



TM5 Bad Faith Project


Digest version of Case Examples

October 2022



CNIPA

Title	MOTO RETA v. MOTO RETA	
Case Info.	18021136/Mar 29,2018/ Trademark Office/China	
Mark	Plaintiff	Defendant
		
Summary		
<p>A case in which the defendant's applicant of the trademark is lack of intention to use and has obvious intention of imitating and copying third-party's trademarks. The defendant was concluded to be filed for the purpose of imitating or copying third-party's trademarks, which disputes the normal order of trademark registration management and harms the market order of fair competition.</p> <p>Pursuant to related articles of the Trademark Law, the Trademark Office decides not to register the disputed trademark" MOTO RETA ".</p> <p style="text-align: right;">Please refer to p29</p>		

Title	伊顿 v. 伊顿公学 (Eton College)	
Case Info.	3068234/3068235/Jun 20,2019/ Trademark Office/China	
Mark	Plaintiff	Defendant
		
Summary		
<p>A case in which the defendant's registered trademark is determined as having been obtained contrary to ethics of good faith and being liable to cause confusion with services connected with another party's business.</p> <p>Pursuant to Articles 10(1)(vii) ,41(1) of the Trademark Law amended in 2013 and Articles 44(1),(3) and 46 of the Trademark Law, the Trademark Office decides to revoke the disputed trademark"伊顿".</p> <p style="text-align: right;">Please refer to p33</p>		



EUIPO





Title	LUCEO v. LUCEA LED	
Case Info.	T82/14 / Jul. 7, 2016 / General Court / European Union	
Mark	Plaintiff (disputed mark)	Intervener
	LUCEO	LUCEA LED
<p>Summary</p> <p>The General Court found that the EUTM Proprietor pursued an unlawful filing strategy, consisting in successively chaining together applications for registration of national trade marks in Austria and Germany seeking to claim priority for an application of an EUTM and to grant a blocking position in order to oppose applications for registration of EUTMs filed by third parties. The EUTM Proprietor also requested the payment of 75 000 € from the Invalidity Applicant. The General Court found this filing strategy incompatible with the objectives of the EUTM Regulation and qualified it as an abuse of law. It also noted that bad faith exists inter alia where trade mark applications are diverted from their initial purpose and filed speculatively or solely with a view to obtain financial compensation. Please refer to p48</p>		

Title	SIMCA	
Case Info.	T-327/12 / May 8, 2014 / General Court / European Union	
Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
	SIMCA	
<p>Summary</p> <p>The mark SIMCA has been used for cars since 1930 by the predecessors of the invalidity applicant. Even though the mark has not been used since 1980, the invalidity applicant maintained registration of that mark in several EU Member States and the mark still had a certain surviving reputation among the public interested in cars. The General Court found that the registration of the European Union trade mark (EUTM) was deliberately sought in order to create an association with the earlier marks and to take advantage of their surviving reputation on the motor vehicle market, even to compete with those earlier marks in the event the invalidity applicant decided to reinitiate their use in the future. Please refer to p52</p>		



Title	TARGET VENTURES	
Case Info.	T-273/19 / Oct. 18, 2020 / General Court / European Union	
Mark	TARGET VENTURES	
<p>Summary</p> <p>The EUTM Proprietor, a venture capital fund, registered TARGET VENTURES as an EUTM even though it has operated and rendered its services under the designation TARGET PARTNERS. The EUTM Proprietor also had the domain names ‘www.targetventures.com’ and ‘www.targetventures.de’ but those sites merely redirected to its official site, ‘www.targetpartners.de’. The General Court found that registration of the contested mark ‘TARGET VENTURES’ not with the intention to use it but with the sole purpose of strengthening the scope of protection of the EUTM Proprietor’s actually used mark ‘TARGET PARTNERS’, was inconsistent with the essential function of a trade mark to indicate to consumers the commercial origin of goods and services.</p>		

JAPAN

Title	ASRock v. Asrock	
Case Info.	2009(Gyo-Ke)10297 / Aug. 19, 2010 / Intellectual Property High Court / Japan	
Mark	Plaintiff (disputed mark)	Defendant (cited mark)
		
Summary		
<p>This trademark application was found to have been filed as plagiarism, ahead of the plaintiffs and with an unfair purpose and thus was found to fall under Article 4(1) (vii) of the Trademark Act.</p> <p>The Defendant was concluded to be filed for the purpose of gaining unfair profits from the assignment of trademark right or causing damages to ASRock and its dealers for the reasons that</p> <ol style="list-style-type: none"> (1)The Defendant has no intention to engage in business in Japan. (2) Although the Defendant is not substantially engaged in any business activities, the Defendant has intentionally applied for a trademark identical with or similar to, the trademarks to be used by other companies in foreign countries. (3) After the registration of the Defendant's trademark, requesting distributors of the products bearing the Plaintiff's trademark, including the Plaintiff, to cease importing and sales of the products and warning them that it may institute a criminal prosecution unless they follow the request. <p style="text-align: right;">Please refer to p68</p>		

Title	Manhattan passage v. ManhattanPortage	
Case Info.	2002(Gyo-Ke)593 / Nov. 20, 2003 / Tokyo High Court / Japan	
Mark	Plaintiff (disputed mark)	Defendant (cited mark)
		
	 	
Summary		
<p>The Plaintiff's trademarks were determined as being filed for the unfair purposes such as to prevent the foreign well-known trademark proprietors from entering into Japan or have them buy out expensively or sign a domestic agency contract and thus to fall under Article 4 (1) (xix) of the Trademark Act.</p> <p>It was found that the Defendant's trademark had been widely known in the U.S. and the Plaintiff was aware of it. Also, there was a fact that the Plaintiff and the Defendant had once basically agreed the Plaintiff would purchase the Defendant's goods, however, no actual contract was signed eventually.</p> <p>The court, considering the fact mentioned above, judged that there was an unfair purpose in the behavior of the Plaintiff which filed the applications for registration of the trademarks closely similar in appearance understanding that the Plaintiff had no license to use these marks.</p> <p style="text-align: right;">Please refer to p74</p>		

KOREA

Title	MK v. MK	
Case Info.	2017Huh2604 / April 13, 2018 / The Patent Court of Korea / ROK	
Mark	Plaintiff	Defendant
		
Summary		
<p>Comprehensively considering the revenue, advertising costs in relation to defendant’s trademarks, the way how they have been used, the extent to which they have been exposed via various media (e.g. newspaper), the prior mark was deemed to have been known as a sign which indicates products of a certain person in the US and Korea. The designated goods of the disputed trademarks, artificial leathers and bags under Class 18 and sneakers, dresses, suits, neckties, scarfs, belts made of leather under Class 25, are similar to or have economic relation with those of the prior mark which are bags, wallets and scarfs. Furthermore, the motive and appearance of the prior and the disputed marks are so similar that it is reasonable to determine that the disputed marks are an imitation of the prior mark. Also, looking at how those marks have been used, it is difficult to distinguish the defendant’s goods from the plaintiff’s. Thus, it is considered that the defendant intended to take unfair advantage of goodwill of the trademark of Michael Kors.</p> <p style="text-align: right;">Please refer to p118</p>		

Title	THEZARA v. ZARA	
Case Info.	2017huh2109 / Sep 21, 2017 / The Patent Court of Korea / ROK	
Mark	Plaintiff	Defendant
	ZARA	THEZARA
Summary		
<p>Since the distinctive nature of “THE”, a definite article, included in the disputed mark is inherently weak, “ZARA” in the mark serves as the principal part of the mark, which makes the sound and meaning of the plaintiff’s and dependent’s marks identical. Furthermore, the plaintiff expanded his business to produce bedding and household products for hotels and motels in 2003, and opened shops branded as “ZARA HOME” in Korea in 2008. Given that the defendant’s main customers who use hotels and motels and plaintiff’s customers who buy clothes overlap, if the disputed mark is used for the signboard of accommodation facilities as well as bedding and household products, average consumers are likely to be confused as to the source of services. All in all, the disputed mark is determined to be filed to take unfair advantage of goodwill of the prior mark.</p> <p style="text-align: right;">Please refer to p120</p>		

USPTO


Work in progress. Will be listed shortly.

Other Countries/Regions

Brazil

Title	HIMEDIA v. HIMEDIA	
Case Info.	0098824-29.2017.4.025101 / Jun. 13, 2018 / 31 ^a Federal Court of Rio de Janeiro / Brazil	
Mark	Plaintiff (cited mark)	Defendant (disputed mark)
	HIMEDIA	HIMEDIA
Summary		
<p>Plaintiff, in this case, argues that the Defendant registered in bad faith the Plaintiff's well-known trademark since the Defendant knew it belonged to the Plaintiff and due to the business relations kept by the parties at the time the registration was filed.</p> <p>The Plaintiff had a registration for the trademark "HIMEDIA" since 1998 in India. In 2004, the Plaintiff signed a business agreement with the Defendant for commercial representation of its products in Brazil. And then the Defendant filed a trademark application for "HIMEDIA" mark in Brazil, without the Plaintiff's consent in 2004.</p> <p>The court ruled in favor of the Plaintiff, alleging that it could be verified that there was commercial bad faith in the conduct of the Defendant in its act of filing an application for a trademark that, in several other countries, belonged to the company from which it imported the products identified by the sign and with whom it maintained a business relationship based on trust. The court judged that Article 166 of the Brazilian Industrial Property Law and Article 6 septies of the Paris Convention must be applied in this case.</p> <p style="text-align: right;">Please refer to p184</p>		

Canada

Title	Bugatti International S.A. v Bugatti Hotels & Resorts Ltd.	
Case Info.	2017 TMOB 60 / May 30, 2017 / Trademarks Opposition Board / Canada	
Mark	Plaintiff (disputed mark)	Defendant (cited mark)
	BUGATTI	EB BUGATTI & DESIGN 
Summary		
<p>The Plaintiff's registration for the "Bugatti" trademark for use in association with a range of hospitality and real estate services including hotel services was opposed by the Defendant, who is a famous car manufacturer.</p> <p>It was found that there was evidence illustrating that the Plaintiff intended and expected that its use of the Bugatti trademark would be perceived and immediately understood by consumers to be the same as the Defendant's Bugatti trademark, and as a result the business would enjoy the same cache and goodwill associated with the Defendant's Bugatti trademark. There was also evidence that the Plaintiff had registered numerous domain names associated with other well-known brands.</p> <p>The Trademarks Opposition board ruled that the Plaintiff's application must be rejected as the Plaintiff had applied for the trademark in bad faith.</p> <p style="text-align: right;">Please refer to p193</p>		



India

Title	EGO v. EGO	
Case Info.	ORA/49/2008/TM/DEL / May 1, 2009 / The Intellectual Property Appellate Board / India	
Mark	Appellant (cited mark)	Respondent (disputed mark)
	EGO	EGO
Summary		
<p>The applicant has been engaged in the business of manufacturing, marketing and selling industrial valves and other products since 1984. The Applicant has adopted the trademark EGO in good faith and has continued to use it continuously, uninterruptedly and exclusively since 1984 as the owner and proprietor thereof.</p> <p>Defendant 1 obtained registration of the opposed trademark "EGO" for valves for water supply and sanitation, etc., included in Class 11.</p> <p>The applicant used documents to establish that defendant 1 was a commissioned agent until 2001 and was also aware of the applicant's use of the trademark. The court granted the fraudulent petition against defendant 1.</p> <p>The court further held that defendant 1 had obtained the registration in violation of the provisions of Section 18 of the Trademark Act, 1999. The application for the opposed trademark was filed in 2001 and the defendant claimed to have used the trademark since 1998, but it was found that the order was not placed until 2001.</p> <p style="text-align: right;">Please refer to p.233</p>		

Kenya

Title	In the Matter of Trademark No. 67586 "KENYA BOYS CHOIR" (Words) and opposition proceedings thereto by KENYAN BOYS CHOIR	
Case Info.	N/A / Feb. 27, 2015 / Kenya Industrial Property Institute Tribunal / KENYA	
Mark	Appellant (cited mark)	Respondent (disputed mark)
	"KENYA BOYS CHOIR"	"KENYAN BOYS CHOIR"
Summary		
<p>The choir grew in size and stature and began to take part in several tours and performances using the name Kenyan Boys Choir. In 2010, the Proprietor successfully applied for and obtained registration of the mark "KENYA BOYS CHOIR".</p> <p>The Applicants filed the trademark cancellation application on the grounds that they were the owners of the similar "THE KENYAN BOYS CHOIR" and "THE BOYS CHOIR OF KENYA" names and that they had obtained registration of these names as business names. The Applicants argued that the Proprietor's intention in registering the Trademark was to ride on the goodwill that the choir had garnered in Kenya and especially in the United States of America and to block the Applicants from obtaining bona fide registration of their marks.</p> <p>The Registrar expressed the view that the Proprietor's attempt to get exclusive rights over the Trademark and its variations demonstrated that the registration of the Trademark was not made in good faith and that a proprietary right obtained through bad faith cannot be protected.</p> <p style="text-align: right;">Please refer to p.251</p>		



Thailand

Title	Belmont Brands Limited v. Mr. Boonyasak Wattanaharuthai	
Case Info.	9972/2558 / Aug. 28, 2015 / Thai Supreme Court / Thailand	
Mark	Plaintiff (cited mark)	Defendant (disputed mark)
		
Summary		
<p>This is a case brought to the Supreme Court on passing off with a Request for Invalidation. The Claimants (Plaintiffs) of this case began using their marks worldwide before the Registrant (Defendant) filed for registration of its marks in Thailand, which were similar to the Claimants' marks (not yet registered in Thailand).</p> <p>A similarity or connection between the goods to which the parties' marks were used made it likely that concurrent use of such marks by different parties would lead to consumer confusion as to the origins of the goods. While the parties' marks were not identical, the Defendants use of their marks in a manner similar to the Claimants' use of their marks showed that the Defendants had the intention to pass off their goods as the Claimants'.</p> <p>Although as the Claimants' marks were not registered in Thailand, they were entitled to remedies under the law of passing off. Because of this, the Defendants were ordered to cease using all trademarks, product forms and designs which were rightful intellectual property of the Claimants.</p>		
Please refer to p.328		



UK

Title	One Max	
Case Info.	O-486-17 / Oct. 6, 2017 / Appeal to Appointed Person / United Kingdom	
Mark	Appellant (cited mark)	Respondent (disputed mark)
	ONE MAX	
Summary		
<p>Based on the facts and evidence, the Opponent showed that the Proprietor's trademark applications were made in bad faith, with the knowledge that the Opponent was about to launch a product under the identical name as the mark.</p> <p>The Managing Director of One Max Ltd ("One"), then a long-time dormant company, became aware in June 2013 that HTC Corporation ("HTC") was planning to launch a new product to be called HTC One Max and decided to make Trademark applications for both a logo and words "One Max" with respect to goods (such as mobile phones and tablets) in class 9 and services in class 42, which were outside One's area of activity.</p> <p>HTC opposed the marks on the basis of the application being made in bad faith and the Hearing Officer decided in its favor, holding that One's applications were simply blocking ones. The Appointed Person agreed that One's argument that the application was not done with a blocking intention was difficult to reconcile with One's actions and chronology of events.</p>		
Please refer to p.337		

Ukraine

Title	Mando v. MANDO	
Case Info.	760/15975/15-II/ Mar. 14, 2016 / Court of general jurisdiction, Solomjanskyj district of Kyiv, Ukraine / UKRAINE	
Mark	Appellant (cited mark)	Respondent (disputed mark)
		
Summary		
<p>Trademark legislation in Ukraine does not foresee refusal of bad-faith applications or cancellation of bad-faith trademark registrations as such. However, in accordance with Article 6.2.5 of the Trademark Law, a trademark registration cannot be registered in Ukraine if it is misleading or may mislead as to the producer of goods, services or producers of goods or provider of services. In the reported case, the contested trademark was cancelled as the court ruled that it may mislead as to the producer of the goods.</p> <p>The Plaintiff in this case is Halla Holdings Corporation, a part of Hall Group, a South Korean industrial conglomerate and producer of auto parts. In 2013, Halla Holdings filed two trademark applications for the verbal stylized mark “Mando”, which were refused for protection by the Ukrainian IPO on the basis of an earlier registration for the “MANDO” verbal mark registered in the name of a Ukrainian individual with respect to identical or similar goods and services. The Plaintiff filed a trademark invalidation action against the cited trademark arguing that it was registered in bad-faith and that it was free riding on the reputation of the Plaintiff’s mark.</p> <p style="text-align: right;">Please refer to p.341</p>		

Vietnam

Title	SNAPCHAT vs. SNAPCHAT	
Case Info.	N/A / Jun. 6, 2018 / National Office of Intellectual Property of Vietnam (“NOIP”) / Vietnam	
Mark	Appellant (cited mark)	Respondent (disputed mark)
		
Summary		
<p>The Defendant’s registered trademark was determined to be confusingly similar to the Plaintiff’s trademark, which was well known before the filing date of the Defendant’s trademark. The Defendant’s trademark filing aimed to take advantage of the reputation and goodwill attached to the Plaintiff’s trademark. In the invalidation action, the Plaintiff successfully argued that the Defendant’s trademark would cause confusion to consumers based on the following:</p> <ul style="list-style-type: none"> (i) The Plaintiff was the owner of the trademark “SNAPCHAT” for various goods/services, which was well known in many countries in the world and Vietnam prior to the filing date of the Defendant’s trademark; (ii) The Plaintiff’s mobile application “SNAPCHAT” was introduced several years earlier and had been provided to users all over the world and in Vietnam since then, with users in over 70 countries in the world; (iii) The Plaintiff’s trademark “SNAPCHAT” had earned well-known status and was used by many celebrities. <p>Based on the above, NOIP decided to invalidate the Defendant’s trademark for all services.</p> <p style="text-align: right;">Please refer to p.345</p>		

