

Trademarks

The New Bad Faith Ground in Opposition Cases: What Can Canada Learn From Other Countries?

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Canada

- *Trademarks Act*, as amended June, 2019 adds a new ground of opposition:
 - Section 38(2) *Grounds* – A statement of opposition may be based on any of the following grounds:....
 - (a.1) that the application was filed in bad faith
- There is no definition of “bad faith” in the *Trademarks Act*
- To date there are no TMOB or court decisions interpreting:
 - bad faith under s. 38(2)(a.1); or
 - bad faith under s. 18(1)(e) (trademark invalid if application filed in bad faith)

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Canada

What Canadian sources can we look to?

1. TMOB and Federal Court case law where failure to comply with section 30(i) of the *Trademarks Act* was a ground of opposition:
 - See *Sapodilla Co. v. Bristol Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) where the court stated that a ground of opposition based on s. 30(i) should only succeed in exceptional cases, such as where there is evidence of bad faith
 - *Sapodilla* has been cited by the Federal Court and hundreds of times by TMOB

Canada

2. Internet Registration Authority (CIRA) domain name Dispute Resolution Policy (CDRP) Domain Registry (CDRP)
 - Under the CDRP, registration in bad faith by the other party is one of the elements needed to be successful in a domain name dispute
 - CDRP sets out a non-exhaustive list of 4 circumstances that constitute "bad faith"
 - Access past CDRP decisions at: <https://www.cira.ca/cdrp-decisions>

Canada

3. Canadian jurisprudence on bad faith in other areas of the law

- Contracts Law: *Bhasin v. Hrynew* 2014 SCC 71
 - a lack of good faith requires more than acting in a self-serving manner, it requires dishonesty and an undermining of the interests of the other party
 - Courts should be careful not to veer off into a form of ad hoc judicial morality
- Insurance Law: *McDonald v. Insurance Corp of BC* 2012 BCSC
 - bad faith does not carry a precise legal definition and a bad faith claim must be evaluated in light of the surrounding circumstances on a case-by-case basis

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Bad Faith In United States Trademark Law

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Overview

- 1 - “Bad Faith” filings at the USPTO.**
- 2- “Bad Faith” in a U.S. infringement analysis.**
- 3 - “Bad Faith” in ICANN proceedings.**

I. “Bad Faith” at the USPTO



Bona Fide Intent to Use

- An Intent to Use under Section 1(b).
 - Application requires a “*bona fide* intent to use” in “good faith”.
 - Also applies to Madrid applications extending into the U.S.
- Good faith application requirement with penalties on applicant or attorney.



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Examples - Objective

- Written business plans;
- Emails and written communications naming the mark to suppliers/buyers;
- Notes of meetings or phone calls discussing current plans;
- Engagement of developers;
- Securing a URL;
- Shipments of products (more than 1).

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NO *Bona Fide* Intent to Use -TTAB

- *Swatch AG v. M. Z. Berger & Co., Inc.*, Opposition No. 91187092, 108 U.S.P.Q.2d 1463 (Fed. Cir. 2015).



- Opposer opposed the application for “iWATCH” in connection with a variety of goods including watches based on likelihood of confusion and lack of *bona fide* intent.
- Finding for Opposer, the Board held no *bona fide* intent.

NO *Bona Fide* Intent to Use -6th Cir.

- *Kelly Services, Inc. v. Creative Harbor, LLC*, 846 F.3d 857 (6th Cir. 2017).
- Two companies wanted to use “WorkWire” for workplace apps.
- District court found Defendant intended to use on some goods/services, but not others.
 - REMEDY: VOID.
- 6th Cir. some evidence of *bona fide* intent, remanded.
 - **REMEDY: NOT VOID in entirety**, deletion of goods acceptable (similar to TTAB cases).

NO *Bona Fide* Intent to Use -TTAB

- *Los Santos, LLC v. Jonny D. Gabriel and Rosalie Gabriel*, Opp. No. 91223574 (T.T.A.B. June 10, 2019).
 - The Applicants had **no documentary evidence**.
 - Arguing 82 year old owner does business old-fashioned way (over phone/in person) inadequate.



NO *Bona Fide* Intent to Use - TTAB

- *Hole in 1 Drinks, Inc. v. Lajtay*, Cancellation No. 92065860 (T.T.A.B. 2020).
 - An individual, in his individual name, applied for the trademark; but at the time his business plans were to form an LLC with the partner.
 - There was documentary evidence of business plans.
 - **Intention has to follow the legal entity expected to use the mark.**

Additional Specimens

- To combat “bad faith” PTO can ask for more specimens.
- To clear “dead wood”, PTO has been asking for additional specimens at filing of Sec. 8 and 71.
- PTO critical of specimens filed.

Takeaways

- Document your evidence of intent.
 - Even for Madrid Applications.
- Critically look at goods, too broad?
- Amend applications/delete non-use items.

Fraud at the USPTO

- Under *In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009), fraud requires a showing, among others, that:
 - There was an *intent to deceive*.
- **Fraud claims are notoriously hard to prove** in the U.S. due to the intent element from *Bose*.

Fraud at the USPTO - TTAB Cases

- Even where there is direct evidence that the Applicant made false and material representations, the Board may not find fraud. *Tommie Copper IP Inc v Gcool-Tech Usa LLC*, Opposition No 91223768 (T.T.A.B 2018).
- On rare occasion, the Board will find fraud, but the evidence must be clear. *Nationstar Mortgage LLC v. Ahmad*, Opp. No. 91177036 (T.T.A.B. 2014).

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Fraud - In Practice

- Most common “fraud” we see in practice: altered or fake specimens.



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Fraud - In Practice

- In recent years, the USPTO has taken various actions to curb this behavior so that fraudulent marks are not registered:
 - Post registration audits, U.S. counsel requirements, specimen database, URL and access date requirements.

II. “Bad Faith” in the U.S. Infringement Analysis



Bad Faith as Part of an Infringement Analysis

- “Bad Faith” in adoption/use of a mark is also a concept considered by U.S. Courts in an infringement analysis.
- The concept is generally viewed through the lens of the defendant’s “intent”.
- Applicable especially in awards assessment.

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Bad Faith as Part of an Infringement Analysis

- A finding that a defendant acted in bad faith in selecting a mark or intended to trade off of the goodwill can lead to enhanced monetary damages and award of attorney fees in “exceptional” cases. U.S.C. § 1117.
- While a finding of “willfulness” is no longer needed for a defendant’s profits, the defendant’s state of mind “without question” remains important in the consideration of damages. *Romag Fasteners, Inc. v. Fossil, Inc.*, 590 US __ (2020).



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SportFuel, Inc. v. PepsiCo, Inc., 2019 U.S.P.Q.2d 287482 (7th Cir.2019).

- SportFuel alleged that the district court erred because it never properly considered evidence of Gatorade's bad faith.
- The Court:
 - Gatorade's "mere knowledge" of the plaintiff's mark, without other evidence of subjective bad faith, is insufficient.



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Tiffany & Co. v. Costco Wholesale Corp., 2020 U.S.P.Q.2d 10942 (2d Cir. 2020).

- Tiffany alleged that Costco was liable for trademark infringement and counterfeiting in connection with its sale of diamond engagement rings identified by point-of-sale signs containing the word "Tiffany."
- The District Court awarded damages of \$21,010,438 finding that "*no* rational finder of fact could conclude that Costco acted in good faith in adopting the Tiffany mark."
- However, the Second Circuit disagreed.
- Case remanded for trial.



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III. Bad Faith in ICANN Proceedings

- Under the Uniform Domain Name Dispute Resolution Policy, “bad faith” in selection of a domain name is a factor to be considered.
- Paragraph 4(a)(iii) of the URDP outlines what may be considered “bad faith”:
 - (1) Disrupting a competitor, (2) preventing the trademark owner from using the corresponding domain name, (3) attempting to trade off of the mark owner’s good will, (4) reserving the domain name and then trying to sell it to the mark owner (i.e., cybersquatting).
- Where appropriate, it is advisable to include an allegation of bad faith.



SUMMARY

- Bona fide intent to use – DOCUMENT.
- Use claims – EACH ITEM.
- Fraud is hard to prove.
- Work with experienced U.S. counsel.

Thank You

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Bad Faith: EU and UK Review

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Overview

- Relevant legislative provisions
- Definition and approach to assessment of bad faith in the UK and EU
- Examples of 'bad faith' conduct

Summary

- UK trade marks: bad faith is an absolute ground for refusal of an application and also a ground for invalidity.
- EU trade marks: bad faith is not an absolute ground for refusal of an EUTM application (other than in relation to an application in the name of an agent of the proprietor without consent), but is a ground for invalidity.
- EU Member States: bad faith *may* be an absolute ground for refusal of a national trade mark application in EU Member States as it is optional under the Trade Mark Directive. It is a mandatory ground for invalidity in all EU Member States.

Trade Mark Directive 2015/2436

- Article 4(2): “A trade mark shall be liable to be declared invalid where the application for the registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered.”
 - It is now a mandatory ground of invalidity (cf. 2008 Directive), but optional in relation to trade mark applications.
- Article 5(4)(c): “Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that ... (c) the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that, at the date of the application,
- Article 7: “Where grounds for refusal of registration or for invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied or registered, refusal of registration or invalidity shall cover those goods or services only”.

UK Legislation

- Section 3(6) UK Trade Marks Act 1994: “A trade mark shall not be registered if or to the extent that the application is made in bad faith.”
- Note also home-grown provision section 32(3) Trade Marks Act 1994: “The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used”.
- Section 47(1) Trade Marks Act 1994: “The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3....”
- Section 47(5) Trade Marks Act 1994: “Where the grounds for invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only”.

EU Trade Mark Regulation 2017/1001

- No equivalent absolute ground for refusal
- Article 59(1)(b): “An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings ... (b) where the applicant was acting in bad faith when he filed the application for the trade mark”.
- Article 59(3): “Where the ground for invalidity exists in respect of only some of the goods or services for which the EU trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only”.

What Does ‘Bad Faith’ Mean?

- No legislative definition of ‘bad faith’ in the TM Directive, EUTM Regulation or UK Trade Marks Act
- “... plainly it includes dishonesty and ... also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined” (*Gromax v. Don & Low* (1999))
- “...the expression ‘bad faith’ has moral overtones which appear to make it possible for an application for registration to be rendered invalid ... by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding on the applicant...” (*DEMON ALE* (2000) (UKIPO Appointed Person))

What Does 'Bad Faith' Mean?

- Two stage test developed in *AJIT Weekly* (2006) (UKIPO Appointed Person):
 - Identify subjectively what the applicant knew or ought reasonably to have known
 - Taking into account that knowledge, decide whether the applicant's conduct fell below the objective standard
- EUIPO adopted broader approach to bad faith compared to UK

What Does 'Bad Faith' Mean? CJEU guidance in Lindt



Lindt's 3D trade mark



Hauswirth's chocolate bunny

What Does 'Bad Faith' Mean? CJEU Guidance in Lindt

Chocoladefabriken Lindt & Sprüngli AG v. Franx Hauswirth GmbH (2009) CJEU

- Lindt had produced and marketed chocolate Easter bunnies since 1950s (from 1994 in Austria), wrapped in gold foil with ribbon and/or bell
- Others had been marketing similar chocolate bunnies since 1930s, including Hauswirth since 1962
- Some third parties had acquired unregistered rights
- Lindt applied for 3D TM in June 2000, with knowledge that it would be confusingly similar with existing third party marks, and of unregistered rights of third parties
- Intention was to use the mark to prevent continued use of third party marks
- Austrian court referred questions to CJEU concerning Lindt's knowledge of competitor activities under identical/similar sign

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What Does 'Bad Faith' Mean? CJEU Guidance in Lindt

Chocoladefabriken Lindt & Sprüngli AG v. Franx Hauswirth GmbH (2009) CJEU

- Determination of bad faith is "an overall assessment, taking into account all the relevant factors relevant to the particular case" and, in particular:
 - Fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical/similar sign for an identical/similar product capable of being confused with the sign for which registration is sought;
 - Applicant's intention to prevent that third party from continuing to use that sign; and
 - Degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought

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What Does 'Bad Faith' Mean? CJEU Guidance in *Lindt* ctd.

The CJEU also said:

1. A presumption of knowledge may arise from inter alia general knowledge in the economic sector concerned of such use, and can be inferred from the duration of such use. Long standing use makes it more probable the applicant will have had knowledge of it.
2. Fact applicant knew/must have known of 3rd party use in at least one Member State is a relevant circumstance to take into account but is not sufficient, in itself, to conclude bad faith.
3. Applicant's intention at time of filing is a subjective factor to be determined by reference to the objective circumstances of the case.
4. Intention to prevent a third party from marketing a product may, in certain circumstances, constitute bad faith e.g., where sole objective was to prevent a third party from entering the market.
5. Long term use of a sign by a third party which enjoys some degree of protection is a relevant factor. However, the applicant's registration of the sign may still be in pursuit of a legitimate objective.

What Does 'Bad Faith' Mean? CJEU Guidance in *Lindt* ctd

6. Nature of the mark may be relevant e.g., bad faith may be more readily established where the sign consists of the entire shape and representation of a product and competitors' freedom to choose the shape of a product/presentation is restricted by technical or commercial factors.
 7. Regard should also be given to the extent of the reputation of the applicant's sign which could justify wider protection.
- The CJEU's finding in *Lindt* was a narrow one. In particular, it provided no definition of 'bad faith' or guidance as to the appropriate standard to apply

Application of Lindt Guidance

- *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* (2010), UK Court of Appeal
 - Claimant owned and operated Hotel Cipriani in Italy; third parties operated hotels and restaurants under Cipriani name in Italy.
 - Claimant applied for EUTM for CIPRIANI for hotel and restaurant services; sued Defendant operator of 'Cipriani' restaurant in London.
 - Defendant's argued application made in bad faith rejected:
 - Intention and state of mind of applicant (subjective factors) should be determined by reference to the objective circumstances of the particular case.
 - Although third parties were using 'Cipriani' for hotels at the date of EUTM application, these were special cases and there was no suggestion the trade mark could be used to prevent their use.
 - Defendant was not using 'Cipriani' at the date of filing in a way in which the EUTM registration could pre-empt.

Application of Lindt Guidance ctd.

Red Bull GmbH v Sun Mark Ltd (2013), UK High Court. Mr Justice Arnold set out following guidance:

- Relevant date is application date. Later evidence casting light backwards on position at the application date may be relevant.
- Good faith conduct presumed. Bad faith is a serious allegation and must be distinctly proved, with cogent evidence.
- Bad faith includes dishonesty and also 'some dealing which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined'.
- The provisions are intended to prevent abuse of the trade mark system: (1) abuse against the office and (2) abuse against third parties.
- The tribunal must make an overall assessment, taking into account all relevant factors.
- The tribunal must ascertain what party knew about the matters in question and then decide whether, in light of that knowledge, conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour).
- Consideration must be given to applicant's intention.

Development of CJEU Case Law

Malaysia Dairy Industries Pte Ltd v. Ankenoevnet For Patenter Og Varemoerker (2013), CJEU

- Yakult registered shape of bottle as a trade mark in Japan and several EU Member States. Malaysia Dairy had produced a milk drink bottle since 1977 and applied for trade mark protection.
- Parties entered into co-existence arrangement. Malaysia Dairy registered 3D mark in Denmark and Yakult applied for cancellation relying upon Article 4(4)(g) 2008 Trade Mark Directive.
- CJEU:
 - Concept of 'bad faith' is an autonomous concept of EU law and must be given an uniform interpretation, in line with Article 52(1)(b) of the EUTM Regulation 2007/2009
 - Applied *Lindt* factors
 - Fact that the applicant knew/should know that a third party was using a mark abroad at the time of filing the application which was liable to be confused with the applied for mark was not sufficient in itself. Consideration had to be given to the applicant's intention at the time of filing the application.

Development of CJEU Case Law

Koton v. EUIPO (2019) (CJEU)

- Services in Class 39 were not similar.
- CJEU: bad faith ground for invalidity could apply regardless of whether use of an identical/similar sign for goods and services identical/similar to those for which the mark was ultimately registered

Development of CJEU Case Law

Sky v SkyKick

Sky plc & ors v. SkyKick UK Ltd & anr (2020) (CJEU)

- SkyKick provides a service migrating email accounts from Microsoft's *Office* platform to *Office 365*
- Sky sued for trade mark infringement and passing off
- SkyKick counterclaimed that Sky's marks were invalid, arguing that:
 - The specification included broad terms (such as *computer software*) which were not clear and precise (and therefore it was not possible to determine the extent of protection); and/or
 - Filing for such broad terms is bad faith.
- SkyKick further argued that, if the marks were invalid, then the whole mark should be revoked, even goods and services for which Sky had a reputation.

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Sky v SkyKick

High Court Decision

- High Court (Arnold J) had found trade mark infringement for: *computer software, computer software supplied from the internet/to enable connections to databases, data storage and electronic mail services*
- Arnold J conducted a wide-ranging survey of EU and UK trade mark law, none of which had gone so far as to hold that a mere intention not to use a trade mark could amount to bad faith. However, he concluded SkyKick's invalidity counterclaim raised issues which were not *acte clair*.
- Referred five questions to the CJEU, including:
 - Is lack of clarity and precision a ground of invalidity?
 - If so, does *computer software* lack clarity and precision?
 - Can it constitute bad faith to apply to register a trade mark without any intention to use it?
 - If so, does the finding of bad faith apply to the whole trade mark or only the goods and services which were held to have been filed in bad faith?
 - Is s.32(3) UK Trade Marks Act 1994 compatible with the Trade Marks Directive?

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Sky v SkyKick High Court Decision

- Arnold J expressed certain preliminary views:
 - Coverage for computer software was “unjustified and contrary to the public interest because it confers on the proprietor a monopoly of immense breadth which cannot be justified by any legitimate commercial interest of the proprietor”.
 - But – agreeing with Sky – a trade mark may only be partly invalid if the application was made partly in bad faith.

Sky v SkyKick CJEU Decision

- Lack of clarity and precision: **NOT** a ground of invalidity
- Therefore: computer software cannot be invalid on such a ground
- Lack of clarity and precision does not give rise to a public policy objection (cf. Advocate General Opinion)

Sky v SkyKick CJEU Decision

- Bad faith is an autonomous concept of EU law
- Bad faith presupposes the presence of a dishonest state of mind or intention
- Where a trade mark is filed, 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
 - obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark

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Sky v SkyKick CJEU Decision

- What constitutes bad faith?
 - Lack of intention to use may equal bad faith where there is no rationale for the application for registration
 - Such bad faith may be established only if there is objective, relevant and consistent indicia tending to show that the applicant had the intention of:
 - (A) undermining, in a manner inconsistent with honest practices, the interests of third parties, or
 - (B) obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark
 - There is no presumption of bad faith simply because the applicant had no economic activity in the goods and services of the application at the time of filing.

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Sky v SkyKick CJEU Decision

- If there is a bad faith finding, are the goods/services affected severable?
- *Gruppo Salini* (2013) (General Court): existence of bad faith at the time the application is filed entails nullity of the mark in its entirety
- CJEU: “Where the ground for invalidity exists in respect of only some of the goods or services for which the trade mark is sought to be registered, the trade mark is to be declared invalid as regards those goods or services only”.

Sky v SkyKick Impact of CJEU Decision

- Scope of bad faith
 - Lack of intention to use of itself is not bad faith
 - Need to show evidence of intention to:
 - Undermine third parties in a manner inconsistent with honest practices, OR
 - Obtain a trade mark other than to use it as a trade mark (e.g., to indicate origin or to support other functions of the trade mark, e.g., investment function)

Disputes over Ownership of The Mark

- Agent applies to register mark of foreign trader
- Party in contractual negotiations with other party applies to register mark of other party (or where there are no negotiations but knowledge as a result of contact with third party)
- Bona fide conflicts between rights of traders e.g., *Lindt, Cipriani*
 - Arnold J (High Court) in *Cipriani*: the applicant may be aware of third parties using the mark for identical or similar services but may believe it has a superior right to registration and use, or that it is entitled to registration.
 - *Walton International Ltd & Anr v Verweij Fashion BV* (2018) (UK High Court): not bad faith to apply to register trade mark to provide “an additional piece of armoury in order to bolster its position in the UK ... Although the parties were in discussions ... the trade mark war had already started”.

No Bona Fide Intention to Use the Mark / Breadth of Specification

- *Sky v. SkyKick* (2020) (UK High Court):
 - Mark found partially invalid on the grounds of bad faith.
 - Court found application made in bad faith in three ways:
 - No intention to use the mark in relation to some goods and services covered by the specification, and no foreseeable prospect that they would ever intend to use the mark in relation to some goods and services
 - Specification included categories of goods and services that were so broad Sky could not, and did not, intend to use the mark across the breadth of the category, e.g., *computer software*
 - Specifications were intended to cover all of the goods and services in relevant classes

Hijacking / Spoiling / Blackmail

- Applicant wishes to prevent a competitor using the mark or a similar one
- Applicant becomes aware that someone else plans to use the mark, and files a pre-emptive application with a view to e.g., selling it
 - *BT v. One in a Million* [1999]
 - Gleissner applications/registrations

Gleissner: Bad Faith at UKIPO

- Application for declaration of invalidity against Gleissner registrations for PARASITE
 - Gleissner sought to surrender registrations before hearing, but did not dispose of invalidity application
 - EUIPO revoked invalidity applicant's trade mark for non-use (on appeal)
- UKIPO found Gleissner filed application in bad faith: part of a blocking strategy intended to obtain financial benefit from owner of Parasite trade mark and had no intention to use the trade mark in accordance with its essential function
- Rejected Gleissner's argument based on '5 year grace period' to use the mark, applying CJEU in *SkyKick*.

Gleissner: Abuse of Process at EUIPO

- Gleissner has been linked to 850 revocations before EUIPO between 2015-2018, amounting to 11% of *all* EUIPO cancellations
- Revocation proceedings re SANDRA PABST mark, owned by company in Peek & Cloppenburg group. Gleissner has attacked 36 other trade marks owned by group.
- Hundreds of cancellation actions suspended pending final outcome before Grand Chamber of EUIPO Board of Appeal, including 120 non-use revocation actions against a tech company
- Gleissner argued cancellation applicant did not have to have a particular purpose when applying to invalidate

Gleissner: Abuse of Process at the EUIPO

- Grand Board of EUIPO in February 2020 dismissed Gleissner's appeal and held his company's actions amounted to abuse of rights and abuse of process.
- Revocation request was brought before Office with improper and illegitimate ulterior purpose eg:
 - contested mark was on the market
 - numerous revocations filed by Gleissner against same trade mark owner
 - applications for marks filed by Gleissner identical to those held by trade mark owner
 - activities in unrelated matters.
- Whilst there is a public interest in cancelling non-used trade marks, it is not in public interest to flood other parties/trade mark offices with vexatious requests and burdensome litigation

Ever-greening

- *pelicantravel.com v. EUIPO* (2012), General Court
 - Where EUTM proprietor “files a repeat application for the same mark in order to avoid the consequences entailed by total or partial revocation of earlier trade mark for reasons of non-use, that fact is something which may be taken into account in order to assess whether the proprietor acted in bad faith”.
 - The later mark was not identical, but was a modernised/updated version of the earlier mark
- See also *PATHFINDER* and *CANAL+* (EUIPO Boards of Appeal)

Pelikan 

Mark registered 1 April 1996

Pelikan 

Applied for mark

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Ever-greening ctd.

Kreativni Dogadaji v. Hasbro, Inc (2019) (EUIPO Board of Appeal, on appeal to EU General Court)

- Third party applied to register DRINKOPOLY and Hasbro opposed, relying on earlier MONOPOLY registration. Identical to earlier registrations owned by Hasbro but which were older.
- Cancellation applicant argued later MONOPOLY registration filed in bad faith.
- Hasbro’s evidence was that it TOOK a number of commercial factors into account when filing a trade mark, such as new licensing opportunities, the desire to maintain a consistent and up to date trade mark portfolio, and to address any gaps in protection due to new products or services.
- Hasbro also acknowledged there was a benefit in having “young” trade marks, given no requirement to prove use.

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Ever-greening ctd.

MONOPOLY EUIPO Board of Appeal:

- Where there is an intention to circumvent the obligation to prove use of the earlier marks, re-filing improperly and fraudulently extends the five year grace period and amounts to bad faith.
- Whilst there were other commercial objectives at play, a filing strategy will not be made acceptable by the fact that it was not motivated only by the advantage of avoiding proof of use.
- The fact re-filing was a common practice did not make it acceptable.

Well Known Name or Image

- Bad faith *may* arise where applicant seeks to exploit the name or image of a famous person without permission. However, there is no separate right of personality in the UK.
- May not be necessary to rely upon bad faith, i.e., if the name/image is associated with goods/services

Questions?



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