



## 5<sup>th</sup> IP Case Law Conference

29 - 30 April 2024

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Latest achievements: The harmonisation of practice on bad faith (CP13) and public policy and morality (CP14)

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## LAYERS OF HARMONISATION IN EUROPE



## CONVERGENCE OF PRACTICES: VISION AND OBJECTIVES

“To establish and communicate **clarity, legal certainty, quality** and **usability** for users of the IP system.”



## COMMON PRACTICES IMPLEMENTED TO DATE

COMMON PRACTICES	N° IMPLEMENTATIONS
CP1. Acceptability of Classification Terms and the General Indications of the Nice Class Headings	26
CP2. Interpretation of Scope of Protection of Nice Class Headings (formerly Implementation of 'IP Translator')	26
CP3. Distinctiveness - Figurative Marks Containing Descriptive/Non-Distinctive Words	24
CP4. Scope of Protection of Black and White (B&W) Marks	23
CP5. Relative Grounds – Likelihood of Confusion (Impact of Non-Distinctive/Weak Components)	25
CP6. Graphic Representation of Designs	22
CP7. Harmonisation of Product Indications	26
CP8. Use of a Trade Mark in a Form Differing from the one Registered	26
CP9. Distinctiveness of Three-Dimensional Marks (Shape Marks) Containing Verbal and/or Figurative Elements when the Shape is Not Distinctive in Itself	26
CP10. Criteria for Assessing Disclosure of Designs on the Internet	22
CP11. New Types of Marks: Examination of Formal Requirements and Grounds for Refusal	25
CP12. Evidence in Trade Mark Appeal Proceedings: Filing, Structure and Presentation of Evidence, and the Treatment of Confidential Evidence	19
CP13. Trade Mark Applications Made in Bad Faith	25 (in progress)
CP14. Trade Marks Contrary to Public Policy or to Accepted Principles of Morality	26 (in progress)

## CP13: TRADE MARK APPLICATIONS MADE IN BAD FAITH

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## CP13: TRADE MARK APPLICATIONS MADE IN BAD FAITH

Why was the CP13 Common Practice needed?



The **concept of bad faith** in trade mark applications is **not defined, delimited or described** in EU trade mark legislation



**EU case-law** has established some guidance on this topic  
**Open to interpretation**



The **EU Trade Mark Directive (TMD)** made it compulsory for all Member States to establish **administrative revocation and invalidity proceedings** as from 14 January 2023 (Arts. 45 and 54)



As a result of the combined effects of **Article 4(2) and Articles 45 and 54 TMD**, by that date, MS IPOs had to assess bad faith, **at least, as an absolute ground for invalidity.**

## CP13: TRADE MARK APPLICATIONS MADE IN BAD FAITH

### 1 Key notions that appear in bad faith cases



- 'Applicant'
- 'Claimant'
- 'Earlier right'
- 'Contested trade mark'

### 2 The general notion of bad faith in trade mark applications



- Common understanding of the general notion of bad faith
- Common understanding of dishonest intention
- Different facets of bad faith: (i) Misappropriation of the rights of the third party, (ii) Abuse of the trade mark system

### 3 General rules for the assessment of bad faith in trade mark applications



- Burden of proof in bad faith cases
- The relevant point in time for determining whether there was bad faith
- 'The applicant' in bad faith cases

### 4 Common factors for the assessment of bad faith in trade mark applications



- Mandatory factors
- Non-mandatory factors

### 5 Scenarios of bad faith in trade mark applications



- Scenarios regarding the misappropriation of the right/s of the third party facet
- Scenarios regarding the abuse of the trade mark system facet

CP14: TRADE MARKS CONTRARY  
TO PUBLIC POLICY OR TO ACCEPTED  
PRINCIPLES OF MORALITY

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## CP14: TRADE MARKS CONTRARY TO PUBLIC POLICY OR TO ACCEPTED PRINCIPLES OF MORALITY

Why was the CP14 Common Practice needed?



The TMD does **not include a definition** of public policy and accepted principles of morality

**Nor an indication of the criteria for its assessment**



**EU case-law** has established some guidance on this topic (e.g. *Fack Ju Göhte*)

**Open to interpretation**



**Increase in the number of trade mark applications related to well-known events** (COVID-19, BLACK LIVES MATTER, *Je suis Charlie*, Brexit)

## CP14: TRADE MARKS CONTRARY TO PUBLIC POLICY OR TO ACCEPTED PRINCIPLES OF MORALITY

### 1 Common understandings of



- Public policy
- Accepted principles of morality

### 2 Assessment of signs contrary to public policy and/or to accepted principles of morality



- Potential scenarios
- Relevant date for the assessment
- Criteria and factors

### 3 Overlap between public policy and accepted principles of morality

### 4 Freedom of expression

### 5 Signs that could fall under Art. 4(1)(f) TMD



- Illicit substances
- Public safety risks
- Religious or sacred nexus
- Vulgar elements (swear words, offensive gestures, etc)
- Obscenity, sexuality and innuendo
- Disparaging or slurring a particular group
- Criminal activities
- Well-known tragic events
- Historical figures, national/EU symbols and personalities held in high esteem

## CP13 AND CP14: PUBLICATION AND IMPLEMENTATION

### CP13: TRADE MARK APPLICATIONS MADE IN BAD FAITH

✓ **PUBLICATION DATE**  
 **22/03/2024**

✓ **IMPLEMENTATION DATE**  
(max. 3 months after publication)

 **From 22/03/2024 to 22/06/2024**

✓ **WEBINAR**  
 **2024**

[CP13 webpage](#)



### CP14: TRADE MARKS CONTRARY TO PUBLIC POLICY OR TO ACCEPTED PRINCIPLES OF MORALITY

✓ **PUBLICATION DATE**  
 **19/04/2024**

✓ **IMPLEMENTATION DATE**  
(max. 3 months after publication)

 **From 19/04/2024 until 19/07/2024**

✓ **WEBINAR**  
**Link to past [webinar](#) 'Public policy and morality in trade marks: Gauging badness'**

 **New webinar in 2024**

[CP14 webpage](#)



## BENEFITS OF COMMON PRACTICES



### Increased legal certainty

*More consistent and predictable outcomes of the examination*



### Clarity and transparency

*CPs available publicly in 23 EU languages*



### Quality and usability

*Clear and detailed criteria, user-friendly and reflect market realities*



### Time and cost savings

*Reduction in application processing*

**THANK YOU!**