



**OPPOSITION AND CANCELLATION SUBCOMMITTEE**

**INTA ENFORCEMENT COMMITTEE**

**Report and Recommendations:**

**Repeat Filings of Trademark Applications After Successful Opposition/Cancellation  
Against the Same Mark Based on Prior Rights**

**March 9, 2015**

## Table of Contents

<b>I. Introduction</b> .....	03
<b>II. Background</b> .....	04
<i>A. Laws/Rules Preventing Re-filing</i> .....	07
<i>B. Examination</i> .....	08
<i>C. Expedited Hearings/Summary Procedures in New Oppositions/Cancellations</i> .....	10
<i>D. Principles of Res Judicata</i> .....	11
<b>III. Proposals/Recommendations</b> .....	12
<b>IV. Subcommittee Members</b> .....	13

## I. Introduction

When protecting and defending their mark, trademark owners will undoubtedly come up against an entity or individual who files an application for an identical or confusingly similar mark for the same or virtually the same goods or services. On the most basic level, this situation can easily be addressed by the prior-rights owner initiating an opposition proceeding against the applicant. Unfortunately, however, applicants may re-file identical applications for the same mark, despite it having previously been successfully opposed on the basis of prior rights. Similarly, an application may be filed for an identical mark after the registration for that mark has been cancelled pursuant to a cancellation action based on prior rights.<sup>1</sup> This is an issue faced by brand-owners and practitioners, and in most jurisdictions, the prior rights owner has to, once again, litigate the opposition fully, which also drains Trademark Office resources.

Therefore, this Subcommittee proposes that in order to address the issue to the extent it arises, there should be an expedited procedure in place rather than requiring prior rights holders to continually re-litigate the same matter. Thus, when the circumstances surrounding the repeated trademark application have not changed since the previous successful opposition/cancellation based on prior rights and between the same parties, the Subcommittee proposes that jurisdictions should deter Nuisance Repeat Filings and to this end, adopt one or both of the following:

1. An official procedure allowing the prior-rights owner to file a Letter of Objection (or Protest) related to the alleged Nuisance Repeat Filing (defined below) and requiring examiners to consider such letter during examination. This letter would bring the earlier opposition/cancellation decision to the Examiner's attention during the examination period, so that the opposition/cancellation decision concerning the same mark between the same parties may be given immediate consideration and possibly result in the refusal of the Nuisance Repeat Filing on that basis or, at least, an office action, before the need for opposition;

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<sup>1</sup> The Subcommittee notes that this Resolution is not intended to address the circumstance where an opponent who loses an opposition proceeding later files a cancellation action once the opposed mark registers, as that would not be a "repeat filing". See *Tegometall International AG v Office for Harmonization in the Internal Market* (OHIM) (Case T-11/13, September 23 2014).

2. Some form of summary procedure in opposition proceedings involving Nuisance Repeat Filings to allow the matter to be brought to an expedited hearing (if needed or applicable), and decision.<sup>2</sup>

## II. Background

For the purposes of this report, “Nuisance Repeat Filing” is defined as a re-filed trademark application by the same applicant and for the same or virtually the same goods or services for the same mark that was previously the subject of a successful opposition/cancellation proceeding based on prior rights. Additionally, the circumstances are unchanged from the previously decided opposition/cancellation between the same parties denying registration, where the passage of time, in and of itself, is not a sufficient change. Further, “virtually the same goods or services” means that any changes made to the description of goods or services are immaterial, or involve the mere addition of goods or services. Furthermore, “a successful opposition/cancellation proceeding” is one that is not subject to a pending appeal or otherwise awaiting decision.

The Subcommittee conducted extensive research over two terms and in follow-up to the work of the previous Subcommittee, the current Subcommittee surveyed eighteen (18) jurisdictions (See Appendix A) and found that while Nuisance Repeat Filings have been encountered in many jurisdictions, the prevailing laws and procedures do not adequately address the issue. The result is that Nuisance Repeat Filings may escape scrutiny at examination and are dealt with as any other filing at opposition.

Of the eighteen (18) jurisdictions surveyed by the current Subcommittee, practitioners from thirteen (13) jurisdictions (Argentina, Brazil, Belarus, Canada, CTM, Germany, India, Mexico, Peru, United Kingdom, China, Taiwan and Thailand) stated that they had come across what we have defined as Nuisance Repeat Filings. Practitioners from Belarus, China, Taiwan and India could not discern any change in circumstances/justification for them.

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<sup>2</sup> For the sake of clarity, the Subcommittee recognizes that a strict prohibition on all repeat filings is not desirable as it might impose an unduly onerous burden on applicants re-filing in good faith due to a change of circumstances or other analysis

Further, whilst Nuisance Repeat Filings are not treated differently and progress as any other application, among the jurisdictions surveyed by both the current and former Subcommittee, only the U.S. allows for a formal mechanism of filing a letter of protest at examination, and the U.S. and Panama provide for a “summary judgment” procedure in opposition proceedings. Three jurisdictions,<sup>3</sup> Belarus, Poland and Thailand, entitle right holders to file informal letters of protest/observations with the Trademark Offices. Where Nuisance Repeat Filings are not likely to be addressed during the process of registration, right holders expressed that they would find such repeat filings without justification to be a nuisance.

Respondents from six (6) jurisdictions (Canada, India, Peru, China, Taiwan and Thailand) shared instances of Nuisance Repeat Filings. In India, an application seeking registration of a mark for watches in Class 25 goods was successfully opposed. The applicant filed an application for registration of the same mark which had to be opposed again. In another case, a mark of a well-known FMCG (Fast Moving Consumer Goods) company was applied for and successfully opposed. Thereafter, it was applied for again and upon opposition, the applicant even challenged the registrations of the FMCG company. The applicant withdrew the cancellation applications and the trademark application after completion of all pleadings/evidence just before the matters were to be heard.

The respondent from China mentioned a case where the mark of an international luxury brand was applied for many times by the same applicants despite several oppositions decided in favor of the brand owner. Further, two cases were cited from Thailand where the applicants refiled for registration of the marks after the previously filed applications were opposed and abandoned by maintaining the key features/characteristics of the successfully opposed marks. The Respondent from Taiwan cited the instance where a shareholder of the applicant of a word mark which was successfully opposed applied for a composite mark consisting of the identical word mark and a design element. Opposition was filed on the same grounds and ultimately the refiling was refused.

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<sup>3</sup> The Subcommittee is aware that Korea and Russia also provide for a letter of protest but were not covered in the survey conducted by the current Subcommittee.

Respondents were asked whether there is any legal rule or principle such as *res judicata* which assists the opponent to prevent Nuisance Repeat Filings from proceeding to registration. Three (3) jurisdictions mentioned that *res judicata* is applicable and may be relied upon by the right holder. However, irrespective of availability/recognition of *res judicata*, right holders cannot avoid full-fledged proceedings for want of a summary procedure to be able to raise *res judicata*. Further, jurisdictions where *res judicata* is not available do not have any formal recourse available to block the Nuisance Repeat Filing.

Based upon the survey results, the Subcommittee concludes that there is a lack of efficient means in many countries to address Nuisance Repeat Filings both at the examination stage and at opposition.

The surveys conducted by the Subcommittee revealed that:

- a) there are instances of Nuisance Repeat Filings appearing in many countries;
- b) in most countries there is no formal procedure at the examination stage to enable a previously successful rights holder to bring the prior proceeding to the attention of the examiner so as to have the fact of the previous proceeding considered at the examination stage;
- c) most countries lack an expedited opposition process for Nuisance Repeat Filings necessitating that rights holders engage in a further full blown opposition proceeding;
- d) *res judicata*, in those countries where it is even recognized, does not assist a rights holder facing this issue because, for the principle to be applied, adjudication, often through a full-fledged opposition proceeding, is necessary.

For further background, the 2012-2013 Subcommittee conducted a survey (see Appendix B) to identify how Nuisance Repeat Filings would be handled, specific differences in practices and to help determine whether harmonization or standardization is necessary and desirable in connection with the treatment of Nuisance Repeat Filings. The Subcommittee received completed responses from 66 jurisdictions. This survey revealed the following:

## **A. Laws/Rules Preventing Re-filing**

Although none of the jurisdictions surveyed have express legislation prohibiting Nuisance Repeat Filings, two jurisdictions, namely, South Korea and Japan, do have laws expressly prohibiting the filing of a fresh application for the same or similar mark in connection with the same or similar goods, for a defined period of time, by the owner of a mark, after the registration for that mark has been cancelled as the result of a cancellation action.

**South Korea:** Under Article 7(5) of the Korean Trademark Act, if a mark is cancelled by a cancellation action (whether based on non-use or on other grounds), an application for an identical or similar mark cannot be filed by the owner of the cancelled mark unless three (3) years have lapsed from the conclusion date of the cancellation proceeding. The three year waiting period works as a sanction against the owner of the cancelled mark, and is intended to give the successful party in the cancellation proceeding an opportunity to apply for the mark itself, if it so wishes. To avoid a situation where the owner of the cancelled mark tries to make a minor change to the application to circumvent Article 7(5), the prohibition also covers fresh applications for similar marks covering similar goods. When such an application is filed in violation of Article 7(5), KIPO should refuse the application *ex officio*. However, in case the Trademark Office erroneously overlooks the earlier filing, the prior successful party must monitor the new filings itself in case it needs to take protective measures. As noted, Article 7(5) does not apply to opposition proceedings, and therefore, in order to prevent a re-filed application for the same mark from registering, it is necessary for the prior-rights owner to file an opposition.

**Japan:** Japan also has a law (i.e., Japanese Trademark Law Sections 51(2), 52.2(2), and 53(2)), prohibiting the junior registrant from re-filing an application for a mark that is the same as or similar to a trademark that has been cancelled by a decision in a cancellation trial based on unfair use (Articles 51(1), 52.2(1) and 53(1)) for a period of five (5) years. During this waiting period the prior trademark owner may re-file only for goods/services that are not similar, or it must change the mark so that it is not considered similar to the mark that was cancelled. This prohibition is valid only for cancellation trials based on unfair use; it is not valid for cancellation trials based on non-use (Article 50(1)), or in opposition trials or invalidation trials.

Sections 51(2), 52.2(2), and 53(2) of the Japanese Trademark Act are not, however, directly aimed at preventing repeat trademark filings. Instead, they are directed at preventing the registrant, a new owner or a licensee from deceptive use of a trademark, and designed to serve as a sanction. Specifically, this prohibition applies in three cases where unfair use is deemed to have occurred: (1) when the owner of the registration is intentionally using the identical/similar mark with the registered mark for identical/similar goods and services, which will cause a likelihood of confusion; (2) when, due to partial assignment, an assignee and assignor both own the same mark, and there is unfair competition; and (3) when a licensee of the owner of the mark is using the identical/similar mark as the registered mark, and the likelihood of confusion is caused. There have been very few cases applying this law and very little legal commentary on this law; therefore, the Subcommittee is not in a position to comment on its effectiveness.

## **B. Examination**

Approximately 72% of the survey respondents indicated that the Trademark Office in their country *does* examine applications *ex officio* for relative grounds for refusal.<sup>4</sup>

Among those countries that *do* offer *ex officio* examination on relative grounds, there were mixed responses regarding whether or not the Trademark Office would take into consideration the fact that the applied-for mark had previously been successfully opposed or cancelled: 37% responded in the negative and 28% responded in the affirmative (ie, more jurisdictions would not take into account the previous opposition/cancellation than would). For example, the respondent in Indonesia stated that the Trademark Office would refuse the application *if* the prior opposition was discovered during the examination. In several countries the Examiner *might* consider the prior opposition but was not *required* to do so. In Panama, the Trademark Office would only consider the former opposition if the refusal was based on a non-registered famous mark. Therefore, being able to expeditiously draw the previous opposition decision to the attention of the examiner would help to address the issue.

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<sup>4</sup> The eighteen (18) jurisdictions identified as not having such an examination included OAPI, Benelux, Croatia, Czech Republic, Denmark, European Union, France, Germany, Hungary, Italy, Latvia, Macedonia, Romania, Slovakia, Slovenia, Spain, Switzerland and the United Kingdom.

In those countries where the Trademark Office would consider the prior opposition or cancellation, it does not appear that the Nuisance Repeat Filing would necessarily be refused as a result. In most countries, the evidence would be considered relevant, but would not necessarily be a cause for a mandatory refusal. In these instances the prior opposition or cancellation could be a possible ground for refusal depending on whether there were any changed circumstances prior to repeat filing (for example, the trademark on which the successful prior opposition was based has been cancelled or is vulnerable to a cancellation action based on non-use). This appears to be the case in Brazil, Canada, Costa Rica, Guatemala, Peru, the USA, Uruguay, Hong Kong, India, New Zealand, Philippines, South Korea, Greece, the Russian Federation, Sweden, and the Ukraine. This supports the resolution in that the Subcommittee does not seek to preclude all instances of repeat filings, but only Nuisance Repeat Filings as that term has been defined (no change in circumstance). However, the Subcommittee does seek a process to address the issue in an expedited manner and only in instances where there are no changed circumstances.

It was noted that in Germany, where applications are not reviewed *ex officio* on relative grounds, bad faith is considered an absolute ground for refusal. Therefore, in this regard, a repeat filing might nonetheless be a basis for a refusal in an *ex officio* examination.

Some countries allow a prior-rights owner to file a letter bringing the fact that the repeat filing was previously the subject of a successful opposition to the attention of the Trademark Office during the examination process (sometimes alternatively called a “Letter of Objection” or “Letter of Protest”). The USPTO expressly allows for the filing of a “Letter of Protest”. However, in several countries, the submission of such letters appears to be a matter of informal practice and not official procedure. Therefore, there are no assurances that such a letter will be formally considered during the examination process, even if one is submitted.<sup>5</sup>

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<sup>5</sup> The only exceptions noted in our survey responses were (1) in France, where it was suggested that the prior successful opposition result might be brought to the Trademark Office’s attention at the time of publication, (2) in Australia, where it was also noted that the prior-rights owner could contact the Examiner and bring the earlier opposition decision to the Examiner’s attention, and (3) in Japan, where it was noted that the prior-rights owner

As the Trademark Office cannot be assumed to have the time and resources to discover such proceedings on its own, a rule allowing the simple filing of a Letter of Objection (or Protest), which the Examiner will be required to consider, would be helpful and may avoid the need for a repeat opposition or cancellation proceeding. This would provide a less burdensome enforcement mechanism for a trademark owner to assert its rights.

Nonetheless, in recognition of the differing rules in various jurisdictions, the mere existence of an adverse decision in a prior proceeding should not necessarily be deemed dispositive of the viability of the new filing and automatically result in a refusal of the application. For the reasons set out above, a new application might in fact be appropriate in certain cases. Therefore, the evidence should be considered and its impact determined on a case-by-case basis, and not be deemed conclusive in all cases. If, however, upon examination, the application is proved to be for the same mark for the same or virtually the same goods or services and filed under unchanged circumstances as discussed above, the prior decision should be considered conclusive and the application rejected.

**C. Expedited Hearings/Summary Procedures in New Oppositions/Cancellations**

As a result of the possibility of justified repeat filings, and because the successful prior opposition or cancellation action will not necessarily result in a refusal of the repeat filing during the examination phase, in many countries it is necessary (at least in theory) for a prior-rights owner to initiate a new opposition or cancellation proceeding against the fresh application for the same mark. As noted above, from the countries surveyed, only the U.S. and Panama have a means for an expedited process upon publication, that is via a Summary Judgment motion to which the applicant can respond and have the opportunity to be heard. Such motion assists in speedy disposal (without the necessity of a full-fledged trial) where the pleadings and evidence demonstrate that there is no genuine need for trial. Most jurisdictions do not have such a summary procedure in place, generally, let alone to address Nuisance Repeat Filings.

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could raise the issue with the Examiner in the examination stage. It was also noted that in Argentina it might be possible to send a “warning notice” to the Trademark Office at the time of examination, presumably avoiding the need to oppose.

#### **D. Principles of Res Judicata**

Although the prior-rights owner would need to initiate a new opposition or cancellation proceeding to protect its rights if a refusal was not issued during examination, in some countries it appears a full opposition proceeding through to hearing would not be required. Fourteen percent (14%) of our survey respondents indicated that the principle of *res judicata* would apply and estop the applicant from re-litigating the matter when it had already been unsuccessful in the prior proceeding. For example, while formal opposition proceedings must be initiated in such circumstances in South Africa and Nicaragua, *res judicata* could be raised in the founding evidence at the time a Notice of Opposition is lodged. In Canada, an opponent may be able to simply file a copy of the decision previously rendered by the Board or court and obtain a refusal of the application; however, this would have to be done in the context of a full opposition proceeding involving the filing of evidence, written argument and a hearing. In Panama and the USA, there is an opportunity to request an expedited decision, such as via a Motion for Summary Judgment, based on the prior decision, so as to avoid fully re-litigating the matter.

Some countries do not recognize the principle of *res judicata* in administrative proceedings. This appears to be the case in the United Kingdom, in many Latin American countries, and in Hong Kong, where the doctrine of *res judicata* applies only in court proceedings and not in decisions rendered by an administrative body. While, the opponent can raise bad faith in the context of having to re-oppose a Nuisance Repeat Filing, it nevertheless must re-litigate the matter in the Trademark Office.

With respect to the consequences of a successful opposition or cancellation, survey results show that costs can be awarded to the prevailing party in about 15% of the countries, including Nigeria, South Africa, Australia, Hong Kong, Malaysia, New Zealand, Singapore, Bosnia & Herzegovina, the European Community, France, Spain and Israel. In some countries, the prior successful opposition can support the issuance against use of the mark by the applicant, or result in the applied-for mark being transferred to the successful opponent, thereby potentially mitigating the number of cases of Nuisance Repeat Filings.

In countries where the principle of *res judicata* (or similar rule) is available, the Subcommittee recommends that INTA encourage the adoption of a procedure that would allow for the bringing of the decision in the earlier matter to the attention of the adjudicatory board at a very early stage of the opposition, such as through a summary judgment motion, so that the prior-rights owner would not need to undergo the cost and burden of a full opposition proceeding again. Similarly, even in jurisdictions where *res judicata* is not recognized, it would be beneficial to have express provisions in place to allow for a summary adjudication process in the context of a Nuisance Repeat Filing.

### III. Proposals/Recommendations

The Subcommittee proposes a solution that it believes strikes a balance by protecting the trademark owner against Nuisance Repeat Filings, possibly made in bad faith, but also recognizes the need for a nuanced approach that does not place undue burden on good faith applicants who undertake a repeat filing on the basis of an actual, legitimate change in circumstance. To be clear, the Subcommittee does not recommend a *per se* prohibition on all repeat filings, as there could be a justification, such as a change in circumstance. The proposal is limited to the narrow circumstances defined as a Nuisance Repeat Filing. The Subcommittee recommends that jurisdictions adopt one or both of the following:

1. An official procedure allowing the prior-rights owner to file a Letter of Objection (or Protest) related to the alleged Nuisance Repeat Filing and requiring examiners to consider such letter during examination. This letter would bring the earlier opposition/cancellation decision to the Examiner's attention during the examination period, so that the opposition/cancellation decision concerning the same mark between the same parties may be given immediate consideration and possibly result in the refusal of the Nuisance Repeat Filing on that basis or, at least, an office action, before the need for opposition;
2. Some form of summary procedure in opposition proceedings involving Nuisance Repeat Filings to allow the matter to be brought to an expedited hearing (if needed and appropriate) and decision.

These procedures would not only protect the trademark owner from burden and costs of having to, once again undertake a full opposition against a Nuisance Repeat Filing, but would also save resources for Trademark Offices by allowing for these applications to be refused at an earlier stage. Having such procedures and laws in place may also help to deter Nuisance Repeat Filings altogether.

#### **IV. Subcommittee Members**

The Subcommittee members who contributed to this report include:

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