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Bad-Faith Trademark Filings

As you may know, the Japan Patent Office (JPO) participates in the framework “TM5” along with the Korean Intellectual Property Office (KIPO), the European Union Intellectual Property Office (EUIPO), the State Administration for Industry and Commerce of the People’s Republic of China (SAIC) and the United States Patent and Trademark Office (USPTO) for the exchange of information on trademark-related matters.

On May 21, 2017, TM5 announced the Case Examples of Bad-Faith Trademark Filings in each office. JPO introduced ten (10) cases which were based on the following statutory basis. In other words, you may challenge the validity of the registered trademarks by way of opposition and/or cancellation petition based on the following provisions if you trademarks are plagiarized.

Art.4(1)(vii): Trademarks against public order or morality

Art.4(1)(xix): Trademarks identical with or similar to another person’s well-known trademarks and used for unfair purposes

Example (Trademark Registration A was invalidated based on B.)

A.

B.



In the meantime, JPO announced last year that you should never give up the registration of your trademarks if you find the prior trademarks filed by Mr. X. Mr. X is a former patent attorney and filed large number of trademark applications (more than 10,000 cases per year). In many cases, application fees are never paid. Mr. X also uses divisional application system so that the application where the application fee is not paid may survive for a long time.

You may encounter the prior applications by Mr. X during the trademark search in Japan. However, these citations may be disregarded by JPO and you may have a chance to overcome these citations.

If you have any questions, please do not hesitate to contact us.