

European Union Intellectual Property Network Published Common Communication on the Common Practice on Trademark Applications Made in Bad Faith

5 Jul 2024

European Union Intellectual Property Network ("EUIPN") published Common Communication on the Common Practice ("CP13") on trademark applications made in bad faith. CP13 serves as guidance and aims to ensure that the relevant authorities, including member states' Intellectual Property Offices, come to a uniform and predictable outcome when assessing bad faith.

The document was made publicly available through the release of the Common Communication on 22 March 2024, signaling the beginning of the 3-month implementation period by member states' Intellectual Property Offices.

The CP13 includes an agreement on common factors for the assessment of bad faith in trademark applications and contains the following:

- 1- The preliminary section includes common understandings of certain key notions that are important when assessing whether there was bad faith on the part of the applicant when filing a trademark application. Specifically, it outlines the common understandings of the terms 'applicant', 'claimant', 'earlier right', and 'contested trademark', which have been developed with the aim of ensuring a harmonized and consistent application of the principles of the Common Practice and to provide common guidance on how these notions should be understood.
- 2- Following section moves on to differentiate between two non-exhaustive facets of bad faith: (1) the misappropriation of the right/s of the third party: where the applicant is targeting the interests of a specific third party; and (2) the abuse of the trade mark system: where, even if a specific third party is not being targeted, the applicant applied for the contested trade mark for purposes other than those falling within the essential functions of a trade mark. Following a description of each facet, illustrative examples are provided from case-law, including some examples of cases where, in view of the specific facts of the case, bad faith was not found.
- 3- Next section sets out general rules for the assessment of bad faith in trademark applications. The first subsection confirms that there is a presumption of good faith on the part of the applicant until proof to the contrary is adduced, and that in bad faith cases, the initial burden of proof is on the claimant. The second subsection provides guidance as to the relevant point in time for determining whether there was bad faith, which is the time of filing of the application for registration. The last subsection covers the topic of 'the applicant' in bad faith cases.
- 4- The comprehensive section titled Common Factors for the Assessment of Bad Faith in Trademark Applications defines the applicant's dishonest intent, which is the mandatory factor and other non-mandatory factors.
- 5- The next section titled 'scenarios of bad faith in trademark applications' refer to concrete situations where several factors (relevant for the assessment of bad faith), need to appear and interplay in order to reach the conclusion that there was bad faith on the part of the applicant.
- 6- Finally, the last section provides guidance as to the extent of a refusal/cancellation due to bad faith. It establishes that bad faith will, in general, exist in respect of all the contested goods and/or services for which the contested trademark was applied for or registered.

The CP13 is the outcome of consultations and contributions from EUIPN stakeholders over the past two years. The Working Group, composed of experts from member states' Intellectual Property Offices, the EUIPO, and User Associations, played a central role in the drafting of the document.

The CP13 is available on the EUIPN website from the [link](#) in 23 EU languages.

Related Practices

- [Trademarks](#)
-

Related Attorneys

- [EZGI BAKLACI GÜLKOKAR, LL.M.](#)
 - [MERVE ALTINAY ÖZTEKİN](#)
-