
CP13 - Questionnaire for User Associations - Trade mark applications made in bad faith

Date submitted

06-18-2021 21:41:35

A. Basic information

Please indicate the User Association that you represent:

CITMA

Please indicate your name, job title and email address (in case clarification is needed regarding any of your answers):

Eleanor Merrett

Partner

Eleanor.Merrett@cms-cmno.com

B. General notion of bad faith

1. Would your User Association agree with the wording proposed below for the common understanding of the 'general notion of bad faith in trade mark applications'?

The general notion of bad faith in trade mark applications cannot be confined to a limited category of specific circumstances. This notion presupposes the presence of a subjective motivation on the part of the trade mark applicant/proprietor, namely a dishonest state of mind or intention or other sinister motive, that will normally be established by reference to the relevant, consistent and objective criteria. It involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices, which can be identified by assessing the objective facts of each case against such standards.

(opinion of Advocate General Sharpston in C-529/07, Chocoladefabriken Lindt & Sprüngli, § 60; 12/09/2019, C-104/18 P, STYLO & KOTON, § 45-46; 29/01/2020, C-371/18, SKY, § 74-75; 07/07/2016, T-82/14, LUCEO, § 28; 14/05/2019, T-795/17, Neymar, § 23)

Yes. [A1]

1. Would your User Association agree with the wording proposed below for the common understanding of the 'general notion of bad faith in trade mark applications'?

The general notion of bad faith in trade mark applications cannot be confined to a limited category of specific circumstances. This notion presupposes the presence of a subjective motivation on the part of the trade mark applicant/proprietor, namely a dishonest state of mind or intention or other sinister motive, that will normally be established by reference to the relevant, consistent and objective criteria. It involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices, which can be identified by assessing the objective facts of each case against such standards.

(opinion of Advocate General Sharpston in C-529/07, Chocoladefabriken Lindt & Sprüngli, § 60; 12/09/2019, C-104/18 P, STYLO & KOTON, § 45-46; 29/01/2020, C-371/18, SKY, § 74-75; 07/07/2016, T-82/14, LUCEO, § 28; 14/05/2019, T-795/17, Neymar, § 23)

[Comment]

C. Other concepts, including terminology, related to the assessment of bad faith

2. Would your User Association agree with the wording proposed below for the common understanding of 'dishonest intention'?

A dishonest intention on the part of the trade mark applicant/proprietor will exist where it is apparent from the relevant, consistent and objective circumstances of the particular case that the application for registration of the mark was made:

- With the intention of undermining, in a manner inconsistent with honest practices, the interests of third party/ies, and not with the intention of engaging fairly in competition; or*
- With the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin.*

(11/06/2009, C-529/07, Chocoladefabriken Lindt & Sprüngli, § 42; 12/09/2019, C-104/18 P, STYLO & KOTON, § 46-47; 29/01/2020, C-371/18, SKY, § 75)

Yes. [A1]

2. Would your User Association agree with the wording proposed below for the common understanding of 'dishonest intention'?

A dishonest intention on the part of the trade mark applicant/proprietor will exist where it is apparent from the relevant, consistent and objective circumstances of the particular case that the application for registration of the mark was made:

- With the intention of undermining, in a manner inconsistent with honest practices, the interests of third party/ies, and not with the intention of engaging fairly in competition; or*
- With the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin.*

(11/06/2009, C-529/07, Chocoladefabriken Lindt & Sprüngli, § 42; 12/09/2019, C-104/18 P, STYLO & KOTON, § 46-47; 29/01/2020, C-371/18, SKY, § 75)

[Comment]

3. Which terminology would your User Association prefer to use when referring to a 're-filing case'?

Re-filing [A1]

3. Which terminology would your User Association prefer to use when referring to a 're-filing case'? [Other]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Same applicants]

Yes [Y]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Applicants belonging to the same company group]

Yes [Y]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Different applicants]

Yes [Y]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Equivalent representation of the marks]

Yes [Y]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Similar representation of the marks]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Different representation of the marks]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Same goods and/or services]

Yes [Y]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Similar goods and/or services]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Closely related goods and/or services]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Different goods and/or services]

4. Which elements should IPOs take into account to identify that they are dealing with a possible case of re-filing? [Other]

4.1. Please specify your reasons and provide in Question 4.2 the relevant EU or national case-law, if any.

CITMA's Working Group approached Q4 on the assumption that an IPO would only be dealing with a bad faith claim in the context of inter partes proceedings. If bad faith is being considered ex officio, then CITMA would suggest a more restricted approach (i.e. triple identity with an earlier registration).

The Working Group's opinion was that a fairly narrow view of marks and goods/services is appropriate. However, it is necessary to consider the full range of applicants, so as to capture bad faith situations where different group companies are used, or an individual director of a company files in their personal name and then a company name. In those situations, the dishonest intention required for a finding of bad faith might still be present even where the applicant is a different legal entity.

4.2. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 4.2. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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5. How should IPOs assess whether the representation of a new trade mark application is 'equivalent' to the representation of an earlier trade mark?

Option 1: When assessing a re-filing case, a sign will be considered identical to the earlier trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer (13/12/2012, T-136/11, Pelikan, § 30; 20/03/2003, C-291/00, LTJ Diffusion, § 54; 19/01/2012, T-103/11, justing, § 16) [A1]

5. How should IPOs assess whether the representation of a new trade mark application is 'equivalent' to the representation of an earlier trade mark? [Other]

5.1. Please specify your reasons and provide in Question 5.2 the relevant EU or national case-law, if any.

This is the criteria used for assessing the validity of priority claims.

5.2. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 5.2. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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6. Would your User Association consider the following situation as a case of a 're-filing made in bad faith'?

Filing which is carried out in order to avoid the consequences entailed by non-use of earlier mark/s.

(21/04/2021, T-663/19, Monopoly, § 57; 13/12/2012, T-136/11, Pelikan, § 27)

Yes. [A1]

6. Would your User Association consider the following situation as a case of a 're-filing made in bad faith'?

Filing which is carried out in order to avoid the consequences entailed by non-use of earlier mark/s.

(21/04/2021, T-663/19, Monopoly, § 57; 13/12/2012, T-136/11, Pelikan, § 27)

[Comment]

7. Would your User Association agree with the wording proposed below for the common understanding of 'free-riding'?

Free-riding relates to the attempt to ride on the success (reputation) of the earlier mark, that is, to take an unfair advantage of its good reputation making unlawful use of the sign. Free-riding may also cover cases where the objective is to take advantage of the fame or reputation of a particular person (e.g. name of the cancellation applicant).

(08/05/2014, T-327/12, SIMCA, § 56, 60 and 68; 14/05/2019, T-795/17, Neymar, § 51)

Yes, we agree with the proposed wording overall. However, we would like to suggest a modification to the wording. Please specify your reasons and indicate a modified proposal in the comment box, and upload in Question 7.1 the relevant legislation and/or EU or national case-law on which your User Association is basing your answer. [A2]

7. Would your User Association agree with the wording proposed below for the common understanding of 'free-riding'?

Free-riding relates to the attempt to ride on the success (reputation) of the earlier mark, that is, to take an unfair advantage of its good reputation making unlawful use of the sign. Free-riding may also cover cases where the objective is to take advantage of the fame or reputation of a particular person (e.g. name of the cancellation applicant).

(08/05/2014, T-327/12, SIMCA, § 56, 60 and 68; 14/05/2019, T-795/17, Neymar, § 51)
[Comment]

Free-riding relates to the attempt to ride on the success (reputation) of the earlier mark, that is, to take an unfair advantage of its reputation making unlawful use of the sign. Free-riding may also cover cases where the objective is to take unfair advantage of the fame or reputation of a particular person (e.g. name of the cancellation applicant).

There was some discussion on the CITMA Working Group as to the relevance of free-riding and this terminology. It seems to relate to a Neymar type situation, but conjures up 8(5) provisions too.

7.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 7.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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8. Would your User Association agree with the wording proposed below for the common understanding of 'defensive registrations' (also referred to as 'strategic registrations')?

Trade mark registrations which are not intended to be used (in relation to all or part of the goods and/or services) in trade on account of their purely defensive function. Their sole purpose is to strengthen the scope of protection of the applicant/proprietor's actually used mark or to prevent other traders registering or using identical/similar signs in the future (in relation to all or part of the goods or services), but otherwise have no legitimate trade mark function.

(26/02/2006, T-194/03, Bainbridge, § 46; 22/07/2019, R 1849/2017-2, MONOPOLY, § 50; Opinion of Advocate General Ruíz-Jarabo Colomer in C-40/01, Ajax/Ansul, § 42; 28/10/2020, T-273/19, Target Ventures, § 35-44)

Yes, we agree with the proposed wording overall. However, we would like to suggest a modification to the wording. Please specify your reasons and indicate a modified proposal in the comment box, and upload in Question 8.1 the relevant legislation and/or EU or national case-law on which your User Association is basing your answer. [A2]

8. Would your User Association agree with the wording proposed below for the common understanding of 'defensive registrations' (also referred to as 'strategic registrations')?

Trade mark registrations which are not intended to be used (in relation to all or part of the goods and/or services) in trade on account of their purely defensive function. Their sole purpose is to strengthen the scope of protection of the applicant/proprietor's actually used mark or to prevent other traders registering or using identical/similar signs in the future (in relation to all or part of the goods or services), but otherwise have no legitimate trade mark function.

(26/02/2006, T-194/03, Bainbridge, § 46; 22/07/2019, R 1849/2017-2, MONOPOLY, § 50; Opinion of Advocate General Ruiz-Jarabo Colomer in C-40/01, Ajax/Ansul, § 42; 28/10/2020, T-273/19, Target Ventures, § 35-44)

[Comment]

Trade mark registrations where there is no bona fide intention to use them (in relation to some or all or some of the goods and/or services) in trade on account of their purely defensive function. Their sole purpose is to strengthen the scope of protection of the applicant/proprietor's mark or to prevent other traders from registering or using identical/similar signs in the future (in relation to all or some of the goods and/or services), but otherwise have no legitimate trade mark function.

A mark may be unused but still be well-known in the EU and a reason for filing defensively. The Working Group considered the example of Whatsapp, which is widely known as ZapZap in some countries, though this is a nickname. Would filing this mark be in bad faith?

Additional case law - Skykick / Banksy "Flower Thrower" case - Cancellation No. 33843 C

8.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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9. Would your User Association agree with the wording proposed below for the common understanding of 'abuse of law'?

The cases of 'abuse of law' are characterised by circumstances in which, first, despite formal observance of the conditions laid down by trade mark rules, the purpose of those rules has not been achieved, and that, secondly, there is a subjective element consisting in the intention to obtain an advantage from those rules by creating artificially the conditions laid down for obtaining it.

(07/07/2016, T-82/14, LUCEO, § 52; 21/04/2021, T-663/19, Monopoly, § 72; 21/07/2005, C?515/03, Eichsfelder Schlachtbetrieb, § 39)

Yes, we agree with the proposed wording overall. However, we would like to suggest a modification to the wording. Please specify your reasons and indicate a modified proposal in the comment box, and upload in Question 9.1 the relevant legislation and/or EU or national case-law on which your User Association is basing your answer. [A2]

9. Would your User Association agree with the wording proposed below for the common understanding of 'abuse of law'?

The cases of 'abuse of law' are characterised by circumstances in which, first, despite formal observance of the conditions laid down by trade mark rules, the purpose of those rules has not been achieved, and that, secondly, there is a subjective element consisting in the intention to obtain an advantage from those rules by creating artificially the conditions laid down for obtaining it.

(07/07/2016, T-82/14, LUCEO, § 52; 21/04/2021, T-663/19, Monopoly, § 72; 21/07/2005, C-2515/03, Eichsfelder Schlachtbetrieb, § 39)

[Comment]

The cases of 'abuse of law' are characterised by circumstances in which, first, despite formal observance of the conditions laid down by trade mark rules, the purpose of those rules has not been achieved, and that, secondly, there is an intention to obtain an advantage from those rules by creating artificially the conditions laid down for obtaining it.

The GC at para 72 in Monopoly and para 52 in LUCEO only refer to "an intention"

Eichsfelder Schlachtbetrieb, § 39 refers to "abusive practice" not abuse of law.

9.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 9.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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10. Would your User Association agree with the wording proposed below for the common understanding of 'misappropriation of the right/s of the third party'?

When the applicant/proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third party/ies.

(29/01/2020, C-371/18, SKY, § 75; 12/09/2019, C-104/18 P, STYLO & KOTON, § 46)

Yes. [A1]

10. Would your User Association agree with the wording proposed below for the common understanding of 'misappropriation of the right/s of the third party'?

When the applicant/proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third party/ies.

(29/01/2020, C-371/18, SKY, § 75; 12/09/2019, C-104/18 P, STYLO & KOTON, § 46)

[Comment]

11. Would your User Association consider it important to include any other concept, including terminology, related to the assessment of bad faith in the CP13 Common Practice?

Yes. Please specify which concepts and put your reasons in the comment box and upload in Question 11.1 the relevant legislation and/or EU or national case-law on which your User Association is basing your answer. [A1]

11. Would your User Association consider it important to include any other concept, including terminology, related to the assessment of bad faith in the CP13 Common Practice? [Comment]

Disputes over ownership of band names e.g. Procol Harum - UK opposition - O-047-20

Michael Gleissner type cases where registrations are obtained purely for blocking strategies to obtain financial gain from third parties who are likely to use or wish to use a particular mark as a trade name or part of a domain name - see below for link to supporting UK High Court case.

11.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 11.1. Please upload a Word document containing the relevant legislation and/or EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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12. Are there any concepts, including terminology, that if included in the CP13 Common Practice, could be problematic due to national law and/or settled case-law?

No. At this stage of the project, we do not foresee any legal constraints regarding concepts, including terminology, related to the assessment of bad faith. [A2]

12. Are there any concepts, including terminology, that if included in the CP13 Common Practice, could be problematic due to national law and/or settled case-law? [Comment]

D. Different facets of bad faith and possible scenarios

13. In the SKY case (C-371/18), as well as in the STYLO & KOTON case (C-104/18 P), the CJEU presented the following distinction regarding the intention of the applicant/proprietor of a trade mark when filing an application:

'§75 Consequently, the absolute ground for invalidity [...] applies where it is apparent from relevant and consistent indicia that the proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin [...]'.

Based on the distinction presented above, would your User Association agree with the two following cases/facets of bad faith?

- A. **Cases where the applicant/proprietor of the contested mark has allegedly misappropriated the rights of the third party**
- B. **Cases where, even if a specific third party is not being targeted, the applicant/proprietor applied for the contested mark for purposes other than those falling within the essential functions of a trade mark (abuse of the system/abuse of law)**

Yes. [A1]

13. In the SKY case (C-371/18), as well as in the STYLO & KOTON case (C-104/18 P), the CJEU presented the following distinction regarding the intention of the applicant/proprietor of a trade mark when filing an application:

'§75 Consequently, the absolute ground for invalidity [...] applies where it is apparent from relevant and consistent indicia that the proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin [...]'.

Based on the distinction presented above, would your User Association agree with the two following cases/facets of bad faith?

- A. **Cases where the applicant/proprietor of the contested mark has allegedly misappropriated the rights of the third party**
- B. **Cases where, even if a specific third party is not being targeted, the applicant/proprietor applied for the contested mark for purposes other than those falling within the essential functions of a trade mark (abuse of the system/abuse of law)**

[Comment]

14. In order to analyse how the criteria for the assessment of bad faith may interplay, please indicate, based on your experience, what is/are the most typical scenario/s of bad faith cases before the IPOs that should be included in the CP13 Common Practice, and provide the relevant EU or national case-law on which your User Association is basing your answer in Question 14.1 [For example: knowledge of the use of an earlier identical or similar sign for identical or similar goods and/or services + free-riding on the reputation of an earlier mark]

- Re-filing with the intent to avoid proving use in oppositions/cancellations i.e. so-called "ever greening".
- Filing applications for goods/services for which there is no bona fide intention to use the mark.
- Trade mark squatters such as Michael Gleissner who adopt abusive filing strategies - see TRUMP TV High Court case - Trump International Ltd v DTTM Operations LLC [2019] EWHC 769 (Ch).
- Parodic use of trade marks - ('ONE MORE THING' opposition by Apple against Swatch - UK High Court)
- Opportunism - celebrity names, noting a new movement (e.g. Black Lives Matter)
- Squatting - filing for a mark used in another jurisdiction
- Blocking a competitor (Lindt)

14.1. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

filecount - 14.1. Please upload a Word document containing the relevant EU or national case-law in English (please highlight the relevant paragraphs). Should you experience any technical issues, please email the file to CommonPractices@euipo.europa.eu.

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E. Partial refusal/cancellation based on bad faith

15. Based on your experience, if observations/application for cancellation is directed against all the goods and services for which the trade mark was applied for/registered, do IPOs check, in all types of bad faith cases (please see the two facets of bad faith included in Question 13), if bad faith concerns/applies to only certain goods and/or services for which the trade mark is sought to be registered/is registered?

Yes, and if so, the mark will be refused/cancelled only for the goods and/or services to which bad faith applies (i.e. partially). Please specify the IPO/s. [A1]

15. Based on your experience, if observations/application for cancellation is directed against all the goods and services for which the trade mark was applied for/registered, do IPOs check, in all types of bad faith cases (please see the two facets of bad faith included in Question 13), if bad faith concerns/applies to only certain goods and/or services for which the trade mark is sought to be registered/is registered? [Comment]

UKIPO. UK High Court followed CJEU in SkyKick - see [2020] EWHC 990 (Ch)

F. Evidence which may prove bad faith

16. Bearing in mind that in March 2021 the [CP12 Evidence in Trade Mark Appeal Proceedings](#) (which may also be used in first instance proceedings) was published, and it includes inter alia a non-exhaustive list of means of evidence which may be submitted in trade mark proceedings (please see: Chapter 3.1. Means and sources of evidence), what other information regarding evidence which may prove bad faith does your User Association consider necessary to be presented in the CP13 Common Practice?

There is no need to include an additional topic regarding evidence in the CP13 Common Practice. [A1]

16. Bearing in mind that in March 2021 the [CP12 Evidence in Trade Mark Appeal Proceedings](#) (which may also be used in first instance proceedings) was published, and it includes inter alia a non-exhaustive list of means of evidence which may be submitted in trade mark proceedings (please see: Chapter 3.1. Means and sources of evidence), what other information regarding evidence which may prove bad faith does your User Association consider necessary to be presented in the CP13 Common Practice? [Comment]

G. Other questions

17. Taking into consideration the approved scope of the CP13 project, would your User Association like to include any additional comments for further consideration by the CP13 WG members?

The CITMA Working Group discussed the issue of re-filing where the filings are in different jurisdictions, i.e. a national filing in an EU member state and then an EUTM filing, or vice versa. It would be helpful if the definition of re-filing addressed this issue and made clear whether any later filing would have to be made before the same IPO.