Second Seminar on Bad Faith TM Filings
Second seminar on bad faith trade mark filings

OUTLINE

01  Bad faith as invalidity ground
02  Concept of bad faith
03  Where to find OHIM Guidelines on bad faith
04  Legal reform
• invalidity ground
• not ex officio
• time of filing
C-529/07 of 11 June 2009

- applicant knows or must know
- identical or confusingly similar third party sign for identical or similar product
- intention of applicant
- degree of legal protection of both signs
C-320/12 of 27 June 2013

- bad faith = autonomous concept of EU law, uniform interpretation

- applicant’s knowledge or presumed knowledge of use by third party abroad is not, in itself, enough to find for bad faith
Selection of other cases

- T-291/09 of 1 February 2012, Pollo Tropical
- T-33/11 of 14 February 2012, BIGAB/BIGA
- T-507/08 of 7 June 2011, 16PF
T-136/11 of 13 December 2012

- artificial extension of grace period for non-use through repeat application can be bad faith

- however, different situation is protection, in accordance with normal business practice, of variations of signs, e.g. evolution of logo
T-321/10 of 11 July 2013
GRUPPO SALINI/SALINI

- CTM declared invalid due to bad faith is invalid for all goods and services it was registered for, even those dissimilar to the goods and services of the other party/invalidity applicant
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<td>and invalidity based on relative grounds for refusal</td>
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Where to find the judgments

**OHIM Case-law database**
https://oami.europa.eu/eSearchCLW/#advanced

**Database of the Court of Justice**
http://curia.europa.eu/

Article 8(3)(b): “Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered….where the trade mark is liable to be confused with an earlier trade mark protected outside the Union, provided that, at the date of the application, the earlier trade mark was still in genuine use and the applicant was acting in bad faith.”
Alicante

BEAUTIFUL, MEDITERRANEAN, UNIQUE
Thank You

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