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Bad Faith @BOIP

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Agenda

	First BOIP cases	
	Bad faith? Bad faith! Or?	
	Practical considerations	
	BOIP or court, how to decide?	
	2022, pending cases	
	Q & A	





Poll 1... Just checking

Have you been involved, directly or indirectly, in a Bad Faith procedure before BOIP or are you considering to start one?



A: Yes

B: No

Don't worry, the other participants will not see who is giving which answer. Confidentiality is guaranteed, you will not be spilling the beans.





Bad faith, what does that mean?

- No real definition
 - Neither regulation nor directive provide a definition of the concept of 'bad faith'.
 - It is an autonomous concept of EU law that must be interpreted in the context of directive and regulation
- Dishonest intentions of applicant
 - Meaning of the words in "normal language"





Bad faith, what does that mean?

- Dishonest intentions of applicant
 - Applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

- To be determined by the arguments and supporting evidence brought forward by parties
 - All factual circumstances of the case
 - Commercial logic behind an application
 - The party climbing the ladder highest will win



A party has 20 TM registrations “on the shelf” because:

1. "I have linked them to corresponding domain names and I still want to sell the combination to Asian parties who want to enter the European market".
2. "hopefully a buyer or licensee will come along, then I can earn my pension with that".
3. "I managed to license brands before and these are attractive names. Hopefully it will work again".
4. "my company wants to launch eight new products and these 20 names remained after an initial screening. I thought: I'll file them and hopefully 10 will be left for me to choose from."





Poll 2

Which applications were made in bad faith?

1. Linked domains + intention to sell in Asia
2. Hope to sell to earn pension
3. I've made money on selling brands earlier. Maybe...
4. Claim for protection given market ambitions



What do you think?

- A. Case #1
- B. Cases # 1 and 2
- C. Cases # 1, 2 and 3
- D. All these examples are clearly bad faith applications, these registrations should be cancelled



First cases... how is this working out at BOIP?

- | | | | | |
|----|------------|---------|------------------------|------------------------|
| 1. | 18-12-2019 | 3000100 | Jetten Jachtbouw | TM cancelled |
| 2. | 20-10-2020 | 3000105 | ONEWORLD | TM cancelled |
| 3. | 24-11-2020 | 3000092 | PIZZATALIA ORIGINAL | TM cancelled |
| 4. | 29-04-2021 | 3000109 | BOBO BIRD | Case rejected |
| 5. | 28-05-2021 | 3000191 | Boos op autoveiligheid | Tm cancelled |
| 6. | 02-06-2021 | 3000251 | JUFFROUW VAN ZANTEN | Case rejected |
| 7. | 25-08-2021 | 3000210 | Nielson | TM partially cancelled |





First cases... Bad faith?

- | | | | | |
|----|------------|---------|------------------------|-------------------|
| 1. | 18-12-2019 | 3000100 | Jetten Jachtbouw | BF claim rejected |
| 2. | 20-10-2020 | 3000105 | ONEWORLD | Sustained |
| 3. | 24-11-2020 | 3000092 | PIZZATALIA ORIGINAL | BF claim rejected |
| 4. | 29-04-2021 | 3000109 | BOBO BIRD | BF claim rejected |
| 5. | 28-05-2021 | 3000191 | Boos op autoveiligheid | Sustained |
| 6. | 02-06-2021 | 3000251 | JUFFROUW VAN ZANTEN | BF claim rejected |
| 7. | 25-08-2021 | 3000210 | Nielson | BF claim rejected |

- All in Dutch, first decision in French is expected
- 5/7 times BOIP found no bad faith





Cases: Jetten Jachtbouw

Grounds: 1. Prior registration; 2. Bad faith.

Mainly civil law: was the trademark part of the bankruptcy and was an agreement including a non-filing article play binding?

Case decided upon prior registration, bad faith not judged

But BOIP notices: BOIP is not authorised to judge contractual agreements that are ruled by national law (Dutch Civil Code)

MH: it seems the defendant thought it could remove the subject registration because of interpretation of a contract and in a counterclaim ("in reconventie"). Both actions are not possible in proceedings with BOIP





Cases: Oneworld (1)

Ground: Bad faith.

BOIP: Claimant is successful in evidencing bad faith as the Defendant

- has an illogical trademark strategy
- owns hundreds of TM filings without an indication and unlikely these marks are put into use
- involved in many TM proceedings without clear interest
- abuses the trademark system and frustrates trademark owners
- has no i.t.u. his TM's according to TM functions

And BOIP continues, that Defendant:

- did not provide any concrete counter argument
- argument that a TM is a desirable object with potential is insufficient
- no plans, no i.t.u.





Cases: Oneworld (2)

Appeal by Defendant with BCJ withdrawn recently.



MH: this is the widely discussed Gleissner bad faith case. Claimant did a thorough job and BOIP makes it very clear that there is no room for such trademarks. For future cases: do your homework by evidencing the bad faith and as long as Gleissner cannot evidence a credible i.t.u., all his marks seem to be under potential attack.



Cases: Pizzatalia

Grounds: 1. Prior registration; 2. Bad faith.



Case decided upon prior registration (for which evidence of use was provided), bad faith not judged. But BOIP notices: evidence would have been insufficient





Bad faith before March 2019

Old article 2.4, sub f, BCIP

Bad faith application, in particular when:



1°. a filing in the knowledge or in inexcusable ignorance of normal use in good faith of a similar trademark for similar goods or services by a non-consenting third party on Benelux territory during the last three years;



2°. a filing in the knowledge, resulting from direct relationships, of the normal use in good faith of a similar trademark for similar goods or services by a third party outside Benelux territory during the last three years, unless the third party consents or the said knowledge was acquired only subsequent to the start of the use which the applicant has made of the trademark on Benelux territory;





Application by agent/ representative

ECJ: Mineral Magic. Article 2.2ter, par 3 BCIP

- Prevent misuse by those who 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.
- Therefore the concepts of 'agent' and 'representative' must be interpreted in such a way as to cover all forms of relationship based on a contractual agreement under which one of the parties represents the interests of the other
- With the result that it is sufficient, for the purposes of the application of that provision, that there is some agreement or commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark.





Cases: Bobo Bird

Ground: Bad faith.

Dutch dealer of BOBO BIRD wooden watches faced a cancellation action by the German TM owner (with TM rights in Germany).

Defendant: I sell official BOBO BIRD watches which I purchase from China. The Chinese seller provided consent to the TM registration. It seems I'm involved in a dispute between the German TM owner and his Chinese manufacturer.

BOIP: knowledge: yes. Bad faith: no.

BOIP: good faith is the starting point. Claimant did not provide sufficient evidence to rule otherwise.

"It cannot be established that the (subjective) intention of the Defendant was to harm the interests of third parties in a manner inconsistent with honest practices. After all, the Defendant is using the mark for its own benefit and, in addition, it states that it has never offered the mark for sale to the applicant or to third parties, which has also not been alleged by the applicant."





Cases: Boos op autoveiligheid

Grounds: 1. Bad faith 2. prior well known TM (6bis ParisC)

Claimant is Belgian institute for technical car tests and driving license examinations.

Defendant registered the TM (including similar graphic's) as a means of protest. Parties have encountered one another in Court and in opposition proceedings.

BOIP: 1. knowledge: yes. Bad faith: yes.

No concrete i.t.u for vehicles. Intention to block Claimant.

MH: what if Defendant had registered its mark in relation to lobbying ...?



Cases: Juffrouw van Zanten

Ground: Bad faith.



Disagreement who has prior use.



BOIP: bad faith not evidenced. And adds: as far as prior tradename rights are invoked, a court case may have been a better option.





Cases: Nielson

Grounds: 1. no genuine use 2. misleading 3. bad faith

Claimant is the well known Dutch singer Nielson, who takes action against a TM registration of a third party.



BOIP concludes there is genuine use for part of the class 41 services. This makes that there seems a commercial logic for this use and thus no bad faith. The fact that Defendant contacted Claimant to seek a commercial solution is, on itself, no deciding bad faith indicator.



MH: the fact that someone else is less successful does not make it bad faith when he files for TM protection. Interesting to read when Claimant explains what a Dutch “singer-songwriter” looks like: “een zanger van zelfgeschreven ritmische Nederpopnummers, die zichzelf begeleidt op akoestische gitaar.”





Summarizing (1)

1. Not all bad faith issues involve a Gleissner entity;
2. Most cases are just regular business disagreements
3. But for which a cancellation action based on bad faith with BOIP is not always the (best) remedy.
4. Simply because its not bad faith (according to the law)
5. And because there is a heavy burden of evidence
6. Depending on the matter a case before a court may be a better option





Summarizing (2)

When determining to go to BOIP or a Court: possibilities with the Court much wider: consider what you need.



- To which actions of the other side do you object?
A trademark registration only, or use as well?



- On which grounds do you object?
Bad faith only, or combined with other rights? When it involves business agreements/contractual issues: go to the Court



- What measures do you wish to be taken?
With BOIP, only cancellation of the registration can be achieved

Poll 3

Which applications were made in bad faith?

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First cases

1.	18-12-2019	3000100	Jetten Jachtbouw	Appeal pending
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3.	24-11-2020	3000092	PIZZATALIA ORIGINAL	Appeal pending
4.	29-04-2021	3000109	BOBO BIRD	Appeal pending
5.	28-05-2021	3000191	Boos op autoveiligheid	Final
6.	02-06-2021	3000251	JUFFROUW VAN ZANTEN	Appeal pending
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- All in Dutch, first decision in French is expected
- 5/7 times BOIP found no bad faith
- 5/7 BOIP cases may still be corrected





Practical considerations

- Position of claimant vs defendant
 - Claim vs counter claim
 - The claimant has a heavy burden
 - proof defendants intentions
 - Defendant may consider trying to show his good intentions

- What to file, and what not to file
 - Paperwork, numbers
 - Overview helps, all involved, especially submitter (!)
 - Rule DG on what to introduce



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Q & A



Thank you for joining!

- Next week:
Ellen Gevers and Pieter Veeze on new types of TMs
- PE Points
 - Confirmation e-mail
 - Code word (BMM)
- Survey, please fill it out



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Trademarks
Intellectual Patents
Property Designs
Copyright Ideas



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Case law mentioned

- ECJ, Lindt, 11 June 2009, C-529/07, ECLI:EU:C:2009:361
- ECJ, Malasia Dairy, 27 June 2013, C-320/12, ECLI:EU:C:2013:435
- ECJ, Koton, 12 September 2019, C-104/18 P, ECLI:EU:C:2019:724
- ECJ, Sky, 29 January 2020, C-371/18, ECLI:EU:C:2020:45
- ECJ, Mineral Magic, 11 November 2020, C-819/18 P, ECLI:EU:C:2020:902

