

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

March 9, 2015

### Action request

The Opposition and Cancellation Standards & Procedures Subcommittee of the Enforcement Committee requests that the Board of Directors approve the following Resolution setting out the International Trademark Association's position on the treatment of repeated filings of trademark applications after a successful opposition/cancellation against the same mark.

### Resolution

**WHEREAS**, opposition proceedings provide a prior-rights owner the invaluable opportunity to protect and defend its trademark rights against an entity or individual attempting to file a trademark application for a mark that is identical or confusingly similar to or otherwise infringes upon or dilutes its mark;

**WHEREAS**, cancellation proceedings can lead to a registered mark being expunged from the Register on any available grounds (e.g. likelihood of confusion, lack of distinctiveness, fraud) thus maintaining a clean and efficient trademark registry and further allowing trademark owners to protect their rights;

**WHEREAS**, applicants can, and sometimes do, file an application for the same mark for the same or virtually the same goods or services that was previously the subject of a successful opposition/cancellation proceeding based on prior rights made under circumstances that are unchanged from a previously decided opposition/cancellation between the same parties denying registration, where the passage of time, in and of itself, is not a sufficient change (hereafter "Nuisance Repeat Filing");

**WHEREAS**, this is an issue that has been faced by brand owners in several jurisdictions and requires that the entire opposition or cancellation process be repeated;

**WHEREAS**, for purposes of this resolution, "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/services. Furthermore, "a successful opposition/cancellation proceeding" is one that is not subject to a pending appeal or otherwise awaiting decision;

**WHEREAS**, prosecution of an opposition against such Nuisance Repeat Filing, wastes valuable time and resources and creates an unwarranted burden on both the prior-rights holder and the Trademark Office and adjudicatory bodies of the corresponding jurisdiction and, hence jurisdictions should implement mechanisms to ensure that Nuisance Repeat Filings are effectively deterred.

**BE IT RESOLVED**, that it is the position of the International Trademark Association 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 and requiring examiners to consider such letter during examination; and/or
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.

### **Background**

The Opposition and Cancellation Standards & Procedures Subcommittee of the Enforcement Committee has determined that, in the absence of an actual, legitimate change in circumstance, a repeated application filed for the same mark for the same or virtually the same goods or services already refused registration/expunged from the Register due to its adjudication in a previous opposition/cancellation proceeding based on prior rights imposes an undue burden on prior-rights owners and presents a resource-draining nuisance for both trademark owners with prior-rights and Trademark Offices. The Subcommittee thus believes there is a need to deter such specific forms of repeat filings.

The Subcommittee conducted extensive research over two terms 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.

Further, among the jurisdictions surveyed by the 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. A few jurisdictions do entitle right holders to file informal letters of protest/observation 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.

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.

The Subcommittee therefore proposes a solution that 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 of an amended mark or on the basis of an actual, legitimate change in circumstance. The recommendations would not only protect the prior-rights owner from the burden and cost 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 refusal of these applications at an earlier stage. Having such procedures and laws in place may also help to deter Nuisance Repeat Filings altogether.

The Opposition & Cancellation Standards and Procedures Subcommittee thus sets forth the recommendation 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 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 or applicable), and decision.