

# TM5

## Manga Booklet

**For Counter Measures  
Against Bad-Faith  
Trademark Filings**





**What is it?**

You are able to provide useful information for examinations such as that a TM application does not satisfy the requirements for registration or falls under the grounds of unregistrability.

The provision of useful information for examinations contributes to accurate and fast examinations. This system is helpful for countermeasures against Bad faith filings.

**Outline (requirement)**

**Who?** - Anyone

**When?** - As long as application is pending at the JPO

**How much?** - Free of charge

**For which provision?** - another person's well-known mark, contravention of public order or morality, distinctiveness etc.

**What documents?** - a periodical, catalogues, pamphlets and trading documents etc.

For detail: [https://www.jpo.go.jp/e/system/trademark/shinsa/touroku\\_jouhou.html](https://www.jpo.go.jp/e/system/trademark/shinsa/touroku_jouhou.html)



# Be aware of the scope of Trademark Protection

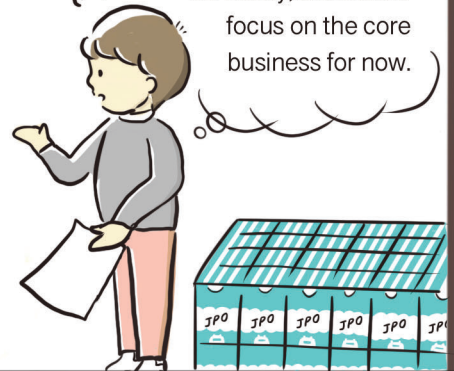
Do a TM Search to Prevent Bad-faith Filings



All done! Anyhow, my trademark has been registered. what a relief.



We want to extend our product line to include real "robots" someday, but should focus on the core business for now.



A few years later...

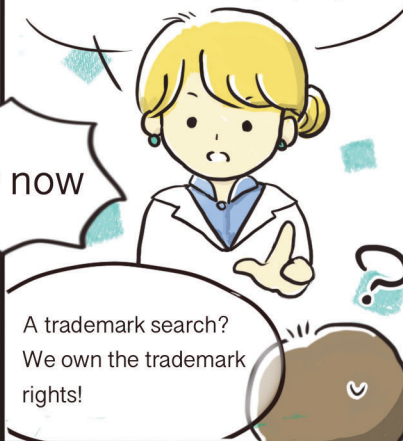
Our business is doing well! Let's extend our product line to include JPO branded "robots" that has always been our dream...



Have you done a trademark search properly?

Hey now

A trademark search? We own the trademark rights!



- ✓ The scope of protection depends on the type of goods.  
→ You have the right to use the trademark for the goods "toy"!
- ✓ In Japan, the "J-PlatPat" search engine is available.
- ✓ A trademark search helps us to stop bad-faith trademark filings.

**Trademark Search is Essential!**



There's no prior trademark for our goods "robots"!

J-PlatPat Search

Excellent!

We'll register our trademark!



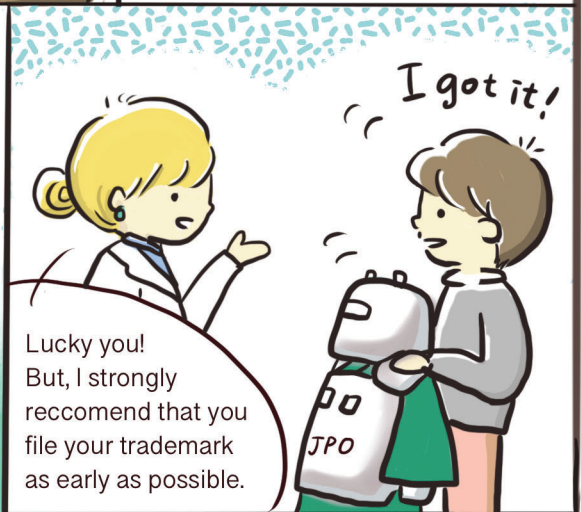
A month later...





We have found that someone filed the same trademark, and his filing date is just a few days later. This time, we were OK because we filed our trademark earlier.



I got it!

Lucky you! But, I strongly recommend that you file your trademark as early as possible.



-  Trademark protection has no effect on any of the goods/services that are not similar to the designated goods/services.
-  It may be that your trademark is being targeted. If you have a plan to extend your product line, file your trademark as early as possible!
-  The J-platpat is the database of trademarks registered in Japan you can use for free. Using this database, you can do a trademark search before you file your trademark, and watch out for a bad-faith trademark to take a preemptive action!
-  Trademarks by nature are territorial. Thus, the applicant needs to file his trademark on a country by country basis.

J-platpat <https://www.j-platpat.inpit.go.jp/t0100>

**Tips**



A Bad-faith Filing  
can Lead You to...



Boy, these popular cakes in country-X are not sold and the trademark has not registered in Japan yet!

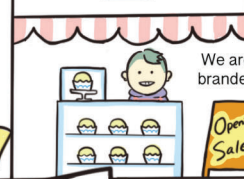
Cheating.co



Cheating company



And then, in Japan...



We are selling branded cakes!

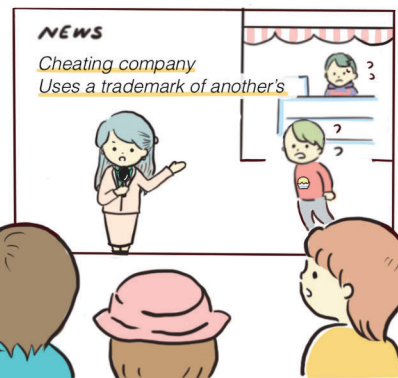


We have got trademark right because this is unknown in Japan!

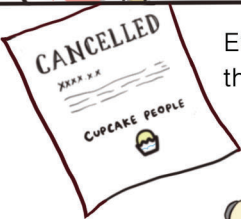
But then, on the website...



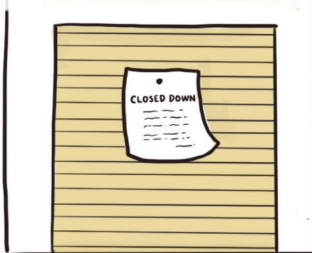
Japanese consumers bombarded with a responsible company with criticism on social media.



Then, it was featured in the news on TV and more Japanese consumers blamed the company.



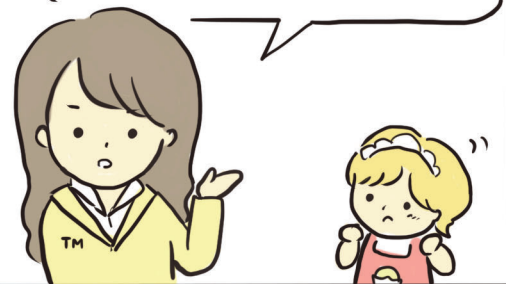
Eventually, they published an apology and their shop was forced to close soon.



Moreover, the trademark owner filed an opposition to revoke the registered trademark.



This time, you were OK, but it's not easy to revoke the registered trademark. If you have a new plan for your business, don't forget to file your trademark first!



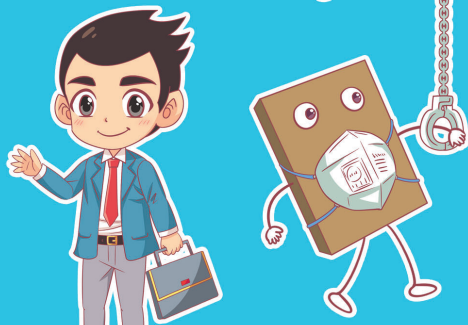
- ✓ Even if you could start your business in Japan and register the trademark which is well-known abroad but unknown in Japan, this kind of information spreads on social media as most people are internet users. As a result, a responsible person can get bombarded with criticism by the society.
- ✓ If the unfair intentions become apparent afterwards, the registered trademark may be revoked.
- ✓ It is not a good idea to file a bad-faith trademark even if it is not registered in the country yet.
- ✓ Each country provides regulations to revoke the registered trademark filed in bad faith. The TM5 has published the Case Examples of Bad-Faith Trademark Filings, which you can use as a reference.

TM5 Bad-Faith Trademark Filings(English) <http://tmfive.org/continuationexpansion-of-bad-faith-project-2-2-2-2/?red=>



## The story of Xiaoming and trademark

### Cracking down on bad-faith trademark registrations

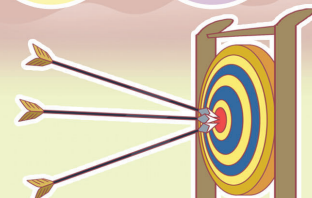


In 2019, China's Trademark Law was amended for the fourth time to include a key change involving banning bad-faith applications for trademarks not for practical use from the source.

初审

异议

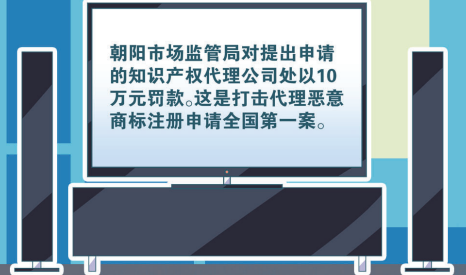
评审



The Trademark Office of CNIPA has strengthened coordination throughout the examination, opposition and review process to precisely crack down on bad-faith applications for trademarks not for practical use.

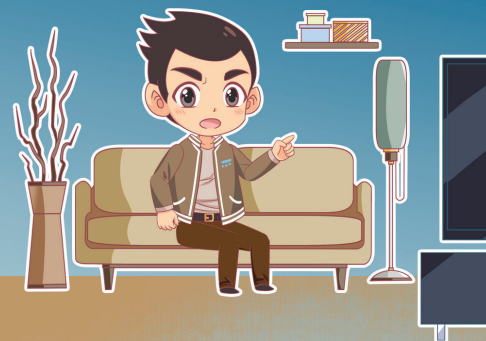


According to the new Trademark Law, bad-faith applications for trademarks not for practical use will be rejected.



朝阳市场监管局对提出申请的知识产权代理公司处以10万元罚款。这是打击代理恶意商标注册申请全国第一案。

The China National Intellectual Property Administration (CNIPA) rejected 63 bad-faith applications for trademarks related to the COVID-19 pandemic including Huoshenshan. The intellectual property agency filing the applications was fined RMB100,000 (\$15,210) by the Market Supervision Administration of Chaoyang District, Beijing.



That was too much! They took advantage of public attention on the epidemic to file trademark applications. I support CNIPA's decision.



CNIPA has taken a firm stand to crack down on bad-faith trademark applications involving the epidemic. It asked relevant local authorities to question and punish applicants and agencies infringing relevant regulations and require violators to make corrections.



Those measures safeguard social justice and fairness and create a favorable social atmosphere for epidemic prevention and control.



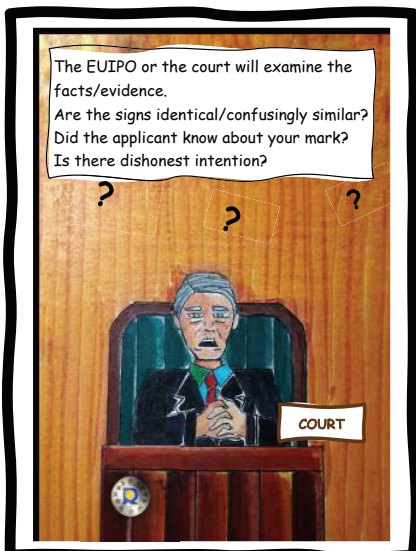
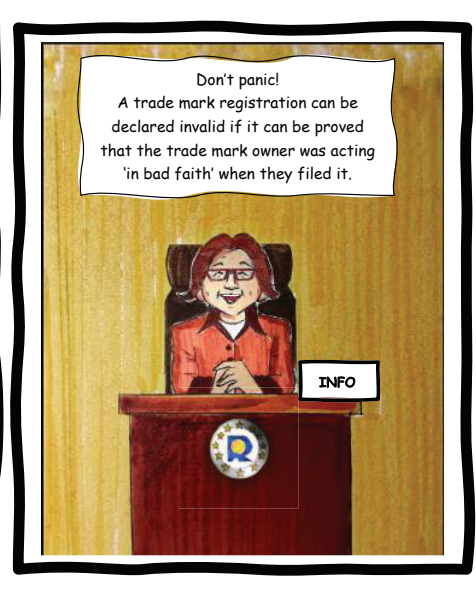
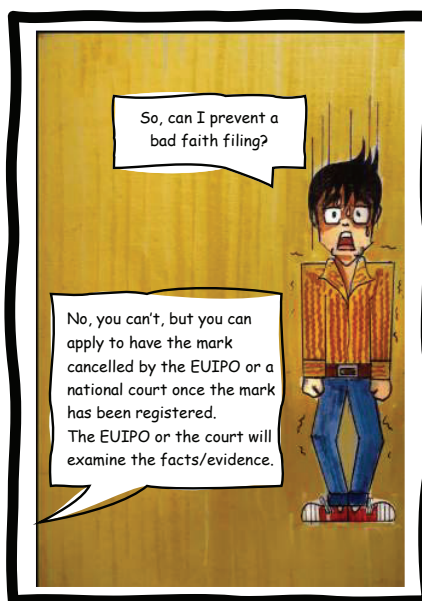
Xiaoming's tips: Although the application for trademark registration is the most convenient and efficient way for market entities to conduct IP protection in market operation, the application shall not violate the Trademark Law or the Rules on Regulating Trademark application and Registration Conducts.





# Cancellation of Bad Faith Trade Marks

## Measures against Bad Faith Filings



The relevant point in time is the application date of the trade mark registered in bad faith.

Invalidity applications can be successful even if the trade mark registered in bad faith was for different goods and/or services.

Burden of proof: it is up to you to prove that the other party acted in bad faith.

Fee for invalidity application: EUR 630

For info visit [EUIPO trade mark guidelines webpage](#)






# 1. Information Provision System against Bad-Faith Filings

**POPO TV**

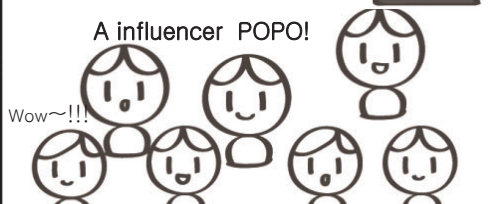
It is one of the most popular cookies these days. I'll try them and tell you how they taste!



**ON AIR**

A influencer POPO!

Wow~!!!




The sale has sharply increased after streaming



Month	Sales
1	Low
2	Low-Mid
3	Mid
4	Mid-High
5	High
6	Very High
7	Peak

Hey, your business seems to be going great!

When will you get trademark registration? It's very important for your business.

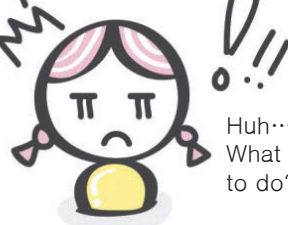
I registered mine last year.

Trademark registration?




Someone has filed to register the same trademark.

Huh...! What am I supposed to do?




In this case, you should remember "Information Provision System" of KIPO.



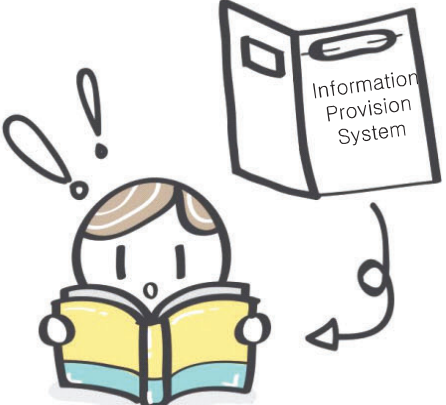
**Provision of information System**

- \* Who can use? Anyone
- \* When? Before the decision of TM registration
- \* How much? Free of charge

I'll prevent the registration of a bad-faith trademark through the 'Information Provision System'.



The examiner may refer to "provision of information" during the examinations.




**Result of the review on provision of information**

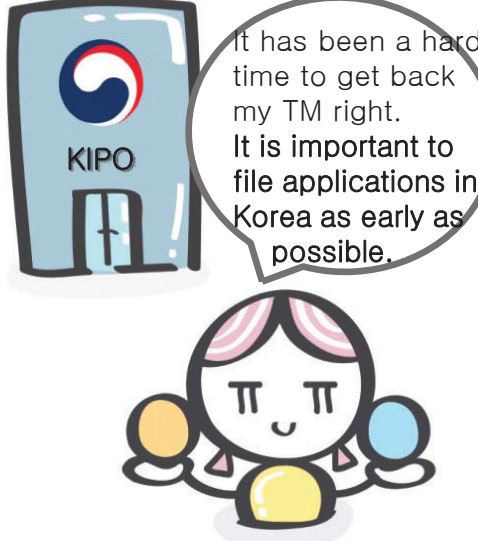
been  accepted    been  dismissed

The provision of information was accepted.

Refusal!



It has been a hard time to get back my TM right. It is important to file applications in Korea as early as possible.



\* The trademark "A" is a randomly selected mark for this illustration.

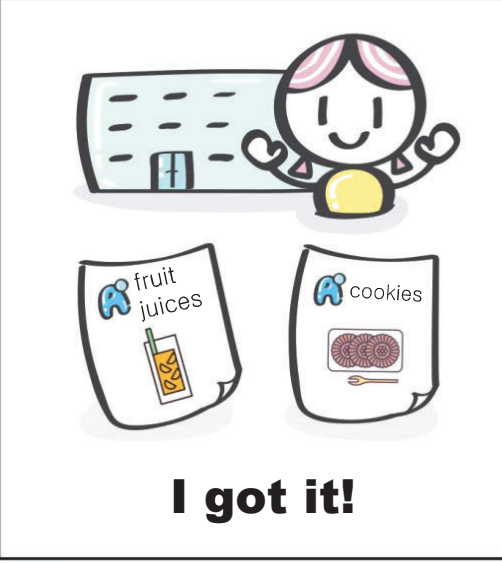
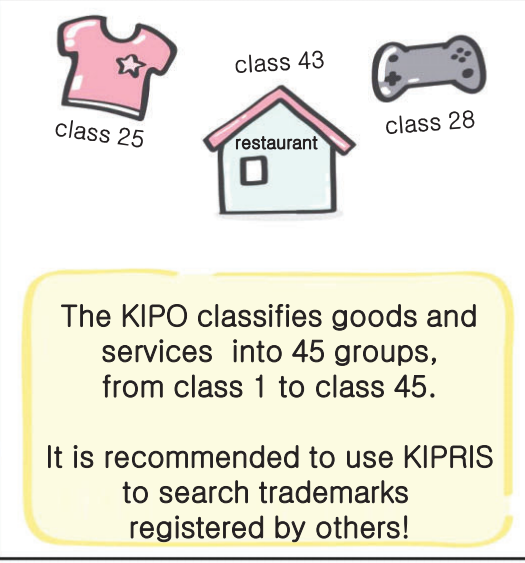
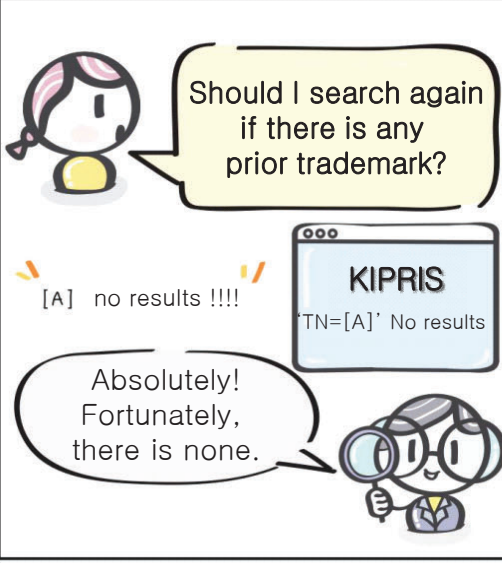
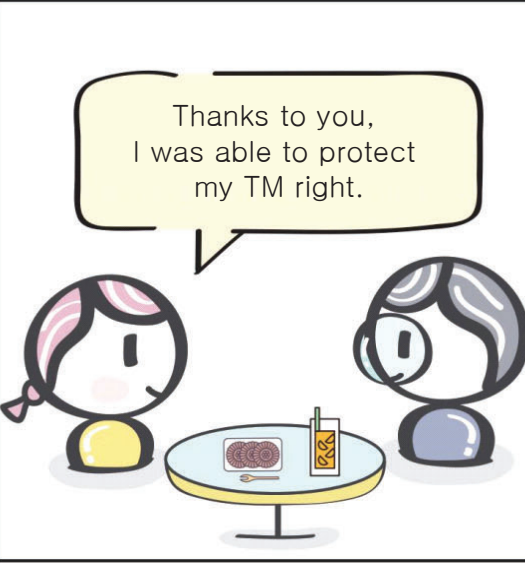
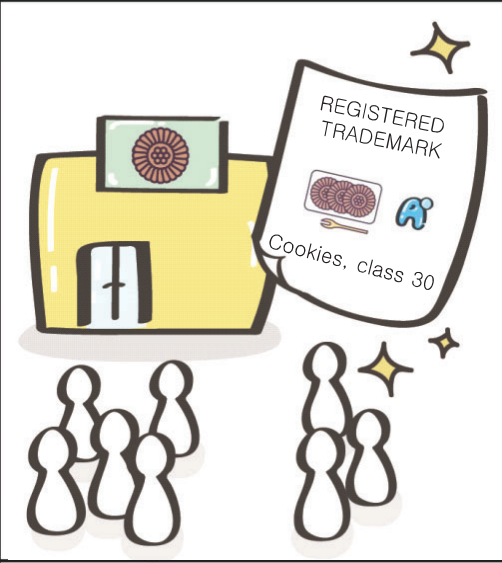
\* As provision of information is available in the process of examination, bad-faith TM filings can be refused in a short period of time without charge. It helps secure a business by prohibiting the registration of illegitimate trademarks.



# 2. The Scope of Trademark Protection

Korean Intellectual Property Office

## Things to consider when expanding your business

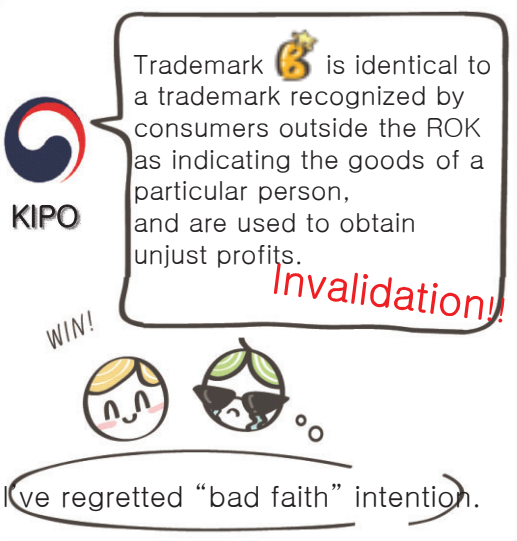
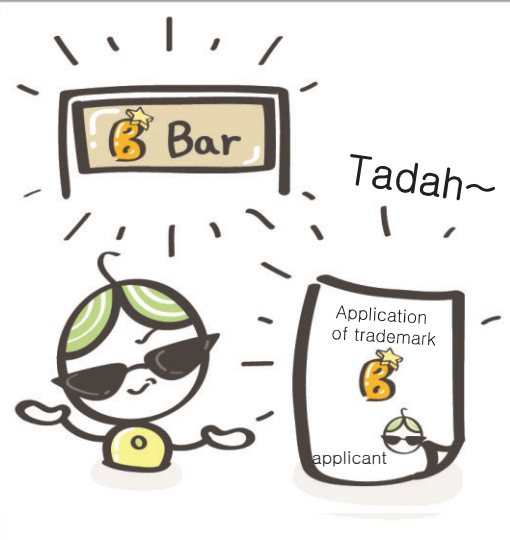


\* The trademark "A" is a randomly selected mark for this illustration.  
\* Trademark registration in the Republic of Korea has effect only within the territory of ROK. If the applicant wants to use it overseas, (s)he needs file an application on a country by country basis.  
\* KIPRIS(<http://kipris.or.kr>) is a search engine provided by KIPO. You can search and browse data, applied for or registered trademarks in Korea, for free.





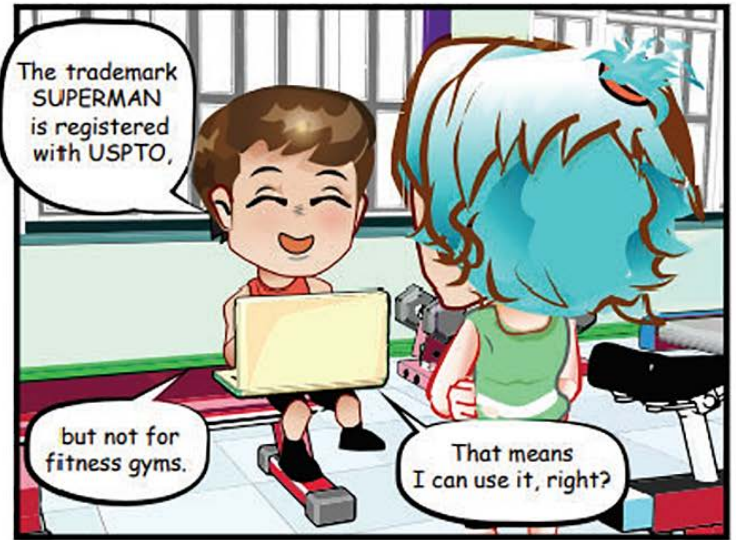
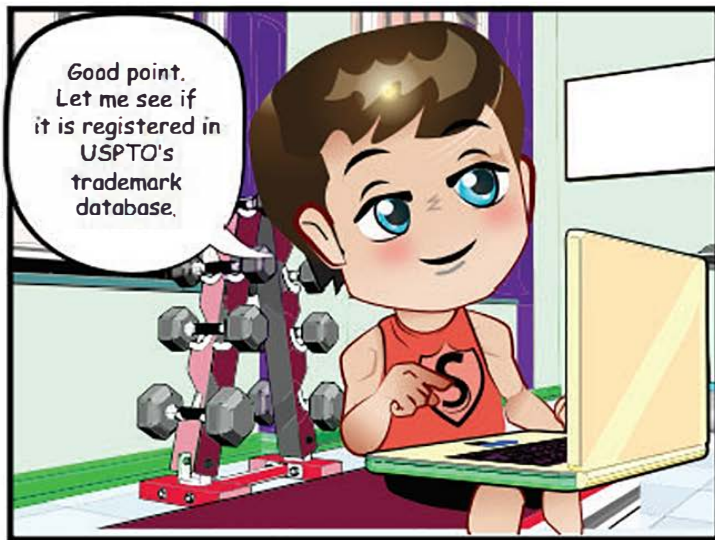
### 3. The End of Bad-faith Filings - Trademark Invalidation Trial -



- \* The trademark "B" is a randomly selected mark for this illustration.
- \* Bad faith intention is a factor considered by IPT or Court in determining invalidation or revocation of the registered trademarks.
- \* TM5 has published Case Examples of Bad-faith Trademark Filings, which can be used as a reference, via TM5 website(tmfive.org).



他社/他者の商標登録を使用しないで下さい。  
Don't Use Well-Known Marks in Your Trademark!





# Monitor your Trademark Rights! 商標権を監視!

