



# WELL-KNOWN TRADE MARKS (REPUTATION) AND BAD FAITH TRADE MARKS

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- 1. Well-known trade marks ( with reputation): Art. 8 (5) EUTMR**
- 2. Practical examples**
- 3. Trade marks filed in Bad Faith**



## Well-known trade marks (with reputation): Art 8(5) EUTMR

# ARTICLE 8(5) EUTMR TRADE MARKS WITH REPUTATION

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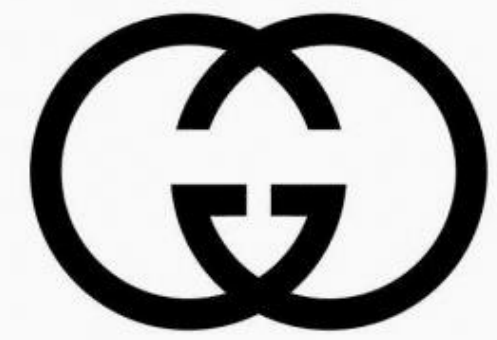
## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Article 8(5) EUTMR

Upon opposition by the proprietor of a registered earlier trade mark ..., the trade mark applied for shall not be registered where it is **identical with, or similar to, an earlier trade mark**, irrespective of whether the **goods or services** for which it is applied are **identical with, similar to or not similar** to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a **reputation** in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where **the use without due cause** of the trade mark applied for **would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark**.



GUCCI



amazon



adidas



Google

Microsoft

ZARA



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## Well-known trade marks (with reputation): Art 8(5) EUTMR

### REQUIREMENTS

Earlier registered TM which is reputed

Similarity of signs

Link between the signs/G&S

Risk of injury

No due cause

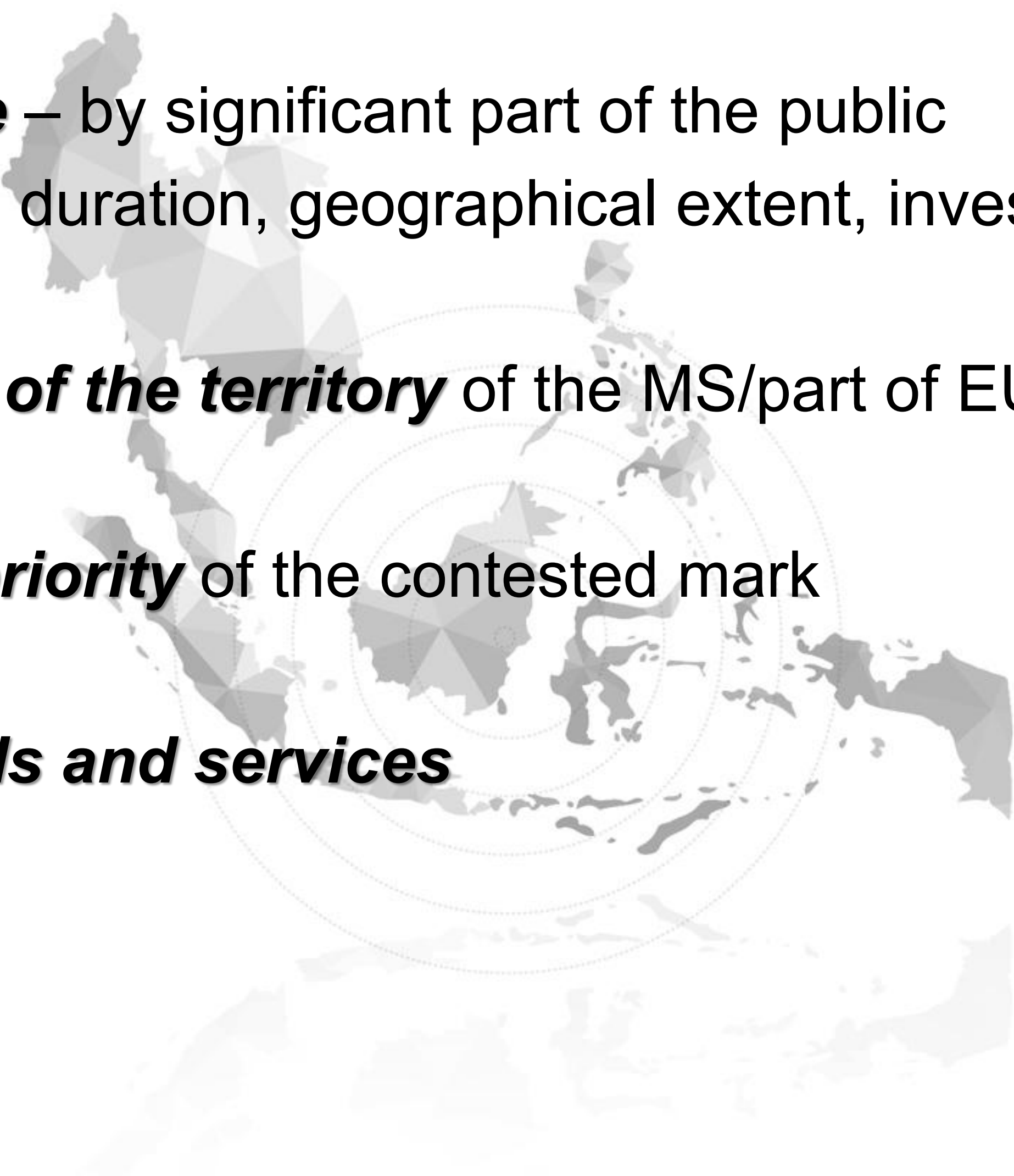
Cumulative

CONCLUSION





## Well-known trade marks (with reputation): Art 8(5) EUTMR

- 
- degree of **knowledge** – by significant part of the public  
(market share, intensity, duration, geographical extent, investment)
  - in **a substantial part of the territory** of the MS/part of EU
  - **before the date of priority** of the contested mark
  - for the **relevant goods and services**



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### EVIDENCE OF REPUTATION

- market surveys
- company profiles, annual reports, affidavits
- ranking, recognitions, awards, press articles
- statements from third parties
- sales turnover, market share
- invoices, delivery notes
- advertising expenditure, advertising and promotional material
- sponsorship of cultural, sports events, merchandising
- previous national court/EUIPO/CJ decisions, successful enforcement track record





## Well-known trade marks (with reputation): Art 8(5) EUTMR

### SIMILARITY OF THE SIGNS

- the **method** of assessment is **the same** as in Article 8(1)(b) EUTMR
- the **standard** of similarity is **not the same**
- a similarity which may not be sufficient to lead to a likelihood of confusion under Article 8(1)(b) EUTMR may be sufficient to bring the earlier reputed mark to mind
- but **if there is no similarity** at all, there **can be no infringement**
- reputation has no impact on similarity of signs

## Well-known trade marks (with reputation): Art 8(5) EUTMR

### LINK BETWEEN THE SIGNS – RELEVANT FACTORS

- *degree of reputation*
- *similarity of signs* (not to the point of confusion, but only to the extent that the contested mark calls the earlier reputed mark to mind)
- overlap of *public*
- *spill over beyond the relevant public* for the G/S of the earlier reputed mark (requires relevant public analysis)
- *proximity* of the market sectors
- classic tests for assessing similarity of G&S will not help to find the necessary connection between otherwise dissimilar G&S
- *inherent distinctiveness* of the earlier mark (particularly for dilution)





## Well-known trade marks (with reputation): Art 8(5) EUTMR



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Similarity of the signs

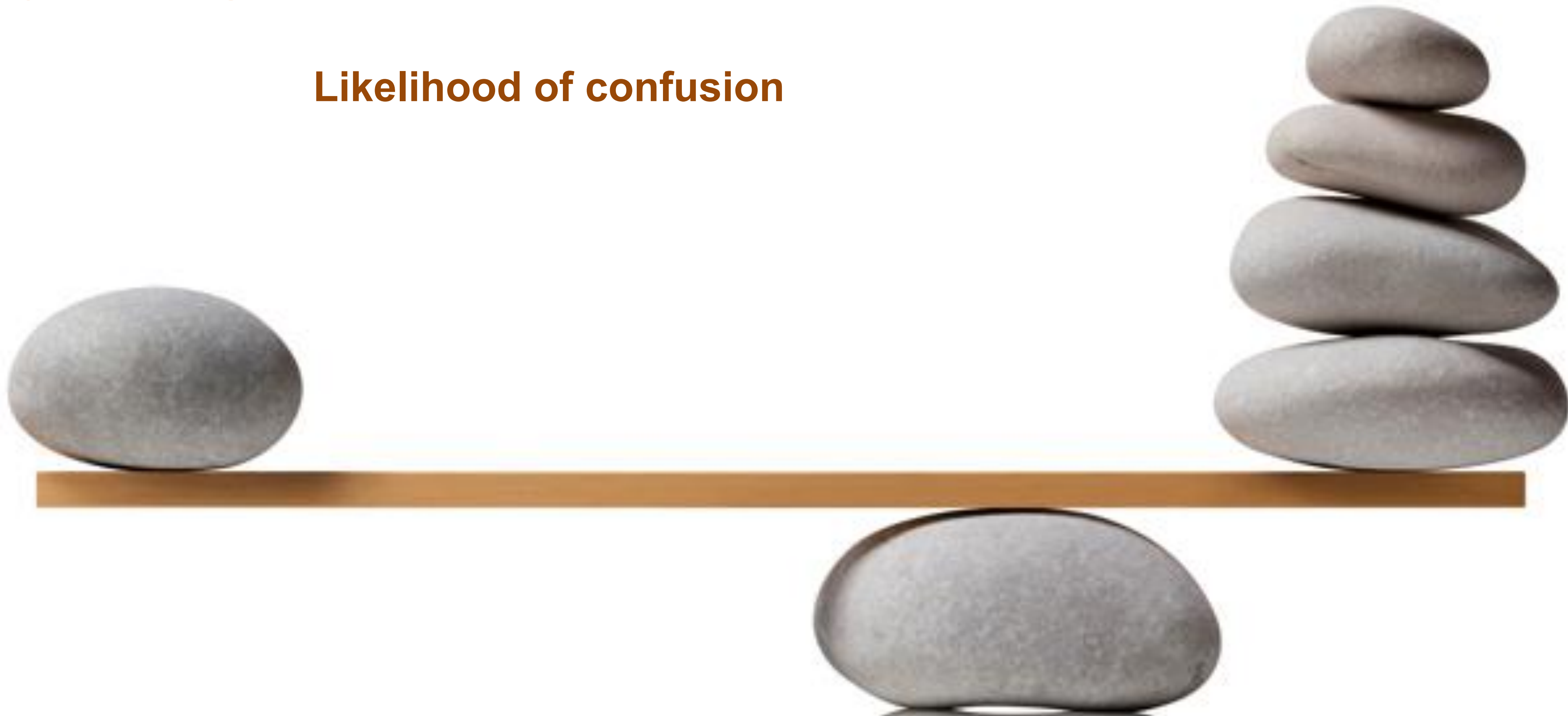




## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion



## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

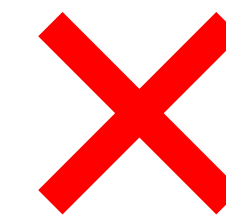
Proximity of the G&S





## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Proximity of the G&S



T-288/19, *IPANEMA (fig.) / iPANEMA (fig.) et al.*,





## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Proximity of the G&S



*T-509/19, Flügel / ... Verleiht Flügel et al*



## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

Proximity of the G&S

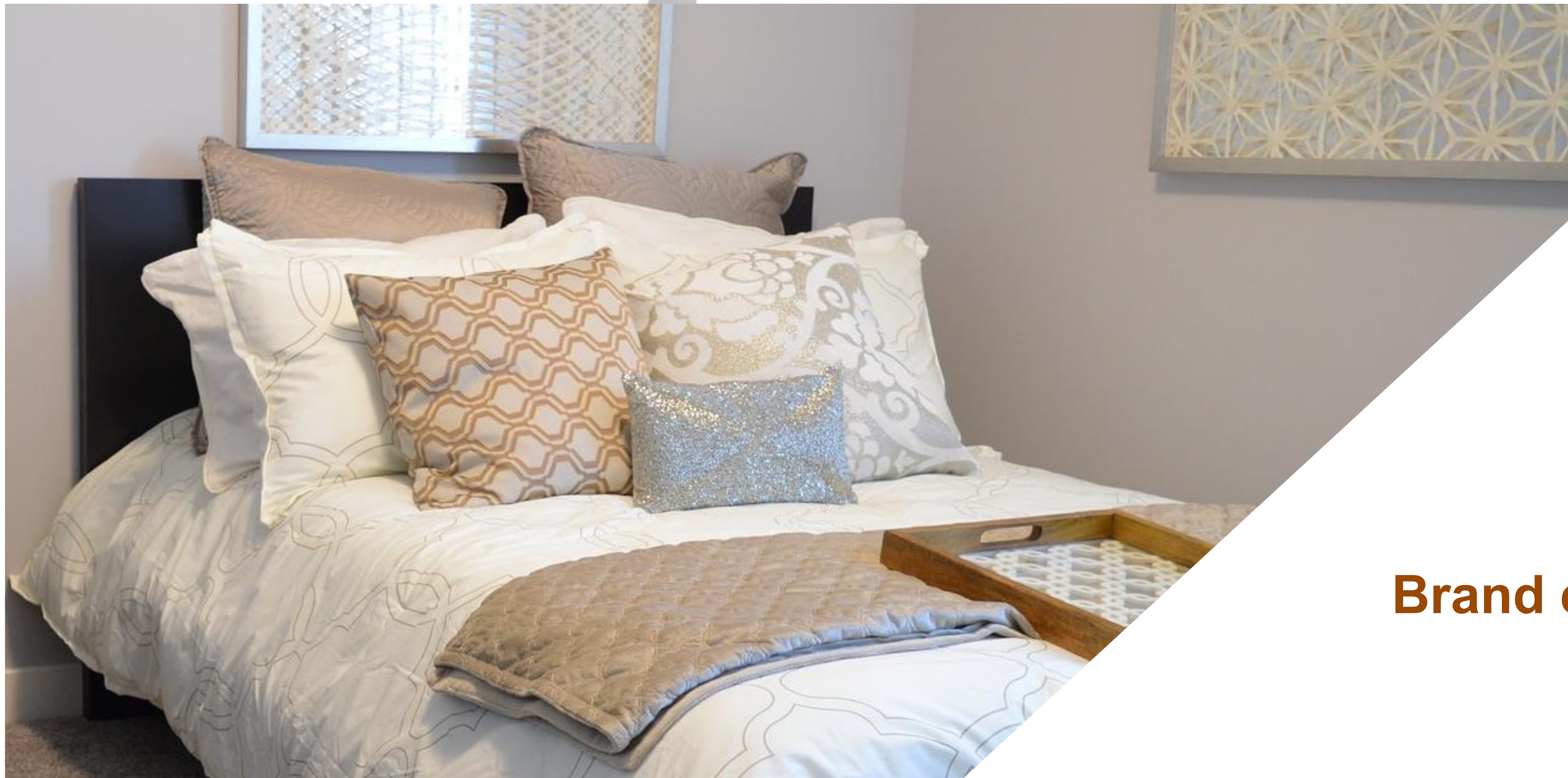
Market reality





## Well-known trade marks (with reputation): Art 8(5) EUTMR

**Market reality**



**Brand extension**





## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Market reality



### Merchandising



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Market reality



### Sponsorship



## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

Proximity of the G&S

Market reality

Relevant public



## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

Proximity of the G&S

Market reality

Relevant public

**Inherent distinctiveness**





## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

Proximity of the G&S

Market reality

Relevant public

Inherent distinctiveness

**Reputation and its strength**



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Reputation and its strength

The fact that the marks are similar and that the earlier mark has an exceptional reputation **cannot automatically be sufficient** for a link between those marks to be found (§ 71).

This is the case **even if it is established that the specialised public** targeted by the goods protected by the contested mark **is aware of the earlier mark**, whose reputation goes beyond the public of the goods covered by the earlier mark (§ 85).

*10/03/2021, T-71/20, Puma-system / PUMA (fig.), EU:T:2021:121, § 71, 85  
Against machine tools, saws etc.)*

**PUMA**





## Well-known trade marks (with reputation): Art 8(5) EUTMR

Similarity of the signs

Likelihood of confusion

Proximity of the G&S

Market reality

Relevant public

Inherent distinctiveness

Family of marks

Reputation and its strength



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### Family of marks

Case reference: T-518/13 MACCOFFEE



McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN, derived from the McDONALD'S



## Well-known trade marks (with reputation): Art 8(5) EUTMR





## Well-known trade marks (with reputation): Art 8(5) EUTMR

# ARTICLE 8(5) EUTMR TRADE MARKS WITH REPUTATION

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## EXAMPLES





## Similarity of the signs

Case reference: T-398/16

**Earlier mark**



**Contested mark**



# Similar appearance?



## Similarity of the signs

Case reference: T-201/20

**Earlier mark**



**Contested mark**



# Similar?





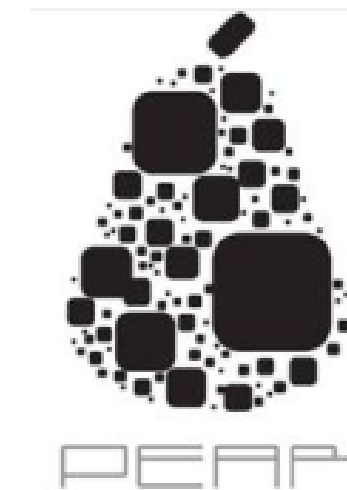
## Similarity of the signs

Case reference: T-215/17

**Earlier mark**



**Contested mark**



# Conceptually similar?



## Similarity of the signs

Link?

### Earlier mark

STAR TREK

Reputed for *cinematographic films*

### Contested mark



Nutritional supplements



Opponent demonstrated a high degree of reputation and the use of its mark for various merchandising articles





## Similarity of the signs

**LINK ESTABLISHED – R1328/2019-2**



### Earlier mark

**STAR TREK**

Reputed for *cinematographic films*

### Contested mark



Nutritional supplements



Opponent demonstrated a high degree of reputation and the use of its mark for various merchandising articles



## Well-known trade marks (with reputation): Art 8(5) EUTMR

### THREE TYPES OF INJURY

Unfair advantage taken of the  
distinctiveness / reputation of the  
earlier mark (free-riding)

Detriment to the distinctiveness of the  
earlier mark (dilution)

Detriment to the repute of the earlier  
mark (tarnishment)

Alternative

CONCLUSION





## Taking unfair advantage of distinctiveness or repute

Case reference: T-428/18

### Earlier mark

McDONALD'S et al

### Contested mark



*Träumen zum kleinen Preis!*

## Risk of unfair advantage



## Taking unfair advantage of distinctiveness or repute

Case reference: T- 215/03

### Earlier mark



Reputed for *tobacco products*

### Contested mark



Foodstuffs in CI 29, 30 and 31

# Detriment to distinctiveness established





## Taking unfair advantage of distinctiveness or repute

### Earlier mark



Reputed for *mineral waters*

### Contested mark

SPA<sup>ce</sup> NK

*Scourising and polishing  
preparations and substances*

# Detriment to repute established



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## Bad faith trade marks

# TRADE MARKS FILED IN BAD FAITH



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## Bad faith trade marks

### What is Bad Faith?

- **No definition in law**, but clarified by case-law.
- Means **dishonest intention** when applying for a trade mark.
- Behaviour that **departs from honest commercial practices**.
- Determined using **objective facts**



## Bad faith trade marks

### Two main facets/ cases

- **Misappropriation of rights of a third party**  
Targeting someone's existing rights.
- **Abuse of the trade mark system**  
Using the system for purposes outside a trade mark's real function (indicating origin).





## Bad faith trade marks

### How is it assessed?

- **Mandatory factor:**
  - ✓ Dishonest intention.
- **Non-mandatory factors:**
  - ✓ Knowledge of existing rights.
  - ✓ Similarity of signs.
  - ✓ Past relationship between parties.
  - ✓ Lack of commercial logic.
  - ✓ Request for payment to surrender mark.
  - ✓ Pattern of abusive filings.



## Bad faith trade marks

### When (the intention) is it evaluated?

- **At the time of filing** the application.
- Earlier and later facts may help to **understand intent**.
- **Presumption of good faith** – **burden of proof is on the challenger**.





## Bad faith trade marks

### Illustrative examples

- **Neymar** – Applicant filed footballer's name to profit from reputation

T-795/17 - Moreira v EUIPO - Da Silva Santos Júnior  
(NEYMAR)





## Bad faith trade marks

### Illustrative examples

- **Simca** – Car brand re-filed to ride on residual reputation of historic mark.

#### *Factors:*

- ✓ The applicant's knowledge that the third party is using an earlier identical/similar right
- ✓ Lack of honest commercial logic behind the filing of the contested trade mark
- ✓ Chronology of events leading up to the filing of the contested trade mark

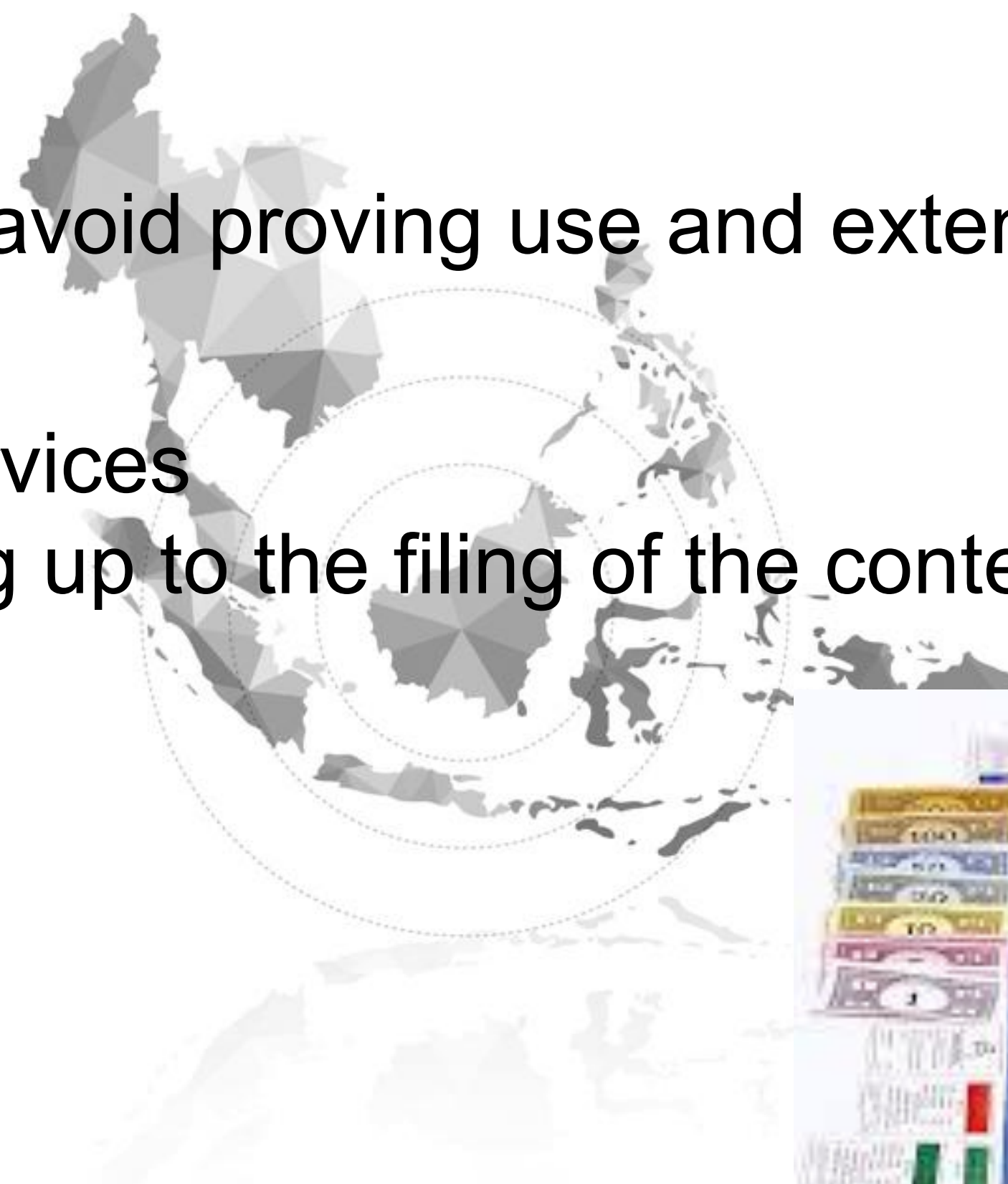




## Bad faith trade marks

### Illustrative examples

- **Monopoly** – Re-filed mark to avoid proving use and extend grace period
  - ✓ Identical or similar goods/services
  - ✓ Chronology of events leading up to the filing of the contested trade mark



## Bad faith trade marks

### Why it matters

- Prevents **unfair competition**.
- Protects the **integrity of the trade mark system**.
- Ensures trade marks serve their **true function** – identifying origin

More information and cases in **CP13 – TM applications made in Bad Faith**







# THANK YOU

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Presentation			
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Approved by owner	-		
Authors	-		
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Contributors	-		
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