

Bad faith filings of trade marks in EU – different aspects

欧盟商标的恶意申请注册——不同视角

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Introduction 引言

Article 59 EU Trade Mark Regulation (EUTMR) – absolute ground for invalidity

“An EU trade mark shall be declared invalid (...) where the applicant was acting in bad faith when he filed the application for the trade mark.”

欧盟商标条例第59条——商标宣告无效的绝对理由

“申请人恶意申请欧盟商标注册的，商标应被宣告无效（……）。”

Introduction 引言

What is bad faith?

‘inherent **defect in the application** (rather than in the trade mark), which fundamentally **vitiates the registration** regardless of other circumstances.’

and what is beyond it?

什么是恶意？

“**商标注册申请**中的固有**缺陷**（而非商标的缺陷）；无论其他情况如何，该缺陷从根本上**使商标无效**。”

哪些情形超出上述范畴？

EUTM Trade mark System – EU system and national systems working in parallel 欧盟商标体系——欧盟系统和成员国系统并行



Who can represent?

- legal practitioner
- professional representatives
- employee representatives
based in EEA

谁能作为代表人？

- 法律从业者
- 专业代表人
- 欧洲经济区员工代表

Obligatory for party that **does not have** domicile/principle place of business/real and effective establishment in European Economic Area, except for:

- filling application for EUTM/RCD
- renewal of EUTM/RCD
- inspection of file

在欧洲经济区**没有**住所 / 主要营业所 / 真实有效单位的当事人需指派代理人，但以下情形除外：

- 申请注册欧盟商标 / 外观设计
- 申请展期欧盟商标 / 外观设计
- 查阅档案

- Procedural misrepresentation
- Misuse of the User Area credentials
- 不合代理程序要求
- 不当使用用户域凭证

Article 8(3) – unauthorised filling by an agent/representative 第8(3)条——代理人未经授权注册商标

Art. 8(3) EUTMR

‘Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered:

where **an agent or representative** of the proprietor of the trade mark applies for registration thereof **in his own name without the proprietor’s consent**, unless the agent or representative **justifies** his action.’

欧盟商标条例第8(3)条

“代理人或代表人未经同意，以自己的名义将权利人的商标进行注册，权利人提出异议的，不予注册。代理人或代表人有正当理由的除外”。

Article 8(3) – unauthorised filling by an agent/representative 第8(3)条——代理人未经授权注册商标

- relative ground for opposition/invalidity
- entitles trade mark proprietors to oppose/invalidate the registration of their marks as EUTMs by others
- additional remedy in invalidity – transfer of the EUTM
- 异议/无效的相对理由
- 授权商标权利人对他人注册的欧盟商标提出异议/请求宣告无效
- 宣告无效的附加救济措施——转让欧盟商标

Important case law– C- 89/18 (Mineral Magic)

重要判例

- **EUTM application ‘MINERAL MAGIC’** for goods in Cl 3, including cosmetics, make up EUTM
- opposed by US company on the basis of trade mark **‘MAGIC MINERALS BY JEROME ALEXANDER’** protected for face powder in Cl 3 in USA
- the applicant was their EU distributor
- **申请注册欧盟商标 “MINERAL MAGIC”**用于第三类商品，包括美容、化妆品
- 美国公司提出异议，理由是 **“MAGIC MINERALS BY JEROME ALEXANDER”** 系在美国受保护的商标（第三类商品—粉饼）
- 申请人曾是美国公司在欧盟的经销商

Article 8(3) EUTMR – objective of the provision – Court of Justice of EU 欧盟商标条例第8(3)条规定的目的——欧盟法院

“to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark, as those persons may **exploit the knowledge and experience** acquired during their business relationship with the proprietor and may therefore **improperly benefit from the effort and investment** which the proprietor himself has made”

C-89/18 (Mineral Magic)

要防止商标权利人的代理人或代表人滥用在先商标，因为该等代理人或代表人可能通过与权利人的业务往来，**获取相关知识和经验，利用权利人的劳动和投资成果谋取不正当利益**”

C-89/18 (Mineral Magic)



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Thank you