></p> <p>Application for registration of Trademark No. 9150014 "FRUH KOLSCH SEIT 1904 及图", submitted by Xianghe on February 25, 2011, was approved applicable to the commodities Class 32 "beer; malt beer; wort for beer". KG owns the internationally registered trademark and Germany trademark of "FRUH KOLSCH 及图". On its website, Xianghe stated itself as the general agent of Fruh Kolsch beer in China; its subsidiary Xianghe (Germany) GmbH performed auxiliary services for Xianghe in Germany with respect to agency business of Fruh Kolsch beer in China. Fruh Kolsch beer is called "福利红 Fruh Kolsch" in China. Fruh Kolsch top beer in Germany has existed for more than 100 years. The address of Xianghe (Germany) GmbH on its website is the same as that of Defudao Company, which is the agent of KG in China. On September 23, 2010, an email (inscriber is Jiangsu Xianghe International Investment Co., Ltd.) sent from an email box "xiang.×××" to the personnel of KG, concerning sales of 5 liters of barreled Fruh Kolsch beer in China as an agent. Xianghe personnel had accepted training programs about Fruh Kolsch beer and were granted the training certificate by KG.</p> <p><u>Judgment of the Court</u></p>		


Pursuant to Article 15.1 of the Trademark Law, where an agent or a representative applies for registration of a trademark of the principal or the represented party in the agent's or the representative's own name without authorization, the trademark shall not be registered and shall be prohibited from use upon objection from the principal or the represented party. Where a trademark agent, a representative or an agent or a representative under the distributorship or agency relationship applies, in its name, for registration of a trademark of the principal or the represented party without authorization, the People's Court shall determine it constitutes a bad-faith registration of the trademark of the principal or the represented party by the agent or the representative. In trial practice, bad-faith registration may occur during negotiation about the agency or representative relationship, namely, bad-faith registration prior to establishment of the agency or representative relationship. In such case, it shall be deemed as bad-faith registration by the agent or the representative. The applicant registering the trademark in bad faith through collusion with the aforesaid agent or representative may be deemed as the agent or representative. Registration in bad faith through collusion may be determined on the basis of special personal relationship between the applicant and the aforesaid agent or the representative.

Evidence submitted for the Case proves that, prior to the date of application for the disputed trademark, Xianghe negotiated with KG about Fruh Kolsch beer. Although it was Defudao Company that concluded a cooperation agreement with KG, Xianghe stated on its website that its subsidiary Xianghe (Germany) GmbH performed auxiliary services for Xianghe in Germany with respect to agency business of Fruh Kolsch beer in China and that the address of Xianghe (Germany) Co., Ltd. is the same as that of Defudao Company, therefore, a conclusion may be made that Xianghe also took part in bad-faith registration of the trademark of "Fruh Kolsch" owned by KG through collusion with Defudao Company. Accordingly, application for registration of the disputed trademark violates Article 15.1 of the Trademark Law.

10.Tags	
① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

Case Examples of USPTO

【USPTO-1】

1. Title	NATIONSTAR MORTGAGE v. NationStar	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91184456	
5. Date of the judgment	2014/9/30 [citation: Nationstar Mortg. LLC v. Ahmad, 112 USPQ2d 1361 (TTAB 2014)]	
6. Parties:	Nationstar Mortgage LLC	
Plaintiff	Mujahid Ahmad	
Defendant		
7. Mark	Plaintiff	Defendant
	NATIONSTAR MORTGAGE	NationStar
		
8. Outline of the case		
<p>Opposition filed by Nationstar Mortgage (Opposer) against application for the mark NATIONSTAR for various real estate brokerage services filed by Mujahid Ahmad (Applicant) on the grounds of fraud, likelihood of confusion, and lack of bona fide intent to use.</p>		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) held that Applicant’s averments as to his use of NATIONSTAR for the services identified were fraudulent. The application contained a statement that “The applicant, or the applicant’s related company or licensee, is using the mark in commerce...” and was signed by the Applicant as Owner. Applicant provided specimens with a signed declaration under 37. C.F.R. Section 2.20 in response to an Office action. During the course of the opposition, the Applicant amended the application to an intent to use application.</p> <p>Opposer filed the opposition based on fraud, alleging that the Applicant did not use the mark for any of the identified services prior to filing the application, submitted a fabricated specimen, and knowingly made false statements as to use of mark with intent to deceive the USPTO.</p> <p>During the proceeding, the Board found that the Applicant’s testimony was characterized by contradictions and inconsistencies. For example, Applicant testified he is owner, president and sole person who runs NationStar Mortgage, Inc., yet did not know if the company had earned any income or had any revenue. Applicant admitted that NationStar Mortgage, Inc. did not have a bank account and had never rendered any payments. Applicant tried to dodge answering simple questions as to whether company had not done any business and had filed any tax</p>		



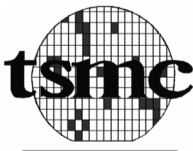

returns. Applicant did not answer the straightforward question whether he knew of or had placed a telephone directly listing under the name NATIONSTAR, and was unable or unwilling to identify who created business cards, postcards and flyers. The Board noted that oral testimony “should not be characterized by contradictions, inconsistencies and indefinitely but should carry with it conviction of its accuracy and applicability.” B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 583, 66 USPQ 232, 236 (CCPA 1945). The record established that Applicant could not lawfully hold himself out as a mortgage broker, insurance broker or real estate broker because he was not properly licensed at the time he filed the application.

The Board found that the applicant was not using the mark NATIONSTAR in commerce in connection with any of the services identified – the record at best establishes that Applicant may have rendered real estate agency services under the mark NATIONSTAR prior to the filing date; however, real estate agency services were not listed on the application. The law does not require “smoking gun” evidence of deceptive intent but instead has long recognized that direct evidence of deceptive intent is rarely available and deceptive intent may be inferred from the surrounding facts and circumstances. The surrounding facts and circumstances provide clear and convincing evidence that Applicant did not have a good faith reasonable basis for believing that he was using the NATIONSTAR mark in commerce for all the services identified in the application. Because the opposition was sustained on the grounds of fraud, the Board did not reach the additional grounds of likelihood of confusion and lack of bona fide intent to use the mark in commerce.

10.Tags

① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	
Immoral	
Lack of intention to use	✓

【USPTO-2】

1. Title	 v. 	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition Nos. 91171146 and 91171147	
5. Date of the judgment	2010/4/23 [citation: Taiwan Semiconductor Mfg. Co. v. Semiconductor Mfg. Int'l (Shanghai) Corp., 2010 TTAB LEXIS 117, 2010 WL 1791171 (TTAB Apr. 23, 2010)]	
6. Parties: Plaintiff Defendant	Taiwan Semiconductor Manufacturing Co., Ltd. Semiconductor Manufacturing International (Shanghai) Corporation	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
Opposition filed by Taiwan Semiconductor Manufacturing (Opposer) against the application for SMIC and Design for semiconductors and integrated circuits and other related goods filed by Semiconductor Manufacturing International (Shanghai) Corporation (Applicant) on the basis of a likelihood of confusion with the registered mark TSMC and Design for semiconductors and integrated circuits.		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) sustained the opposition on the grounds of likelihood of confusion. The Board considered a number of factors, including the similarities in the marks and goods and services and evidence of bad faith. With regard to evidence of bad faith, the Board found that Applicant's history with the opposer should be considered to determine Applicant's intentions. Applicant arrived on the scene thirteen years after opposer was founded, and within two years, a foreign court had issued an injunction prohibiting Applicant from soliciting or hiring certain classes of Opposer's employees. Opposer then filed four law suits against Applicant between December 2003 and August 2004, including multiple claims of patent infringement, unfair competition, trade secrets misappropriation, and interference with business relationships. As part of a settlement, Applicant agreed to pay opposer 175 million dollars and promised to cease and abstain from making statements that would suggest to third parties that SMIC's processes use or are derived from TSMC information.</p> <p>Based on this and other evidence, the Board found that Applicant had been complicit in multiple attempts to misappropriate and infringe Opposer's intellectual property rights. Moreover, Applicant's logo over the years had moved closer to Opposer's long established design logo. The Board found that Applicant's action, taken as a whole, demonstrates a history of blatant disregard for Opposer's intellectual property rights. This factor,</p>		

balanced with the similarities in the marks and the identical nature of the goods or services, led to a finding of likelihood of confusion.

10.Tags

① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【USPTO-3】

1. Title	CHIRO-KLENZ v. SUPER CHIRO TEA	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91193427	
5. Date of the judgment	2012/3/30 [citation: Edom Labs. Inc. v. Lichter, 102 USPQ2d 1546 (TTAB 2012)]	
6. Parties: Plaintiff Defendant	Edom laboratories, Inc. Glenn Lichter	
7. Mark	Plaintiff	Defendant
	CHIRO-KLENZ	SUPER CHIRO TEA
8. Outline of the case		
Opposition filed by Edom Laboratories against the application SUPER CHIRO TEA for herbal teas for medicinal purposes on the grounds of likelihood of confusion with the registered mark CHIRO-KLENZ for herbal teas for medicinal purposes filed by Glenn Lichter, alleging bad faith.		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) held that Applicant's mark SUPER CHIRO TEA is likely to cause confusion with Opposer's mark CHIRO-KLENZ, finding that Applicant acted in bad faith in adopting its mark. In assessing a likelihood of confusion, the Board considered a number of factors, including the similarity of the marks and the goods, as well as extensive evidence of bad faith. In addition to copying Opposer's trade dress, evidence was introduced that the packaging of Applicant's SUPER CHIRO TEA tea included a tag line: "FROM THE ORIGINAL MAKERS OF CHIRO-KLENZ". Moreover, Applicant owns domain name www.chirolenzforless.com, re-directs visitors to his www.superchirotea.com website, and uses testimonials from CHIRO-KLENZ on his website to promote SUPER CHIRO TEA. Evidence was further introduced that Applicant substituted delivery of SUPER CHIRO TEA for an order of CHIRO-KLENZ. In addition, Applicant's SUPER CHIRO TEA product comparison page has in small print: "Not affiliated with Edom Laboratories, Inc., the owner of the TM CHIRO-KLENZ", but also says "from the Original Formulators of CHIRO-KLENZ Tea." Applicant also had a pattern of bad faith actions leading up to this opposition, including having filed a petition to cancel Opposer's CHIRO-KLENZ registration.</p> <p>The Board held that SUPER CHIRO TEA is similar in sight, sound, meaning and commercial impression to Opposer's mark CHIRO-KLENZ, and that the goods are legally identical and available to the same classes of consumers through similar trade channels. The Board determined that Applicant has been trading off the goodwill in Opposer's mark to Opposer's detriment, and that "bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion."</p>		

10.Tags	
① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【USPTO-4】

1. Title	AUDITORIO TELMEX v. TELMEX	
2. Country	United States	
3. Court	Court of Appeals for the Federal Circuit	
4. Case No.	No. 2010-1558	
5. Date of the judgment	2012/7/11[citation: Estrada v. Telefonos De Mexico, S.A.B. de C.V., 447 F. App'x 197 (Fed. Cir. 2011)]	
6. Parties: Plaintiff Defendant	Telefonos de Mexico Andres Estrada	
7. Mark	Plaintiff	Defendant
	AUDITORIO TELMEX	TELMEX
8. Outline of the case		
Opposition filed by Telefonos de Mexico (Opposer) against Andres Estrada (Applicant) on the grounds that the mark AUDITORIO TELMEX for arena and entertainment services are likely to be confused with the common law mark TELMEX for telecommunication services. Opposition was sustained and appealed to the Court of Appeals for the Federal Circuit.		
9. Summary of the judgment		
<p>The Court of Appeals for the Federal Circuit (Court) upheld the decision of the Trademark Trial and Appeal Board (Board), concluding that substantial evidence supported the Board's finding of Applicant's bad faith, which supported a likelihood of confusion. These facts included that Opposer began using the mark TELMEX in the United States for telecommunication and telephone calling card services prior to the filing date of both opposed applications. Although Opposer's mark was in use in the United States, Opposer had no significant market share and no proof of reputation or fame in the United States. Nevertheless, Opposer is a major telecommunication company based in Mexico, and began offering its services in Mexico in 1947. Opposer has used its TELMEX mark throughout all of Mexico, on billboards, on pay phones, in printed media, etc. Opposer also provides telecommunication services to several countries in Central and South America and sponsors a large arena under the AUDITORIO TELMEX mark in Guadalajara, Mexico. For 30 years, Applicant had lived in Mexico and resided 10 miles away from the arena. Although Applicant lived near the arena for three decades, he denied any prior knowledge of Opposer's mark. Applicant further claimed that he had made up the mark. Applicant continued to be evasive in his discovery responses, alleging that he had never used a phone booth, pay phone or public phone, and thus did not have any exposure to the TELMEX mark. Based on this evidence, the Board found that the circumstances lead to "inescapable conclusion" that Applicant filed in bad faith.</p> <p>Although Applicant on appeal challenged the Board's findings on other likelihood of confusion factors such as the</p>		

strength of the TELMEX mark, the similarity of the marks, and the similarity of the services, the Court upheld the Board's decision, concluding that substantial evidence supported the Board's findings of likelihood of confusion based on these factors, along with Applicant's bad faith.

10.Tags	
① Type of trial	Appeal of Opposition Decision
② Decision	Opposition decision upheld (application denied)
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【USPTO-5】

1. Title	UVF861 v. UVF861	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Cancellation No. 92057088	
5. Date of the judgment	2015/6/29[Citation: UVeritech, Inc. v. Amax Lighting, Inc., 115 USPQ2d 1242 (TTAB 2015)]	
6. Parties: Plaintiff Defendant	Uveritech, Inc. Amax Lighting, Inc.	
7. Mark	Plaintiff	Defendant
	UVF861	UVF861
8. Outline of the case		
This case involves a cancellation proceeding between a U.S. seller (Petitioner) and its foreign manufacturer (Respondent) over ownership of the mark UVF861 for light bulbs and fixtures. Petitioner argued that the goods were manufactured to its order, and therefore it owned the mark. Respondent argued that as manufacturer it owned the mark because Petitioner was a mere distributor.		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) found that the Petitioner was the rightful owner of the mark. Although this proceeding was brought on the ground of likelihood of confusion, the actual issue in this case was ownership of the mark. Although usually there is a presumption that the manufacturer is the owner of a disputed mark, this may be rebutted. In this case, since there was a neglect of formalities in defining the business relationship, the Board looked at the following relevant factors:</p> <p>(1) which party created and first affixed the mark to the product; (2) which party's name appeared with the trademark on packaging and promotional materials; (3) which party maintained the quality and uniformity of the product, including technical changes; (4) which party does the consuming public believe stands behind the product, e.g., to whom customers direct complaints and turn to for correction of defective products; (5) which party paid for advertising; and (6) what a party represents to others about the source or origin of the product.</p> <p>The Board found that testimony and evidence in the case established that the Petitioner designed the bulbs and conceived the mark UVF861. In addition, the Petitioner contracted, although not in a written document, with Respondent to manufacture the bulbs under the mark according to Petitioner's specification to be compatible with Petitioner's equipment. Moreover, it was Petitioner's decision to market bulbs under UVF861 and Petitioner</p>		

controlled technical changes to bulbs. At one point, due to quality concerns, Petitioner transferred production to another manufacturer, yet Respondent never alleged infringement. When quality problems arose, customers approached Petitioner not Respondent. The literature distributed with the Petitioner's bulbs had the Petitioner listed as the manufacturer. There was no evidence introduced regarding advertising of the product, so this factor was neutral. As a result, the Board found that the Petitioner was the owner of the mark.

10.Tags

① Type of trial	Petition for cancellation of trademark registration
② Decision	Cancelled
③ Type of bad faith	
Free Ride	
Immoral	✓
Lack of intention to use	

【USPTO-6】

1. Title	Benny Goodman Collection THE FINEST QUALITY v. BENNY GOODMAN	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Application Serial No. 77600412	
5. Date of the judgment	2012/7/11 [citation: In re Jackson Int'l Trading Co., 103 USPQ2d 1417 (TTAB 2012)]	
6. Parties: Plaintiff Defendant	Jackson International Trading Co. Kurt D. Bruhl GmbH & Co. KG	
7. Mark	Plaintiff	Defendant
		
8. Outline of the case		
<p>An application for the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrances, cosmetics, leather, and clothing filed by Jackson International Trading Co. was refused by the Examining Attorney (Examiner) under Section 2(a) of the Trademark Act for falsely suggesting a connection with the musician Benny Goodman. Appealed to the Trademark Trial and Appeal Board (Board).</p>		
9. Summary of the judgment		
<p>The Board upheld the Examiner and found that Benny Goodman has fame or renown such that the use of that name as a trademark by an unauthorized user will falsely suggest a connection with the musician Benny Goodman.</p> <p>Under Section 2(a), the Examiner needed to prove:</p> <ol style="list-style-type: none"> (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 because 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 goods and/or services. <p>The applicant did not contest that the mark is a close approximation of the late bandleader Benny Goodman. The Board held that the public would perceive the mark as pointing unmistakably to the late bandleader, for several reasons. The record showed that the Estate of Benny Goodman continues to protect its IP rights today. For example, the bennygoodman.com website provides that "CGM Worldwide is the exclusive representative for the</p>		

Estate of Benny Goodman...The words and the signature “Benny Goodman” are trademarks owned and protected by the Estate of Benny Goodman...Any use of the above, without the express written consent of the Estate, is strictly prohibited.” Moreover, a search for “Benny Goodman” on the Internet produced excerpts from sources such as the Britannica Concise Encyclopedia, Music Encyclopedia, U.S. History Companion, Columbia Encyclopedia, The Fine Arts Dictionary, and Filmography showing that Benny Goodman was a famous jazz clarinetist, composer and bandleader, and that he is known as “The King of Swing,” “The Professor,” “Patriarch of the Clarinet,” and “Swing’s Senior Statesman.” The record also included excerpts from the last.fm, Amazon.com, and Borders.com websites, showing that sales of Benny Goodman recordings continue to this day. These facts also showed that the late bandleader remains famous.

The Board noted that it is commonplace for performers and owners of well-known marks to expand their product lines to incorporate a diverse set of goods, and that licensing of commercial trademarks for use on collateral products such as clothing, linens, etc. which are unrelated to those goods on which the marks are normally used has become common practice. The Board concluded that, in the context of applicant’s fragrances, cosmetics, leather goods and clothing, consumers would view the mark as pointing only to Benny Goodman, the bandleader, composer and clarinetist.

10.Tags

① Type of trial	Appeal of examiner's decision of refusal
② Decision	Refusal upheld (application denied)
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

【USPTO-7】

1. Title	FLANAX v. FLANAX	
2. Country	United States	
3. Court	Court of Appeals for the Fourth Circuit	
4. Case No.	No. 15-1335	
5. Date of the opinion	2016/3/23[citation: Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697 (4th Cir. 2016)]	
6. Parties: Original Plaintiff Original Defendant	Bayer Consumer Care AG Belmora LLC	
7. Mark	Plaintiff	Defendant
	FLANAX	FLANAX
8. Outline of the case		
<p>This case involves the question of whether the Lanham Act permits the owner of a foreign mark well-known among U.S. consumers, but not registered or used in the United States, to seek cancellation of the registration for a mark used to misrepresent the source of goods as those produced by the foreign trademark owner, to pursue a false-association claim based on the domestic trademark owner's passing off of its products as those of the foreign mark owner, and to pursue related false-advertising claims.</p>		
9. Summary of opinion		
<p>Bayer owns a Mexican registration and uses the mark FLANAX for pain relievers in Mexico. Bayer asserts that its FLANAX mark is also known to U.S. consumers, although Bayer does not sell its FLANAX product in the United States. After Bayer's FLANAX mark became known to U.S. consumers, Belmora registered and began using the FLANAX mark in the United States, also for pain relievers. Belmora's advertising and packaging included language that suggested that Belmora's FLANAX product came from Bayer.</p> <p>Bayer first filed a Trademark Trial and Appeal Board (TTAB or Board) action seeking cancellation of Belmora's FLANAX registration for misrepresentation of source under Section 14(3). The TTAB granted Bayer's petition for cancellation and ordered Belmora's FLANAX registration cancelled. The TTAB decision was reviewed in the United States District Court for the Eastern District of Virginia after Belmora sought review in the Court of Appeals for the Federal Circuit and Bayer elected to proceed in district court. At the district court, Bayer added claims under Section 43(a) for false designation of origin and false advertising.</p> <p>The district court found that use of a mark in the United States was required to bring a claim under Section 43(a) or to petition to cancel a mark for misrepresentation of source under Section 14(3). Thus, it dismissed Bayer's unfair competition and false advertising claims under section 43(a) of the Lanham Act because Bayer did not</p>		

allege prior use of its own FLANAX mark in the United States. The district court also held that the Board erred in not dismissing Bayer’s misrepresentation of source ground under Section 14(3) because Bayer did not allege prior use of its own FLANAX mark in the United States.

The Court of Appeals for the Fourth Circuit reversed. The Fourth Circuit found that Bayer has a cognizable false-association claim by following the plain, broad statutory language found in the Lanham Act. Additionally, the Fourth Circuit clarified past precedent that seemingly imposed a requirement not present in the statutory language of Section 43(a) that a plaintiff must plead rights in a trademark in order to have a cognizable false-association/unfair competition claim. It held: “In sum, the Lanham Act’s plain language contains no unstated requirement that a Section 43(a) plaintiff have used a U.S. trademark in U.S. commerce to bring a Lanham Act unfair competition claim. The Supreme Court’s guidance in Lexmark does not allude to one, and our prior cases either only assumed or articulated as dicta that such a requirement existed. Thus, the district court erred in imposing such a condition precedent upon Bayer’s claims.”

10.Tags	
① Type of trial	Appeal of cancellation of the registration of a trademark
② Decision	Pending, remanded for consideration by district court
③ Type of bad faith	
Free Ride	✓
Immoral	✓
Lack of intention to use	

【USPTO-8】

1. Title	IWATCH v. SWATCH	
2. Country	United States	
3. Court	U.S. Court of Appeals for the Federal Circuit	
4. Case No.	No. 2014-1219	
5. Date of the judgment	June 4 2015[citation: M.Z. Berger & Co., Inc. v. Swatch AG, 787 F.3d 1368 (Fed. Cir. 2015)]	
6. Parties: Applicant (Appellant) Opposer (Appellee)	M.Z. Berger & Co. Swatch AG	
7. Mark	Applicant (Appellant)	Opposer (Appellee)
	IWATCH	SWATCH
8. Outline of the case		
Swatch opposed the application for the mark IWATCH on grounds of likelihood of confusion with SWATCH for watches and a lack of bona fide intent to use. The opposition was sustained on a lack of bona fide intent to use, but no likelihood of confusion was found. Case appealed to the Court of Appeals for the Federal Circuit.		
9. Summary of the judgment		
<p>The Court of Appeals for the Federal Circuit (Court) upheld the decision of the Trademark Trial and Appeal Board (Board), finding a lack of bona fide intent to use but no likelihood of confusion. In its determination, the Court considered a number of facts showing a lack of genuine intent to use the mark. Although the applicant applied for watches, clocks, and other items, the testimony of record showed that Applicant never intended for the mark to be used on any goods other than watches. With respect to watches, the applicant lacked a genuine plan to commercialize the iWatch on watches because the documents produced related solely to the prosecution of the application for registration. In fact, the only documents produced were (i) a trademark search (a couple of days prior to filing), (ii) internal email concerning the application, and (iii) internal emails forwarding images of watches and a clock bearing the iWatch mark (in response to USPTO request for additional information). In addition, the employees told inconsistent stories about the company's intent to commercialize the mark on watches. Although the company has a long history in the watch business, Applicant's inaction with the potential iWatch product diminished the value of the evidence of a long history in the business. Rather, the testimony from Berger indicated that intent was to merely reserve the mark: "if we decided to do a – either a technology watch or information watch or something that would have that type of characteristics that would be a good mark for it."</p> <p>The Court noted that "bona fide" should be read as a fair, objective determination of intent, consistent with the definition of "use in commerce" (a bona fide use of a mark in the ordinary course of trade, and not merely to</p>		

reserve a right). The intent requirement requires not only subjective good faith, but also objective evidence of intent: although the bar is not high, circumstances must indicate that the intent was firm. The Court agreed with the Board that even though the mark was intended to be used with a “smart” watch, Applicant Berger did not have a bona fide to use the mark in commerce, evidenced by the facts that it had never made such a watch, took no steps following the application to develop such a watch; and that there was no nexus between Berger’s general capacity to produce watches and the capacity required to produce a “smart” watch.

10.Tags

① Type of trial	Appeal of opposition decision
② Decision	Opposition decision upheld (application denied)
③ Type of bad faith	
Free Ride	
Immoral	
Lack of intention to use	✓

【USPTO-9】

1. Title	L'OREAL v. L'OREAL PARIS	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91184456	
5. Date of the judgment	2012/3/20 [citation: L'Oreal S.A. v. Marcon, 102 USPQ2d 1434 (TTAB 2012)]	
6. Parties:	L'Oreal Paris and L'Oreal USA, Inc.	
Plaintiff	Robert Victor Marcon	
Defendant		
7. Mark	Plaintiff	Defendant
	L'OREAL	L'OREAL PARIS
	L'OREAL PARIS	
8. Outline of the case		
<p>Robert Victor Marcon (Applicant) filed for the mark L'OREAL PARIS for aloe vera drinks.</p> <p>L'Oreal S.A. and L'Oreal USA, Inc. (together Opposer) opposed the application on the basis of likelihood of confusion with and dilution of its registered L'OREAL and L'OREAL PARIS marks for cosmetics, and a lack of intent to use in commerce.</p>		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) sustained the opposition on the grounds of likelihood of confusion and lack of bona fide intent to use the mark in commerce, and decided it therefore was unnecessary to decide the issue of dilution. With respect to likelihood of confusion, Opposer introduced significant evidence showing fame of its mark in connection with cosmetics. The Board also considered evidence of bad faith as part of its likelihood of confusion analysis. The Board found that Applicant has a pattern of filing intent-to-use applications to register various well-known marks, and that it is highly unlikely that adoption of marks was an unintended coincidence. The Board found that bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion.</p> <p>With regard to lack of bona fide intent to use, Applicant's lack of documentary evidence or any other objective evidence that he can/will use the mark, lack of capacity or experience needed to manufacture or otherwise offer the identified goods, vague allusions to use the mark through licensing or outsourcing, and failure to take any concrete actions or to develop any concrete plans for use, combined with his pattern of filing intent to use applications for disparate goods under the well-known marks of others, demonstrates that Applicant lacks the requisite bona fide intent to use his mark in commerce for aloe vera drinks. As a result, the Board sustained the opposition on likelihood of confusion and lack of bona fide intent to use.</p>		

10.Tags	
① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	✓

【USPTO-10】

1. Title	MISTER SOFTEE(a registered sound mark) v. a sound mark	
2. Country	United States	
3. Court	United States District Court for the Eastern District of New York	
4. Case No.	No. 1:15-cv-04770-SJ-SMG	
5. Date of the judgment	2016/6/27[citation: Mister Softee, Inc. v. Konstantakakos, No. 1:15-cv-04770-SJ-SMG (E.D.N.Y. June 27, 2016) (unpublished order), objections overruled via unpublished order (Aug. 11, 2016)]	
6. Parties: Plaintiff Defendant	Mister Softee, Inc. and Mister Softee of Queens, Inc. Dimitrios Konstantakakos and 3 DDD Ice Inc.	
7. Mark	Plaintiff	Defendant
	MISTER SOFTEE (a registered sound mark)	
8. Outline of the case		
<p>Plaintiffs Mister Softee, Inc. and Mister Softee of Queens, Inc. (together Plaintiffs) brought this action in the United States District Court for the Eastern District of New York (Court) under the Lanham Act for trademark infringement, false designation of origin, and trademark dilution, and common law unfair competition and unfair trade practice. Plaintiffs allege that defendant Dimitrios Konstantakakos owns 3 DDD Ice Inc. (together Defendants), which operates an ice cream truck that infringes on plaintiffs' trademark by playing Mister Softee's jingle, a registered trademark. Plaintiffs seek an award of injunctive relief and attorney's fees.</p>		
9. Summary of the judgment		
<p>Since Defendants failed to appear or otherwise defend the court action, the Plaintiffs moved for entry of a default judgment. The Court awarded a default judgment. As noted in the record, Mister Softee owns multiple registered trademarks, including "Mister Softee" and the Mister Softee musical jingle ("Sonic Mark") that are used in connection with mobile ice cream truck businesses that sell ice cream, frozen desserts, novelties, and other products, and only authorized licensees are permitted to use Mister Softee's trademarks. Plaintiffs claimed that the Mister Softee marks have been extensively promoted and are associated in the public mind with plaintiffs' products, and that the Sonic Mark in particular is famous and widely recognized as designating plaintiffs' products.</p> <p>The Court found that bad faith has been established by Plaintiffs' unchallenged allegations in the complaint that Defendants "willfully intended to trade on Mister Softee's reputation," and may also be inferred from Defendants' intentional copying of Plaintiffs' Sonic Mark. The inference of bad faith is further supported by Defendants' knowledge of an almost identical trademark infringement suit against the former owner of the infringing truck. These elements of bad faith, balanced with the similarities in the marks and the goods and services, led the Court</p>		

to conclude that Plaintiffs have sufficiently alleged the elements of trademark infringement and false designation of origin pursuant to the Lanham Act. An injunction was awarded.

Moreover, under the Lanham Act, the court in exceptional cases may award reasonable attorney fees to the prevailing party. 15 U.S.C. §1117(a). Exceptional circumstances include willful infringement, and thus, a finding of willfulness determines the right to attorneys' fees. When a defendant has defaulted, then by virtue of its default it is deemed to be a willful infringer. Because defendants have defaulted, they were deemed to be willful infringers, and this case is as a result "exceptional" for the purpose of determining plaintiffs' entitlement to attorney's fees.

10.Tags

① Type of trial	Suit for infringement of a trademark
② Decision	Injunction and attorney's fees awarded
③ Type of bad faith	
Free Ride	✓
Immoral	
Lack of intention to use	

III. Appendix

Related Articles of each countries

【EUIPO】

European Union:

- Art. 52.1.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.

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 cumulative factors (non exhaustive list) to be particularly relevant to indicate the existence of bad faith:

1. **Identity/confusing similarity of the signs:** The EUTM allegedly registered in bad faith must be identical or confusingly similar to the sign to which the invalidity applicant refers.
2. **Knowledge of the use of an identical or confusingly similar sign:** The EUTM owner knew or must have known about the use of an identical or confusingly similar sign by a third party for identical or similar products or services.
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/P

<art-D/02->

part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf

【JPO】

Trademark Act

(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.

【KIPO】

TRADEMARK ACT Wholly Amended by Act No. 14033, Feb. 29, 2016

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;

- (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.

【SAIC】

Trademark Law

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

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 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 44 (a) A registered trademark shall be declared invalid by the trademark office if it is in violation of Article 10, Article 11 or Article 12 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.

【USPTO】

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.

Comparison Tables

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

I. General

	EUIPO	JPO	KIPO	SAIC	USPTO
1. Definition of bad faith under the legal system	No definition	No definition	No definition	No definition	No definition
2. Timing when bad faith is taken up	①Cancellation after registration ② Counterclaim in infringement case	①Examination (by ex officio) ②Opposition, trial ③Counterclaim in national infringement case	①Examination (by ex officio) ②Opposition, trial	①Opposition, trial (invalidation)	①Examination (by ex officio) ②Opposition, trial (cancellation)
3.(1). The earliest stage when bad faith is taken up	After registration of mark	Stage of examination	Stage of examination	Opposition	Stage of examination Opposition
(2). Is there any time limit to claim bad faith ?	No time limit	No time limit	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	5 years, 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

				interested party may, within five years from the date of registration, request the Trademark Review and Adjudication Board to 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.	living individual.
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	It is inferred in consideration of	It is inferred in consideration of	Bad faith is inferred in consideration of some	Bad faith may be inferred by circumstantial evidence.

	applicant/demandant demonstrates bad faith.	circumstantial evidence.	circumstantial evidence.	factual actions and circumstantial evidence..	
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	Not exist

II. Details

	EUIPO	JPO	KIPO	SAIC	USPTO
1. From The View of “Intent to Use”					
Does lack of intention of use become a reason for rejection or invalidation?	No However, an indication of dishonest intention could be, if it becomes apparent, subsequently, that sole objective of owner was to prevent third party from entering the market (CJ judgment C-529/07 of 11 June 2009, “Lindt Goldhase”, Item 44).	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.	There’s no provision to reject application with no intention of use. 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.	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 also be challenged by third party.
i) Text	Article 52(1)(b)	Principal 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	Section 1(b) Section 44 Section 66(a)

ii)At time of judgment standard	Assessment whether bad faith was present back when the registered mark was applied for	At time of decision	At time of decision	At time of application for cancellation	At time of application
iii)Examination by ex officio or opposition, trial	(1) Cancellation (invalidity) trial (2) trial	(1)Examination (by ex officio) (2)Opposition, trial	(1) Examination (by ex officio) (2) Cancellation (invalidity) trial	Cancellation	(1)Examination if 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	(1)(2)Applicant, right owner	(1)(2)Applicant, right owner	The owner of trademark	(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, Principal Paragraph of Article 3(1)	Trademark Examination Guideline Article 42-2	Trademark Trial Standards Part 7(5)	TMEP § 818 (Section (b) or Section 44) TMEP § 1904.01(c) (Section 66(a))
vi)Specific judgment method					

Example 1) Evidence demonstrating use in cancellation for non-use	<p>Cancellation of registered mark for non-use is separate action (not bad faith related), which can be raised at end of 5 year grace period (CTMR, 51(1)(a)). Bad faith cancellation challenge cannot be based on non-use as such as there is no requirement of intention to use. However, it could be an indication of dishonest intention, if it becomes apparent, subsequently, that the sole objective of the EUTM owner was to prevent third parties from entering the market.</p>	<p>Documents allowing to clearly confirm trademark user, using products, using trademark, the manner of use and use period (such as catalog, newspaper advertisements) (Article 50)</p>	<p>Cancellation (Article 119(1)(iii) or validation (Article 117(1)(i)) of registered mark for non-use is separate action (not bad faith related)</p> <p>Cancellation (Article 119(1)(iii) can be raised 3 years after registration of a trademark. Evidential materials showing that a mark, which is substantially identical to the registered one, has been used on goods/services, which are also substantially identical to the goods/service of registered mark within 3 years from the date when a cancellation action is filed.</p>	<p>Cancellation of registered mark for non-use is separate action (not bad faith related), which can be raised 3 years after registration of a trademark.</p>	<p>Elements taken into consideration for bona fide use of mark in the ordinary course of trade:</p> <ul style="list-style-type: none"> • Amount of use • Nature or quality of trade • Typical use in particular industry • Any other probative facts
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Example 2) Whether the following facts and situations ((1)~(7)) are taken into consideration when intention of use of trademark is judged					
(1)Applicant designates a broad range of goods and services.	Intention to use not required by EUTM system. No bad faith based on the length of the list of goods and services designated.	This is taken into consideration. Principal Paragraph of Article 3(1) is applied as there's a rational doubt in use of trademark or its use intention.	The examiner can consider that there is a rational doubt about whether an applicant has used a mark or had a intention to use.	An element may be considered in bad faith.	It is necessary to submit a verified statement of intention to use for each good or service. May be refused if no statement is filed, see answer above.

<p>(2)Applicant applied for a large number of unregistered trademarks of other person.</p>	<p>Intention to use not required by EUTM system. However, large number of applications for trademarks of others can be a strong indication that owner of registered CTM had dishonest intention when applying for it.</p>	<p>This is taken into consideration. There's a judgment that applicant was not identified to use the trademark or to have any intention to use.</p> <ul style="list-style-type: none"> ・「RC TAVERN」 <p>(Intellectual Property High Court, 2012 (Gyo Ke) No. 10019)</p>	<p>(Article 2.2.2. Trademark Examination Guideline) When a KIPO examiner has a doubt that the application was filed 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 trademark applications and/or registration and/or the scope of the applicant's current business.</p>	<p>An element to be considered in bad faith.</p>	<p>An examiner will not evaluate whether the intention to use is in good faith. Third party may challenge based on lack of intent to use in good faith. Judges have found pattern of filing for others parties' marks shows lack of intent to use. In addition, prior to registration, Section 1 applicants must prove good faith by submitting specimens of use for the goods/services in the application.</p>
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<p>(3)Individual person applied for goods and services which required large scale facilities such as general merchandise store.</p>	<p>Intention to use not required by CTM system. However, it could be an indication of dishonest intention, if it becomes apparent, subsequently, that the sole objective of the owner was to prevent third parties from entering the market.</p>	<p>This is taken into consideration. Principal Paragraph of Article 3(1) is applied as there's a rational doubt in use of trademark or its use intention.</p>	<p>(Article 2.2.2. Trademark Examination Guideline) A KIPO examiner can issue a provisional refusal. In this case, the examiner should consider the nature of goods/services, market situation, etc. as a whole; however, the examiner should not regard the scope of the possible business conducted by individual person too narrowly.</p>	<p>An element may be considered in bad faith.</p>	<p>An examiner will not evaluate whether the intention to use is in good faith. However, intent to use may be challenged by a third party. The focus is on the entirety of the circumstances, as revealed by the evidence of record. There is a case example where lack of intention to use in good faith was identified (HONDA case). In addition, prior to registration, Section 1 applicants must prove good faith by submitting specimens of use for the goods/services in the application.</p>
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(4)When services etc. prohibited by laws are designated	Not relevant	This is taken into consideration. Principal Paragraph of Article 3(1) is applied as there's a rational doubt in use of trademark or its use intention.	(Article 2.2.2. Trademark Examination Guideline) A KIPO examiner can issue a provisional refusal on a condition that an individual files an application for more than two non-closely related services such as hospital services and legal services, for which law requires licenses.	An element may be considered in bad faith.	This may be a factor to support lack of intention to use in good faith.
(5)When intention to interfere with market is clear	Intention to use not required by EUTM system. However, an indication of dishonest intention could be, if it becomes apparent, subsequently, that the sole objective of the EUTM owner was to prevent third parties from entering the market.	This is taken into consideration. This may be a factor to be taken into consideration.	The intention of market interference can be considered to determine whether there is bad-faith or not on the condition that the intention of market interference includes filing a trademark application for the purpose of prior occupation and/or interfering with a third party's trademark registration without the	An element may be considered in bad faith.	This may be a factor to support lack of intention to use in good faith.

			intention of use.		
(6)When trademark registration was cancelled due to non-use	Insufficient, in itself, to find bad faith.	The situation is not insufficient to judge intention of use of trademark.	Insufficient to identify bad faith.	An element may be considered in bad faith.	Insufficient to identify bad faith.
(7)Others	Repetition of application of same mark to prevent cancellation for non-use may suggest dishonest intention of EUTM owner.	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 a judge would weigh evidence carefully.
vii)Examination example, decision example, judgment example	<p>Apart from those referred 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) 	<p>There is the following judgement.</p> <ul style="list-style-type: none"> • 「RC TAVERN」 (Intellectual Property High Court, 2012 (Gyo Ke) No. 10019). 	istar logitics case (Case No. 2010Heo4397, rendered by the Patent Court on Oct. 7, 2010)	—	<p>The following are some examples of judgments.</p> <ul style="list-style-type: none"> • Honda Motor Co. , Ltd. v. Friedrich Winkelmann, 90USPQ2d1660 (TTAB2009) • Nintendo of America v. Adar Golad, Opposition No. 91178130, 2011 WL 2360099 (TTAB May 31, 2011) [not precedential]

2. From The View of “Unfair Intention”.					
Is there any legislation for refusing an application (or invaliding the registration) on the basis of unfair intention?	Dishonest intention of EUTM owner is an element of particular relevance in the overall assessment. No legislation, but clear indications in case-law.	Yes	Yes	Yes	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 52(1)(b)	Article 4(1)(xix) Article 4(1)(vii)	Article 34(1)(xiii) Article 34(1)(xx) Article 34(1)(xxi)	Article 32	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	Cancellation (invalidity) 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	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.
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 intent 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 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.
(2)Applicant designates a broad range of goods and services.	No bad faith based on the length of the list of goods and services designated	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.
(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 CTM 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)Others	Repetition of application of same mark to prevent cancellation for non-use may suggest dishonest intention of EUTM owner.	<ul style="list-style-type: none"> • Well-Known of other person's trademark • Creativity of well-known trademark • Preparation state of 	<ul style="list-style-type: none"> • Famousness of well-known and famous trademark • Creativity of well-known trademark 	(1) Whether the common area of the applicant of the pending trademark and the holder of the trademark or the goods/services of the	The TTAB or a court has broad discretion to consider any number of factors that could provide circumstantial evidence of

		<p>business of well-known trademark owner</p> <ul style="list-style-type: none"> • Prevention of the market entry of foreign right holder of trademark • Concern to impair credibility, reputation and customer attraction of well-known trademark 	<ul style="list-style-type: none"> • Preparation state of business of applicant • Whether designated goods and services are same or similar, or presence/absence of economic relation 	<p>both sides are within the same sales route and range or not;</p> <p>(2) Whether another conflict has been present between the applicant of the pending trademark and the holder of the trademark or not, and whether the both sides knew trademark of a prior user or not;</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</p>	<p>bad faith, such as bad faith in disclosure of evidence during discovery.</p>
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				<p>applicant of the pending trademark conducts misleading advertisement, enforces dealing and partnering (on a trademark) to the prior user, releases the trademark to the prior users or other persons at a high price, and charges them a license fee or compensation of infringement of right by utilizing a certain good fame and impact of the trademark possessed by the trademark holder, or not;</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>	
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(5)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.
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) 	<p>There are the following judgments.</p> <ul style="list-style-type: none"> ・「Asrock」 (Intellectual Property High Court, 2009 (Gyo Ke) No. 10297) ・「KYOKUSHIN」 (Intellectual Property High Court, 2008 (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> <p>①“黑面蔡” Trademark opposition case (No. 1611206)</p> <p>②KUREYON Shinchan Figure trademark dispute case (No. 1033444)</p> <p>③“ERE” Trademark opposition case (No. 4809737)</p>	<p>There are the following examples:</p> <ul style="list-style-type: none"> ・ Estrada v. Telefonos de Mexico, 447F.App'x197 (Fed. Cir. 2011) ・ Carr v. Garnes, Opposition No. 91171220, 2010 WL 4780321 (TTAB Nov. 8, 2010 [not precedential])

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’s 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 52 (1)(b)	Article 4(1)(x) Article 4(1)(xv) Article 4(1)(xix)	Article 34(1)(xiii)	Article 13	False Association : Section 2(a) and Section 43(a) Likelihood of confusion : Section 2(d) Dilution : Section 43 (c) Misrepresentation of Source Section 14(3)
ii)At time of judgment standard	Assessment whether bad faith was present back 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) (2)Opposition, trial	(1)Examination (by ex officio) (2)Opposition, trial	Opposition, trial	(1)Examination (by ex officio) (False association 2(a) and likelihood of

					confusion 2(d)) (2) Trial for opposition and cancellation
iv) Burden of proof	Party claiming that other side was in bad faith, i.e. invalidity applicant	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 Section 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” and “reputation” Standard	• “Well-known” (EUTMR 8(2)(c)) is same as Paris, Article 6 bis. "Reputation"	• No definition of each phrase • For “well-known” and	• No definition of each phrase • For “well-known” and	It is stipulated that facts of advertisement activities and trademark use period	• “Well-known” is identified when likelihood of confusion is judged.

and evidence of well-known famousness	<p>(CTMR 8(5)).</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, reputation is taken into consideration when bad faith is assessed, but is not a prerequisite for a finding of bad faith. 	<p>“famous”, facts of advertisement activities and trademark use period are totally taken into consideration.</p>	<p>“famous”, facts of advertisement activities and trademark use period are totally taken into consideration.</p>	<p>are totally taken into consideration on examination standard.</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
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(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"	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. 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 countries	No specific law for foreign famous marks.	Article 4(1)(xix)	Article 34(1)(xiii)	No laws	No law

(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 right 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 ?	In addition to the situation of similar or identical goods and services, a finding of bad faith may also be justified if the CTM was applied for in respect of goods and services, which, although dissimilar, belong to a neighboring market.	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 Section 2(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 dilution, there may be tarnishment or dilution if no similarity of goods or services.

(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.	Together with other elements, depending on the claim	To determine likelihood of confusion, bad faith or fame is not necessary. But if present, both are factors a judge will weigh in a likelihood of confusion analysis.
(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

					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 ?	Yes	No	Yes WARAWARA case (Case No. 2012Hu672) cited	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 is, inter alia, the following judgment. • 「Lindt Goldhase」 (CJ judgment C-529/07 of June 11, 2009)	There are the following judgments. 4-1-10 case example • 「Computer world」 (Tokyo High Court, 1991 (Gyo Ke) No. 29) 4-1-15 case example	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 re-examination (rejection	The following is one example: • L'Oreal S.A. v. Marcon, 102 USPQ2d 1434 (TTAB 2012)

		<ul style="list-style-type: none"> • 「L'Air du Temps」 (Supreme Court, 1998 (Gyo Hi) No. 85) 4-1-19 case example • 「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) • 「M.A.C • MAKEUP ART COLLECTION」 Opposition decision (1998 Opposition No. 92239) 	<ul style="list-style-type: none"> • 「BarbieQueen」 (Case No. 2013Hu1986) 	decision dissatisfaction trial) case (No. 1649903) ③“神州三号”Trademark opposition case (No. 3217926)	
4. Unfair Application filed by Agent or Representative					
Is there any legislation for refusing an unfair application (or invalidating the registration) filed by	Yes	Yes	KIPO has no such a law. However, if such an application is considered to be filed under the bad-	Yes	Yes

agent or representative (related to Article 6 section of the Paris convention)			faith, such as free-ride on the fame of a third party, the application can be rejected.		
i)Text	Article 8 (3) EUTMR Article 53(1)(b) EUTMR	Article 53 -2		Article 15	Section 1 (a)(1), Section 1(b), Section 44, 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 ②Cancellation/Invalidity against registered mark	Cancellation trial	—	Opposition or trial	①Examination (ex parte) if ownership contradicted in the record. ②Opposition or cancellation
iv)Burden of proof	Opponent or invalidity applicant. For "negative facts", burden of proof reversed, e.g. agent to prove that he had owners 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	No standard	—	Trademark Trial standards Part 2	TMEP § 1201.06(a)

vi) Specific judgment method	See EUIPO Guidelines for examination, Part C, Section 3	See vii)	—	Refer to the Trademark Trial standards in v)	See TMEP § 1201.06(a)
vii) Examination example, decision example, judgment example	See EUIPO Guidelines for examination, Part C, Section 3	There is the following judgment. • 「Chromax」 (Intellectual High Court, 2011 (Gyo Ke) No. 10194)	—	There are some examples. ① 「BRUNO MANETTI」 Trademark opposition case (No. 3083605) ② “头包西灵 Toubaoxilin” Trademark opposition case (No. 3304260) ③ “安盟 SecurID” Trademark opposition re-examination (No. 3514462)	The following is one example. • Lipman v. Dickinson, 174 F.3d 1363, 1372 (Fed. Cir. 1999)
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 53(2)) • Different invalidity ground from that of bad faith (EUTMR 52(1)(b)) 	• Name of other person	No	Yes	Copyright or right of publicity: not a ground for opposition or cancellation; party may file a civil lawsuit on grounds of copyright infringement or right of publicity;

					trade name:possible to file an opposition, cancellation, or lawsuit;Right to a name or likeness (false association): ex parte, opposition, cancellation. Refusal ex parte if name of a living individual and no consent provided.
i)Text	Article 53 (2) CTMR	Article 4(1)(viii) (Reference) Article 29	Article 34(1)(vi) Article 92(1)	Article 32	Section 2(a) Section 2(c)
ii)At time of judgment standard	In principle, any time after registration of the EUTM.	At time of application and decision	At time of application	At time of application	Application date
iii)Examination by ex officio or opposition, trial	Invalidity/cancellation action	(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	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	Trademark Examination Guideline, Article 4(1)(viii)	Trademark Examination Guideline 5.6.	Trademark Trial Standards Part 4.	See aboveTMEP Section 813, TMEP Section 1203.03(c).

	on Article 53(2) CTMR				
vi))Specific judgment method	Guidelines for examination, Part D, Section 2, Sub-heading 4.3 on Article 53(2) EUTMR	See v)	Same as above	See the answer in v)	Same as above
vii)Examination example, decision example, judgment example	Guidelines for examination, Part D, Section 2, Sub-heading 4.3 on Article 53(2) EUTMR	There is the following judgment. • 「SONYAN」 (Tokyo High Court, 1977 (Gyo Ke) No. 133)	There is the following judgment. • 「2NE1」 (Case No. 2012Hu1033) • 「KT」 (Case No. 2009Heo1705)	There are some examples. ① 「季世家 1915」 FigureTrademark 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 FigureTrademark opposition case (No. 3308372) ⑥ 「易建联」 商標係争案	The following are case examples. • In re Richard M. Hoefflin, 97 USPQ2d 1174 (TTAB 2010) • In re Jackson Int’l Trading Co., 103 USPQ2d 1417 (TTAB 2012)

				件 (No. 3517447) ⑦Figure 商標異議復審案 件 (No. 1004698)	
6. Any other views except for 1.- 5.					
Viewpoints other than the above	None	None	—	None	None

III. Procedures

	EUIPO	JPO	KIPO	SAIC	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 (Trademark Act, Ordinance, Article 19)	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) 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 application from being registered since August 2013, indicating that the bad-faith filing application could be rejected by ex	It can be referred as work of the Trademark office, however, reception of this kind of document is not a legal procedure.	There's no provision to offer information. However, it is possible to submit documents. "Letter of protest" is unofficial procedure. It may be taken into consideration at discretion of examiner.

			officio examination even without information provided by a third party.		
2. Integration of procedures in opposition, trial	They may be treated as related cases.	They are integrated (Patent Act, Article 154(1) shall apply to Trademark Act, Article 56(1), and Article 43-10(1))	They are integrated (Article 54(3)[Examination] Article 117(1)(i) [trial] Article 119(1)(iii) and (5) [trial])	They are integrated.	They are integrated.

IV. Others

	EUIPO	JPO	KIPO	SAIC	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 Trademark Trial Appeal Board Manual (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)