

TRENDS IN ASSESSING (BAD) FAITH

认定恶意注册商标：新趋势分享

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RECAP 总览

Bad Faith (Article 59(1)(b) EUTMR) is an absolute ground for invalidity of a EUTM:

- It can only be raised post registration
- By a third party (it is not examined ex-officio)

This remedy of Bad Faith does not cover situations such as:

- Unfair advantage taken from a reputed mark (Articles 8 (5) and 60(1)(a) EUTMR)
- Unauthorised fillings by agents of the owner (Articles 8(3) and 60(1)(b) EUTMR)

→ Which are separate relative grounds that may be invoked pre or post registration

恶意注册 (EUTMR 第 59(1)(b) 条) 是欧盟商标无效宣告请求的绝对理由:

- 只能在商标注册后提出
- 需由第三方提出无效宣告请求 (商标局不依职权审查)

不包括以下情形:

- 不当利用知名商标牟利的 (EUTMR 第 8 (5) 条、第 60(1)(a) 条)
- 代理机构未经权利人授权擅自申请注册的 (EUTMR 第 8(3) 条、第 60(1)(b) 条)

→ 上述情形可以在商标注册前或注册后作为无效宣告请求的相对理由

ASSESSMENT: OBJECTIVE - SUBJECTIVE ? 评价：客观—主观？

- The EUTM applicant's subjective intention should be determined by reference to the objective circumstances of the case – very fact based ?

欧盟商标申请人的主观意图应根据案件的客观情况进行判断——基于事实？

- **Overall assessment of the relevant factors and factual circumstances of each case has to be performed**

必须对个案要素和事实情况进行全面评价

FACTORS LIKELY TO INDICATE THE EXISTENCE OF BAD FAITH 可能表明存在恶意的要素

- Contractual acknowledgement of pre-existing right in the contested sign
- Preventing the marketing or sales of competing products
- Attempt to obtain the right to market goods under an identical trade mark
- Intention to free-ride on a person's reputation
- Power of representation
- No intention to use; Abusive filing strategy; Repeat filings of a mark
- 存在对涉争商标在先权利的合同确认
- 阻碍竞争产品的市场推广或销售
- 试图获得以相同商标销售商品的权利
- 意图攀附他人知名度
- 系商标代理人
- 无意使用；滥用申请程序；反复申请商标

FACTORS (UN)LIKELY TO INDICATE THE EXISTENCE OF BAD FAITH 未必表明存在恶意的要素

- Existence of cooperation, correspondence or a distribution agreement, contractual relations (concealed act) 存在合作关系、通信往来、分销协议 / 合同关联 (隐瞒行为)
- Business relationship with an intermediary who knew of the existence of the mark 与知悉在先商标的中间人进行业务往来
- ‘First-to-file’ principle “先申请”原则
- Commercial logic of expansion 业务拓展
- Knowledge of the previously reputed former mark, lost of right to the former renowned mark 知悉在先知名商标 / 丧失对在先知名商标的权利
- Revival and reuse of a previously renowned former mark 重新使用过往知名商标
- Infringement proceedings 侵权诉讼

OUTCOME 审查结果

- **BAD FAITH – trade mark invalid ex tunc BAD FAITH**
存在恶意——宣告商标无效
- **NO BAD FAITH – trade mark remains registered**
不存在恶意——商标依然有效
- **PARTIAL INVALIDITY?**
部分无效?

CHALLENGES 痛点

Chronology of events vs commercial logic vs (dis)honest intentions
事件时间表 vs 商业逻辑 vs (不)诚实意图

At the time of filling of the challenge application
以提出宣告无效请求为时间节点

PITFALLS

陷阱

Contradictory reasoning 15/02/2023, T - 684/21, Mostostal, EU:T:2023:68 (§§ 30, 31, 32, 36)
自相矛盾的推理

RECOMMENDATIONS

建议

FACTS vs REASONING

or

FACTS = REASONING

事实 vs. 推理

或

事实 = 推理

GRAND BOARD

上诉委全体讨论

R 1499/2016-G LA IRLANDESA 1943 (fig.) Upheld by the GC T-306/20 R
1499/2016-G IRELAND 1943

R 2445/2017-G Sandra Pabst R 2445/2017-G

R 368/2016-G INMOBILIARIA PORTIXOL (fig.) R 368/2016-G PORTIXOL
REAL ESTATE

T- 306/20, 29/6/2022 LA IRLANDESA T- 306/20, 6/29/2022



Bad faith is connected to the EUTM proprietor's subjective motivation, like dishonest intention or deceitful motive, determined by reference to objective circumstances (§ 55-58)

EUTM proprietor's intention was to continue the association with Ireland and benefit from the previous business relationship so to take undue advantage of the good image of Irish products (§ 70-72)

This is likely to distort the economic behavior of relevant consumers so the contested mark was filed in bad faith (§ 73-74)

是否存在恶意，与当事人主观动机相联。例如，应参考客观情况，判断是否存在不诚实意图或欺骗性动机 (§ 55-58)

当事人的意图，是继续保持其商标与爱尔兰的关联，不当利用过往业务关系，攀附爱尔兰产品的良好形象 (§ 70-72)

很可能扭曲相关消费者的经济行为；涉争商标系恶意注册 (§ 73-74)

MEASURES 措施

ORAL PROCEEDINGS

口头程序

21/04/2021, T - 663/19, Monopoly, EU:T:2021:211, repeat filings

QUALITY MEASURES 质量把关

IMPORTANT DECISIONS 重要决定

- [01/02/2023, R 904/2022 4, JUVÉDERM No bad faith – Commercial logic – Cancellation applicant acting in bad faith – Decision confirmed – Application for invalidity rejected – pending before the Court](#)

01/02/2023, R 904/2022 4, JUVÉDERM 权利人并非恶意注册—商业逻辑推断—无效宣告请求存在恶意—审查结果确认—驳回无效宣告请求—等待法院审理

- [20/01/2022, R 223/2021-2, bâoli BEACH \(fig.\) Alleged filing in bad faith in view of lack of intention to the mark and refiling of the mark to circumvent the proof of use](#)

20/01/2022, R 223/2021-2, bâoli BEACH (图)：涉嫌恶意注册——当事人缺乏商标使用意图，通过再次申请注册规避对商标使用证明的要求

REPORTS

报告

QUALITY MEASURES 质量把关

ADR – MEDIATION

- Complementary to decision taking path
- Voluntary
- Confidential
- Flexible
- Time-efficient
- Services provided on-line and in person

替代争议解决机制——调解

补充路径

自主

保密

灵活

省时

线上、线下调解

GOOD CANDIDATE 适用下列情形

- **A tailor-made approach**
- **Due to the emotional and personal aspects of the dispute, family-owned businesses or previous business partners**
- **Flexible and beneficial solutions for all parties**
- **定制化解决方案**
- **情感及个人方面原因，如争议涉及家族企业、过往商业伙伴等**
- **为各方提供灵活、有益的解决方案**



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Thank you