

The logo for ECTA (European Communities Trade Mark Association) features the letters 'ECTA' in a bold, green, sans-serif font. The background of the logo area is white, with a green diagonal stripe running from the top-left corner towards the center.

European Communities Trade Mark Association

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Global research on best practices

DIRECTIVE (EU) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015 to approximate the laws of the Member States relating to trade marks



Oppositions/Invalidity actions against bad faith applications/registrations

- ✓ *Article 4 (2) TMD - Absolute grounds for refusal or invalidity*
- ✓ *Article 5 (4) (c) TMD- Relative grounds for invalidity*

Article 4 (2) Absolute grounds for refusal or invalidity

2. A trade mark shall *be liable to be declared invalid* where the application for 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.*

Article 5 (4) Relative grounds for refusal or invalidity

Any Member State may provide that a trade mark is not to be registered or, if registered, is 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, the applicant was acting in bad faith.

The TM Directive is in process of being implemented in all the EU Member States

Deadline for the transposition of its main part expired:

January 14, 2019

Extended Deadline for some provisions (Invalidity/Revocation) :

January 14, 2023

ECTA Survey on provisions on Bad Faith : situation in the EU



CONCLUSION

- ✓ Almost all Member States already had special provisions under their respective **national trade mark laws** regarding the issue of bad faith trademark filings.
- ✓ Only some countries in the EU have **laws on unfair competition** which can be used for fighting against bad faith trade mark filings, e.g. Austria, Germany, the Czech Republic, Estonia, Italy, Portugal, Sweden and in Cyprus and the UK (the law of passing-off).

Bad Faith as absolute ground for refusal and possibility by the national PTOs to raise an objection ex officio

- ✓ Possible in Finland, Germany, Greece, Hungary, Ireland, Latvia, Malta, Poland, Estonia and Cyprus, UK*
- ✓ Not possible by the national PTOs in the Benelux, Bulgaria, Denmark, Austria, Estonia, France, Italy, Portugal, Romania, Slovenia, Spain, Czech Republic, Lithuania and Sweden. *A Court or administrative action needs to be initiated by the interested party in these countries.*

Possibility of filing invalidity actions before the national offices

- ✓ Austria, Germany, Greece, Poland, Hungary, Bulgaria, Denmark, Czech Republic, Cyprus, Estonia* Benelux*, Ireland, Finland, Croatia and the UK.
- ✓ In the rest of the EU with the exception of Sweden*, an invalidation action must be brought before the competent national courts.
- ✓ In Germany, Sweden the Czech Republic, Ireland, Cyprus and the UK, the claimant has the choice.

Bad Faith can be used as a counterclaim in defence in a trade mark infringement proceedings

- ✓ Germany, Greece, Austria, Slovenia, Italy, Cyprus, UK, Ireland, Sweden, Estonia, Malta and the Benelux.

Possibility of filing simultaneous invalidity actions before the national offices and before the Courts

- ✓ In the UK: invalidation actions **cannot** be filed at the UKIPO and the Court at the same time.
- ✓ In Germany, Ireland and Cyprus : simultaneous applications may be filed before the PTO and the Court.
- ✓ However, in such cases, it is likely that either the PTO or the Court will stay the proceedings until the other reaches a decision.

Situation in the EU

with the second phase of the implementation of the Directive will significantly change:

PTOs will have to decide on invalidity and revocation actions

(however the deadline for these provisions will be January 14, 2023)

Until then the situation is still very different in the different Member States

Transfer of the TM filed in bad faith to the rightful owner

France, Ireland, Spain, Italy, Slovenia, Sweden* and the UK allow for a transfer of trade marks filed in bad faith to the rightful owner.

The laws of the majority of the EU countries merely provide the possibility of claiming cancellation or invalidation of the bad faith trade mark registration not including such transfer.

National Case Law



Tribunal de Grande Instance de Nanterre

December 20, 2018

**Société Chapter 4 Corp d/b/a SUPREME v. Mr
Majid CJEIKH**



- **Invalidity action and subsidiarily ownership claim on behalf of CHAPTER 4**



Supreme

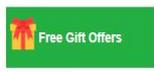
Over its twenty-two plus year history, Supreme has worked with some of our generation's most groundbreaking designers, artists, photographers and musicians - all who have helped continue to define its unique identity and attitude. Supreme is the definition of Streetwear and in many ways is the force that continues to bless the streetwear world and carry it into the next generation. There will never be another Supreme. All products are super limited and sell out quickly.



Sort by

SUPREME: SHOP BY CATEGORY

- SUPREME - NEW ARRIVALS
- SUPREME - STEALS AND DEALS
- SUPREME - TOP 10 SELLERS
- SUPREME - GRAPHIC TEES



In respect of the claim for the transfer of the ownership, the Court considered that:

- ✓ **the fields of interest of both companies were identical**, namely the sale of clothing street or urbanwear and that on the reason of the advertising investments of the plaintiff, as well as due to the fact that a boutique had been opened in Paris, *the defendant should necessarily be aware of the existence of the prior registrations and in spite of that,*
- ✓ **insisted of filing an identical figurative trade mark without any need for making such a choice.**

It was concluded that taking into account all the circumstances of the case, *in spite of the dissimilarity between the products*, **the notoriety reached by the sign SUPREME of the plaintiff in France**, **the total identity between the signs** and the *evident competition of both parties in the only sector where the defendant had its activities*, implied a serious likelihood of association including for products for which the mark was not used.

Therefore, the Court upheld the claim and ordered the transfer of the ownership to the plaintiff.

Juzgado de lo Mercantil de Barcelona
Decision of January 28, 2019
Cuina Celeri SL v. Lorenzo

- **Invalidity action against the registration of the Spanish Trademark No. 3605539 CELERI in class 43 cummulated with a claim for the transfer of the ownership**



-
- CUINA CELERI SL filed an Invalidity action on the ground of bad faith against Spanish Trademark Registration No. 3605539 CELERI filed by Mr. Lorenzo, cumulating an action claiming its ownership.
 - The defendant filed a counterclaim by invoking the infringement of the challenged mark through the use of the plaintiff's company name.

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- The Court considered that when filing the application, the defendant was entirely aware that the company CUINA CELERI SL, of which he was a partner, was known in the market under such denomination also knowing that CELERI was the trade name used for the restaurant in which he had worked.
 - The success of the restaurant was not only due to the chef but also to the financial investment and the management of the restaurant which has been made by the company CUINA CELERI SL.

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- Therefore, the Court found that *the behaviour of the defendant when filing the trade mark once the restaurant was already a success was an unlawful behaviour* which was sufficient to proceed with the declaration of the invalidity of the trade mark.
 - Furthermore, it was found that the conditions for the transfer of the ownership of the mark were also met.



Thank you very much for your
attention!

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