



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Second Seminar on Bad Faith TM Filings

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TM5, Hong Kong, 13 May 2014



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



Chocoladefabriken Lindt & Sprüngli AG

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



Malaysia Dairy Industries Pte. Ltd

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

Pelikan 

Pelikan 

Pelikan Vertriebsgesellschaft
mbH & Co. KG

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

Law

- Community Trade Mark legal texts
- Community Design legal texts
- International treaties & National laws
- Invalidity concerning Community Designs
- Decisions & Communications of the President
- Presidium of the Boards of Appeal
- Official Journal
- Preliminary rulings

Practice

- Current Trade Mark Practice
- Current Designs Practice
- Appeal
- Mediation

Online manual of
Trade Mark Practice

Read the manual ➤



Learning portal
Upcoming events
Academy

Learning

eSearch plus - Trade marks, designs, owners, representatives and bulletins

TMview - Trade marks in the European Union

DesignView - Designs in the European Union

[More databases](#)

Search

13 FEB - Save the date - new OHIM Guidelines webinar

12 FEB - Why the need to sign up to OHIM's website?











12 FEB - The Republic of Korea joins TMview

OHIM website reported errors

News

Why sign up to OHIM's website?

Law

Part D: Cancellation		
 Section 1: Cancellation proceedings		New Guidelines
Section 2: Substantive provisions		
		
 Revocation for lack of use; invalidity on the ground of bad faith and invalidity based on relative grounds for refusal		New Guidelines
 Revocation (CTM becoming a generic term, CTM becoming misleading), absolute grounds for invalidity (CTM registered contrary to article 7, Defence against a claim of lack of distinctiveness)		Manual
Part E: Register Operations		
 Section 1: Changes in a registration		Manual
 Section 2: Conversion		New Guidelines
Section 3: CTMs as objects of property		
 Chapter 1: Transfer		Manual
 Chapter 2: Licences		Manual
 Section 4: Renewal		New Guidelines
 Section 5: Inspection of files		New Guidelines

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/>

Proposal COM (2013) 161 of 27 March 2013

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.”





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Thank You