



Second Seminar on Bad Faith TM Filings

Alexandra Poch, OHIM TM5, Hong Kong, 13 May 2014

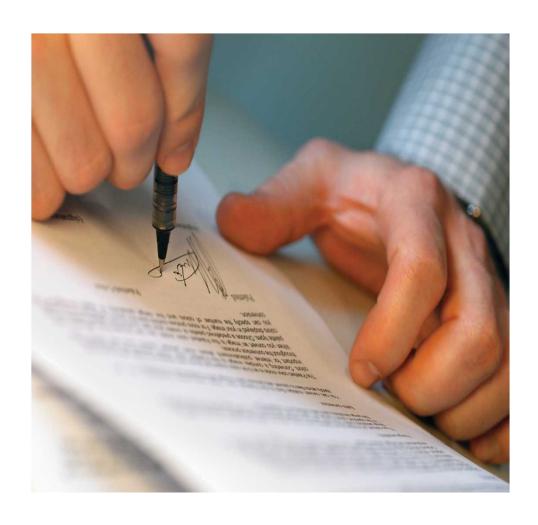


OUTLINE

- 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

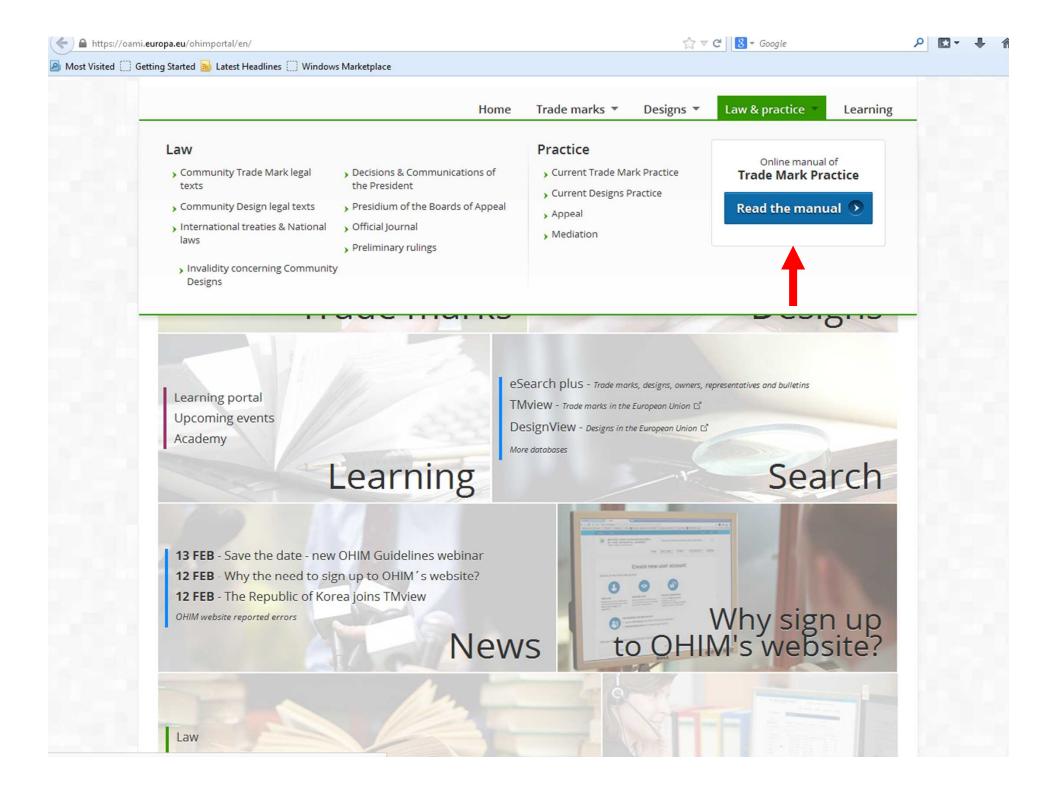


Pelikan Vertriebsgesellschaft mbH & Co. KG



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



art 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
art 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."







Alicante

























BEAUTIFUL, MEDITERRANEAN, UNIQUE





ONTACT US:

(+ 34) 965 139 100 (switchboard)

(+ 34) 965 139 400 (e-business technical incidents)

(+ 34) 965 131 344 (main fax)

information@oami.europa.eu

e-businesshelp@oami.europa.eu



twitter/oamitweets



youtube/oamitubes

www.oami.europa.eu

Thank You