



Bad Faith Trademark Filing Across the Globe – Summary of Survey Responses

Prepared by the Bad Faith Task Force of the Enforcement Committee

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BAD FAITH TRADEMARK FILING ACROSS THE GLOBE – SUMMARY OF SURVEY RESPONSES

Bad faith trademark filings have increased dramatically within the last few years and are rapidly becoming a global problem for legitimate brand owners and trademark registries. Jurisdictions across the world are experiencing a rush of trademark applications that are filed either with no bona fide intent to use the mark in commerce or with the intention of purposefully copying another's trademark. This rise in bad faith filings threatens the effectiveness and strength of trademark protection worldwide as the increase of bad faith filings may clog up the registration process, hold unused and otherwise viable trademarks hostage, interfere with legitimate trade (particularly for small and medium-sized entities) and dramatically increase costs for trademark owners. In the face of this problem, there is a growing consensus that many jurisdictions do not have adequate legal protections to effectively address and deter bad faith filings.

This Summary provides a high-level overview of the results from INTA's Global Bad Faith Task Force Questionnaire of 2019 regarding the prevalence of bad faith filings around the world and the methods of dealing with such filings in each jurisdiction. The Questionnaire investigated the extent to which bad faith filings poses concerns in each jurisdiction and how each jurisdiction deals with bad faith at different stages of the trademark registration process. Responses were gathered from experienced trademark practitioners in 90 different jurisdictions and all data was accurate as of December 2019. Many jurisdictions had more than one respondent. In a few cases multiple respondents from the same jurisdiction gave conflicting answers. Such jurisdictions are marked with an asterisk (*). In a few cases, the survey response was not completely clear. Such jurisdictions are marked with a hash symbol (#). The jurisdictions surveyed and the respondents who graciously gave their time to complete the Questionnaire are listed in the Appendix. The results from the Task Force's research formed the basis of INTA's November 2020 [Board Resolution](#) on Bad Faith Trademark Applications and Registrations.

Regions Where Bad Faith Filing Is an Issue

- Question 1: *Bad faith filing is a known issue in EU, China, India, Indonesia, Korea, Turkey, US. Please identify any additional jurisdictions **including your own jurisdiction**, where the problem of bad faith filing is severe or otherwise worthy of closer attention and provide a brief explanation of the nature and scope of the problem in each jurisdiction.*

Respondents from the following jurisdictions indicated yes, bad faith filing is an issue in their jurisdiction that is either severe or worthy of attention:

Argentina (although not severe); Armenia; Australia; Austria (worthy of attention, but not a severe problem); Benelux; Bolivia; Brazil; Bulgaria; Cambodia; Canada; Chile; China; Colombia; Croatia; Cuba; Dominican Republic; Ecuador; Egypt; EUIPO; Germany; Greece; Guatemala; Honduras; Hong Kong; Hungary; India; Iran; Israel; Japan; Jordan; Kazakhstan; Kenya (but not a severe problem); Kuwait; Latvia; Lithuania; Mexico; Morocco; Myanmar¹; Namibia; New Zealand; Nigeria; Pakistan; Paraguay; Peru; Philippines; Portugal; Qatar; Russia; Saudi Arabia; Serbia; Singapore; South Africa; South Korea; Spain; Switzerland; Taiwan; Thailand; Tunisia; Turkey; Ukraine; United States; Uruguay; Venezuela (but not severe); Vietnam.

Respondents from the following jurisdictions indicated no, bad faith filing is not an issue:

Bahrain; Costa Rica; Czech Republic (not a major issue); Denmark; El Salvador; Estonia; Finland; Ghana; Iceland; Ireland; Italy; Lebanon; Malaysia; Nicaragua; Norway; Oman; Poland; Romania; Slovakia; Slovenia; Sweden; Sri Lanka; UAE; UK.

The survey revealed that bad faith filing is perceived as a severe or noteworthy problem in many jurisdictions across the globe. In 57² jurisdictions, at least one respondent indicated that bad faith trademark filing presented either a severe problem or an issue worthy of attention within their borders. Furthermore, of those that did not indicate bad faith filings were a major issue, some noted they were still somewhat common in the region.³ Respondents also listed an additional six jurisdictions they believed to have severe or worthy of closer attention bad faith filing issues.⁴

Bad Faith Within the Trademark Registration Process

- **Question 2a:** *Is there a requirement that an application be made with good faith – either with intention to use the mark or without intention to copy the marks of others or both?*

Respondents from the following jurisdictions indicated yes, their jurisdiction requires applications be made with good faith: Armenia; China; Finland; Ghana; Hong Kong; Indonesia; Ireland; Israel; Italy; Japan; Latvia; Lithuania; Malaysia; Mexico; Namibia; New Zealand; Nigeria;

¹ Information for Myanmar was correct at the time of the survey; however, the law has since changed but it was not possible to obtain details of the new laws due to the ongoing political situation.

² This includes Indonesia and China, the respondents for which did not directly affirm the issue because it was implied by the wording of the question.

³ Slovakia, Sri Lanka, and the UAE.

⁴ Yemen, Algeria, Syria, Malaysia, Benelux, and the EU. Although Malaysia and Benelux were among two of the jurisdictions surveyed, neither clearly listed themselves as a jurisdiction that had bad faith filings issues that were either severe or worthy of further attention.

Pakistan; Paraguay; Peru; Philippines; Poland; Romania; Singapore; Slovakia; South Africa; Tunisia; UK; United States.

Respondents from the following jurisdictions indicated no, their jurisdiction does not require applications be made with good faith: Argentina; Australia; Austria; Bahrain; Benelux; Bolivia; Brazil; Bulgaria; Cambodia; Canada; Chile; Colombia; Costa Rica; Croatia; Cuba; Czech Republic; Denmark; Dominican Republic; Ecuador; Egypt; El Salvador; Estonia; EUIPO; France; Germany; Greece; Guatemala; Honduras; Hungary; Iceland; India; Iran; Jordan; Kazakhstan; Kenya; Kuwait; Lebanon; Morocco; Myanmar⁵; Nicaragua; Norway; Oman; Portugal; Qatar; Russia; Saudi Arabia; Serbia; Slovenia; South Korea; Spain; Sweden; Switzerland; Sri Lanka; Taiwan Region; Thailand; Turkey; UAE; Ukraine; Uruguay; Venezuela; Vietnam.

Although respondents in most surveyed jurisdictions recognized bad faith in connection with trademark filing, only twenty-nine stated they explicitly required applications be made with good faith. However, in some jurisdictions that do not explicitly require good faith, respondents noted that other trademark provisions or legal requirements necessitate something similar.⁶ For example, Canada requires that the applicant state they are entitled to use the mark, and in Australia a lack of good faith intent to use the mark at the time of application subjects the registration to removal. Respondents in many of the jurisdictions that do not have such a requirement explained that good faith is presumed in the filing of trademark applications.⁷ Given such a presumption, bad faith is not usually examined at the application phase.

- Question 2b: *Is bad faith grounds for the trademark office to reject an application during the examination phase? If so, please explain the conditions imposed by the trademark office for such rejections.*

Respondents from the following jurisdictions indicated yes, bad faith constitutes grounds for application rejection during examination: Armenia; Bolivia (under unfair competition); Brazil (via pre-examination opposition); China; Costa Rica; Czech Republic; Denmark (but unlikely); Ecuador (but unlikely); Estonia (but unlikely); Finland; Germany (but unlikely - would have to be highly obvious); Ghana (but uncommon); Greece (but uncommon); Guatemala; Hong Kong (but uncommon); Iceland (but highly unlikely); India (but not practically speaking); Indonesia; Iran; Ireland (but rare); Japan (but uncommon); Latvia; Lithuania (but unlikely); Mexico; Namibia (but highly unlikely); New Zealand (in exceptional cases); Norway (but unlikely); Pakistan (but

⁵ See footnote 1 above.

⁶ Australia, Brazil, Canada, Costa Rica, Denmark, and Switzerland.

⁷ Bolivia, Chile, Ecuador, Guatemala, Hungary, Mexico, Peru, and Uruguay.

uncommon); Paraguay; Peru; Poland; Qatar; Romania; Slovakia (if obvious); South Korea; Sweden; Sri Lanka*; Taiwan (but uncommon); Ukraine (but conditional/limited).

Respondents from the following jurisdictions indicated no, bad faith does not constitute grounds for application rejection during examination: Argentina; Australia; Austria; Bahrain; Benelux; Bulgaria; Cambodia; Canada; Chile; Colombia; ; Croatia; Cuba; Dominican Republic; Egypt; El Salvador; EUIPO; France; Honduras; Hungary; Israel; Italy; Jordan; Kazakhstan; Kenya; Kuwait; Lebanon; Malaysia; Morocco; Myanmar⁸; Nicaragua; Nigeria; Oman; Philippines; Portugal; Russia; Saudi Arabia; Serbia; Singapore; Slovenia; South Africa; Spain; Switzerland; Thailand; Tunisia; Turkey; UAE; UK; United States; Uruguay; Venezuela; Vietnam.

Consequently, bad faith does not constitute grounds for the trademark office to reject an application in the majority of jurisdictions surveyed. Despite explicit or implicit good faith requirements, respondents from many jurisdictions explained that their trademark examiners do not investigate applications for signs of bad faith during examination. Some respondents explained that because their system presumes good faith, the onus is often on third parties to file observations or otherwise show indications of bad faith. Furthermore, as many jurisdictions do not require proof of good faith upon registration, determining which applications are invalid on the basis of bad faith is difficult given the limited information available at the time of examination. This lack of evidence creates an issue for jurisdictions that do allow rejection based on bad faith as well.

Of the jurisdictions surveyed, respondents from only thirty-five jurisdictions clearly indicated that their jurisdiction allows for rejection of a trademark application at the examination phase on the basis of bad faith. Some, like Armenia and Sweden, have specific provisions allowing trademark applications to be rejected during examination for a finding of bad faith, while others have more complex procedures. For instance, in Costa Rica and Romania, if the Trademark Office receives notification from a third-party that the applicant filed in bad faith, the Office will closely examine the application for such a deficiency.⁹ Greece and Hong Kong employ factor-based tests to determine bad faith during the examination phase. In Greece, bad faith is an absolute ground for refusal and the intention of the applicant when registering is considered. To determine whether an application was made in good faith in Greece, several factors are considered including: (1) whether the applicant knows or should know that a third party is using the same or similar mark for the same or similar services, (2) the applicant's intention to prevent another from using a mark, (3) the origin and use of the mark, (4) the commercial logic underlying the application, and (5) the chronology of the events leading up to the filing. Hong

⁸ See footnote 1 above.

⁹ However, as refusals are not published by the Romanian Trademark Office, the survey respondent could not say how many such examinations take place let alone actually lead to a rejection.

Kong considers similar factors when determining if an application was filed in bad faith, such as whether the mark is well known, whether the applicant filed a number of applications for various trademarks of which one or more was well known, and whether the mark incorporates the name or image of a well-known person without their consent. If such considerations lead to a reasonable suspicion as to the applicant's entitlement to the mark, a rejection is issued.

Despite these various systems of detecting bad faith at the examination phase, counsel in approximately half of the jurisdictions that allow for such a rejection admitted such action is relatively uncommon.¹⁰ The issues involved in determining an applicant's intent make rejections on a bad faith basis difficult early in the examination phase. Even with a detailed factor test like that employed by Greece, respondents noted that rejections were rarely issued as it is often difficult in practice for an examiner to determine substantive bad faith from the information available to the examiner. Furthermore, respondents from New Zealand, Iceland, Pakistan, and South Africa all noted that although bad faith rejections were technically available, such rejections were not commonly employed by their jurisdiction's trademark office. Respondents from jurisdictions like Germany and Slovakia, where a high degree of obviousness is required to find bad faith during examination, also reported that rejections grounded in bad faith were not frequent. Given the low availability of bad faith as a basis for rejecting an application at the examination phase, as well as the difficulty of issuing such a rejection even if available, many bad faith applications make it past the examination process.

- Question 2c: *Is bad faith grounds to oppose an application? If so, please explain the elements of a successful opposition and identify whether the authority for such a claim is trademark office rules, statutes, or case law.*

Respondents from the following jurisdictions indicated yes, bad faith is grounds to oppose an application: Argentina; Armenia; Australia; Bahrain; Brazil; Bulgaria; Canada; Chile; China; Costa Rica; Czech Republic; Denmark; Dominican Republic; Ecuador; Estonia; Finland; Ghana; Greece; Guatemala; Honduras; Hong Kong; Iceland; India; Indonesia; Iran; Israel; Japan; Jordan; Kenya; Kuwait; Latvia; Mexico; Namibia; New Zealand; Nigeria; Norway; Pakistan; Paraguay; Peru; Philippines; Poland;; Qatar; Romania; Singapore; Slovakia; Slovenia; South Africa; South Korea; Sweden; Sri Lanka; Taiwan; Tunisia; Turkey; UK; Ukraine (but conditional/limited); United States; Uruguay (with additional factors, e.g., notoriety or knowledge).

Respondents from the following jurisdictions indicated no, bad faith is not an independent ground to oppose an application: Austria; Benelux; Cambodia; Colombia; Croatia; Cuba; Egypt;

¹⁰ Ecuador, Estonia, Germany, Ghana, Greece, Hong Kong, Iceland, Ireland, Japan, Namibia, New Zealand, Norway, Pakistan, Slovakia, South Africa, and Taiwan.

El Salvador; EUIPO; France; Germany; Hungary; Ireland; Italy; Kazakhstan; Lebanon; Lithuania; Malaysia; Morocco; Myanmar¹¹; Nicaragua; Oman; Portugal; Russia; Saudi Arabia; Serbia; Spain; Switzerland; Thailand; UAE; Venezuela; Vietnam.

Respondents indicated that a majority of the surveyed jurisdictions allow for oppositions based on bad faith, and unlike rejections at the examination phase, it appears that oppositions are in fact frequently employed to weed out bad faith filings across the world. Usually, the opponent bears the burden of proving that the applicant acted in bad faith. The proof necessary to demonstrate bad faith varies from jurisdiction to jurisdiction and depends on whether an individual nation recognizes lack of intent to use or intention to copy as bad faith.

Generally, a showing of bad faith requires some sort of proof that the opponent used the mark at issue prior to the applicant's use or application and that the applicant knew or should have known of the opponent's rights or acted with malice or deceit. For example, in Australia, to oppose the registration of a mark on the basis of bad faith, an opponent must demonstrate purposeful dishonesty or a deliberate intent to deceive or mislead the Register by the applicant. The standard is that of a reasonable person and focuses on whether a reasonable person in the applicant's position would know or should have known that they ought not to apply for the mark. Similarly, Singapore focuses on the behavior of the applicant and requires that the opponent show that the applicant's conduct did not meet the standard of commercial behavior, in that the applicant did not actually intend to use the mark for the goods and services registered or that the applicant knew of the opponent's conflicting mark at the time of filing. The common standard of proof thus requires both an objective and subjective element regarding the applicant's intent and knowledge of a prior conflicting mark to demonstrate bad faith in an opposition proceeding.

Notably, in a number of jurisdictions that do not allow for opposition on bad faith grounds *per se*, respondents noted that bad faith was a factor or an aggravating circumstance to be considered in oppositions on other grounds. Cuba, El Salvador and Nicaragua take an applicant's alleged bad faith into consideration in opposition proceedings based on other grounds such as unfair competition. Although Cuba does not acknowledge bad faith as a standalone basis to oppose a registration, it does recognize bad faith as a main factor when considering whether a trademark was filed to perpetrate, facilitate or strengthen an act of unfair competition, which is grounds for refusal. Likewise, in Nicaragua bad faith is considered an aggravating circumstance in opposition proceedings as bad faith helps distinguish between applicants who unknowingly filed marks similar to another's from applicants who had knowledge or intent to copy or cause harm.

¹¹ See footnote 1 above.

- Question 2d: *Is bad faith a basis for eliminating a registration, i.e., via cancellation, invalidation, expungement, or another form of removal? If so, are the conditions for successful action the same as those for oppositions? If not, please explain the elements of a successful claim and identify whether the authority for such a claim is trademark office rules, statutes, or case law.*

Respondents from the following jurisdictions indicated yes, bad faith is a basis for eliminating a registration: Argentina; Armenia; Australia; Austria; Bahrain; Benelux; Bolivia; Brazil; Bulgaria; Canada; Chile; China; Colombia; Costa Rica; Croatia; Cuba (must be accompanied by likelihood of confusion); Czech Republic; Denmark (if in conflict with an older mark); Dominican Republic; Ecuador; El Salvador; Estonia; EUIPO; Finland; Germany; Ghana (not expressly but in practice); Greece; Guatemala; Honduras; Hong Kong; Hungary; Iceland; India; Indonesia; Iran; Ireland; Israel; Italy; Japan; Jordan; Kenya; Kuwait; Latvia; Lebanon (cannot be sole grounds); Lithuania; Malaysia; Mexico; Morocco; Myanmar¹² (via petition to the court only); Namibia; New Zealand; Nigeria (only by brand owner); Norway; Oman; Pakistan; Paraguay; Peru; Philippines; Poland; Portugal; Qatar; Romania; Singapore; Slovakia; Slovenia; South Africa; South Korea; Spain; Sweden; Switzerland; Sri Lanka; Taiwan (five year statute of limitations); Tunisia (claimant must have prior right); Turkey; UAE; UK; Ukraine; United States; Uruguay; Vietnam.

Respondents from the following jurisdictions indicated no, bad faith is not a basis for eliminating a registration: Cambodia; Egypt; France (but is a factor that supports fraud claim); Kazakhstan; Nicaragua (but is an aggravating circumstance); Russia; Saudi Arabia; Serbia; Thailand; Venezuela.

The vast majority of respondents indicated bad faith is a basis for eliminating a registration in their jurisdiction. For most, the opponent's burden of proof for eliminating a registration is similar, if not identical, to the requirements for successfully opposing a registration. However, respondents in a number of jurisdictions stated that cancellation proceedings may either be more formal, or more difficult, as they often proceed before a court.¹³ Additional restrictions may also apply to cancellation proceedings such as proof of ownership of the mark by the opponent, proof of likelihood of confusion,¹⁴ or time restrictions.¹⁵ Also, many jurisdictions impose a five year statute of limitations for cancellation claims which can create an additional hurdle in cancellation proceedings. However, in some jurisdictions this limitation does not apply when the

¹² See footnote 1 above.

¹³ Ukraine, Italy, Morocco, Slovenia, Spain, Switzerland.

¹⁴ Lebanon and Cuba.

¹⁵ See, e.g., Colombia, Mexico, Peru, and Taiwan.

contested mark was filed in bad faith or by fraud¹⁶, giving a potential opponent a longer grace period.

Of the handful of jurisdictions that do not allow for cancellation or expungement of a registration on the basis of bad faith, many consider bad faith, or something similar, as a factor in cancellation proceedings. France and Saudi Arabia allow for cancellation of a mark if the application was fraudulent, and Canada considers unsubstantiated use claims or false declarations as flaws that can result in expungement. Similarly, Russia allows for cancellations of trademarks that abuse the rights of others or create unfair competition. Other jurisdictions, such as the Dominican Republic and Nicaragua, consider bad faith important in elimination proceedings but require additional grounds beyond mere bad faith.

Definition of Bad Faith

- *Question 3: Please provide brief summaries of key cases in your jurisdiction that define bad faith and/or the absence of bad faith, or discuss the factual bases for a finding of bad faith or the absence of bad faith, including issues such as the burden of proof.*

Trademark filings are generally presumed to be executed in good faith and create rights of exclusivity for the owner. When a filing is used to deprive competitors of the benefits of their existing mark and cause confusion amongst consumers, the motives behind trademark law are undermined. The seriousness of these bad faith filings was summarized by an Indian court which stated that, “[i]n law, the term ‘bad faith’ does not simply mean bad judgement, but it implies the conscious doing of a wrong with a dishonest purpose. It contemplates a dishonest state of mind.”¹⁷ To determine whether the intent behind a filing was in bad faith, jurisdictions look to their respective courts and trademark offices to evaluate objective and subjective evidence to protect the integrity of trademark filing.

Across the European Union, courts review the facts on a case-by-case basis but pay particular attention to (1) the owner’s knowledge of identical or similar marks; (2) the owner’s intent to either use the mark or block third parties from using the mark; (3) the relative reputation of the mark; and (4) the type of mark. These factors are similar to those enumerated by the courts in China that have indicated the relevance of any commercial relationship between the parties, the geographical scope of the goods or services, the degree of originality of the mark, and whether or not the owner hoards a large number of marks without the intent to use them in commerce.

¹⁶ See, e.g., Dominican Republic, El Salvador, France, and Morocco.

¹⁷ Manish Vij & Ors. v. Indra Chugh & Ors (Delhi High Court).

Although there is no uniform standard across Africa as there is in Europe, Nigerian courts have also adopted a similar standard of review that encompasses many of these listed factors. The courts have generally indicated proof of identical or similar marks is not sufficient in itself to support a finding of bad faith, but accounting for these types of factors in each case enables them to subjectively determine the intent of the filing party.

Impediments to Successful Bad Faith Claims

- *Question 7: Are there any difficulties in your jurisdiction that impede findings of bad faith in relation to filings (for example: does your office require notarization of evidence; is it difficult to obtain a finding of bad faith in relation to filings for goods/services that are unrelated to the goods/services identified by the “victim’s” mark)?*

Respondents from the following jurisdictions indicated yes, there are difficulties (formalities such as notarizations or translations, as well as substantive issues such as evidentiary requirements) impeding findings of bad faith in their jurisdiction: Argentina; Australia; Austria; Benelux; Brazil; Bulgaria; Cambodia; China; Costa Rica; Croatia; Ecuador; El Salvador; Germany; Ghana; Guatemala; Honduras; India; Iran; Ireland; Israel; Jordan; Kenya; Latvia; Lithuania; Mexico; Nigeria; Oman; Pakistan; Paraguay; Peru; Philippines; Portugal; Romania; Russia; Saudi Arabia; Slovakia; Sri Lanka; Thailand; Turkey; UAE; Ukraine; Uruguay; Venezuela; Vietnam.

Respondents from the following jurisdictions indicated no, there are no difficulties impeding findings of bad faith in their jurisdiction: Armenia; Bahrain; Bolivia#; Canada; Chile; Colombia; Cuba; Czech Republic; Denmark#; Dominican Republic; Egypt; Estonia; EUIPO; Finland; France; Greece; Hong Kong; Hungary; Iceland; Indonesia; Italy; Japan; Lebanon; Kenya; Kuwait#; Malaysia; Morocco; Myanmar¹⁸; Namibia; New Zealand; Nicaragua; Norway; Poland; Portugal; Serbia; Singapore; Slovenia; South Africa; South Korea; Spain.

More than 50% of respondents reported that there are various difficulties associated with bad faith filings in their jurisdictions that may discourage a claimant from proceeding with a claim of bad faith. In some of these jurisdictions, it may be difficult to proceed with a claim due to challenges in collecting sufficient documentation of bad faith, particularly when the claim dates back multiple years. In many jurisdictions with such issues, documents must be originals or must be notarized, and may need to undergo other processes such as translation into the jurisdiction’s official language before they can be filed as evidence supporting a claim of bad faith. Note that while some respondents identified these issues as difficulties that impede

¹⁸ See footnote 1 above.

findings of bad faith, others saw them as part of the normal legal process instead of as specific challenges in their jurisdictions. For example, many respondents indicated that the notarization requirement is standard for their courts, and that additional requirements for evidence that originates abroad are typical.

Additionally, trademark offices or other governing entities may create more steps in the process to establish bad faith. In Russia, for example, a decision on a bad-faith cancellation action is ultimately made by a court or by an antimonopoly governing body – with the latter requiring that the applicant operate in a competing field to support a bad-faith claim. In Turkey, the trademark office will request proof that the claimant's mark has been used in Turkey. China has a very narrow interpretation of bad faith and filing a successful claim there requires a significant amount of evidence to support consumer confusion and show that the existing mark has a high reputation or is well known. In contrast to China, Vietnam does not have any regulations that define bad faith, but it also lacks regulations that mention bad faith as a ground for rejection, opposition, or invalidation.

For other respondents, the difficulty in succeeding on a bad faith claim does not arise from explicit procedural or other requirements but rather is a function of the subjective nature of a claim of bad faith. To overcome the presumption of good faith, claimants must provide certain objective evidence, such as proof of an existing business relationship between the parties or a very high degree of similarity between the parties' marks. It is difficult to prove a negative, such as a lack of intent to use a mark, and inferences alone typically cannot be used to invalidate an existing registration. Some jurisdictions have addressed these challenges. Mexico, for example, enacted amendments to grant more flexibility to authorities to conclude that a mark is filed in bad faith.

Other Measures to Deter Bad Faith Filings

- Question 11: *Are non-use cancellations an effective tool for deterring or eliminating bad faith filings in your jurisdiction, if so in what way do they have a positive effect?*

Respondents from the following jurisdictions indicated yes, non-use cancellations are an effective deterrent¹⁹ in their jurisdiction: Armenia; Australia; Cambodia; Canada; Dominican Republic; Egypt; Estonia; Finland; Ghana; Greece; India; Iran; Ireland; Israel; Kazakhstan;

¹⁹ Note that respondents here assessed the non-use cancellation provisions in their jurisdiction as being a deterrent to bad faith applications, ie preventative; cf. the next section where the provisions are a useful tool for removal of bad faith registrations.

Malaysia; Mexico; Morocco; Namibia; Nicaragua; Nigeria; Pakistan; Poland; Portugal; Qatar; Slovenia; Tunisia; Vietnam.

Respondents from the following jurisdictions indicated non-use cancellations either are an effective tool or could be in some situations:²⁰ Argentina; Bahrain; China; Colombia; Costa Rica; Croatia; Cuba; Czech Republic; France; Guatemala; Honduras; Indonesia; Kenya; Lithuania; New Zealand; Norway; Oman; Peru; Romania; Russia; Saudi Arabia; Serbia; Singapore; Slovakia; South Africa; South Korea; Spain; Switzerland; Taiwan; Turkey; UAE; UK; Ukraine; Uruguay.

Respondents from the following jurisdictions indicated no, non-use cancellations are not an effective deterrent in their jurisdiction or that there was no evidence to support this: Austria; Brazil; Bolivia; Bulgaria; Chile;²¹ Denmark; Ecuador; El Salvador; EUIPO; Germany; Hungary; Iceland; Japan; Jordan; Kuwait; Latvia#; Lebanon; Paraguay; Philippines; Sri Lanka; Thailand; United States; Venezuela.

Most jurisdictions have processes to nullify existing trademarks that have not been used at all for a period of years, regardless of whether bad faith can be shown. Although primarily intended to provide a means of purging the Register of unused marks, by definition, marks filed in bad faith are unlikely to have been put to genuine use and so this is a further process that is available to remove bad faith registrations from the Register. This process can be useful under certain circumstances because it reverses the burden of proof from the claimant to the trademark owner, who must demonstrate use. In jurisdictions like Australia, this switch can be an efficient way to achieve fairly prompt cancellation of the mark. While approximately 80% of respondents affirmed that non-use cancellations are or could be an effective tool for deterring or eliminating bad faith, many of these respondents recognized that the procedural time frame requirements, or grace periods, involved with such claims limited the number of situations in which such actions could be useful.

²⁰ Many jurisdictions have five-year requirements before a non-use cancellation can be filed. Some jurisdictions have a three-year requirement. Respondents in many of those with a five-year requirement see this time period as an impediment to a process that could be effective if actions could be brought earlier. Respondents generally view the three-year requirement as positive and responded that non-use cancellations are an effective tool for deterring or eliminating bad faith filings. *See, e.g., UK Response, Question 11 (“UK and EU: The problem with non-use revocations is that they can only be brought after five years and, in the meantime, such marks can be on the register and enforced. This may be sufficient time to deter competitors from using marks that they should be entitled to use.”)*.

²¹ Non-use cancellations are not available in Chile.

Most jurisdictions provide either a three-year²² or a five-year²³ grace period during which the trademark owner is not required to prove that it is using a mark to retain its registration.²⁴ To rebut an allegation of non-use after the respective grace period has ended, the trademark owner often need only demonstrate one commercial sale involving the mark. As a respondent from Russia noted, in the age of online retail, that usually will not be a difficult hurdle to clear. The result of such standards in non-use cancellation proceedings means that the process may only be effective when a mark is filed by a squatter “warehousing” multiple marks without a substantial commercial purpose for them.

However, respondents recognized that certain benefits of non-use cancellations were so significant that they should still be considered when seeking to nullify an existing registration. In Hong Kong, for example, bad faith claims typically take at least two years, while non-use cancellation proceedings can be decided in 10-12 months. A non-use cancellation is also particularly beneficial in South Korea, where a successful claim means the losing party is prohibited from registering a mark for similar goods and services for the next three years. In Russia, non-use disputes are usually settled without proceeding to trial, and the losing party must pay the prevailing party’s pre-judicial expenditures, including attorneys’ fees. Some jurisdictions are only beginning to incorporate non-use cancellations into their trademark laws. In Switzerland, for example, the provision has only been available for two years. In some jurisdictions, for example Jordan, only an aggrieved party has standing to file for non-use cancellation. By contrast, others like Lithuania are already taking steps to allow any party to file.

²² Canada, Colombia, Israel, Japan, Kazakhstan, Mexico, Namibia, New Zealand, Peru, South Korea, United States.

²³ Australia, Austria, Brazil, Costa Rica, Croatia, Czech Republic, Dominican Republic, Estonia, the European Union, Ghana, Latvia, Nigeria, Oman, Serbia, Singapore, Slovakia, Sri Lanka, South Africa, UAE, Vietnam

²⁴ Jurisdictions listed are those which directly indicated their grace period in the survey; this list is not meant to be comprehensive.

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Norway	Thomas Gaard-Olsen
Oman	Zeina Salameh
Pakistan	Sana Shaikh
Paraguay	Leticia de Fernandez, Virginia Cervieri
Peru	Juan Carlos Durand Grahammer
Philippines	Andre Philippe G. Betita/Candice Kwok, Bienvenido Marquez
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Russia	Olesya Zakharova, Alexander Baranchikov
Saudi Arabia	Theuns van de Merwe, Zeina Salameh
Serbia	Milan Milojevic
Singapore	Prithipal Singh / Aditi Pranav Desai, Winnie Tham, Candice Kwok
Slovakia	Taras Kulbaba
Slovenia	Taras Kulbaba
South Africa	Blain de Villiers, Lindy Lowne-Hughes
South Korea	Ann Nam-Yeon Kwon
Spain	Xavi Lamiquiz, Ernesto Cebollero
Sweden	Charlotte Norklit
Switzerland	Stefano Codoni, Roger Staub
Sri Lanka	John Wilson, Ms. Anomi I Wanigasekera / Ms. Navindi Naotunna; Raja Selvam, Pranavan Neelakandan
Taiwan	Ruey-sen Tsai
Thailand	Fabrice Mattei, Jump (Nuttachai) Unaratana, Sukontip Jitmongkolthong
Tunisia	Firas Qumsieh, Chris Walters
Turkey	Uğur Aktekin, Gizem Akguloglu
UAE	Raka Roy
UK	David Stone
Ukraine	Iliia Shliakhovetskij, Taras Kulbaba, Olga Belyakova,

United States	Jason Vogel, Ted Davis, Kurt E. Anderson, Thomas Brooke
Uruguay	Martin Pittaluga Pereira,, Tatiana Carrillo, Virginia Cervieri
Venezuela	Laura Rada, Diane Phoebus, Luiz Henriquez
Vietnam	Linh Thi Mai Nguyen, Manh Hung Tran, Dzung Pham