



Jagiellonian University
Department of Law and Administration

Master's Programme
in Intellectual Property and New Technologies

**IN SEARCH OF A COMMON STANDARD
FOR BAD FAITH IN TRADEMARK LAW:
COMPARATIVE STUDY OF EUROPEAN, POLISH
AND CHINESE TRADEMARK LAW**

Sylwia Kaszuba

1189609

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under the supervision of dr hab. Justyna Ożegalska-Trybalska

Abstract

Growing economic cooperation and trade between China and EU countries, including Poland, increase the importance of trademark protection. However, the territorial nature of trademark law causes differences in local legal systems which might result in difficulties in effective protection of trademarks at all stages of the supply chain. One of the greatest threats in this regard might be the registration of trademarks in bad faith. Although many legal provisions of trademark law worldwide refer to bad faith, the concept is not defined by any legislator and indication of the meaning of the given concept remains the task of the case law. Which is why its understanding might vary from one legal order to another. Therefore, the idea to create a common standard for bad faith in trademark law based on the deep analysis of given jurisdictions and comparative study of European, Polish and Chinese systems may be the answer for the problem and current increased demand for cross border trademark protection. The thesis is divided into four chapters and in each chapter relevant materials for all three jurisdictions are presented. The first chapter provides general aspects of the trademarks which are important from the perspective of bad faith. The second chapter aim to find normative definition of bad faith by analyzing trademark law provisions and guidelines provided by relevant patent office's addressing this concept. The third chapter consists of in-depth analysis of case-law regarding bad faith divided into corresponding matters. The last, fourth chapter aims to provide common standard of the concept of bad faith. All the conclusions presented in the last part of the thesis are based on the analysis made in previous chapters.

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Abbreviations

CJEU	The Court of Justice of the European Union
CNIPA	China National Intellectual Property Administration
Directive (EU) 2015/2436	Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks
EU	European Union
EUIPO	European Union Intellectual Property Office
EUTM	European Union trade mark
EUTMR	Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
GIs	Geographical Indications
Industrial Property Act	Act of 30 June 2000 Industrial Property Law as amended by act of 23 January 2004 and act of 29 June 2007
Madrid Agreement	Madrid Agreement Concerning the International Registration of Marks (as amended on September 28, 1979)
Madrid Protocol	Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)
Madrid System	The Madrid System for the International Registration of Marks
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on September 28, 1979)
Paris Convention	Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979)
PPO	The Polish Patent Office
Regulation (EU) 2015/2424	Regulation (EU) 2015/2424 of the European Parliament and the Council of 16 th December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)
The Trademark Law of the PRC	the Fourth Amendment of the Trademark Law of the People's Republic of China as of 1 November 2019
TRIPS Agreement	Agreement on Trade-Related Aspects of Intellectual Property Rights
TRAB	The Trademark Review and Adjudication Board
TTAB	The Trademark Trial and Appeal Board
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

Introduction

Trademarks are distinctive signs that can distinguish the goods or services on the market originating from different enterprises. They have an important role in an integrated market-based economy and global business.¹ Trademarks play a vital part in building up and maintaining the company's image and goodwill in the mind of consumers not only locally, but also worldwide. As valuable assets, they are protected by intellectual property rights. Growing economic cooperation between China and EU countries, including Poland², increase the importance of trademark protection. Development of trade in goods and services between these regions as well as enhanced exchange of information in the era of globalization and One Belt, One Road Initiative³, are great opportunity for many businesses. Nevertheless, entities involved in international trade always have to take into account the risk involved. Bad faith trademark application remains a great concern in this regard. Not efficient trademark protection strategy might obstruct the smooth running of the business and significantly disrupt company operations. The territorial nature of trademark law causes differences in local legal systems which might result in difficulties in effective protection of trademarks at all stages of the supply chain. From my point of view, as international trade practitioner, being the target of bad faith trademark registration might involve much greater risks than those associated with counteroffering. Many entrepreneurs believe that effective trademark protection is important only for those who plan to export and sell goods in foreign territory. Nevertheless, it is not true. This misconception cause that unaware importers are much more likely to face the consequences of disregarding the protection of intellectual property. Having in mind that in 2021, right after Germany, the most goods to Poland were imported from China⁴ ensuring effective trademark protection in the territory of both partner countries is of crucial importance. When a trademark is registered in bad faith administrative, civil, or even criminal actions to stop true proprietor from producing, selling, or exporting goods in given territory can be invoked. Currently trademark squatters target not only large companies but also small and medium enterprises. While examining this issue, it is

¹ K.Sangsuvan, Trademark Squatting. Wisconsin International Law Journal 2003, vol.31 no. 2, p. 253-254.

² China-EU - international trade in goods statistics, accessed on 07.02.2023 at: https://ec.europa.eu/eurostat/statistics-explained/index.php?title=China-EU_-_international_trade_in_goods_statistics

³ The Belt and Road Initiative known in China s One Belt One Road (一带一路) is a global infrastructure strategy adopted by Chinese government in 2013 by which the two ends of Euroasia, as well as Africa and Oceania are being connected via land and maritime networks.

⁴ Poland Imports by Country, accessed on 08.02.2023 at: <https://tradingeconomics.com/poland/imports-by-country>

important to mention that in 2021 according to WIPO, 65% of all trademarks filling in the world occurred in China.⁵ British Embassy in Beijing announced that bad-faith trademark application is the single most common business irritant affecting hundreds of marks each year across all industry sectors.⁶ The risk associated with bad faith trademark registration might affect exporters of goods, which are not allowed to export to, sell or distribute their own goods if their trademark was earlier registered by another person or entity in the territory of a given country. In addition, in China shopping centers in prestigious locations are reluctant to rent a space to the company without the right to a trademark. Certificate or license confirming the rights to the mark in China is often a prerequisite for opening a store. The same requirements apply to online stores such as Alibaba, Tmall or Jindong. Companies exhibiting at the international fairs are also exposed to the bad faith trademark registration. Many entrepreneurs come to the fair in search of interesting products and new business ideas. Having a technical catalog and a sample of a product, it is very easy to steal an unregistered brand. Trademark squatter, after obtaining exclusive trademark rights in a specific territory may legally start mass-production and sale of the goods under hijacked brand. There are also many companies which do not actively sell their products or services in China, but only outsource there the mass-production under their own brand. In terms of intellectual property, the risk associated with such an outsourcing might involve situation in which Chinese supplier or a competitor will register the trademark used by the importer in bad faith. Then, in China, the importer is deprived of the right to further manufacture goods bearing this mark. Quite often manufacture will register trademark of its' foreigner customer and become the only rightful entity to use the mark in China. This will allow them to inflate prices for goods and keep the customer, since they obtained exclusive right and no one else in whole China is allowed to produce and sell goods bearing the same mark. Moreover, the export of goods from China is also impossible without the consent of the person or company that registered the mark. China is called the world's factory⁷ therefore the risk might also involve international companies that are not present on this market at all. Therefore most, if not all, global brands have their trademark registered in China, regardless of whether they manufacture or sell their products there or not. Lack of trademark registration in China means that any third party can apply for exclusive rights to this mark. Obtaining such a registration allow the

⁵ Accessed on 09.01.2023 at: <https://www.wipo.int/en/ipfactsandfigures/trademarks>

⁶ Bad-Faith Trademarks in China, British Embassy Beijing, accessed on 08.02.2023 at: https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/977258/Bad-faith_Trade_Marks_-_IP_in_China_Factsheet.pdf

⁷ P. Bajpai, The Five Reasons Why China is the World's Biggest Manufacturer, accessed on 08.02.2023 at: <https://www.investopedia.com/articles/investing/102214/why-china-worlds-factory.asp>

applicant e.g. to start mass-production of a goods bearing registered mark and selling them cheaper in the local shop or online to international consumers in the platforms as Alibaba or AliExpress. Which, in turn, can have catastrophic consequences, both financial and image-wise. To declare trademark invalid, especially when applicant is actively using it, may be very difficult and involve expensive, burdensome, and lengthy procedures. Common practice is also to register the trademark in bad faith to offer to sell the trademark to the true owner at inflated rates. The nature of Chinese economy, language as well as cultural and historical background and the development of intellectual property law make bad faith registration in China rather widespread. Foreign entities often find it out only after they trademark have fallen victim to bad faith registration. The problem was a on the huge scale that prior to the entry into force of the Fourth Amendment to the Chinese Trademark Law, in China existed even online platforms with already registered trademarks for sale. Therefore, in order to improve trademark system China had to introduce some legislative changes. The abovementioned amendment aims to solve the problem of bad faith trademark registrations. Although many legal provisions of trademark law worldwide refer to bad faith, the concept is not defined by any legislator. There are still many considerations on what bad faith actually means and indication of the meaning of the given concept remains the task of the case law. As mentioned before due to territorial nature of trademark law, the understanding of the concept of bad faith may way from one country to another. Therefore, the idea to create a common standard for bad faith in trademark law based on the deep analysis of given jurisdictions and comparative study may be the answer for the problem and current increased demand for cross border trademark protection. For the purpose of this thesis European, Polish and Chinese trademark systems were analyzed and compared. Poland as a member of European Union is obliged to implement into its national laws European directives therefore it would be difficult to discuss Polish system without mentioning European. Moreover, trademark law is one of the most harmonized areas of intellectual property law.⁸ Equally valuable when analyzing the European system will be to discuss a national system of one of the Member States as an example. Common standard which reflects shared and consistent interpretation could enhance cooperation and facilitate trade by removing barriers of legal protection, promote common understanding of the notion of bad faith, increase legal certainty improve fair competition and at the same time make global trade exchange easier for industry and consumers.

⁸ J.Ożegalska-Trybalska, *Znaki towarowe a zła wiara, Qui bene dubitat, bene sciet: księga jubileuszowa dedykowana Profesor Ewie Nowińskiej*, Warszawa, Wolters Kulwer, 2018, p. 489

1. Trademarks as a Subject of Intellectual Property Rights

The first chapter of this thesis is devoted to a general overview of trademarks and their embedding in the legal context. These broader general considerations of the selected issues serve as the basis for the more detailed analysis presented in the subsequent chapters. It also plays an important role in determining the selection and scope of legal acts and provisions discussed in chapter two. Firstly, trademarks are tangible assets classified as intellectual property. They play a very important role in commercial activities and are noticed by consumers on products, packaging, or advertisements daily. From a legal point of view, trademarks are signs that distinguish the goods or services of one enterprise from those of other enterprises on the market.⁹ The essence of a trademark is the association of a mark with a product or service. Therefore, distinctiveness is of fundamental importance when assessing whether a given sign is capable to constitute a trademark since without distinctive character a sign is unable to fulfill its essential function of indicating origin.¹⁰ To obtain trademark protection, the trademark owner shall fill trademark application and indicate the classes of goods or services for which protection is sought. Indicated classes determine the scope of protection, which applies only with respect to identical or similar goods and services. Some exceptions might therefore apply to well-known trademarks. The granted trademark protection is territorial in nature and gives the owner the exclusive right to use the trademark in the course of business in limited territory. In Poland, the European Union (hereinafter the EU), and China trademark protection resulting from successful registration is valid for ten years and may be extended indefinitely for a subsequent ten-year protection period.

1.1. What Constitutes a Trademark?

In general, trademarks fall into two categories: visible signs such as words, slogans, figurative elements, pattern marks, three-dimensional marks, color marks, holograms, motion or multimedia signs, position or gesture marks, and non-visible signs such as sound marks, olfactory marks, taste marks or texture marks.

⁹ Article 15(1) Agreement on Trade-Related Aspects of Intellectual Property Rights

¹⁰ See more: R.Skubisz, *Prawo własności przemysłowej system prawa prywatnego* tom 14b, C.H.Becks, Warszawa 2017, p.474 and A.Kur, M.Senftleben, *European Trademark Law: A Commentary*, Oxford University Press, 2016 p.8

In the EU, a legal framework that governs trademarks is provided by: the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (hereinafter EUTMR), and the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (hereinafter Directive (EU) 2015/2436). Sign to be considered as a European Union trade mark (hereinafter EUTM) shall have a distinctive character which may also be acquired through prior use according to art. 7(1) of EUTMR. This regulation establishes also that EUTM might be any sign, in particular words, including personal names, designs, letters, numerals, colors, the shape of goods or the packaging of goods, or sounds. As a result of Regulation (EU) 2015/2424 of the European Parliament and the Council of 16th December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (hereinafter Regulation (EU) 2015/2424), the ‘graphical representation requirement’ was removed. The art. 3 of the abovementioned regulation provides new formats of representation, accepted by the European Union Intellectual Property Office (hereinafter EUIPO).

In Poland normative definition of a trademark is contained in the art. 120 of Act of 30 June 2000 Industrial Property Law as amended by act of 23 January 2004 and act of 29 June 2007 and act of 20 February 2019 (hereinafter Industrial Property Law) states that a trademark might be any sign that simultaneously meets two conditions, firstly it should be represented in the register and secondly it should be distinctive. In Poland distinction can be acquired as a result of prior use of a mark under average trading conditions.¹¹ From March 16, 2019, due to latest amended to the provisions of the Industrial Property Law trademarks may be presented in any form using generally available technology, as long as the representation is clear, precise, self-contained, understandable, durable, objective and easily accessible. Provisions of the abovementioned regulation contains only list of an exemplary forms that might be trademarks, in particular: word, drawing, ornament, color

¹¹ See more: Ł. Żelechowski, *Prawo własności przemysłowej: komentarz* (art. 1-119), C.H. Becks Warszawa 2022, accessed on 18.10.2022 at: <https://sip-1legalis-1pl-147d9peea0890.hps.bj.uj.edu.pl/document-view.seam?documentId=mjxw62zogi3danbrgq2tkmboobqxa1rv43tqmbqha3q&refSource=toc#>

composition, spatial form including the form of packaging or goods, melody or other sound signal.

In China, trademark might be composed of one or more sign such as: words, graphs, letters, numbers, three-dimensional symbols, color combinations, sound. Three-dimensional sign that is dictated by technical means cannot be registered. Amended to Trademark Law of the People's Republic of China 2013 erased the requirement of graphical representation thus registration of sound mark became available, while smell mark and single color is still not permitted.¹² A sign to be liable to legal protection shall be distinctive. A merely descriptive sign might acquire secondary meaning by domestic use on the Chinese market.

1.2. Sources of Trademark Law and Registration Procedures

In this chapter sources of trademark law as well as registration procedures on the international, regional, and national levels are briefly described. This will serve as the basis for further analysis of bad faith provisions in trademark law conducted in the latter part of this thesis. As already mentioned in the introduction, due to the growing economic cooperation between Poland and China increases the demand for the protection of intellectual property. In 2021 according to WIPO, 65% of all trademarks filing in the world occurred in China.¹³ Enhanced exchange of trade and business information might also contribute to bad faith trademark registrations¹⁴ therefore clear understanding of laws governing EU, Poland and China is of a crucial importance.

1.2.1. International Treaties

To protect trademarks worldwide several international treaties were adopted. In 1883 Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979) (hereinafter Paris Convention)¹⁵ introduced the principle of national treatment, minimum standard of protection, right of priority for six months from first registration in one of the countries of the union, protection of service marks, and protection of well-known

¹² G.Piscane, D.Zibetti, *Intellectual Property in China*. Springer 2020, p.35.

¹³ Accessed on 09.01.2023 at: <https://www.wipo.int/en/ipfactsandfigures/trademarks>

¹⁴ See more: K.J.Hickey, N.M.Hart, *Intellectual Property Violations and China, Legal Remedies*, Congressional Research Service, 7 September 2020, p.22

¹⁵ Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/288514>

trademarks. Later, in 1957 international classification of goods and services was established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on September 28, 1979)(hereinafter Nice Agreement)¹⁶.

The next international source that should be mentioned is the Agreement on Trade-Related Aspects of Intellectual Property Rights¹⁷ (hereinafter TRIPS Agreement) which is part of the Marrakesh Agreement Establishing the World Trade Organization¹⁸ (hereinafter WTO) that was signed in 1994. This agreement not only bound parties to the WTO to the rules stated in Paris Convention but also introduced some more obligations. Trademark Law Treaty¹⁹ adopted in 1994 was introduced to make national and regional trademark registration procedures more standardized, simplified, and harmonized. Singapore Treaty on the Law of Trademarks²⁰ was built on Trademark Law Treaty and aimed at creating a modern and international framework for the harmonization of administrative trademark registration procedures. It also addressed more recent developments in the field of communication technologies, including an electronic form of communication.

An important role plays the Madrid System for the International Registration of Marks (hereinafter Madrid System) is governed by two treaties: Madrid Agreement Concerning the International Registration of Marks (as amended on September 28, 1979)²¹(hereinafter Madrid Agreement) and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)²²(here in after Madrid Protocol). It was adopted to offer a convenient solution for registering and managing trademark registration worldwide. These two treaties are open to any state that is a party to the Paris Convention as well as to the international organization. After obtaining trademark registration in a home country, which is a party to the Madrid System, it can be used as a basic application to grant trademark protection in large numbers of countries that are also party to the system. It will result in obtaining many national registrations by filling out a single application in one langue and being subjected to one set of fees and deadlines.

¹⁶ Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/287532>

¹⁷ Accessed on 09.01.2023 at: https://www.wto.org/english/docs_e/legal_e/27-trips.pdf

¹⁸ Accessed on 09.01.2023 at: https://www.wto.org/english/res_e/booksp_e/agrmntseries1_wto_e.pdf

¹⁹ Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/294357>

²⁰ Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/290019>

²¹ Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/283530>

²² Accessed on 09.01.2023 at: <https://www.wipo.int/wipolex/en/text/283484>

Table 1: Contracting parties to the international treaties concerning the protection of trademarks

	Paris Convention	Nice Agreement	TRIPS Agreement	Trademark Law Treaty	Singapore Treaty	Madrid Agreement	Madrid Protocol
Poland	✓	✓	✓	✓	✓	✓	✓
EU			✓	✓			✓
China	✓	✓	✓	✓	✓	✓	✓

1.2.2. Regional Laws

Regional trademark laws are agreements between neighboring states. This allows one to fill out only one application and obtain trademark protection on a wider territory. It offers simpler procedures for registering and managing trademark rights in selected regions. In the EU in 1993 EUTM was established, where the single application leads to single trademark rights, having an effect in the whole EU and being regulated by just one law-EUTMR. In EU trademarks can be also registered at the national level as national trademark. Additionally, the Directive (EU) 2015/2436 was introduced to ensure the approximation of legal provisions of trademark laws of Member States, therefore trademark legislation in Member States is harmonized. While Poland is a party to EUTM, China is not bound by any regional trademark regulations.

1.2.3. National Legislations

Intellectual property law is by its nature territorial and is strongly related to the local culture. In case of trademark law, it gives the right to use trademark within boundaries of granting state and according to its own national legislation. Nevertheless, national legislation rarely remains not influenced by the international laws and as it appears from the chapter 1.2.1 Poland and China are parties to several international agreements. In this regard brief overlook at cultural background, history of accession to treaties and Trademark Law transformations is crucial for understanding current trademark regulatory framework in given jurisdictions.

Poland

In Poland, the framework of trademark law started to develop relatively late. It was after Poland regained its independence in 1918.²³ Currently, trademark law is addressed in chapter 5 of Industrial Property Law, which came into force on 21st August 2001. The provisions regarding trademark rights are harmonized with the Directive (EU) 2015/2436. As a member of the EU, Poland also protects EU trademarks based on EUTMR. Trademarks can also be protected based on the Fair-Trading Act (16 April 1993) and the Copyright and Related Rights Act (4 February 1994). In Poland, trademarks can be protected as a result of national, regional, and international registration. The trademarks can be registered at EUIPO, to receive unitary protection in the whole EU. It can also be registered locally in the Patent Office to receive national protection. A nationally applied trademark may become protectable internationally, by extending the right to countries, which are parties to the Madrid Union.

China

Chinese understanding of intellectual property and trademarks, deeply rooted in Confucian philosophy, was quite different from the one known in Europe. Chinese law undergone significant changes in these regards and framework of current trademark law in China was strongly affected by the western legal environment, in order to enhance international trade.²⁴ The initial step to promote trade with the outside world was signing a bilateral

²³ When in 19th century intellectual property law was developing in other countries, Poland was already under the occupation of the partitioning states (Russia, Prussia, and Austria) for over a hundred years and thus had to rely on their legislation. In 1918 Poland regained independence and Polish Patent Office was established. In 1919 first decree on the protection of trademarks was signed. Therefore, this provision introduced the possibility of obtaining a protection certificate for a trademark filed by the entitled person in the partitioning states before the date of establishing the decree. In the same year, Poland became a member of the Paris Convention. In 1924 Sejm passed the law on the protection of trademarks and the first trademark registration took place in Poland. In 1928 Poland accessed Madrid Agreement. Poland's accession to World Intellectual Property Organization (hereinafter WIPO) took place in 1975 and the accession to Madrid Protocol in 1991. In 1994 Poland joined WTO and ratified TRIPS Agreement. In 1995 Poland became a contracting party to Trademark Law Treaty and two years later to Nice Agreement. In 2004 entered into force accession treaty on Poland's accession to the EU. This event was of key significance for the Polish legal framework. Therefore, Poland accessed a system of community trademarks and geographical indications. Singapore Treaty was ratified in 2009.

²⁴ Trademark conceptions in China emerged in tune with commercial development but also were strongly influenced by collectivism- an inherent element of Confucian society. The gap in the juridical approach towards intellectual property between China and Western countries started in the 19th century. Western societies believed that authors and inventors should be granted individual protection for their own creations, while in China under Confucian philosophy it was the interest of the group (state), not an individual profit, which should be protected thus nothing as exclusive rights existed. In China, private rights were perceived as bad for the common good. Control over signs and creative works was exercised not to protect individuals but in order to guarantee state control over its works and their promotion. Copying was viewed as an expression of admiration, not theft. For Confucian Chinese, using the works of others by copying them was a part of oneself education. It was in the 19th

agreement on Trade Relations Between the United States of America and the People's Republic of China in 1979.²⁵

Currently trademark law in force is the Fourth Amendment of the Trademark Law as of 1 November 2019²⁶ (hereinafter the Trademark Law of the PRC) and it is supported by secondary legislation such as interpretations by the Supreme People's Court among those: Supreme People's Court Interpretation on Several Issues Concerning the Application of Law to the Adjudication of Civil Disputes Cases in Which Protection of Famous Trademarks is Involved; as well as rules, such as Rules of the Supreme People's Court on Issues Relating to the Hearing of Administrative Cases Involving Granting or Affirming Trademark Rights (2017).²⁷ The 4th amendment of the trademark law in China mainly focuses on regulating bad-faith application for trademark registration and increasing punishment for trademark infringement. In January 2022 Guidelines for Trade Mark Examination and Trial released by CNIPA came into effect, which provides guidance on what factors should be considered while assessing bad faith. Furthermore, an important source of trademark law in China are the general laws such as the Criminal Code of 14 March 1997 with provisions on criminal liability for trademark infringements, and the Antimonopoly Law of 30 August 2007 which differentiate between legitimate exercise

century when as a result of the Opium War, China was forced to establish trade relations with the Western world. At that time Sino-Western issues related to the intellectual property began. China with its intellectual property perception deeply rooted in ancient cultural conceptions faced strong criticisms from the international community. In negotiations, Western countries put the protection of intellectual property as the main factor in the development of further trade cooperation. As a result, during the time of the Chinese Republic, in 1930 Trademark Law was introduced. In the Maoist Era, the Communist party was trying to rebuild the country from the civil war through the development of technology and production. At that time the main objective of Trademark Law was to guarantee the quality of manufactured products, but it didn't consider aspects such as exclusive rights or customer protection. In 1980 China joined WIPO. As a result, in 1982 first post-revolution Trademark Law was enacted, which was to reproduce the Western legal environment to attract Western investors. It was the initial adaptation of the Chinese legal framework to internationally recognized standards. This regulation introduced the right of exclusive exploitation of trademarks by providing a registration process on a first-to-file basis. In 1984 China became a member of the Paris Convention and in 1989 joined the Madrid Agreement. In 1993 Trademark law was further reformed. In 1994 China joined Nice Agreement, Trademark Law Treaty, and Madrid Protocol in 1995. In 2001 China became a party of WTO and thus had to comply with the minimum standards imposed by TRIPS Agreement. In order to achieve it, Chinese authorities have completely changed the whole regulatory framework. In 2007 China became the contracting state of the Singapore Treaty. Since that time China is increasing integration into global intellectual property system. See more: P.K. Yu, *The Middle Kingdom and the Intellectual Property World*, 13 Oregon Review of International Law, Vol. 13, 209 (2012), accessed on 15.12.2022 at: <https://scholarship.law.tamu.edu/facscholar/396>, A.S. Greenberg, *The Ancient Lineage of Trade-Marks*, Journal of the Patent Office Society 33, no. 12 (December 1951): 876-887, K. Shao, *Look at My Sign - Trademarks in China from Antiquity to the Early Modern Times*, Journal of the Patent and Trademark Office Society 87, no. 8 (August 2005): 654-686, accessed on 25.10.2022 at: <https://heinonline.org/HOL/Page?handle=hein.journals/jpatos87&collection=journals&id=656&startid=&end=688>

²⁵ Agreement on Trade Relations Between the United States of America and the People's Republic of China, U.S.-China, July 7, 1979, 31 U.S.T. 4652

²⁶ Trademark Law of the People's Republic of China

²⁷ G.Piscane, D.Zibetti, *Intellectual Property in China*. Springer 2020, p.38.

and abuses of the market power conveyed by exclusive rights, the Tort Liability Law of 26 December 2009, the Law on the Application on Law to Foreign-related Civil Relationships of 28 October 2010 or the Civil Procedures Law of 31 August 2012.²⁸ Additionally EU and the U.S. initiated WTO consultations with China on the enforcement of intellectual property law, which in 2020 resulted in the signing Sino-EU Bilateral Agreement²⁹ on protection against imitation and usurpation of around 200 iconic European and Chinese geographical indications and Economic Trade Agreement with the U.S which inter alia covered issues related to trademarks and geographical indications.³⁰ Trademark registration in China can be obtained either domestically directly through China National Intellectual Property Administration (hereinafter CNIPA) or in the international procedure through WIPO.

1.3. Grant and invalidation of a right to a trademark

In general, most trademark laws provide examples of signs which can be registered, however there are some additional circumstances, namely absolute or relative grounds, under which trademark registration might be refused or registered trademark might be invalidated. This chapter will serve as a concise overview of the additional restrictions that trademark law provides at the stage of trademark registration. The brief analysis aims to verify whether provisions of the law regulate and restrict applications filled in bad faith.

In concerned jurisdictions trademark may be denied registration or invalidated on different grounds. This may happen if a sign inter alia doesn't fulfill trademark definition, is misleading or against good morals, or is descriptive, or contains geographical names, conflicts with prior rights, or lacks distinctiveness. In some jurisdictions (e.g., Poland, EU, China) however, a mark that lacks distinctiveness might be registered if following the use, it had acquired distinctive character. There are also some restrictions on the registrability

²⁸ P.Ganea, D.Friedmann, J.Lee, D.Clark, Intellectual Property Law in China, Second Edition. Max Planck Institute for Innovation and Competition, Wolters Kluwer 2021, p.8.

²⁹ Agreement between the European Union and the Government of the People's Republic of China on cooperation on, and protection of, geographical indications, Official Journal of the European Union, accessed on 21.10.2022 at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=uriserv:OJ.LI.2020.408.01.0003.01.ENG>

³⁰ Economic And Trade Agreement Between The Government Of The United States Of America And The Government Of The People's Republic Of China, accessed on 21.10.2022 at: https://ustr.gov/sites/default/files/files/agreements/phase%20one%20agreement/Economic_And_Trade_Agreement_Between_The_United_States_And_China_Text.pdf

of three-dimensional (shape) marks.³¹ Additionally, under Polish Industrial Property Law, registration in bad faith is considered as an absolute ground for refusal or invalidation.³² EUTMR considers bad faith as absolute ground for invalidity.³³ Under the Trademark Law of the People's Republic of China trademark registration in bad faith of a third-party unregistered trademark that is already in use and has a certain degree of reputation is not allowed.³⁴

After the trademark is successfully registered it still might be removed from the register in certain cases. As mentioned previously if a trademark was registered despite the existence of grounds for refusal, it can be declared invalid. Decision of invalidity invalidates the exclusive right with retroactive effect. In case the trademark was continuously unused for the time exceeding the grace period foreseen by applicable law, became generic or deceptive it might be revoked. Invalidity and revocation procedures are usually applied by third parties. A surrender of trademark registration is a voluntary request of the right holder to cancel registration in respect of some or all the goods or services for which the trademark was registered.

1.4. Scope of Rights and Infringement

As mentioned before, in principle trademark registration gives rise to exclusive rights to use the registered mark in course of trade. Rights in a trademark are of proprietary character and are enforceable similarly as rights in any other property.³⁵ In case of infringement, the proprietor of the trademark can take civil action to enforce trademark rights by means provided in applicable law. In this chapter, the scope of rights conferred in a trademark as well as infringement, and available enforcement of those rights will be reviewed. If infringement is understood as unlawful behavior interfering with someone's rights, then it follows from the foregoing that its crucial to firstly determine the scope of

³¹ See more: K.Li, Where Is the Right Balance - Exploring the Current Regulations on Nontraditional Three-Dimensional Trademark Registration in the United States, the European Union, Japan and China, *Wisconsin International Law Journal*, Vol. 30, Issue 2 (Summer 2012), accessed on 10.12.2022 at: https://heinonline-lorg-1a0acmhea08b3.hps.bj.uj.edu.pl/HOL/Page?public=true&handle=hein.journals/wisint30&div=17&start_page=428&collection=journals&set_as_cursor=0&men_tab=srchresults

³² Article 129(6) of Act of 30 June 2000 on Industrial Property Law

³³ Article 59(1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council Of 14 June 2017 on the European Union Trade Mark

³⁴ Article 32 of Trademark Law of the People's Republic of China (2019 revision)

³⁵ See more: A.Mossoff, Trademark as a Property Right, *Kentucky Law Journal*, Volume 107, 2018-2019, ISS:1, Article 2, accessed of 20.12.2022 at: <https://uknowledge.uky.edu/klj/vol107/iss1/2>

rights in order to determine infringement. This review will serve as a basis for the analysis conducted in the further part of the thesis as to whether a bad faith registration might be considered a trademark infringement.

1.4.1. Exclusive Right to Use the Trademark

Trademark owner can exclusively use the registered mark and can prevent third parties from using or registering identical or confusingly similar mark, in respect of the goods or services for which it was registered, without consent of right holder. Scope of exclusive right to use include inter alia right to affix trademark on goods, containers, packaging or labels, use in advertising and introducing goods to the market.

Additionally, renown and well-known trademarks shall be mentioned since often they are the subject matter of bad faith trademark applications.³⁶ Renown trademarks called also reputed trademarks are trademarks that are registered, and significant part of relevant public has sufficient degree of knowledge of these marks.³⁷ This type of trademarks enjoy wider protection in terms of principle of specialty (similarity of goods and services). Well-known trademarks on the other hand concern marks that are not registered but has become widely known to the public because of the use. Article 6bis of the 1967 Paris Convention and Article 16.3 of the TRIPS Agreement require member states, to confer same protection to well-known marks as to registered trademarks.

In Poland well-known marks that are commonly known and are protected against use for identical and similar goods if there is a risk of confusion which includes, in particular, the risk of associating the mark with a well-known mark.³⁸

EUTM system do not grant protection to unregistered well-known marks against dissimilar goods. They only can be protected against identical or similar goods if there is likelihood of confusion.

³⁶ See more: D. Friedmann, Protection Against Abuse of Trademark Law in Greater China: A Brief Analysis of The People's Republic of China, Hong Kong, Macau, And Taiwan, California Western International Law Journal, Vol. 47, No. 2 [2017], Art. 7, p. 164, accessed on 17.12.2022 at:

<https://scholarlycommons.law.cwsl.edu/cgi/viewcontent.cgi?article=1525&context=cwilj>

³⁷ Judgment of 14 September 1999, C-375/97 General Motors Corporation v Yplon SA, (Chevy)), ECLI:EU:C:1999:408

³⁸ See more: See more: Ł. Żelechowski, Prawo własności przemysłowej: komentarz (art. 301), C.H. Becks Warszawa 2022, accessed on 18.10.2022 at: <https://sip-legalis-1pl-147d9peca0890.hps.bj.uj.edu.pl/document-view.seam?documentId=mjxw62zogi3danbrgq2tkmboobqxa1rv43tqmbqha3q&refSource=toc#>

In China notion of well-known mark refer to “a mark known to the relevant sector of the public within the territory of China”.³⁹ Unregistered well-known marks are protected against copy, imitation or translation⁴⁰ for identical or similar goods or services while registered renown trademarks are additionally protected for dissimilar goods or services.

1.4.2. Right to Dispose of a Trademark as an Object of Property

The similarity of the nature of industrial property to ownership within the meaning of civil law consists in the exclusive right to use goods, collect profits, and dispose of goods. Trademark is an object of intellectual property, and the right holder may deal with it as an absolute owner. Trademark rights are transferable and inheritable. The owner of a trademark has the right to assign it to another party or authorize the use of a trademark by granting a corresponding type of license. This characteristic of trademarks is of a significant importance while considering bad faith applications. There are many ways in which trademark squatters might profit from a wrongfully acquired trademark. One of them is to extract payment for the transfer of mark to its rightful owner at inflated rates.⁴¹

1.4.3. Infringement and Enforcement

Trademark infringement is a violation of the exclusive rights conferred to the trademark owner. The most common example of an infringement is sale of counterfeit goods. Counteroffering consists in selling identical, undistinctive goods which are replicating this of the trademark owner. Another practice that is considered an infringement is the use of a distinctive sign which is identical or similar to the registered trademark. The abovementioned practices mislead and confuse customers about the origin of the goods and harm the legitimate interest of the trademark owner. In case of infringement available enforcement might include civil, administrative, and criminal remedies. In the EU

³⁹ Supreme People’s court’s Interpretation of Several Issues Regarding to Application of Law to Trial of Cases of Dispute Involving Protection of Well-known Marks (Adopted at the 1467th Meeting of the Adjudication Board of the Supreme People’s Court on 22 April 2009 and have entered into force on 1 May 2009), accessed on 29.11.2022 at: <https://wipolex.wipo.int/en/text/182139>

⁴⁰ See more: M.Ferrante, Strategies to Avoid Risks Related to Trademark Squatting in China, The Trademark reporter 107, no. 3, May-June 2017, p.737, accessed on 19.12.2022 at: https://heinonline-1org-1a0acmhea08cd.hps.bj.uj.edu.pl/HOL/Page?public=true&handle=hein.journals/thetmr107&div=26&start_page=726&collection=journals&set_as_cursor=0&men_tab=srchresults

⁴¹ J.A.Lee, H.Huang, Post-application Evidence of Bad Faith in China’s Trademark Law, Oxford University Press, Journal of Intellectual Property Law&Practice, 2018 Vol.12, No.5, p.400, accessed on 05.12.2022 at: <https://academic.oup.com/jiplp/article/13/5/400/4717949>

although the EUIPO is responsible for registering EUTM, it is not an enforcement authority, and civil or criminal law enforcement must therefore be brought at national level in the relevant EU jurisdiction. In the case of a EUTM one court can order civil law measures in all Member States, including injunctions and preventive seizures, to prevent illegal use of the trademark. The rules on criminal law measures against counterfeiting and piracy have not been harmonized across the EU, so relevant national law will apply, which may vary from one Member State to another.⁴² In Poland, a trademark for which a right of protection has been granted is subject to both civil and criminal protection. Enforcement might be brought before national court of law of specialized IP courts located in Warsaw, Gdańsk, Poznań, Lublin and Katowice.⁴³ Civil enforcement include injunctions and preventive seizures while criminal enforcement might result in fines or imprisonment. In China, civil trademark infringement cases can be filed in any court corresponding to the jurisdiction where the infringement happened or where the defendant party is located. China has established three IP courts in Beijing, Shanghai, and Guangzhou, however, trademark cases, in general, are heard in basic people's court where cessation of the infringement and claiming compensation are available. To stop the infringement, a preliminary injunction can be applied before starting full legal proceedings. Administrative enforcement in trademark cases lacks detailed procedures. Anyone can make an administrative complaint concerning trademark infringement. Local Administration for Market Regulation can order the infringer to stop infringing, confiscate and destroy infringing goods or tools and impose a fine,⁴⁴ however administrative body cannot determine damage compensation. Trademark infringement in China is considered a crime and for serious counterfeiting, criminal prosecution is often the only way to stop infringing activities. Border enforcement for imported or exported goods suspected of infringing is also available.

⁴² Accessed on 25.11.2022 at: <https://euipo.europa.eu/ohimportal/en/looking-after-your-rights>

⁴³ Rozporządzenie Ministra Sprawiedliwości z dnia 29 czerwca 2020 r. w sprawie przekazania niektórym sądom okręgowym rozpoznawania spraw własności intelektualnej z właściwości innych sądów okręgowych (<https://dziennikustaw.gov.pl/D2020000115201.pdf>)

⁴⁴ P.Ganea, D.Friedmann, J.Lee, D.Clark, Intellectual Property Law in China, Second Edition. Max Planck Institute for Innovation and Competition, Wolters Kluwer 2021, p.520.

2. Legal Provisions Addressing Bad Faith in Trademark Law

Trademark rights are of territorial nature, therefore legal provision differ between different jurisdictions. As different sources of trademark law have already been briefly mentioned previously in chapter 1, attention will now be drawn to the specific provisions of this laws in relation to bad faith.

2.1. EU

As mentioned in the chapter 1 of this thesis EU trademarks are regulated by the Directive (EU) 2015/2436 which ensure the approximation of legal provisions of the Member States, and EUTMR which regulates unitary EUTM and is applicable as such in each Member State. EU trademark law contains several provisions relating to a bad faith. These provisions offer the possibility of challenging a trademark application or the resulting registration on the ground that the application was made in bad faith. Relevant provisions may be found in both the Directive (EU) 2015/2436 and EUTMR. Additionally, EUIPO each year issues The Office's Guidelines that are the main point of reference for users of the EUTM and professional advisers. Therefore, the Office's Guidelines are not legal acts, but self-imposed rules of conduct adopted by an administrative decision.

2.1.1. Directive (EU) 2015/2436

The notion of bad faith appears four times in the Directive (EU) 2015/2436. The preamble, which is an introductory and expressionary part that communicates the purpose and intentions of the document contains notion of bad faith in Article 29. Furthermore, bad faith can be found in Article 4, Article 5, and Article 9 of the directive. It provides a legal tool to invalidate trademark which registration was made in a bad faith and leave it up to Member States to consider bad faith as a ground for refusal of trademark application. Article 29 of the preamble, provides that:

“It is important, for reasons of legal certainty to provide that, without prejudice to his interests as a proprietor of an earlier trademark, the latter may no longer request a declaration of invalidity or oppose the use of a trademark subsequent to his own

*trademark, of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent trademark was made in bad faith.”*⁴⁵

The term bad faith in the directive the first time is used in the explanatory part of the preamble. It makes clear that there is a responsibility imposed on trademark rights holders to actively enforce their rights against others. It follows from the foregoing that if the proprietor of an earlier trademark was aware of the use of the latter trademark, tolerate it, and didn't enforce his rights against it for a substantial length of time, the limitation to invalidation and opposition proceedings would be applied. Nevertheless, the legislator provided also an exception which states that the limitation will not apply if the application of a latter trademark was filled in a bad faith. Moreover art. 4, para. 2 establishes that:

*“A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered.”*⁴⁶

Article 4 of abovementioned directive considers absolute grounds for trademark opposition and trademark invalidation. Pursuant to paragraph 2 a bad faith trademark application constitutes an absolute ground for a trademark invalidation. The possibility is left to the Member States as to consider a bad faith obstacle also on an earlier step, namely as a ground for refusal to be examined ex-officio in the registration proceedings. Most Member States allow for opposition in these cases; therefore, filling of applications in bad faith constitute a mandatory obstacle for protection. Furthermore, the directive also states that:

*“Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that: (c) the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that, at the date of the application, the applicant was acting in bad faith.”*⁴⁷

Article 5 of directive deals with relative grounds for refusal or invalidity of trademark. Paragraph 4 letter c) of said article provides Member States with further voluntary

⁴⁵ Article 29 of the preamble of the Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks

⁴⁶ Idem, Article 4(2).

⁴⁷ Idem, Article 5(4)(c).

restrictions possible to apply in case of bad faith application. This measures against bad faith applications establish bad faith as the relative ground for refusal. It strengthens the protection, by broadening the scope of practices considered as bad faith in relation to marks protected abroad. Which means that foreign registration can be included as part of evidence in support of opposition or invalidation proceedings based on bad faith. Nevertheless, this provision is applicable only if two conditions are met simultaneously. Firstly, there is a possibility of confusion with an earlier trademark protected abroad, and secondly the applicant of senior mark acted in a bad faith at the date of application. In such a case Member States are allowed to refuse registration or invalidate such a trademark. This provision is of key importance given the territorial nature of intellectual property rights and the risk of trademark squatting imposed on well-known and renown trademarks. Finally, the directive establishes that:

*“Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) or Article 5(3)(a) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, that proprietor shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.”*⁴⁸

Term acquiescence in international law means consent conferred from a juridically relevant silence. It concerns a conveyed consent through silence or inaction in circumstances such that a response expressing objection or disagreement in relation to the conduct of other party would be required.⁴⁹ According to paragraph 1 of article 9 of said directive, where the proprietor of an earlier trademark registered in a given Member State has acquiesced in the use of the contested trademark registered in that Member State for a period of five successive years while being aware of such a use, the contested trademark is not liable to be declared invalid. The period of five successive years starts running from the date when the proprietor of the earlier trademark becomes aware of the use of contested trademark and the date must be later than that of registration of contested trademark. The defense against invalidity application based on acquiescence is applicable only to goods

⁴⁸ Idem, Article 9(1).

⁴⁹ D.A. Lewis, N. K. Modirzadeh, G. Blum, Quantum of Silence: Inaction and Jus ad Bellum, Harvard Law School PILAC, 2019, p.12, accessed on 11.12.2022 at: https://pilac.law.harvard.edu/quantum-of-silence-paper-and-annex/part-ii-what-we-mean-by-silence#_ftn39

and services for which contested trademark has been used. This provision also provides the exception to a possible defense based on acquiescence in invalidation proceedings of a contested trademark which is in use, but its application was made in bad faith. If the application of a contested trademark was filled in a bad faith, proprietor of such a sign is deprived of the possibility to base defense on acquiescence, in case of invalidity proceedings.

The abovementioned four provisions in their content directly refer the notion of bad faith. However, there are also provisions in the Directive which, although they do not contain the notion of bad faith, nevertheless address it. They provide protection of well-known and renown trademarks as well as regulate disloyal behavior of representative or agents in regards to trademark registration. Article 5(1) establishes that:

“1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid where: (a) it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;
(b) because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.”⁵⁰

Article 5 regulates the relative grounds for refusal and invalidation of a trademark application caused by the earlier rights of third parties. The substantive examination of relative grounds is not undertaken by patent offices but requires objection from interested party. Relative rounds for refusal of trademark application may also be the basis for invalidation of already registered trademark. It establishes that no protection rights can be granted to a mark that is identical with an earlier trademark provided that it concerns identical goods or services. It applies to double identity, which means both the identity of the signs and the identity of the goods. It is important to mention that in order to establish that the signs are identical, it is not necessary for the junior mark to be an exact reproduction of the earlier trademark. Identity of the signs also occurs when there are such small differences between the signs that the average consumer may not notice these

⁵⁰ Article 5(1) of the Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks

differences. Furthermore, this provision extends the protection not only to identical marks and identical goods or services but also to similar marks and similar goods and services in circumstances that junior mark will cause likelihood of confusion on the part of the public. The assessment of the risk of confusion consists of three main factors listed explicitly in recital 16 of Directive 2015/2436, i.e. the degree of similarity of the signs, the degree of similarity of the goods (or services) and recognition of the earlier trade mark. In terms of bad faith, it is important to mention that under this provision term “earlier trade marks” refers also to well-known trademarks that are well known in the Member State in which application for junior mark was made.⁵¹ The assessment whether the senior mark is a well-known trademark shall be made on the date of application or on the date of claimed priority. Therefore, these provisions provide protection for well-known trademarks. What is more regarding bad faith Article 5(3)(a) and (b) provides subsequent relative grounds for refusal and invalidation establishing that:

“3. Furthermore, a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where: (...)

(a) it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State in respect of which registration is applied for or in which the trade mark is registered or, in the case of an EU trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

*b) an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;”*⁵²

Article 5(3)(a) grants special protection to trademarks that have acquired reputation. Under this provision a proprietor of a reputed trademark may oppose of request declaration of invalidation of another trademark which conflicts with a reputed trademark. It provides the protection that extends beyond the principle of specialty. This means that a mark identical or similar to a reputed trademark may be refused regardless of whether the goods

⁵¹ Idem. Article 5(2)(d)

⁵² Idem. Article 5(3)(b)

or services for which it is applied for or registered. Nevertheless, the legislation defines reputed trademark. Based on a case law it was established that a reputed trademark is a registered trademark known to significant part of the public interested in the goods or services to which it relates and should be assessed based on specific circumstances.⁵³ Furthermore, Article 5(3)(b) refers to the circumstances in which an application is made by a representative or an agent on behalf of the represented person without the consent of this person. It provides the legal grounds for opposition of the application for registration of a trademark filed by unfaithful agent or request of invalidation of such registered trademark. However, the agent or representative may justify filing of the application, which results in the dismissal of the claims. The action might be considered justified when, for example the agent informed the proprietor of his intention to file the mark, and the proprietor for sufficiently long time didn't object the filing. This provision even though doesn't contain the wording "bad faith", in some cases it might address broadly understood bad faith of the applicant. It is important to mention that not all the cases of filing the application by unfaithful agent constitute bad faith filing. Additionally, to that Article 13 establishes that:

"1. Where a trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's consent, the latter shall be entitled to do either or both of the following:

a) oppose the use of the trade mark by his agent or representative;

b) demand the assignment of the trade mark in his favour.

*2. Paragraph 1 shall not apply where the agent or representative justifies his action."*⁵⁴

The abovementioned provision in addition provides several actions that can be taken against unfaithful agent or representative who, without the proprietor's consent applies for a right of protection for this mark or already has obtained such a right in other countries signatory to the Paris Convention. This provision stipulates that the person claiming to be the true owner of the mark registered by the unfaithful agent or representative may oppose the use of the trademark by the agent or representatives. In addition, proprietor of a trademark registered by unfaithful agent might request the assignment of the rights. However, in

⁵³ Judgment of 14 September 1999, C-375/97 General Motors Corporation v Yplon SA, (Chevy)), ECLI:EU:C:1999:408

⁵⁴Article 13 of the Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks

either case, the agent or representative should be able to obtain or retain a registration if he justifies his action.

2.1.2. Regulation (EU) 2017/1001

In the content of EUTMR, the notion of bad faith appears three times, in art. 59, art. 61, and art. 138 respectively. It concerns bad faith in the invalidity application of EUTM as an absolute ground for invalidation and doesn't allow defense based on an acquiescence claim if the EUTM was applied for in a bad faith. It is important to mention that regulation provides only the possibility of invalidation of already registered EUTM due to bad faith filling but there is no legal instrument that allows for the opposition of EUTM application in registration proceedings on a ground of bad faith as such.⁵⁵ Moreover, art. 59 of EUTMR establishes that:

*“An EU trademark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings: b) where the applicant was acting in bad faith when he filed the application for the trademark.”*⁵⁶

Abovementioned provision provides that invalidation of EUTM can be relied on either before the EUIPO or by means of a counterclaim in infringement proceedings. It also introduces absolute grounds based on which EUTM can be invalidated. Bad faith is one of them, as additional ground for cancellation. It follows from the foregoing that EUTM is liable to invalidation if the filling has been made wrongfully. Furthermore, the regulation provides that:

„1. Where the proprietor of an EU trade mark has acquiesced, for a period of five successive years, in the use of a later EU trade mark in the Union while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later EU trade mark was applied for in bad faith.

⁵⁵ J. Sitko, Various Aspects of the Application for a Trademark Made in Bad Faith in the Light of EU Case Law, Białystok Legal Studies, 2022 vol. 27 nr 1, p. 96.

⁵⁶ Article 59(1)(b) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, published in OJ from June 16, 2017.

*2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later EU trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later EU trade mark was applied for in bad faith.”*⁵⁷

These provisions aim to exclude the proprietors of an earlier trademark that have acquiesced in the use of the contested EUTM for a period of five uninterrupted years, while being aware of such use, from seeking a declaration of invalidity of that contested trademark. To prove acquiescence the proprietor of the contested EUTM must show that some conditions are met simultaneously. Firstly, the contested EUTM should be used in the EU during the period of at least five successive years and secondly the invalidity applicant should be proved some behavior that demonstrates apparent consent to the use of the mark. If all the conditions are met, the legislator allows proprietor entitled to such EUTM to continue to use the mark only to the contested goods or services for which the later EUTM has been used. The contested trademark will then therefore be able to coexist with the earlier trade mark. Nevertheless, this article is not applicable when contested EUTM was filed in bad faith. Therefore, a bad faith exception is set to a possible defense of a EUTM based on acquiescence in invalidation proceedings in respect of the goods or services for which the later trademark has been used. It means that if the proprietor of contested EUTM filed a trademark application in a bad faith, the proprietor of an earlier mark might seek a declaration of invalidity of the contested EUTM anytime, and not for the five years since he became aware of such use. An exception applies to both, EUTM proprietors as well as proprietors of the earlier national trademark in the Member State, where it is protected. This exception will only be considered if it is argued and proved by the invalidity applicant. Finally, the regulation establishes that:

“ 1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the EU trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

⁵⁷ Article 61(1) and(2) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, published in OJ from June 16, 2017.

2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the EU trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the EU trade mark was applied for in bad faith.”⁵⁸

The regulation provides also that the proprietor of an earlier trademark which applies to a particular locality may oppose the use of EUTM in this locality to the extent permitted by the legislation of the Member State concerned. A sign which is the subject of the right of prior use may be both the ordinary trademark and the renowned trademark, where the latter is protected against identical and similar signs to the extent that there is a risk of confusion. Although definition of locality is not clearly defined, the doctrine indicates that provisions of the Regulation (EU) 2017/1001 refers to a territory smaller than the territory of a given Member State.⁵⁹ Paragraph 2 of said article introduce the conditions, which if met, cease the prior rights to localities. If all the conditions in said article are met the limitation on acquiescence will apply only to the contested goods or services for which EUTM has been used. Nevertheless, this article provides also exception to cessation of this right. In case of bad faith application of the contested EUTM there is no possibility for rightsholder of contested EUTM to base defense on acquiescence in opposition proceedings.

Furthermore, in the Regulation 2017/1001 other provisions which address widely interpreted bad faith can be found. These provisions don't contain the wording of bad faith but they refer to applications made by unfaithful agents or representatives. This are Article 8(3), Article 13 and Article 21 (1) respectively:

“3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.”⁶⁰

⁵⁸ Idem, Article 138(1) and (2).

⁵⁹ J. Sitko, 2.4. Prawo użytkownika uprzedniego [w:] *Naruszenie prawa do znaku towarowego renomowanego. Studium porównawcze*, Warszawa 2019 Accessed on 07.12.2022 at: <https://sip.lex.pl/#/monograph/369449783/392172/sitko-joanna-naruszenie-prawa-do-znaku-towarowego-renomowanego-studium-porownawcze?cm=URELATIONS>

⁶⁰ Article 8(3) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, published in OJ from June 16, 2017.

“Where an EU trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to oppose the use of his mark by his agent or representative if he has not authorised such use, unless the agent or representative justifies his action.”⁶¹

“1. Where an EU trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment of the EU trade mark in his favour, unless such agent or representative justifies his action.”⁶²

The Article 8 provide relative grounds for refusal of trademark registration. Paragraph 3 of said Article includes in relative grounds for refusal an application of the mark, which is made by an agent or representative of the proprietor in his own name, without proprietor's consent. Additionally, Article 13 and Article 21 (1) of the Regulation 2017/1001 provide proprietor with several legal actions that can be taken against unfaithful agent or representative. Truthful owner might oppose the use of a mark by the agent or representative or request transfer of the rights in his favor. None of these provisions are applicable if the agent or representative justifies his action. The aim of this provision is corresponding to the Article 5 para. 3) letter b) and Article 13 of the Directive 2015/2436 which was described in more detail before, therefore no more attention will be paid to it here. Furthermore, the Regulation 2017/1001 similarly to the Directive 2017/2436 protects well-known and reputed trademarks. In the Regulation the protection of well-known trademarks is provided for under Article 8(1) and Article 8(2)(c). Reputed trademarks are protected under Article 8(5) and Article 9(c). The aim of this protection is corresponding to the protection granted under the Article 5(1), Article 5(2)(1), and Article 5(3)(a) of the Directive.

2.1.3. EUIPO Trademark Guideline

The Guideline provided by EUIPO consist of six parts: A General rules, B Examination, C Opposition, D Cancellation, E Register operations, M International marks. Each Part is divided into Sections and each Section is divided into more detailed points. Information

⁶¹ Idem. Article 13

⁶² Idem. Article 21(1)

relating to a bad faith can be found in section A, C, D and E, which is described in more detail below.

Part A concerning General rules in Section 9 Enlargement, point 2.4 Bad faith, covers bad faith in examination rules. The guideline establishes that in the event of accession of a new Member State to EUTM system, a EURM application made prior to the accession date, for a term that is descriptive or otherwise not eligible for registration in the language of that new Member State and made solely for the purpose of obtaining exclusive rights in the non-registrable subject matter will be considered as made in bad faith.⁶³ As mentioned before the EUTMR does not provide any legal instrument to oppose EUTM application in registration proceedings on a ground of bad faith. Therefore, the EUIPO has no authority to object ex officio and it can only invalidate already registered trademark when a request for a declaration of invalidity is filed.⁶⁴ Pursuant to Article 209(5) EUTMR the use of EUTM might be prohibited if prior rights was registered, applied for or acquired in good faith in the new Member State prior to the date of the accession of that State. Point 3 of the same section provides that in such a case good faith of the applicant of national mark is presumed and owner of EUTM must prove in opposition proceeding that the owner of the earlier national right obtained in a new Member State acted in bad faith when filing the national application or otherwise acquiring the right.⁶⁵

In Part C Opposition, Section 3 which relates to Unauthorized filing by agents of the TM proprietor. Point 1.2 explains the purpose of Article 8(3) EUTMR which is the manifestation of the principle of honest transactions conducted in good faith. It states that protection granted under Article 8(3) EUTMR is narrower than that afforded by Article 59(1)(b) EUTMR (invalidity on the grounds of bad faith) because applicability of Article 8(3) EUTMR require several additional conditions to be met. On the other hand, this provision might also be perceived as broader, because it applies where bad faith wouldn't qualify, for example if agent acted on the incorrect but genuinely held assumption that it had consent to apply for the mark.⁶⁶ Point 4.1.1 of the same Section focus on nature of the

⁶³ EUIPO Trademark Guidelines, Part A, Section 5, Point 2.4 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/2045850/trade-mark-guidelines/2-4-bad-faith>

⁶⁴ Article 59(1)(b) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, published in OJ from June 16, 2017.

⁶⁵ EUIPO Trademark Guidelines, Part A, Section 9, Point 3 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/1980531/trade-mark-guidelines/3-rules-concerning-oppositions-and-cancellations>

⁶⁶ Idem. Part C, Section 3, Point 1.2 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/1981346/trade-mark-guidelines/1-2-purpose-of-article-8-3--eutmr>

relationship. It states that relationship with an agent or representative is of such a nature to give rise to an obligation of trust and confidentiality. An agent or representative can be understood as legal practitioner, attorney, consultant, trademark agents or any other business associates etc. Guidelines highlight that legal representative or manager of opponent's company cannot be considered as agent within the meaning of Article 8(3) EUTMR and infringing acts coming from within opponent's company can be sanctioned under the general bad faith provision in Article 59(1)(b) EUTMR.⁶⁷ Furthermore in the same Part, Section 5 trademarks with reputation, point 3.4.3.1 Taking unfair advantage of distinctiveness or repute, the guideline provide two examples of factors from which bad faith can be inferred. It states that the existence of bad faith might be indicated by applicant's obvious attempt to imitate as closely as possible an earlier highly distinctive sign or the absence of a clear reason why a mark containing such a sign was used.⁶⁸ Under Section 6, Point 2.3.1 guideline covers Geographical Indications (hereinafter GIs) protected under international agreements. It states that GIs originating from non-EU countries protected under Geneva Act of the Lisbon Agreement can be relied on in oppositions under Article 8(6) EUTMR if they were granted protection in the EU and if the contested trademark was applied for after the notification of WIPO to the Commission of the international registration of the GI. If the contested mark was applied for before the notification to the Commission of the international registration but after the filing of the international registration with the International Bureau, the GI only constitutes an earlier right if the opponent proves that the trademark was applied for in bad faith.⁶⁹

Part D dedicated to Cancellation in Section 2 containing Substantive provisions, in Point 3 provides information about bad faith in context of Article 59(1)(b) EUTMR. Regarding relevant point of time for determining bad faith guideline provides that it is the time of filing of the application for registration. Additionally, it allows for facts and evidence that occurred before filing to be considered for interpreting the applicant's intention at the time of filing the EUTM. The guideline mention examples of such facts as whether there is already a registration of the mark in a Member State or in another jurisdiction, the circumstances under which the mark was created and the use of the mark since its creation.

⁶⁷ Idem. Part C, Section 3, Point 4.1.1 accessed on 22.12.2022 at:

<https://guidelines.euipo.europa.eu/1935303/1981350/trade-mark-guidelines/4-1-1-nature-of-the-relationship>

⁶⁸ Idem. Part C, Section 5, Point 3.4.3.1 accessed on 22.12.2022 at:

<https://guidelines.euipo.europa.eu/1935303/1982504/trade-mark-guidelines/3-4-3-1-taking-unfair-advantage-of-distinctiveness-or-repute>

⁶⁹ Idem. Part C, Section 6, Point 2.3.1 accessed on 22.12.2022 at:

<https://guidelines.euipo.europa.eu/1935303/2046034/trade-mark-guidelines/5-2-3-1-----2-3-1-international-agreements-entered-into-by-the-eu>

Guideline also allows to consider facts and evidence which occurred after the filing, in particular whether the owner has used the mark since registration.⁷⁰ Furthermore the guideline describe the concept of bad faith and provides that bad faith is an autonomous concept of European Union law however it's not defined or described in the legislation. In general Article 59(1)(b) EUTMR aims to prevent trademark applications that are abusive or contrary to honest commercial and business practices. The ground of bad faith applies where the applicant of EUTM filled an application in a manner inconsistent with honest practices, or with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trademark, in particular the essential function of indicating origin.⁷¹ Additionally in the Point 3.3.2.1 the guideline provides list of factors likely to indicate the existence of bad faith. Factors are divided into two categories: particularly relevant factors and other potentially relevant factors. Providing particularly relevant factors firstly it establishes that the identity or similarity of the signs may be significant for finding bad faith and in many cases of bad faith this factor is fond, but likelihood of confusion is not a prerequisite of bad faith, and it is not itself sufficient to prove bad faith. Secondly, guideline provides that the knowledge of the applicant of the use of an identical or similar sign by a third party for identical or similar products also might be significant. The knowledge may be presumed to exist, and the extent to which it is presumed depends on circumstances. However, the knowledge of an identical or similar earlier sign for identical or similar goods or services even though is considered as particularly relevant factor, is not sufficient in itself to prove the applicant was acting in a bad faith. Finally, it states that dishonest intention of applicant of EUTM is also relevant for finding a bad faith and provide several examples of scenarios in which bad faith was found. For example, when application is filed speculatively or solely with a view to obtaining financial compensation, or applicant is to "free-ride" on the reputation of the invalidity applicant or on its registered marks and to take advantage of that reputation. Absence of intention to use a trademark in respect to all or some of the goods or services referred to in the application also constitutes dishonest intention. Other examples are filling an application by a party to prior business relationships by its own name or artificially extending the grace period for non-use (evergreening). Furthermore, the guideline provides other potentially relevant factors to assess the existence of bad faith. Among others it might be the nature of the mark whether is restricted by technical or commercial factors or if owner of EUTM

⁷⁰ Idem. Part D, Section 2, Point 3.3.1 accessed on 22.12.2022 at:
<https://guidelines.euipo.europa.eu/1935303/1948893/trade-mark-guidelines/3-3-1-relevant-point-in-time>

⁷¹ Idem. Part D, Section 2, Point 3.3.2 accessed on 22.12.2022 at:
<https://guidelines.euipo.europa.eu/1935303/2047218/trade-mark-guidelines/3-3-2-concept-of-bad-faith>

is able to prevent its competitors not merely from using an identical or similar sign but also from marketing comparable products, degree of inherent or acquired distinctiveness as well as degree of reputation enjoyed by the invalidity applicant's sign and EUTM owner's sign. Finally, the fact that the national mark on which the EUTM owner has based a priority claim has been invalidated due to bad faith.⁷² Furthermore in point 3.3.3 guideline provides that in invalidity proceedings pursuant to Article 59(1)(b) EUTMR EUIPO during examination will consider only grounds and arguments submitted by the parties. The good faith of EUTM applicant is presumed until proven otherwise and it is invalidation applicant who must prove bad faith of EUTM applicant.⁷³ Guideline also provide that the extend of a declaration of invalidity based on bad faith will be determined on the basis of evidence provided by the invalidity applicant. In some cases, trademark might be declared invalid in its entirety but in other bad faith might apply only partially, means only to some goods or services.⁷⁴ Point 4 of Section 2 is dedicated to Relative grounds for invalidity. Point 4.5.3 provide guideline for defense against an invalidity application based on acquiescence and

Furthermore, Part E concerning Register operations in Section 2 Conversions, Point 4.2 states that if EUTM designating the EU has been declared invalid on the grounds of bad faith, this has the effect of excluding conversion for the entire European Union.

2.2. Poland

Poland as a Member State of EU is obliged to implement the provisions of EU law into national legislation. As mentioned in previous chapter, the provisions regarding trademark rights are harmonized with the Directive (EU) 2015/2436 and implemented within national legislation in Industrial Property Act. As a member of the EU, Poland also protects EU trademarks based on EUTMR. Since the provisions of the Directive (EU) 2015/2436 and the EUTMR containing notion of bad faith has been described above therefore in this part attention will be paid to Industrial Property Act. Additionally, the president of the Polish

⁷² Idem. Part D, Section 2, Point 3.3.2.1 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/2047222/trade-mark-guidelines/3-3-2-1-factors-likely-to-indicate-the-existence-of-bad-faith>

⁷³ Idem. Part D, Section 2, Point 3.3.3 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/2047226/trade-mark-guidelines/3-3-3-proof-of-bad-faith>

⁷⁴ Idem. Part D, Section 2, Point 3.3.5 accessed on 22.12.2022 at: <https://guidelines.euipo.europa.eu/1935303/2047234/trade-mark-guidelines/3-3-5-extent-of-invalidity>

Patent Office (hereinafter PPO) issued General Guidance on Trademarks. The purpose of the guidelines is to ensure a uniform interpretation of the law in the field of application of statutory provisions by experts adjudicating in cases of trademarks. Guidelines is of interpretative character and the experts of the PPO are obliged to take it into account when adjudicating in cases. They are instructions for applying the law and are primarily intended to unify the practice of the Patent Office. Nevertheless, the guidelines are binding only for experts. They are not a source of generally applicable law therefore cannot be invoked as a legal basis for a decision or order issued by the PPO.⁷⁵

2.2.1. Industrial Property Act

The Industrial Property Act of Poland contains provisions on the protection of trademarks in Title III. The notion of bad faith appears twice in the act, in art. 129 and in art. 165 respectively. Firstly, the act prohibits registrations in bad faith and secondly, it limits the possibility of defense based on acquiescence in use, in invalidation proceedings for trademarks registered in bad faith. Additionally, art. 164 referring to art. 129 provide a legal tool for trademark invalidation on an absolute ground in case of bad faith application.

*“1. Protection is not granted for a marking that: (...)
6) an application is filed for in bad faith;”⁷⁶*

Under this provision, if the application of a sign was filed in a bad faith no protection rights are granted to such a sign. This provision is an implementation of the possibility left for the Member States to introduce bad faith as an absolute ground for refusal to register to be examined ex-officio in the registration proceedings, referred to in art. 4 para. 2 of Directive 2015/2436. The decisive moment for the assessment of the applicant's bad faith as an obstacle to registration is the date of filing a trademark application. Acting in a bad faith by the applicant after filing date doesn't prevent registration or, in the case of granting a right of protection, invalidates the trademark. Furthermore art. 164 states that a trademark might be invalidated if the conditions required for protection are not met. This provision refers among others to the condition listed in art. 129. It follows from the foregoing that

⁷⁵ General Guidelines of The President of the PPO on Trademarks, accessed on 23.12.2022 at: <https://uprp.gov.pl/pl/przedmioty-ochrony/ogolne-wytyczne-prezesa-uprp>

⁷⁶ Article 129(1)(6) of Industrial Property Act of Poland, „1.Nie udziela się prawa ochronnego na oznaczenie, które: (...) 6) zostało zgłoszone w złej wierze”- translation by legalis accessed on 12.12.2022 at: <https://sip-1legalis-1pl-147d9pe4r2024.hps.bj.uj.edu.pl/document-full.seam?documentId=mfxilrshaydomzqg42dmltqmfyc4mzzgy4tombygmxxhmzlsfyytomrwhe&refSource=guide>

bad faith constitutes absolute ground for trademark invalidity. Moreover art. 165 provides that:

“1. An application to invalidate protection cannot be filed:

1) due to a conflict with an earlier mark or infringement of the applicant's personal or economic rights if, for a period of five successive years of a registered mark being used, the applicant, while being aware of such use, has not opposed it;

2) if a trade mark is granted protection in breach of article 1291 (1)(2)- (4) and by the date of the application has taken on, as a result of use, a distinctive character in average trade conditions;

3) due to a conflict with a well known trade mark if, for a period of five successive years of a registered trade mark being used, the holder of the well known trade mark, while being aware of such use, has not opposed it; (...)

2. Section 1 (1)-(3) applies if the holder has obtained protection by acting in bad faith.”⁷⁷

The legislator introduces a statute of limitations for the applicant's tolerance of using another trademark for five successive years, concerning applications for invalidation based on conflict with earlier rights of third parties to trademarks. This includes well-known trademarks and other personal or economic rights. This provision transposes Article 9 of Directive 2015/2436, which in para. 1 refers to relative grounds for earlier trademarks. The concept of personal or economic rights used in the abovementioned provision covers primarily copyrights, personal rights, rights to the company, and rights from registration of industrial designs. Additionally, the time limit of five years in which an application to invalidate a trademark can be filed constitutes a statute of limitations. It means that upon its expiry, the holder of the earlier right loses the right to request the invalidation of the contested trademark. The burden of proof of using the contested trademark rests with its proprietor. If the use of a contested trademark has been discontinued, the five years period

⁷⁷ Idem, Article 165 „1.Z wnioskiem o unieważnienie prawa ochronnego nie można wystąpić: 1) z powodu kolizji z wcześniejszym znakiem bądź naruszenia praw osobistych lub majątkowych wnioskodawcy, jeżeli przez okres pięciu kolejnych lat używania zarejestrowanego znaku wnioskodawca, będąc świadomym jego używania, nie sprzeciwiał się temu; 2) jeżeli na znak towarowy udzielono prawa ochronnego z naruszeniem art. 1291 ust. 1 pkt 2-4, a do dnia złożenia wniosku znak ten nabrał, w następstwie jego używania, charakteru odróżniającego w zwykłych warunkach obrotu; 3) z powodu kolizji ze znakiem towarowym powszechnie znanym, jeżeli przez okres pięciu kolejnych lat używania zarejestrowanego znaku towarowego, uprawniony do znaku towarowego powszechnie znanego, będąc świadomym jego używania, nie sprzeciwiał się temu; (...). 2. Przepisów ust. 1 pkt 1 i 3 nie stosuje się, jeżeli uprawniony uzyskał prawo ochronne działając w złej wierze.” translation by legalis accessed on 16.12.2022 at: <https://sip-1legalis-1pl-147d9pe4r2024.hps.bj.uj.edu.pl/document-full.seam?documentId=mfxilrshaydomzqg42dmltqmfc4mzzgy4tombygmxxhmzlsfyytomrwhe&refSource=guide>

is counted anew, i.e. from the moment when the holder of the earlier right knew about the resumption of use. This limitation to the possibility of seeking a declaration of invalidity of a later trademark on the grounds of acquiescence is justified by the need to ensure legal certainty. In paragraph 2 of the abovementioned article, the legislator also introduces an exception to this provision. If the contested trademark was registered in a bad faith, there is no time limit in which the proprietor of an earlier trademark can request the invalidation of a later trademark.

“1. To the extent that it results from an international agreement, if an application is made on someone's own account for a trade mark or trade mark protection is obtained by an agent or representative of the person entitled to exclusively use this mark in a foreign state, this person, if the agent or representative acts without his consent, may request that proceedings be discontinued or that protection be invalidated. This person may also request that he be granted protection for this mark and also that any protection already granted to him be transferred.”⁷⁸

This provision establishes the protection of authorized entities or persons against the disloyal actions of their representatives or agents. This provision transposes Article 5 para. 3) letter b) and Article 13 of Directive 2015/2436. The purpose of this provision is to prevent the application of the earlier mark by the representative or an agent of the proprietor of that mark. The representative or an agent with whom the proprietor of the mark cooperates may use the knowledge and experience acquired during the course of business relationship and as a result, take undue advantage of the investments and efforts of the proprietor. The provision is therefore intended to prevent a situation in which a representative or an agent act disloyally towards the owner of a trademark who is his partner. For this provision to apply, some conditions should be met, namely: representative or an agent has applied for a trademark that belong to the entitled person, the application

⁷⁸ Idem, Article 161 „1. W przypadku zgłoszenia na swoją rzecz znaku towarowego albo uzyskania prawa ochronnego na znak towarowy przez agenta lub przedstawiciela uprawnionego z prawa ochronnego na znak towarowy, uprawniony, jeżeli agent lub przedstawiciel działał bez jego zgody i nie uzasadnił swojego działania, może żądać umorzenia postępowania albo unieważnienia prawa ochronnego na ten znak, a także udzielenia mu prawa ochronnego na ten znak albo przeniesienia na niego już udzielonego prawa. Uprawniony może żądać ponadto zakazania używania znaku towarowego przez agenta lub przedstawiciela. 2. Z żądaniem unieważnienia lub przeniesienia prawa nie można wystąpić, jeżeli przez okres pięciu kolejnych lat używania zarejestrowanego znaku osoba uprawniona, o której mowa w ust. 1, będąc świadoma tego używania, nie sprzeciwiała się temu. 3. Do osoby, która nie będąc do tego uprawniona, zgłosiła na swoją rzecz znak towarowy lub uzyskała na niego prawo ochronne, przepis ust. 1 stosuje się odpowiednio.” translation by legalis accessed on 18.12.2022 at: <https://sip-legalis-1pl-147d9pe4r2024.hps.bj.uj.edu.pl/document-full.seam?documentId=mfxilrshaydomzqg42dmltqmfc4mzzgy4tombygmxxhmzlsfyttomrwe&refSource=guide>

concerns a trademark that is protected in one of the member states of the Paris Convention, the application was filled without the consent of the entitled person and the action of the representative, or an agent is not justified. This provision provides the person entitled to a trademark with different requests depending on which stage of registration in Poland is the trademark in question. If the trademark application has not been registered yet the entitled person has a right to oppose an application or demand the right to protection to be granted to him or her. If the trademark in question has been already registered the entitled person might seek invalidation or transfer of the rights. However, the possibility of requesting invalidation or transfer of protection already granted in Poland is excluded if the person entitled to the mark for five consecutive years of use of a registered mark being aware of this use, did not oppose it. The aim of this limitation is to penalize the proprietors of earlier rights that have acquiesced, for a period of five successive years, in the use of such a trademark while being aware of it. It is important to mention that the concept of bad faith and the abovementioned provision is independent of each other with different conditions to be fulfilled for its application. Registration of a trademark by a representative or an agent in the circumstances stated in Article 161 might but will not in every case constitute a bad faith application therefore if the trademark in question was registered in bad faith the limitation of five years does not apply and the trademark might be invalidated any time. Additionally, protection to well-known trademarks is provided in Article 132(1)(4) and (5). This provision is of significant importance since well-known trademarks are often subject to bad faith trademark application. Provision in question establishes:

“1. After an opposition referred to in article 1526a (1) or article 15217 (1) is examined and found to be well founded, protection is not granted for a trade mark: (...)

4) identical or similar to a reputable trade mark for which protection was granted with earlier priority to another person for goods of any type where use of such sign without due cause brings the user unfair advantage or is detrimental to the distinctive character or repute of the earlier mark;

5) identical or similar to a trade mark which, prior to the date according to which priority to obtain protection is determined, was in the Republic of Poland officially recognised and adopted for use as a trade mark used to mark identical or similar goods originating from another person, if there is a likelihood of confusion on the part of the public; the likelihood

of confusion includes the likelihood of association between the sign and an earlier mark.”⁷⁹

The abovementioned provision in paragraph 1(4) provides a ground for refusal of trademark application that is in conflict with a reputed trademark. This provision establishes an exception to the principle of specialization. If trademark application or registered trademark conflicts with reputed trademark neither the similarity of goods or services nor the risk of confusion are factors determining application of the provision, provided that such registration brings unfair advantage or is detrimental to the distinctive character of reputed trademark. This provision corresponds to Article 5(3)a of the Directive 2015/2436. Paragraph 1(5) of the provision provides a ground for refusal of trademark application that is in conflict with a well-known trademark. This provision corresponds to Article 5(1) and (2)(d) of the Directive 2015/2436. A well-known mark is a concept similar to the reputable mark, as both shall be recognized by significant part of the public. However, a reputed trademark is a registered mark and a well-known mark is not. Therefore, the formal registration criterion is the only one that distinguishes a reputable mark from a well-known mark. The well-known trademarks in Poland enjoys the same protection as registered ordinary trademarks and principle of specialty applies to them. The difference however is that due to lack of official registration the provision in question provide protection to well-known trademarks only for goods and services for which it have been used and became well-known. Obtaining the status of reputed or a well-known trademark of the earlier mark is a prerequisite for assessing the applicability of the provision in question as a basis for opposition or for a declaration of invalidity. The right holder who claims special protection bears the burden of proof that the mark is recognized within significant part of the public interested in related goods or services. The proprietor must prove the existence of the reputation on the filing date of the contested mark or an earlier priority date.

⁷⁹Idem. Article 132(1)(4) and (5) „1. Po rozpatrzeniu sprzeciwu, o którym mowa w art. 1526a ust. 1 lub art. 15217 ust. 1, uznanego za zasadny nie udziela się prawa ochronnego na znak towarowy: identyczny lub podobny do znaku towarowego, który przed datą według której oznacza się pierwszeństwo do uzyskania prawa ochronnego był w Rzeczypospolitej Polskiej powszechnie znany i używany jako znak towarowy przeznaczony do oznaczania towarów identycznych lub podobnych pochodzących od innej osoby, jeżeli zachodzi ryzyko wprowadzenia odbiorców w błąd, które obejmuje, w szczególności ryzyko skojarzenia znaku zgłoszonego ze znakiem powszechnie znanym;” translation by legalis accessed on 18.12.2022 at: <https://sip-1legalis-1pl-147d9pe4r2024.hps.bj.uj.edu.pl/document-full.seam?documentId=mfrxilrshaydomzqg42dmltqmfyc4mzzgy4tombygmxxhmzlsfyytomrwhe&refSource=guide>

2.2.2. General Guidelines of The President of the PPO on Trademarks

The Guidelines consists of two parts. First part deals with absolute grounds for granting trademark protection and consist of ten chapters while second part concerns grounds of objection based on Article 132 of Industrial Property Act and consists of four chapters. Chapter five of the first Part is dedicated trademarks applied for in a bad faith.

The Guidelines provide that the PPO refuses to grant protection right to a mark that was applied for in bad faith. In Poland bad faith is considered as absolute ground of refusal and can be examined ex officio. Third parties might also inform the PPO about applicant acting in bad faith. The PPO might refuse granting the protection right to a sign which was applied for in a bad faith both before the publication of the trademark and after its publication in the "Bulletin of the Patent Office".⁸⁰ Additionally it is provided, that there is no legal definition of bad faith nor in Polish or EU legislation therefore judiciary and legal doctrine play a fundamental role in its interpretation. Nevertheless, the Guidelines emphasize that bad faith is an autonomous concept of EU law and should be applied consistently in EU and national trademark systems.⁸¹ Furthermore it is said that under Polish law presumption of good faith is established (pursuant to Article 7 of the Penal Code), which is expressed in the assumption that the applicant of a trademark markets or intends to market goods derived from the application. While accessing bad faith Polish courts are guided by the principle that bad faith should be examined in wide range and to the extend justified by the circumstances. Additionally, the situation in which the applicant and the entity whose mark was applied for had a special relationship of trust resulting from business relations between two parties, is given as example of bad faith. Guidelines emphasize that dishonest behavior of the applicant, which does not comply with honest commercial practices and when applicant intend to compete unfairly with a competitor, is of significant importance when examining bad faith.⁸²

⁸⁰ General Guidelines of The President of the PPO on Trademarks, Chapter V, Introduction, accessed on 23.12.2022 at: <https://uprp.gov.pl/pl/przedmioty-ochrony/ogolne-wytyczne-prezesa-uprp/wytyczne-w-zakresie-znakow-towarowych-/znaki-zgloszone-w-zlej-wierze/wstep>

⁸¹ Idem. Chapter V, Point 1, accessed on 23.12.2022 <https://uprp.gov.pl/pl/przedmioty-ochrony/ogolne-wytyczne-prezesa-uprp/wytyczne-w-zakresie-znakow-towarowych-/znaki-zgloszone-w-zlej-wierze/definicja-zlej-wiary>

⁸² Idem. Chapter V, Point 2, <https://uprp.gov.pl/pl/przedmioty-ochrony/ogolne-wytyczne-prezesa-uprp/wytyczne-w-zakresie-znakow-towarowych-/znaki-zgloszone-w-zlej-wierze/koncepcje-krajowe>

2.3. China

2.3.1. Trademark Law of the PRC 2019

The Trademark Law of the PRC contains the notion of bad faith in four articles. The first article that relates to bad faith is Article 4 and it introduces bad faith as an absolute ground for the refusal and invalidation of the trademark application. Additionally, Article 36 establishes compensation liability of other parties who in bad faith cause losses to the trademark registrant during the time while the decision to approve the registration of a trademark is prolonged due to unsubstantiated opposition claims. Article 45 imposes some limitations to the invalidation of trademarks that are registered for at least five years and provides an exception to these limitations if registration simultaneously infringes well-known trademarks and was filled in bad faith. Furthermore, Article 47 deals with the legal consequences of trademark invalidation and provides a legal tool for compensation of losses caused in bad faith. Paragraph 1 of article 4 of PRC Trademark Law, last amended April 23, 2019, states that:

*“A mala fide trademark registration application not made for the purpose of using the trademark shall be rejected.”*⁸³

After the Trademark Law of the PRC was revised in 2019, Article 4 has become a powerful tool to limit trademark evergreening in China. This article provides possibility for opposition of mala fide trademark application. Mala fide from Latin means “in bad faith” therefore it concerns opposition of a trademark applications on a ground of bad faith. It means that trademark applied for in a bad faith not made with the intention of use can be rejected as early as the substantial examination stage. Bad faith in this article is considered as an absolute ground for refusal therefore it also constitutes absolute ground for invalidation of already registered trademark. The State Administration of Market Regulation, an agency directly under State Council of People’s Republic of China, released Several Provisions on Regulating the Application for Registration of Trademarks,

⁸³ Article 4(1) of the Trademark Law of the People's Republic of China (as amended up to decision of April 23, 2019, of the Standing Committee of National People's Congress), “不以使用为目的的恶意商标注册申请，应当予以驳回。” translation by WIPO accessed on 07.11.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

which came into effect on 1 December 2019.⁸⁴ Article 8 of the abovementioned act provides guidance on which factors shall be taken into consideration while assessing whether the applicant acted in a bad faith. Among others in the act are listed circumstances such as a number of registered trademarks, designated classes, the applicant's industry and business status, whether the applicant has been engaged in the bad faith registration or infringed exclusive rights of others before, whether the trademark applied for registration is identical or similar to another's a well-known trademark or a name of a well-known person, company or other commercial signs. Furthermore, article 36 of the Trademark Law of the PRC 2019 establishes that:

“(…) Where the registration of a trademark is approved after the objection to its registration is found to be unsubstantiated upon examination, the time when the trademark registration applicant obtains the exclusive right to use the trademark shall commence from the date of the expiry of the three-month period of the preliminary examination announcement. During the period from the date of the expiry of the said announcement period to the time when decision is made to approve the registration of the trademark, the trademark shall have no retroactive effect on the use of an identical or similar mark by another party on the same kind of goods or similar goods. However, such other party shall be liable for compensating any losses caused, mala fide, to the trademark registrant.”⁸⁵

This provision establishes compensation liability of the other party which during the period of prolonged registration due to the trademark being challenged in opposition procedure, use in bad faith a trademark identical or similar to the trademark in question. If another party during the time of opposition procedure acts in bad faith and causes damage to the applicant of the trademark, the applicant has the right to claim compensation from the infringer if the opposition will not be successful and the trademark will be approved

⁸⁴Several Provisions on Regulating the Application for Registration of Trademarks, 规范商标申请注册行为若干规定 accessed on 15.12.2022 at: <https://www.cnipa.gov.cn/attach/0/5b14f84d13e84b22965eb1983834d16f.pdf>
reference translation by IPkey.eu accessed on 15.12.2022 at: https://ipkey.eu/sites/default/files/ipkey-docs/2020/IPKey-China_may2020_Several-Provisions-on-Regulating-Trademark-Registration_CE.pdf

⁸⁵ Article 36 of the Trademark Law of the People's Republic of China (as amended up to decision of April 23, 2019, of the Standing Committee of National People's Congress) “(。 。 。)经审查异议不成立而准予注册的商标，商标注册申请人取得商标专用权的时间自初步审定公告三个月期满之日起计算。自该商标公告期满之日起至准予注册决定做出前，对他人在同一种或者类似商品上使用与该商标相同或者近似的标志的行为不具有追溯力；但是，因该使用人的恶意给商标注册人造成的损失，应当给予赔偿。”translation by WIPO accessed on 07.11.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

for registration. This article provides that only use in bad faith can be compensated because, when the opposition procedure takes place, the trademark in question has not been yet approved for registration and is in the process of objection. Use by other parties of an identical or similar trademark in good faith during the time of opposition procedure is not subject to compensation because trademark protection commences from the registration date and the registration of a trademark shall not have a retroactive effect on the use of identical or similar trademarks before the registration date. During a prolonged period of registration, exceeding the statutory 3 months, to protect the legitimate interests of a trademark applicant, the law provides a retroactive effect applicable only for bad faith use. Furthermore Article 44

“A registered trademark shall be declared invalid by the trademark office if it is in violation of Article 4, Article 10, Article 11, Article 12 or the fourth paragraph of Article 19 of this Law, or its registration is obtained by fraudulent or other illegitimate means. Other entities or individuals may request the trademark review and adjudication board to declare the aforesaid registered trademark invalid.”⁸⁶

Having into consideration the notion of bad faith, the most important function of Article 44 is to provide a legal ground for the invalidation of a trademark that was registered in violation of Article 4 (bad faith trademark application). Additionally, it provides that a trademark filled in a fraudulent or illegitimate means should be rejected and, if granted, invalidated. Fraudulent means usually refers to the act of fabricating a signature and seal on application documents or the act of fabricating and altering the applicant's identity certification documents such as an ID card, or business license. Illegitimate means might refer to disturbing the order of trademark registration, harming the public interest, improperly occupying public resources, or obtaining improper benefits. If the trademark will be declared invalid by the trademark office, concerned parties will be notified in writing. Application for the review of the decision of the trademark office might be filled in the Trademark Review and Adjudication Board within fifteen days of the receipt of the notice from the trademark office. After the application for the review is filled TRAB shall within nine months render a ruling on either maintaining the validity of the registered

⁸⁶ Idem. Article 44.” 已经注册的商标，违反本法第四条、第十条、第十一条、第十二条、第十九条第四款规定的，或者是以欺骗手段或者其他不正当手段取得注册的，由商标局宣告该注册商标无效；其他单位或者个人可以请求商标评审委员会宣告该注册商标无效。” translation by WIPO accessed on 07.11.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

trademark or declaring the registered trademark invalid. The decision made by TRAB can be further challenged in the lawsuit in the People's Court within 30 days of receiving the notice. Moreover, Article 45 states that:

„Where a registered trademark is in violation of the second and third paragraph of Article 13, Article 15, the first paragraph of Article 16, Article 30, Article 31 or Article 32 of this Law, the holder of prior rights or an interested party may, within five years upon the registration of the trademark, request the trademark review and adjudication board to declare the registered trademark invalid. Where the aforesaid registration is obtained mala fide, the owner of a well-known trademark is not bound by the five-year restriction.”⁸⁷

This provision introduces five years grace period during which a trademark can be invalidated due to violation of the second and third paragraph of Article 13, Article 15, the first paragraph of Article 16, Article 30, Article 31, or Article 32. The second and third paragraph of Article 13 considers the protection of well-known trademarks not registered in China from reproduction, imitation, or translation for identical, similar, different, or dissimilar kind of goods where registration is liable to cause public confusion or misleads the public so that the interests of the owner of the well-known trademark are likely to be impaired. Article 15 protects clients from circumstances in which the agent or representative, without authorization of the client, seeks to register in its own name the client's trademark. The first paragraph of Article 16 affords protection to geographical indication when the place indicated is not the origin of the goods and misleads the public. Articles 30, 31, and 32 refer to prior rights and prohibit the registration of marks identical or similar to the trademark already registered by another person. If two or more similar or identical trademarks for the same or similar kind of goods are applied the right will be afforded to the trademark with an earlier application date. If the registered trademark violates the abovementioned provisions, it can be invalidated within five years upon the registration. Application to start invalidation proceedings might be requested by any interested party, not only by the holder of prior rights. After five years a registered trademark cannot be invalidated anymore unless by the owner of a well-known trademark

⁸⁷ Idem. Article 45. “已经注册的商标，违反本法第十三条第二款和第三款、第十五条、第十六条第一款、第三十条、第三十一条、第三十二条规定的，自商标注册之日起五年内，在先权利人或者利害关系人可以请求商标评审委员会宣告该注册商标无效。对恶意注册的，驰名商标所有人不受五年的时间限制。”
translation by WIPO accessed on 07.11.2022 at: <https://wipo.int/en/text/579988>

and unless the trademark was registered in bad faith. It follows from the foregoing that wider protection is granted to well-known trademarks and ordinary trademarks are excluded from requesting the invalidation of subsequently registered trademarks if five years passed from the registration date. The last provision which contains the notion of bad faith is Article 47 which establishes that:

“A registered trademark that is declared invalid in accordance with Article 44 or Article 45 of this Law shall be announced by the trademark office, and the exclusive right to use the registered trademark thereof shall be deemed as non-existent ab initio.

The decision or ruling on declaring a registered trademark invalid shall have no retroactive effect on a judgment, ruling or mediation statement on a trademark infringement case already rendered and enforced by a people’s court, a decision on handling a trademark infringement case already made and enforced by an administrative department for industry and commerce as well as a trademark transfer or licensing contract already performed prior to such declaration. However, the trademark registrant shall be liable for compensation where losses are caused, mala fide, to another party.”⁸⁸

This article establishes that trademark office shall announce trademarks which have been declared invalid on grounds stated in Article 44 and Article 45 of Trademark Law of the PRC. What is more exclusive rights to thus invalidated trademark shall be deemed as non-existent ab initio. It means exclusive rights shall be considered as non-existent from the very beginning, like they never existed, and not from the date when trademark was invalidated. Nevertheless, the provision states that the invalidation of a trademark shall not have a retroactive effect on a trademark infringement cases where judgement, ruling or mediation statement has already been rendered and enforced by a people’s court. The invalidation of a registered trademark also shall not have retroactive effect on already made and enforced administrative decision on handling trademark infringement case. Furthermore, trademark licensing contract or a trademark transfer already performed

⁸⁸ Idem, Article 47. “依照本法第四十四条、第四十五条的规定宣告无效的注册商标，由商标局予以公告，该注册商标专用权视为自始即不存在。宣告注册商标无效的决定或者裁定，对宣告无效前人民法院做出并已执行的商标侵权案件的判决、裁定、调解书和工商行政管理部门做出并已执行的商标侵权案件的处理决定以及已经履行的商标转让或者使用许可合同不具有追溯力。但是，因商标注册人的恶意给他人造成的损失，应当给予赔偿。依照前款规定不返还商标侵权赔偿金、商标转让费、商标使用费，明显违反公平原则的，应当全部或者部分返还。” translation by WIPO accessed on 07.11.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

before trademark invalidation also shall not be affected by retroactive effect of such a decision or ruling on declaring a registered trademark invalid. Even though his provision provides certain circumstances in which retroactive effect of invalidation cannot be applied, it also establishes that despite lack of possibility to apply the abovementioned retroactive effect, the registrant of invalidated trademark shall be liable for compensation if the losses were caused in a bad faith. Additionally, the Trademark Law of the PRC 2019 contains other provisions which do not include wording of bad faith but also relate to it.

“The principle of good faith shall be upheld in the application for trademark registration and in the use of trademarks.”⁸⁹

This provision explicitly introduces the principle of good faith into trademark law. Nevertheless, this is a general provision, and each case is assessed on a specific basis. Therefore, this provision is usually not directly adopted by administrative authorities in practical procedures such as trademark rejection, opposition, and invalidation. For example, in the circumstances listed in Article 33 of the Trademark Law of the PRC, where an opposition can be filed with the Trademark Office, it does not include situations that violate the principle of good faith. The general understanding is that the principle of good faith has been refined and reflected through other relevant clauses. Additionally, Article 13 provides protection of well-known trademarks providing that:

“(…) An application for registration of a trademark which is a replication, imitation, or translation of other’s well-known trademark not registered in China for use on identical or similar commodities which is easily misleading shall not be registered and the use of such a mark shall be prohibited.

An application for registration of a trademark which is a replication, imitation, or translation of other’s well-known trademark already registered in China for use on non-identical or non-similar commodities which is misleading to the public and may cause harm to the interest of the trademark registrant of the said well-known trademark shall not be registered and the use of such a mark shall be prohibited.”⁹⁰

⁸⁹ Idem. Article 7 “申请注册和使用商标，应当遵循诚实信用原则。” translation by WIPO accessed on 07.11.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

⁹⁰. Idem. Article 13 para. 2 and 3“就相同或者类似商品申请注册的商标是复制、摹仿或者翻译他人未在中国注册的驰名商标，容易导致混淆的，不予注册并禁止使用。就不相同或者不类似商品申请注册的商标是复制、摹仿或者翻译他人已经在中国注册的驰名商标，误导公众，致使该驰名商标注册人的利益可能受

This article provides protection of well-known trademarks with no regard if they are registered in China or not. In general, protection is provided against reproduction, imitation, and translation for use on identical or similar goods, provided that it is confusing to consumers. Additionally, when a trademark is recognized as well-known and registered in China it enjoys wider protection that extends also to classes and services not related to the registered ones, provided that it misleads the public and it might cause harm to the interest of the proprietor of the registered well-known trademark. In the original Chinese wording for both registered and not registered trademarks which are widely known to the relevant public the same term “的驰名商标” is used. While in EU legislation mark that is known to the relevant public but not registered is referred to as well-known and a registered one is referred to as reputed, in China no distinction like this is provided. It is important to mention that officially nothing like the status of a well-known trademark exists. This status is recognized individually by the administrative or judicial authorities. Trademarks can be granted well-known status during civil or administrative proceedings. Factors to consider while assessing whether a trademark is well-known are several and not cumulative. Authorities among others shall evaluate the degree of recognition among the targeted audience, the duration, extent, and geographic area of use. Nevertheless, if a trademark has been granted the status of a well-known trademark in one case, it doesn't bind the competent authorities to grant protection resulting from this status in another case, but it constitutes a strong reference.⁹¹ Furthermore, Article 15 grant protection against dishonest agents or representatives. It establishes that:

“Where an agent or representative, without authorization of the client, seeks to register in its own name the client's trademark and the client objects, the trademark shall not be registered, and its use shall be prohibited.”⁹²

到损害的，不予注册并禁止使用。” translation by G.Piscane, D.Zibetti, Intellectual Property in China. Springer 2020, p.88

⁹¹ P.Ganea, D.Friedmann, J.Lee, D.Clark, Intellectual Property Law in China, Second Edition. Max Planck Institute for Innovation and Competition, Wolters Kluwer 2021, p.252.

⁹² Article 15 of the Trademark Law of the People's Republic of China (as amended up to decision of April 23, 2019, of the Standing Committee of National People's Congress) “第十五条未经授权，代理人或者代表人以自己的名义将被代理人或者被代表人的商标进行注册，被代理人或者被代表人提出异议的，不予注册并禁止使用。就同一种商品或者类似商品申请注册的商标与他人在先使用的未注册商标相同或者近似，申请人与该他人具有前款规定以外的合同、业务往来关系或者其他关系而明知该他人商标存在，该他人提出异议的，不予注册。” translation by WIPO accessed on 24.12.2022 at: <https://wipo.int/en/text/579988>

This provision is considered to protect unregistered trademarks in China. It derives from the content of Article 6 (7) of the Paris Convention. The conduct of the agent or representative registering the trademark of the person with whom the agent or representative have business relationship, without authorization violates the bona fide doctrine, and infringes the legal rights and interests of the other party. Under this provision the concept of agent includes not only the term provided by the General Principles of the Civil Law and the Contract Law, but also includes the dealers who can learn of the trademark of the person for whom he acts as an agent because of the commercial exchanges.⁹³ This provision doesn't require prior use or reputation of the trademark. The only requirement is a specific business relationship between the parties. It is applicable in circumstances in which an applicant entered into a contractual or commercial relationship with the prior user of a mark and try to register identical or similar for identical or similar goods. In opposition or invalidation proceedings based on Article 15, the burden of proof of the existence of such a business relationship is on the claimant. Additionally, as it was described above, Article 45 provides a legal tool to invalidate a registered trademark that stands in violation of the provisions of this article. Nevertheless, the invalidation proceeding shall be applied for within five years upon the registration date of the infringing trademark. Five years duration is a subject of exception only for proprietors of well-known trademarks, and if the registration of an infringing trademark was made in bad faith. Furthermore, Article 32 stipulates that:

“No applicant for trademark application may infringe upon another person's existing prior rights, nor may he, by illegitimate means, rush to register a trademark that is already in use by another person and has certain influence(...)”⁹⁴

This provision aims to check and combat preemptive registration by improper means for prior-use marks that enjoy substantial influence. Substantial influence refers to an already used trademark that is known by the relevant public in certain fields, and it is decided based on specific circumstances by taking the history and term of trademark use, advertisement situation, and the influence of the trademark into consideration. It is meant

⁹³ Shi Xinzhang, The Understanding and Application of Article 15 of the Trademark Law, accessed on 24.12.2022 at: <http://www.chinaipmagazine.com/en/journal-show.asp?id=290>

⁹⁴ Article 32 of the Trademark Law of the People's Republic of China (as amended up to decision of April 23, 2019, of the Standing Committee of National People's Congress) “申请商标注册不得损害他人现有的在先权利，也不得以不正当手段抢先注册他人已经使用并有一定影响的商标。” translation by WIPO accessed on 24.12.2022 at: <https://wipo.lex.wipo.int/en/text/579988>

to protect non-trademark rights to prevent the act of trading on others' goodwill, which cannot be classified as a trademark right. Under this provision, prior rights include trade name right, copyright, portrait right, geographical indication, the name, package, or decoration of a product with a certain reputation, and other prior rights. Where a trademark is identical with or similar to a prior right that is already registered or used by another party and has certain influence, and the registration of the trademark is liable to create confusion to the public and damage the interest of the owner of the prior right, such registration shall be deemed as an infringement upon other's prior right and shall not be approved. Additionally, if the mark that violates of the abovementioned provision happened to be registered it still can be declared invalid on the grounds of Article 45 of the Trademark Law of the PRC. Additionally, Article 68(3) establishes:

“A trademark agency that commits any of the following acts shall be ordered to make correction within a time limit by the administrative department for industry and commerce, be given a warning, and be fined not less than RMB 10,000 yuan but not more than RMB 100,000 yuan; the persons in charge who are directly responsible and other persons directly responsible shall be given a warning and be fined not less than RMB 5,000 yuan but not more than RMB 50,000 yuan; where a crime is constituted, criminal liabilities shall be investigated in accordance with the law: (...)

(3) Violating the provisions of Article 4, and the third and fourth paragraph of Article 19 of this Law.”⁹⁵

Article 68(3) regulates trademark agencies. It introduces penalties applicable to trademark agencies which fill a trademark application in violation of Article 4. It means that when trademark agency fills a trademark application in a bad faith, without intent to use shall be liable for administrative penalties, including warnings and fines. Fines range from RMB 5,000 (approx. USD 700) to RMB 100,000 (approx. USD 14,300). Provision provides penalties not only for the agencies as a business entity, but also directly for persons in charge and other persons directly responsible. Subsequent statements by CNIPA suggest

⁹⁵ Idem. Article 68(3) “商标代理机构有下列行为之一的，由工商行政管理部门责令限期改正，给予警告，处一万元以上十万元以下的罚款；对直接负责的主管人员和其他直接责任人员给予警告，处五千元以上五万元以下的罚款；构成犯罪的，依法追究刑事责任：（一）办理商标事宜过程中，伪造、变造或者使用伪造、变造的法律文件、印章、签名的；（二）以诋毁其他商标代理机构等手段招徕商标代理业务或者以其他不正当手段扰乱商标代理市场秩序的；（三）违反本法第四条、第十九条第三款和第四款规定的。”translation by WIPO accessed on 24.12.2022 at: <https://wipo.int/en/text/579988>

that this provision by means other responsible persons is also applicable to trademark applicants themselves filling applications or instituting litigation in a bad faith. Additionally, if a trademark agency has committed any of conduct stipulated in Article 68, it will be recorded by the Administrative Department for Industry and Commerce. In case of severe circumstances, the trademark office and TRAB shall decide to stop accepting the trademark agency to handle the trademark agency business and make a public announcement. Moreover, agencies might be subjected to criminal liability if the case reaches the criminal threshold.

2.3.2. Guidelines for Trade Mark Examination and Trial 2022

On 16 November 2021, CNIPA, through Announcement No 462, released the Guidelines for Trade Mark Examination and Trial⁹⁶ which came into effect on 1 January 2022, repealing the Standards for Trade Mark Examination and Trial of 2016. The guidelines aim to standardize the trademark examination and trial procedures and ensure the uniform application of laws in trademark examination and trial aspects. The guidelines consist of two parts where first part focuses on procedures for the formal review and administrative works and second part provides the substantive standards for trademark examination and adjudication. First part is divided into five chapters and second part is divided into nineteen parts. The notion of bad faith is addressed in several chapters of part two of the guidelines. Chapter two focuses on examination and trial of bad faith application with no intend to use, chapter ten concentrate on reproduction, imitation and translation of others' well-known trademarks, chapter eleven deals with unauthorized registration of the principal or the representative's trademark, chapter twelve is dedicated to preemptive registration of a trademark previously used by a specific related person, chapter thirteen covers trademarks applied for registration by trademark agency, chapter fourteen focuses on other's prior right, chapter fifteen provide guideline on preemptive registration of other's trademark already used and having certain influence, and chapter sixteen is devoted to trademark registration obtained by deceptive or other improper means.

The first chapter of the second part of the guidelines is a general overview of basic principles, concepts, and scope of review. It introduces the principle of good faith as a

⁹⁶ Guidelines for Trade Mark Examination and Trial, 国家知识产权局关于发布《商标审查审理指南》的公告（第462号, accessed on 25.12.2023 at: https://www.cnipa.gov.cn/art/2021/11/22/art_74_171575.html

basic principle in various legal relationships such as trademark registration, use, management, and protection. It obliges to handle trademark registration applications and other trademark matters under laws and good faith principles and not by means of knowingly breaking the law, fabrication, concealment, forgery, or deception, avoidance of known social public interests, or abuse of prior rights of others. Furthermore, the first chapter introduces the first to file rule according to which exclusive trademark rights are obtained through registration to whoever is the first to file the application, and other applications or the same trademark on the same goods or services shall be rejected. Even though for most of goods registration of a trademark is a voluntary decision of its proprietor, there are some goods for which trademark registration is required by laws and administrative regulations therefore mandatory for the purpose to sell on the market. The first to file rule is supplemented by the principle of intent to use to eliminate unfair consequences that may result from the strict implementation of the first to file rule and provide a certain degree of protection for prior used unregistered trademarks. The trademark application should be based on real business activity and for purpose of actual use therefore bad faith applications that are not made for real use for legitimate purposes shall be rejected. Additionally, the trademark that has not been used for three consecutive years without justified reasons can be revoked. Registration is not granted for trademarks that reproduce, imitate, or translate other people's well-known trademarks that have not been registered in China on the same or similar goods or services is prohibited, Registration of trademarks previously used by others based on contracts, business relationships or other relationships, and preemptive registration of trademarks that have already been used by others and have a certain influence. In the overview, the principle of protection of legal prior rights is also described. It aims to protect the right of others obtained before the application for trademark registration was made. Prior rights include prior trademark application, prior actual use of a trademark, copyright, design patent right, name right, portrait right, registered business names that have been used and have a certain influence, and commodity or service names that have a certain influence, packaging, packaging, etc. If the trademark application conflicts with the prior rights of others such an application shall be refused, and if such an application was accepted for registration it should be liable to be declared invalid. Moreover, the principle of the prohibition of abuse of rights is introduced, which means that abuse of rights to damage national interests, social public interests, or the legitimate rights and interests of others is prohibited. The exercise of rights must not exceed its legitimate limit, otherwise, it constitutes abuse and should bear the responsibility. Furthermore, point three of the overview deals with

improper means and bad faith. Both terms refer to trademark applicants or trademark agencies that violate the principle of good faith, disrupt the order of trademark registration, and seek illegitimate benefits. Bad faith additionally requires the subject to know or ought to know that the conduct in question violates the law, hinder public order, harm the public interest, or infringe the rights of others and yet carries them out.

Chapter two focuses on the examination and trial of bad faith application without intend to use under Article 4 of Trademark Law of the PRC. The guidelines outline six factors to consider when assessing bad faith. First, the cumulative number of registered trademarks applied for by the applicant or natural persons, legal persons, and other organizations that have an affiliated relationship with applicant, as well as the categories designated for use, trademark transactions, and the applicants' industry and business status will play a role. Secondly, administrative decisions, rulings, or judicial judgments into force will be reviewed to determine whether the applicant has previously been involved in bad faith trademark registration or trademark infringement. Similarity to others well-known or highly distinctive trademarks, name of famous person, the name of enterprise, the abbreviation of the enterprise name or other commercial logos also constitute an important factor. The purpose of Article 4 is to limit bad faith applications made not for the purpose of real use and strengthen the obligation to use the trademark. It might be in the situation when the applicant submits large number of trademark applications that according to the production and business it exceeds the needs of legitimate business and actual production or business capacity. If the applicant has sold or assigned trademark to a third party during the process of trademark registration or after obtaining trademark protection and fails to prove that he intended to use it prior to the sale or transfer, or provide a reasonable explanation for non-use, it may be considered as bad faith application with no intend to use. The same can be implied when trademark applicant actively or publicly sell trademarks to others or asking others for high transfer fees, infringement damages, or litigation settlement fees. The review process of bad faith application on the grounds of Article 4 is mainly based on the evidence on file submitted by opponent in opposition and invalidation proceedings.

Chapter ten deals with examination and trial of reproduction, imitation and translation of others' well-known trademarks on the grounds of Article 13, Article 14, and Article 45. Under Article 13 the protection to well-known trademarks is granted against copy, imitation or translation. If the well-known trademark is not registered in China, the

protection is provided for the same or similar goods and services if the sign is likely to cause confusion with well-known trademark. For well-known trademarks that are registered in China the scope of protection extends to different or dissimilar goods and services if the sign misleads the public and may damage the legitimate interest of proprietor of well-known trademark. These provisions aim to protect the interests of proprietors of well-known trademarks, maintain fair competition on the market, protect customer rights and prevent from the possible use of the popularity and reputation of well-known trademark that cause confusion on the market or mislead the public which may harm the legitimate interests of holder of well-known trademark. Article 14 provides list of factors that should be taken into account while determining the status of well-known trademark. TRAB and the Supreme People's Court for the purpose of trademark disputes, and trial of trademark civil and administrative cases may make the determination of the status of well-known trademark considering the degree of awareness of the trademark by relevant public, the duration of use of the trademark, the duration, extend and geographical scope of marketing of the trademark and other factors relevant for given case. Nevertheless, the producers and operators are not allowed to place the words "well-known trademark" on goods, packages, containers, advertisements, exhibitions and other commercial activities. The relevant public includes but is not limited to consumers, producers or providers, operators or relevant personnel involved in the distribution channels of the goods or services designated in the trademark application. Under Article 45 the prior right holder or interested party within five years from the date of trademark registration may request the TRAB to declare the registered trademark invalid. For bad faith registration, the well-known trademark owner is not subject to the five-year time limit. The existence of a bad faith might be assessed considering whether the applicant of the disputed trademark and the proprietor of a well-known trademark once had a business relationship, or are in the same region, or the goods or services of both parties have the same sales channels and geographical scope, or had other disputes where the owner of disputed trademark can know the famous trademark, had internal personnel exchanges. Additionally strong originality of well-known trademark and behavior of disputed trademark owner that indicates seeking improper benefits like asking for transfer fee, license fee or infringement compensation might be considered. Trademark holder shall submit relevant evidence to factors listed in Article 14 in order to request protection of a well-known trademark. The relevant evidence might include contracts, invoices bills of lading, bank receipts, import and export certificates, online e-commerce sales records, the scope of sales area, distribution of sales outlets, and sales channels and methods of the

goods, media advertisements, comments, reports, rankings and other promotional materials, materials of exhibitions and expositions. Moreover, materials on the earliest use time and continuous use of the trademark, certificate of the trademark registration, financial audit, tax payments, market share, credibility, official public data, awards received by a trademark and others relevant materials might be considered. Furthermore, the guidelines introduce four principles that should be applied where request for protection of well-known trademark is involved. Firstly, the principle of determination of individual case provides that the status of well-known trademark should be examined in specific circumstances of a given case and the result of identification of a status of well-known trademark is only valid in a given case. Secondly, principle of passive protection provides that the determination whether the trademark is well-known is made according to the request of the parties and based on the facts. If the party concerned does not claim the protection of a well-known trademark, the trademark registration department will not take the initiative to identify it. Next principle introduced for protection of well-known trademarks provides that identification of well-known trademark shall be determined according to the need of each specific case. If in given case other provisions of the Trademark Law of the PRC can be applied, or if the registration and use of the disputed trademark will not cause confusion or mislead the public, resulting in possible damage to the interests of the proprietor of well-known trademark, the trademark registration department does not need to issue a review of the trademark in question. The fourth binding principle is the principle of good faith, which has already been described earlier in this thesis.

Chapter eleven is dedicated to the examination and trial of the unauthorized trademark registration by the agent or representative under Paragraph 1 of Article 15 of the Trademark Law of PRC, which aims to prevent bad faith preemptive registration of a trademark for the same or similar goods by the agent or representative, knowing that trademark in question belongs to the client or represented person. This provision is applicable if the agent or representative of the trademark owner fills the application of the disputed trademark and cannot prove that the application has been authorized by the trademark owner, provided that trademarks are identical or similar and are designated for the same or similar goods or services. These four requirements are cumulative and all of them must be met simultaneously to invoke the protection provided for in Paragraph 1 of Article 15. The agent is given a broad meaning and it also includes distributors who may be aware of the trademark based on the business relationship. The representative refers to

an individual who may know the trademark due to performed duties, it might include legal representatives, directors, supervisors, managers, partnership executives, etc. This provision is also applicable if the trademark application was filed by a third party but there is evidence to prove that the applicant for registration has colluded with the agent or representative. In both cases, the claimant must prove the existence of an agency or representative relationship by submitting evidence which among others may include agency and distribution contracts, procurement materials, enterprise registration information, labor contract, employment documents, and social and medical insurance. The agent or representative might also prove the authorization by providing a written authorization document issued by the principal or represented person or other relevant evidence that proves the authorization. Additionally, Paragraph 2 of Article 15 introduces the rules for examination and trial of preemptive by a specific related person. A specific related person relates to the person that has a business relationship with the owner of the unregistered, previously used trademark, or relationship other than those specified in the preceding paragraph. It includes commercial and trade relationships like buyer-seller, contract processing, franchise, investment, sponsorship, business investigation and consultation, and advertising agency relationship. It might also include family relationships, affiliation, or circumstances in which the business address of the trademark applicant and the prior user is close and to those who are aware of prior trademark due to other relationships than those listed above. Under this provision, prior use refers not only to the trademark used on the sold goods and services but also used for the promotion of the trademark, and preparatory activities to put the goods bearing trademark on the market. Prior users need to prove that the trademark has been used.

Chapter thirteen regulates trademarks applied for registration by trademark agency. It aims to protect the public interest and prevent trademark agencies from taking advantage of their business by filing bad faith applications. Trademark agencies, law firms or other companies engaged in trademark agency services relates to entities which accepts the entrustment of the client and handles trademark registration application, trademark review or other trademark matters in the name of the client, including agent trademark registration application, change, renewal, transfer, opposition, revocation, review, Infringement complaints and other related matters, provide trademark legal advice, act as trademark legal counsel, and act as an agent for other trademark-related matters. Trademark agencies shall not apply in their own name for registration of trademarks other than services corresponding to the trademark agency of the forty-fifth class. If a trademark agency

applies for trademark registration on goods or services other than agency services, the application for trademark registration shall not be accepted.

Chapter fourteen focuses on damages to other prior rights under the Article 32 of Trademark Law of the PRC. In this provision term other prior rights relates to rights other than trademark rights that have been obtained before the date of application for registration of the disputed trademark, including trade name, copyrights, design patent, name, portrait, and geographical indications. Trademark application shall be refused or declared invalid if trademark applied for is identical or substantially identical to trade name right which is used by others provided that it has a certain degree of popularity will easily confuse the relevant Chinese public and cause possible damage to the interests of the owner of the trade name. The application for trademark registration shall also be refused or declared invalid if subject matter consists of someone else copyrighted work. Prior copyright can be proved by evidence of prior creation and completion, publication, registration certificate, or acquisition. To establish prior copyright evidence shall be dated before the date of application for trademark registration. Design patents constitute another prior right that is protected under Article 32. The party concerned should submit evidence such as design patent certificate, annual fee payment receipt to claim the protection and prove that the date of patent publication is earlier than application date of disputed trademark. Another right protected is a right to the name, which includes real names, pseudonyms, stage names, translated names, aliases, etc. This provision is applicable only to a name of natural persons who are alive when the disputed trademark is applied for registration. If someone's name which has a certain popularity is applied for trademark without permission, which may cause damage to the name right in question shall be refused or declared invalid. While assessing if registration of disputed trademark will cause damage the degree of popularity of the name and the degree of connection between the goods or services designated by the disputed trademark and the well-known field of the name right holder is taken into consideration. It is also important to specifically determine the protection scope of the prior name right. Furthermore, portrait rights are protected. Under discussed provision portrait is an identifiable external image of a specific natural person reflected on a certain carrier through images, sculptures, paintings. Similarly like in case of right to the name, this provision is applicable only to a portrait of natural persons who are alive when the disputed trademark is applied for registration. If the applicant of the disputed trademark claim that he obtained the permission of the copyright owner, the design patentee, the name right or portrait right holder he shall bear the burden of proof of

licensing. Under this provision geographical indications are also protected. Where the registration and use of the disputed trademark that is identical or similar to the prior geographical indication and is likely to mislead the public, which may damage the legitimate rights and interests related to the prior geographical indication the disputed trademark shall not be approved for registration or shall be declared invalid. Nevertheless, if the geographical indication has already been applied for registration as a collective trademark or certification trademark when the disputed trademark is applied for registration, the relevant provisions on the protection of trademark rights shall apply, and the provisions of this chapter shall not apply. Moreover, names of goods or services, packaging or appearance that is identical or similar to a trademark that has a certain influence and may easily confuse the relevant public and cause possible damage to the legitimate rights and interests of others cannot be registered as trademark.

Chapter fifteen provide guideline on preemptive registration of other's trademark already used and having certain influence on the grounds of Article 32. The provision is based on the principle of good faith to protect the unregistered trademarks that have been used and have a certain influence and prevent bad faith filings. The unregistered trademarks include both trademark that was not registered before the date of application for the disputed trademark or have lost the right to exclusive use because it has not been renewed. A previously unregistered trademark that has been identifying the source of goods or services through commercial promotion and production and operation activities, and is known to a relevant public in China, is deemed to be "already used and has certain influence". To claim protection under this provision claimant shall submit relevant evidence which might include prove of the earliest use time or continuous use of the trademark, contracts, invoices, bill of loadings, e-commerce transactions documents for the goods or services marked by the trademark, scope of sales area, sale volume and channels, advertisements, promotional materials, exhibitions and awards.

Chapter sixteen is devoted to trademark registration obtained by deceptive or other improper means, grounds which are provided under Article 44 of the Trademark Law of the PRC. An application for trademark registration shall abide by the principle of good faith and shall not deceive the trademark registration department to obtain registration by means of falsification, nor may it disturb the order of trademark registration, harm the public interest, improperly occupy public resources, or seek illegitimate interests in other ways. Deceptive means might include forging the stamp or signature, forging or altering

the applicant's identification documents like ID cards or business licenses. Improper means relates to behavior compromising the order of the register or damaging public interests. It might include circumstances in which the applicant applies for the registration of multiple trademarks, which are identical or similar to others' trademarks with certain popularity or strong distinctive features or are identical or similar to other people's trade names, enterprise names, social organizations, and other institutional names, influential commodity names, packaging, and decoration.

3. Bad Faith in a Trademark Case Law

Although many legal provisions of trademark law worldwide refer to bad faith, the concept is not defined by any legislator and its understanding might vary from one legal order to another. While there is lack of a legal definition in the existing legislation, it is the task of the jurisprudence to indicate the meaning of the given concept.⁹⁷ The Court of Justice of the European Union (hereinafter CJEU) points out the necessity to refer to colloquial understanding of a given phrase or word which lack legal definition. It notes that determining the scope and the meaning of the concept, should be done in accordance with its ordinary prevailing meaning, considering the purpose for which given legal act containing analyzed legislation was established and the context in which the term is used.⁹⁸ CJEU in the judgement in the case C-320/12 Malaysia Dairy Industries Pte. Ltd. v Ankenavent for Patenter og Varemarker states that the concept of bad faith is an autonomous concept of EU law, which should be interpreted in a uniform manner in the EU in relation to both EU law (directive and regulation) and national laws of the Member States implementing the provisions of the directive.⁹⁹ On the other hand in China, trademark law is a special civil law therefore the distinction between good faith and bad faith in civil law is applied also to trademark law and should be assessed based on specific circumstances of each individual case.¹⁰⁰

3.1. EU

Despite the fact that the Court of Justice of the European Union (CJEU) has long emphasized that to determine bad faith an overall assessment have to be done, taking into account all the factors relevant to the particular case. However, the European Court and the EUIPO have recently provided some clarification on the many sorts of elements or actions that may constitute a bad faith. In the case C-529/07 Chocladefabriken Lindt v Sprüngli the court indicated the need to take into account all relevant factors, among

⁹⁷ J. Sitko, Various Aspects of the Application for a Trademark Made in Bad Faith in the Light of EU Case Law, Białystok Legal Studies, 2022 vol. 27 nr 1, p. 97.

⁹⁸ Judgement of the Court (Fifth Chamber) of 12 September 2019, C-104/18 P - Koton Mağazacılık Tekstil Sanayi v Ticaret v EUIPO, ECLI:EU:C:2019:287, paragraph 46.

⁹⁹ Judgement of the Court (Fifth Chamber) of 27 June 2013, C-320/12 - Malaysia Dairy Industries v Ankenævnet for Patenter og Varemærker, ECLI:EU:C:2013:435

¹⁰⁰ M.Zhong, J.Chen, 制止恶意抢注的商标法规范体系及其适用, Journal of Law Application, Beijing Higher People's Court, 2012, Edition 8, p.8, accessed on 09.01.2023 at: <https://cebbank.pkulaw.com/qikan/744bd5a682a824d444be344e10195ff9bdfb.html>

which, the applicant's awareness of earlier mark, applicant's intention, and degree of legal protection granted to third party's mark and contested mark was mentioned.¹⁰¹ Furthermore according to the judgement in the case T-33/11 - Peeters Landbouwmachines v OHMI (BIGAB) the circumstances indicated in the C-529/07 Chocoladefabriken Lindt v Sprüngli case, which should be taken into account, are only illustrative, because it is all the circumstances of the case that should determine the existence of bad faith.¹⁰² Additionally in the case C-104/18 P - Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO court held that the concept of bad faith is broader than deliberate registrations of third-party signs for identical or similar goods; the lack of commercial logic underlying the application may itself suffice to establish bad faith.¹⁰³ Furthermore in the case C-371/18 - Sky and Others¹⁰⁴ and T-82/14 - Copernicus-Trademarks v EUIPO (LUCEO)¹⁰⁵ court stated that bad faith exists where trademarks are filed with no intention to use, but only if at the time of application there existed a dishonest intention of undermining the interests of third parties or an intention to obtain exclusive rights for purposes falling outside the functions of the trade mark.¹⁰⁶

3.1.1. Time of Assessment of Bad Faith

In a judgment of the case, C-529/07 Chocoladefabriken Lindt v Sprüngli court held that the relevant time for determining whether the applicant acted in bad faith is the time of applying for registration.¹⁰⁷ According to the judgment in the joined Cases T-3/18 and T-4/18 Holzer y Cia v EUIPO (ANN TAYLOR) the applicant's good faith is presumed until proven otherwise.¹⁰⁸ However registered trademark may be declared invalid when EUIPO finds that the proprietor was acting in bad faith at the time of filing the application. Therefore, changes in the applicant's behavior that occur after the filing date are irrelevant

¹⁰¹ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH, ECLI:EU:C:2009:361, paragraph 54.

¹⁰² Judgment of the General Court (Second Chamber) of 14 February 2012, T-33/11 Peeters Landbouwmachines BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2012:77, paragraph 20.

¹⁰³ Judgment of the Court (Fifth Chamber) of 12 September 2019, C-104/18 P Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v European Union Intellectual Property Office, ECLI:EU:C:2019:724, paragraph 25.

¹⁰⁴ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 88.

¹⁰⁵ Judgment of the General Court (Ninth Chamber) of 7 July 2016, T-82/14 Copernicus-Trademarks Ltd v European Union Intellectual Property Office, ECLI:EU:T:2016:396, paragraph 147.

¹⁰⁶ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH, ECLI:EU:C:2009:361, paragraph 42.

¹⁰⁷ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH, ECLI:EU:C:2009:361, paragraph 32.

¹⁰⁸ Judgment of the General Court of 23 May 2019, Joined Cases T-3/18, T-4/18 Holzer y Cia v EUIPO — Annco (ANN TAYLOR and AT ANN TAYLOR), ECLI:EU:T:2019:357, paragraph 34.

to the assessment of bad faith. In the landmark case *Malaysia Dairy Industries Pte. Ltd. v Ankenavent for Patenter og Varemarker* court stated that in order to assess bad faith all relevant factors which pertained at the time of filing the application should be considered.¹⁰⁹ Additionally, in the case *SA.PAR. Srl v OHIM* court held that bad faith should be assessed at the time of filing the application for registration of the mark in question,¹¹⁰ which was also confirmed in the case *T-772/17 - Café del Mar and Others v EUIPO (Café del Mar)*¹¹¹ and recent decision in a case *R 351/2020-4, 44IP Limited v Hamilton International AG (HAMILTON)*.¹¹²

3.1.2. Awareness of Prior Use of a Mark

The jurisprudence established that the knowledge may be presumed to exist based on *inter alia*, the business relationship, the reputation of a sign, and general knowledge, depending on the individual circumstances. In the case, *T-335/14 José-Manuel Davó Lledó v OHIM (Doggis)* the court held that the knowledge may be presumed even if the prior sign was registered in the non-EU country.¹¹³ Nevertheless, knowledge of the prior use of a mark even if may be a significant factor is not sufficient in itself to indicate the existence of bad faith. The EU case law has established that on a ground of trademark law, the circumstances in which the applicant knows or should have known at the date of filing a trademark application that the application in question infringes the interests of a third party who already use the sign indicated in the application but had not applied for registration, are not sufficient to conclude bad faith. In a preliminary ruling in the context of the case *C-529/07 Chocoladefabriken Lindt v Sprüngli*, where the parties were competitors, the CJEU stated that all the relevant factors should be considered when assessing bad faith. Among mentioned factors was the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought.¹¹⁴

¹⁰⁹ Judgement of the Court (Fifth Chamber) of 27 June 2013, C-320/12 - *Malaysia Dairy Industries v Ankenævnet for Patenter og Varemærker* pkt. 40, ECLI:EU:C:2013:435, paragraph 44.

¹¹⁰ Judgment of the General Court (Sixth Chamber) of 11 July 2013, T-321/10 *SA.PAR. Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, ECLI:EU:T:2013:372, paragraph 24.

¹¹¹ Judgment of the General Court (Fourth Chamber) of 12 July 2019, T-772/17 *Café del Mar, SC and Others v European Union Intellectual Property Office*, ECLI:EU:T:2019:538, paragraph 55.

¹¹² Decision of the Fourth Board of Appeal of 20 October 2020, in a Case *R 351/2020-4, 44IP Limited v Hamilton International AG (HAMILTON)*, paragraph 21.

¹¹³ Judgment of the General Court (Sixth Chamber) of 28 January 2016, T-335/14 *José-Manuel Davó Lledó v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, ECLI:EU:T:2016:39, paragraph 64-71.

¹¹⁴ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, ECLI:EU:C:2009:361, paragraph 40.

It was further referred to in the case T-506/13 Urb Rulmenti Suceava v OHMI (URB)¹¹⁵ Furthermore, in the case, C-320/12 Malaysia Dairy Industries Pte. Ltd. v Ankenavent for Patenter og Varemarker court held that all the relevant factors specific to the given case, that occurred at the time of application should be considered to conclude the existence of bad faith. Therefore, the applicant's awareness of use by third-party mark that is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to conclude that applicant acted in a bad faith.¹¹⁶ Additionally in the case T-321/10 SA.PAR. Srl v OHIM (Gruppo Salini) where the applicant's shareholder previously was a chairman of the intervener's board of directors, the court further confirmed that the awareness of mark is not sufficient to establish bad faith and it is necessary to consider the applicant's intention.¹¹⁷ In the joint cases T-98/13 and T-99/13 C.M.T. v OHIM (Camomilla), the court recalled that the mere awareness of the earlier mark is not sufficient, in itself, to establish that EUTM applicant was acting in a bad faith.¹¹⁸ The same was noted in the case T-257/11 - Pangyrus v OHMI (Colourblind)¹¹⁹, where the parties had a previous commercial relationship, and this approach was further recalled in the case T-772/17 - Café del Mar and Others v EUIPO (Café del Mar) where one of three partners that owned Café del Mar applied for the registration of this EUTM in his name.¹²⁰ Therefore, the case-law emphasizes that at the time of filling out an application, in addition to the awareness of prior use of a mark, the applicant's intention also should be considered.

3.1.3. Dishonest Intention

As mentioned before to assess bad faith, the intention of an applicant at the date of filling application should be also considered. Bad faith application can be concluded if the unfair applicant's intention on the date of filing a trademark application is to obtain protection

¹¹⁵ Judgment of the General Court (Third Chamber) of 7 November 2014, T-506/13 Urb Rulmenti Suceava SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs), paragraph 47.

¹¹⁶ Judgement of the Court (Fifth Chamber) of 27 June 2013, C-320/12 - Malaysia Dairy Industries v Ankenævnet for Patenter og Varemærker pkt. 40, ECLI:EU:C:2013:435, paragraph 44.

¹¹⁷ Judgment of the General Court (Sixth Chamber) of 11 July 2013, T-321/10 SA.PAR. Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2013:372, paragraph 26.

¹¹⁸ Judgment of the General Court (Ninth Chamber) of 9 July 2015 CMT Compagnia manifatture tessili Srl (CMT Srl) v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2015:480, paragraph 18.

¹¹⁹ Judgment of the General Court (Ninth Chamber) of 26 February 2015, T-257/11 Pangyrus v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHMI) (Colourblind), ECLI:EU:T:2015:115, paragraph 76 and 77.

¹²⁰ Judgment of the General Court (Fourth Chamber) of 12 July 2019, T-772/17 Café del Mar, SC and Others v European Union Intellectual Property Office, ECLI:EU:T:2019:538, paragraph 49.

for purposes other than falling within the functions of a trademark.¹²¹ According to the judgment in the case C-529/07 *Chocoladefabriken Lindt v Sprüngli*, the applicant's intention is a subjective element. However, the assessment of this element should consider the objective circumstances of the particular case.¹²² This is further confirmed in the judgment of the case C-320/12 *Malaysia Dairy Industries Pte. Ltd. v Ankenavnet for Patenter og Varemarker*, where the court noted that consideration of bad faith must, in addition, include the applicant's intention at the time of filling the application for registration.¹²³ Moreover, in the abovementioned judgment C-529/07 *Chocoladefabriken Lindt v Sprüngli* court held that the nature of the mark may also be of additional importance for determining the intention of the applicant. Where it consists of the shape and appearance of the product as a whole, the applicant's bad faith may be more easily established if the registration of such a sign would restrict competitors' freedom to choose the shape and appearance of the product for technical or commercial reasons, with the result that holder of a registered mark could prevent competitors not only from using an identical or similar mark but also from marketing comparable goods.¹²⁴ In another case, 306/20, *Hijos de Moisés Rodríguez González, SA v EUIPO (La Irlandesa 1943)* court found bad faith resulting from the application of EUTM "La Irlandesa 1943" for food products, which in the Spanish language gives the impression that the goods originate from Ireland while most of the goods introduced to the market under contested EUTM were not of Irish origin. Thus, the applicant had the dishonest intention to mislead Spanish buyers as to the geographical origin of the goods offered. The court held that such conduct is evidence of bad faith.¹²⁵

3.1.3.1. Repeated Fillings

Repeated fillings, called also evergreening is a phenomenon whereby a legitimate trademark proprietor monopolizes the market by repeating an application of a trademark that is already registered but the goods or services were not put in genuine use. Bad faith

¹²¹ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 *Sky plc and Others v Skykick UK Limited and Skykick Inc*, ECLI:EU:C:2020:45, paragraph 88.

¹²² Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, ECLI:EU:C:2009:361, paragraph 42.

¹²³ Judgement of the Court (Fifth Chamber) of 27 June 2013, C-320/12 - *Malaysia Dairy Industries v Ankenævnet for Patenter og Varemærker* pkt. 40, ECLI:EU:C:2013:435, paragraph 36.

¹²⁴ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, ECLI:EU:C:2009:361, paragraph 50.

¹²⁵ Judgment of the General Court (Sixth Chamber, Extended Composition) of 29 June 2022, T-306/20 *Hijos de Moisés Rodríguez González, SA v European Union Intellectual Property Office (EUIPO)*, ECLI:EU:T:2022:404, paragraph 98.

consists of an attempt to circumvent the obligation to use by applying for the same trademark for the same or similar goods or services shortly before the five-year grace period finishes. Therefore, the practical effect of artificially extending the above-mentioned five-year period is achieved, because while in the case of an already registered mark, the five-year period may expire, making it liable to be declared invalid, in the case of a newly filed identical mark for the same goods, this period runs separately from the date of registration. It aims to prolong the non-use grace period, monopolize the market and block other parties who might want to use or register an identical or similar mark. Although there are no explicit provisions prohibiting repeated filing, EU case law has established this practice as a factor that might indicate bad faith. The case T-136/11 - pelicantravel.com v OHMI (Pelikan) was the first case where the concept of bad faith-refiling was applied by the court. The court held that the fact of filing a repeat application for the same mark in order to avoid consequences of revocation of an earlier trademark due to non-use may be considered when assessing whether the proprietor acted in bad faith.¹²⁶ The same was further confirmed in the case T-663/19 - Hasbro v EUIPO (Monopoly).¹²⁷

3.1.3.2. Exploitation of Renown and Well-known Trademarks

Free Riding

Taking unfair advantage of the distinctive character or the reputation of an earlier mark is called free riding. The first assessment of the notion of free riding was made by the court in the case C-487/07 - L'Oréal and Others, where the court referred to free riding as the advantage taken by the third party as a result of the use of the identical or similar sign with the clear exploitation on the coat-tails of the mark with a reputation.¹²⁸ Furthermore, free riding was noted in the case T-327/12 - Simca Europe v OHMI (Simca) where the court held that the former proprietor wanted to free ride on the reputation of an earlier registered mark and take advantage of that reputation.¹²⁹ This approach was further applied in the

¹²⁶ Judgment of the General Court (Fifth Chamber) of 13 December 2012, T-136/11 pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM), ECLI:EU:T:2012:689, paragraph 27.

¹²⁷ Judgment of the General Court (Sixth Chamber, Extended Composition) of 21 April 2021, T-663/19 Hasbro, Inc. v European Union Intellectual Property Office (OHIM), ECLI:EU:T:2021:211, paragraph 57.

¹²⁸ Judgment of the Court (First Chamber) of 18 June 2009, C-487/07 L'Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd and Starion International Ltd., ECLI:EU:C:2009:378, paragraph 41.

¹²⁹ Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 56.

case T-795/17 - *Moreira v EUIPO (Neymar)* where the court confirmed the invalidity of the trademark based on the name of the famous football player on the ground of bad faith. According to the judgment the real purpose of the registration was to free ride on the intervener's reputation and take advantage of that reputation.¹³⁰ In the case, T-60/10 - *Jackson International v OHMI (Royal Shakespeare)* court held that the EUTM applicant would benefit from the power of attraction, the reputation, and the prestige of the earlier trademark and concluded that contested EUTM should be declared invalid.¹³¹ In another case, T-332/10 *Viaguara v OHIM (VIAGUARA)* court held that due to the huge success of the earlier mark and the intensity of its reputation the applicant by using a mark similar to an earlier mark intend to take advantage of its attractiveness, reputation, and prestige. Therefore, benefiting is regarded as taking unfair advantage of the distinctive character or the repute of the earlier mark and the mark should not be registered.¹³² In the case T-335/14 *José-Manuel Davó Lledó v OHIM (Doggis)* the court declared disputed EUTM invalid and held that the applicant acted in a bad faith at the time of filling the application because the registration was guided by the intention to take undue advantage of the rights attached to the earlier mark. Both marks were nearly identical and covered the same type of activities, in particular franchises in the hot god fast-food sector.¹³³

Dilution

Dilution refers to the whittling away of distinctiveness caused by the illegitimate use of a mark on dissimilar products. This practice is a detriment to the distinctive character of the earlier reputed mark therefore mark's ability to identify the goods for which it is registered and used as coming from the proprietor of that mark is weakened. It was confirmed in the case C-252/07 - *Intel Corporation* where the court held that detriment to the distinctive character also referred to as 'dilution', 'whittling away', or 'blurring' is caused when the ability of the mark to identify the goods or services for which it is registered and used is weakened.¹³⁴ In the same judgement court noted that the more unique the earlier mark

¹³⁰ Judgment of the General Court (Third Chamber) of 14 May 2019, T-795/17 *Carlos Moreira v European Union Intellectual Property Office (EUIPO)*, ECLI:EU:T:2019:329, paragraph 51.

¹³¹ Judgment of the General Court (First Chamber) of 6 July 2012, T-60/10 *Jackson International Trading Co. Kurt D. Brühl GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, ECLI:EU:T:2012:348, paragraph 55 and 70.

¹³² Judgment of the General Court (Fifth Chamber) of 25 January 2012. T-332/10 *Viaguara v OHIM – Pfizer (VIAGUARA)*, ECLI:EU:T:2012:26, paragraph 76, 79 and 81.

¹³³ Judgment of the General Court (Sixth Chamber) of 28 January 2016, T-335/14 *José-Manuel Davó Lledó v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, ECLI:EU:T:2016:39, paragraph 89.

¹³⁴ Judgment of the Court (First Chamber) of 27 November 2008, C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.* ECLI:EU:C:2008:655, paragraph 29.

appears, the greater likelihood that the use of later identical or similar mark will be detrimental to its distinctive character.¹³⁵ Accordingly, in the case, T-215/03 SIGLA v OHMI (VIPS) court held that the risk of dilution is lower if the earlier mark consists of a term very common and frequently used therefore re-use of the term in question is less likely to result in dilution of the earlier mark.¹³⁶ This approach was further confirmed in the judgment in the case T-67/04 Spa Monopole v OHMI (SPA-FINDERS) where the court confirmed that the use of mark Spa-Finders for publications and travel agency services would neither blur distinctiveness nor tarnish the reputation of the mark SPA for mineral water since word spa is frequently used.¹³⁷ In the decision R 69/2013-4 regarding the reputed sign Camel for tobacco products dilution by blurring was established. The court found that appearing of a mark that is similar to a reputed sign, in a different class of goods be detrimental to the advertising function of the earlier sign.¹³⁸

Tarnishment

Trademark tarnishment occurs when someone uses a famous mark in commerce and, in doing so, harms the reputation of the well-known mark. It hinders the trademark owner's reputation and is detrimental to the reputation of the earlier reputed mark. It is associated with degrading the image and prestige of the earlier mark. It was confirmed in the case T-215/03 SIGLA v OHMI (VIPS) where the court noted that for tarnishment to occur there must be some characteristic or qualities of the goods or services on which the contested mark is used that are potentially detrimental to the reputation of the earlier mark.¹³⁹ In the R 297/2011-5 decision regarding KAPPA sign where the earlier sign is used on sportswear and promotes a healthy lifestyle court found that the use of KAPPA sign on tobacco products was likely to prompt negative mental associations with the earlier mark, therefore be detrimental to the reputation of the earlier reputed mark. In this case, tarnishment was established.¹⁴⁰ Furthermore, decision R 21224/2010-1 provides that the use of a mark that

¹³⁵ Idem. Paragrapf 74.

¹³⁶ Judgment of the General Court (Fifth Chamber) of 22 March 2007, T-215/03 Sigla v European Union Intellectual Property Office (EUIPO), ECLI:EU:T:2007:93, paragraph 38.

¹³⁷ Judgment of the General Court (Second Chamber) of 25 May 2005, T-67/04 Spa Monopole, compagnie fermière de Spa SA/NV v European Union Intellectual Property Office (EUIPO), ECLI:EU:T:2005:179, paragraph 44.

¹³⁸ Decision of 28 January 2014, R 69/2013-4 „Camel” accessed on 12.02.2022 at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf

¹³⁹ Judgment of the General Court (Fifth Chamber) of 22 March 2007, T-215/03 Sigla v European Union Intellectual Property Office (EUIPO), ECLI:EU:T:2007:93, paragraph 67.

¹⁴⁰ Decision of 12 April 2012, R297/2011-5 „KAPPA”, paragraph 38. Accessed on 12.02.2022 at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-

is practically identical to Louis Vuitton's trademark on goods of a strong industrial and technological nature would be detrimental to the image of the earlier mark. It is because an earlier trademark is perceived by the public as a luxury brand for fine leather goods and its image would be incompatible with goods such as electric meters, batteries, or supermarket cash registers.¹⁴¹ Similarly, in the case, T-373/09 court held that the use of the sign “Emido Tucci” in respect of toilet paper is likely to cause undesired and negative associations with the earlier mark “Emilio Pucci” which has acquired a reputation in the luxury clothing sector.¹⁴²

3.1.3.3. Lack of Intention to Use

In judgment C-371/18 - Sky and Others, the court held that a trademark application made without any intention to use the trademark for designated goods or services constitutes bad faith in cases if the applicant had the intention to undermine the interest of third parties or obtain an exclusive right for purposes other than falling within the functions of a trademark.¹⁴³ Therefore lack of intention of use itself does not automatically imply bad faith. The court noted that bad faith can be concluded only if there is objective, relevant and consistent evidence that on the date of filing the application for a given trademark, the applicant intended to either infringe, in a manner inconsistent with honest customs, the interests of third parties or to obtain, even without reference to a specific third party, an exclusive right for purposes other than those related to the functions of the trademark.¹⁴⁴ It means that an additional element beyond the mere lack of intention to use, which is strengthening requirements for the assessment of bad faith was introduced. Additionally, the court held that if lack of intention to use concerns only some of the goods or services indicated in the application, the invalidity of contested trademark covers only those goods or services.¹⁴⁵ In the case, C-529/07 Chocladefabriken Lindt v Sprüngli court confirmed that bad faith can be found when EUTM is applied solely to prevent third parties from

guidelines-2017-wp-

lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf

¹⁴¹ Decision of 06 October 2011, Decision No R 2124/2010-1 “LV”, paragraph 28-30. Accessed on 12.01.2023 at: [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-)

guidelines-2017-wp-

lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf

¹⁴² Judgment of the General Court (Sixth Chamber) of 27 September 2012, T-373/09 El Corte Inglés, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2012:500, paragraph 68.

¹⁴³ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 88.

¹⁴⁴ Idem. Paragraph 77.

¹⁴⁵ Idem. Paragraph 79.

entering the market without intending to use it.¹⁴⁶ Furthermore, this judgment was referred to in the case T-327/12 - Simca Europe v OHMI (Simca).¹⁴⁷ In the case T-82/14 – Copernicus-Trademarks v EUIPO (LUCEO) court declared EUTM invalid on the grounds of bad faith since the court found that the applicant didn't intend to use the mark but only wanted to derive economic benefits from opposition proceedings.¹⁴⁸ Additionally, EUIPO found the registration of a mark containing the image of the "Flower Thrower" painted on the wall of a building by famous artist Banksy filled in a bad faith since the applicant had no intention of using the mark containing the work in question, and the registration was made solely in order to prevent other entities from commercial exploitation of that work.¹⁴⁹

3.1.3.4. Preventing a Third Party from Entering the Market

In the case, C-529/07 Chocoladefabriken Lindt v Sprüngli court noted that in certain circumstances the registration of EUTM with the intention to prevent third parties from entering the market and prevent the marketing of the product may be an element of bad faith on the part of the applicant.¹⁵⁰ Furthermore, this judgment was referred to in the case T-327/12 - Simca Europe v OHMI (Simca).¹⁵¹ It was also referred to in the case T-82/14 - Copernicus-Trademarks v EUIPO (LUCEO), where the court found that the EUTM applicant pursued an unlawful filing strategy to oppose the application for registration filed by third parties in order to obtain financial compensation, therefore, acted in a bad faith.¹⁵²

3.1.4. Cluttering Trademark Classes

Filing the trademark application to several different classes with a broad list of goods and services in order to ensure that they will register at least one is called cluttering. It occurs when unused trademarks remain protected reducing the public domain. This practice is not restricted by any provision, but it has been referred to by General Court several times.

¹⁴⁶ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH, ECLI:EU:C:2009:361, paragraph 53 and 54..

¹⁴⁷ Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 37.

¹⁴⁸ Judgment of the General Court (Ninth Chamber) of 7 July 2016, T-82/14 Copernicus-Trademarks Ltd v EUIPO Maquet GmbH, ECLI:EU:T:2016:396, paragraph 145.

¹⁴⁹ Cancellation Decision of 14 September 2022, Decision No 33 843 c, Full Colour Black Limited v Pest Control Office Limited, accessed on 12.01.2023 at: https://euipo.europa.eu/eSearchCLW/#basic/*/number/000033843

¹⁵⁰ Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH, ECLI:EU:C:2009:361, paragraph 53 and 54.

¹⁵¹ Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 37.

¹⁵² Judgment of the General Court (Ninth Chamber) of 7 July 2016, T-82/14 Copernicus-Trademarks Ltd v EUIPO Maquet GmbH, ECLI:EU:T:2016:396, paragraph 145.

In the case, T-507/08 Psytech International Ltd v OHIM (16PF) the court held that there is no legal basis to the effect that the number of goods or services applied for in a trademark application alone could enable to find a bad faith.¹⁵³ The decision in a case R 351/2020-4, 44IP Limited v Hamilton International AG (HAMILTON) further confirms that bad faith cannot be found merely based on the length of the list of goods or services indicated in the trademark application.¹⁵⁴ Furthermore, in the case T-33/11 - Peeters Landbouwmachines v OHMI (BIGAB) court found that it is legitimate for an undertaking to seek the protection of a mark also for goods or services that it intends to market in the future.¹⁵⁵ This approach is also confirmed in the case T-136/11 - pelicantravel.com v OHMI (Pelikan) where the court held that mere registration of a large variety of goods or services doesn't depart from principles of ethical behavior or honest commercial and business practices.¹⁵⁶ The broad registration of a trademark was also addressed in the case C-371/18 - Sky and Others, where the court stated that not clear and not precise terms used to designate the goods and services in respect of which that trademark was registered cannot constitute a ground for trademark invalidation.¹⁵⁷

3.1.5. Identity or Similarity of the Marks

Identity or similarity with an earlier sign itself is not a prerequisite of bad faith although it may be considered as one of the factors. In the case C-104/18 P - Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO court established that bad faith cannot only be established based on the use of identical or similar sign capable of being confused with the sign for which registration is sought.¹⁵⁸ This approach was further confirmed in the judgment T-291/09 - Carrols v OHMI (Pollo Tropical Chicken On The Grill) where the court established that the identity or similarity of the signs itself, where there are no other

¹⁵³ Judgment of the General Court (Second Chamber) of 7 June 2011, T-507/08 Psytech International Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2011:253, paragraph 88.

¹⁵⁴ Decision of the Fourth Board of Appeal of 20 October 2020, in a Case R 351/2020-4, 44IP Limited v Hamilton International AG (HAMILTON), paragraph 35.

¹⁵⁵ Judgment of the General Court (Second Chamber) of 14 February 2012, T-33/11 Peeters Landbouwmachines BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2012:77, paragraph 25.

¹⁵⁶ Judgment of the General Court (Fifth Chamber) of 13 December 2012, T-136/11 Pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM), ECLI:EU:T:2012:689, paragraph 54.

¹⁵⁷ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 71.

¹⁵⁸ Judgment of the Court (Fifth Chamber) of 12 September 2019, C-104/18 P Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v European Union Intellectual Property Office, ECLI:EU:C:2019:724, paragraph 51.

relevant factors do not establish bad faith.¹⁵⁹ In the case T-335/14 - Davó Lledó v OHMI (DoggiS) court also considered different factors from broad perspective, nevertheless stating that nearly identical nature of the marks cannot be a mere coincidence.¹⁶⁰ This raises doubts in the context of the case T-291/09 - Carrols v OHMI (Pollo Tropical Chicken On The Grill). Furthermore, in the case, T-467/21 - DBM Videovertrieb v EUIPO (Lío) court confirms that the identity of the signs does not itself necessarily indicate bad faith. Nevertheless, a broader list of factors based on which bad faith was assessed is provided, where one of which was the identity of the contested mark with an earlier trademark.¹⁶¹

3.1.6. Lack of Commercial Logic

In the case, C-104/18 P - Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO court held that commercial logic underlying the filing of the application and the chronology of events leading to that filing, may also be relevant and considered when assessing bad faith.¹⁶² This judgment was furtherer referred to in the case C-371/18 - Sky and Others.¹⁶³ Additionally, in the case, T-33/11 – Peeters Landbouwmachines v OHMI (BIGAB)¹⁶⁴ court held that the commercial logic may also constitute a relevant factor for trademark invalidation on the ground of bad faith. This judgment subsequently was referred to in the case T-321/10 SA.PAR. Srl v OHIM (Gruppo Salini)¹⁶⁵ and in the case T-506/13 - Urb Rulmenti Suceava przeciwko OHMI (URB).¹⁶⁶ Furthermore, in the case T-335/14 José-Manuel Davó Lledó v OHIM (Doggis) the court also held that in the context of analysis whether the applicant was acting in a bad faith while filing the application commercial

¹⁵⁹ Judgment of the General Court (Eighth Chamber) of 1 February 2012. Carrols Corp. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2012:39, paragraph 59-60.

¹⁶⁰ Judgment of the General Court (Sixth Chamber) of 28 January 2016, T-335/14 José-Manuel Davó Lledó v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2016:39, paragraph

¹⁶¹ Judgment Of The General Court (Fifth Chamber) of 19 October 2022, T-467/21 DBM Videovertrieb v EUIPO - Nube, ECLI:EU:T:2022:645, paragraph 35.

¹⁶² Judgment of the Court (Fifth Chamber) of 12 September 2019, C-104/18 P Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v European Union Intellectual Property Office, ECLI:EU:C:2019:724, paragraph 25.

¹⁶³ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 101.

¹⁶⁴ Judgment of the General Court (Second Chamber) of 14 February 2012, T-33/11 Peeters Landbouwmachines BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2012:77, paragraph 17 and 21.

¹⁶⁵ Judgment of the General Court (Sixth Chamber) of 11 July 2013, T-321/10 SA.PAR. Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2013:372, paragraph 23.

¹⁶⁶ Judgment of the General Court (Third Chamber) of 7 November 2014, T-506/13 Urb Rulmenti Suceava SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs), ECLI:EU:T:2014:940, paragraph 29.

logic underlying the filing may be also considered.¹⁶⁷ Judgment in the case T-327/12 - Simca Europe v OHMI (Simca) also provides that commercial logic behind the filing of the application may be taken into consideration.¹⁶⁸ The same approach is expressed in the case C-409/18 P Senetic S.A. v EUIPO where the court concluded that in determining whether an applicant for registration acted in bad faith, account must be taken of certain factors including the commercial logic underlying the filing of the application for registration.¹⁶⁹

3.1.7. Unauthorized Registration of a Trademark

EUTM “Balbcare” which was registered by an EU distributor of Brazilian products was declared invalid in decision 9805 C. The Cancellation Division stated that it was sufficient to determine that the trademark was filed in bad faith based only on the Brazilian TM owner's assertion that the filing was made without authorization. The finding of bad faith does not require a contractual relationship at the time of filing. It can be sufficient if the parties had an existing, direct, or indirect relationship before the filing.¹⁷⁰ Furthermore, in the case T-306/13 - Silicium España Laboratorios v OHMI (LLRG5) where one of the shareholders through an intermediary registered the name of the company, of which he was a shareholder, as EUTM. The court concluded that the application could be held to be a concealed act with intention of preventing the invalidity applicant from being able to use the sign.¹⁷¹ In the case C-639/16 P - Foodcare v EUIPO where boxer well-known under the name “Tiger” engaged in commercial cooperation with an energy drink producer and authorized the use of his nickname to promote the goods and afterward producer filed an application for registration of “T.G.R. energy drink” trademark. The court found bad faith on the part of the applicant of the contested trademark due to among others, the existence of direct contractual relationships between parties, the intention of a defendant to create an association between marks supported by the strong similarity between marks, and to

¹⁶⁷ Judgment of the General Court (Sixth Chamber) of 28 January 2016, T-335/14 José-Manuel Davó Lledó v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2016:39, paragraph 48.

¹⁶⁸ Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 39.

¹⁶⁹ Order Of The Court (Tenth Chamber) 13 December 2018, C-409/18 P, Senetic S.A. v EUIPO, ECLI:EU:C:2018:1008, paragraph 8, point 19.

¹⁷⁰ Invalidity Decision of 14 September 2015, Decision No 9805 C, Balbpharm Industria De CCosmeticos LTDA v 3B.Solutions (BALBCARE)

¹⁷¹ Judgment of the General Court (Third Chamber) of 16 June 2015, t-306/13 Silicium España Laboratorios, SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2015:382, paragraph 71.

continue benefiting from the reputation of earlier mark while circumventing the contractual obligations arising from the agreements concluded with the plaintiff.¹⁷² In the case T-107/16 - Airhole Facemasks v EUIPO (Air Hole Face Masks You Idiot), where the defendant, previous distributor of the plaintiff's goods in six member states of the EU registered as EUTM sign identical to the earlier plaintiff's mark. The defendant had not proved that it has consent to the filing of the disputed mark and sought to usurp the plaintiff's rights therefore the Cancellation Division found bad faith and declared the disputed trademark invalid.¹⁷³ In the case T-340/16 - Flatworld Solutions v EUIPO (Outsource 2 India) where defendant shortly after the termination of the pre-contractual relationship with the plaintiff, filed an application for registration of a trademark which use the same wording as the earlier mark which the plaintiff was using in its logo, non-registered mark, and its domain named. Bad faith was assessed inter alia on the basis of the previous commercial relations that existed between the two parties.¹⁷⁴ On the contrary in the invalidation case T 674/13 Gugler France v OHMI (GUGLER) the court decided to maintain the trademark registration and held that the defendant had already been producing and exporting relevant products under the name GUGLER for many years before filing the EUTM application. Therefore, applying for EUTM was an obvious and completely justified action that did not reveal bad faith, even though there had been previous business relations between the parties.¹⁷⁵

3.2. Poland

Polish case-law similarly to EU jurisprudence emphasize that to establish bad faith all the relevant factors for each individual case should be assessed. In the case II GSK 464/10 court held that bad faith conduct is generally perceived as dishonest behavior and one that the person committing such an act, would not like to experience it against himself.¹⁷⁶ In the decision I. Sp.459.2014 of the PPO it is stated that the reprehensibility of the applicant's

¹⁷² Order of the Court (Tenth Chamber) of 11 May 2017, C-639/16 P, Foodcare sp. z o.o. v European Union Intellectual Property Office, ECLI:EU:C:2017:367, paragraph 5 (point 11, 12, 13 and 14).

¹⁷³ Judgment of the General Court (Second Chamber) of 16 May 2017, T-107/16 Airhole Facemasks, Inc. v European Union Intellectual Property Office, ECLI:EU:T:2017:335, paragraph 28, 34, 37 and 41.

¹⁷⁴ Judgment of the General Court (Seventh Chamber) of 31 May 2018, T-340/16 Flatworld Solutions Pvt. Ltd v European Union Intellectual Property Office, ECLI:EU:T:2018:314, paragraph 47.

¹⁷⁵ Judgment of the General Court (Ninth Chamber) of 28 January 2016, T-674/13 Gugler France v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2016:44, paragraph 78.

¹⁷⁶ Judgment of the Supreme Administrative Court of April 5, 2011, II GSK 464/10, LEX nr 992394 accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521086090/1/ii-gsk-464-10-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=%20II%20GSK%20464~2F10&cm=SFIRST>

behavior should be assessed in the context of all the established facts.¹⁷⁷ Additionally in the case III. Sp.234.2015 the PPO stated that bad faith covers all the cases of malicious trademark application, and it is matter of subjective element as well as objective facts. PPO established that bad faith application should be associated with the intention to infringe rights or interests of others which might be infringed by filing an application in question.¹⁷⁸ In the case VI SA/Wa 1917/08 court noted that when trademark application is filled despite the knowledge about existence of someone else's right, and when it is dishonest in its entirety, e.g. it is made for a purpose other than distinguishing goods and services it is considered to be made in a bad faith.¹⁷⁹ Furthermore in the case II GSK 1701/17 court distinguished three basic forms of bad faith: when applicant knew that by filling the application it violates someone else rights, when applicant intend to block the application or the use of the mark with certain position in the market by its proprietor, when application is made for a speculative purposes with no intention to use but to obtain financial benefits. Moreover, court stated that bad faith exists when information which applicant possess, if reasonably assessed, would make him think that filling an application may infringe rights of others.¹⁸⁰

3.2.1. Time of Assessment of Bad Faith

In the case II GSK 1912/14 court established that to establish bad faith all circumstances concerning the applicants state of mind on the date of filing application is decisive therefore only the existence of bad faith at the day of application is the basis for

¹⁷⁷ Decision of the PPO of 1 October 2015., I. Sp.459.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 110, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁷⁸ Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 131, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁷⁹ Decision of the PPO of 29 July 2016, IV. Sp.68.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 157, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁸⁰ Judgment of the Supreme Administrative Court of 19 October 2017. II GSK 1701/17, LEX No. 2423068, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522516764/1/ii-gsk-1701-17-zwiazanie-granicami-skargi-kasacyjnej-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%201701~2F17,&cm=SFIRST>

invalidation.¹⁸¹ In the case III. Sp.234.2015 the PPO noted that for the assessment it is necessary to demonstrate circumstances existing on the date of application for the trademark or existing before that date prove that the holder acted in bad faith.¹⁸² In the decision of 10.10.2012 no. DT-V/Z372755/443-11/25/msr where the existence of bad faith was found, PPO assessed the awareness of prior use at the date of filing the application.¹⁸³ However it is also necessary to take into account the circumstances which took place after the application or registration. Dishonest intention may be assessed based on specific circumstances of the case, both prior the filing date and after that date. However, it was confirmed in the judgement II GSK 2477/17 that circumstances which occurred before or after the application or registration of the trademark should also be taken into account.¹⁸⁴ It was further confirmed in the case II GSK 2871/15.¹⁸⁵

3.2.2. Awareness of Prior Use of a Mark

In the case III. Sp.234.2015 the PPO stated that in order to find a bad faith awareness of the existence of obstacles to the registration or previous use of the mark by another person must be accompanied by other, additional circumstances, that objectively prove bad faith.¹⁸⁶ Therefore it is not sufficient to find a bad faith in circumstances in which applicant know or should have known of the use of identical or similar mark by third party. It is also necessary to consider applicants intention (the subjective element), referring to the objective circumstances. Furthermore, in the same case the PPO noted that applicant of

¹⁸¹ Judgment of the Supreme Administrative Court of 21 October 2015. Case No. II GSK 1912/14, LEX nr 1925736, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522019432/1?directHit=true&directHitQuery=II%20GSK%201912%2F14&pit=2023-01-22>

¹⁸² Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 133, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁸³ Following: J. Kępiński, Zła wiara zgłaszającego znak towarowy jako przeszkoda w rejestracji znaku towarowego, Znaki towarowe i ich ochrona (R.Skubisz), C.H. Beck, Warszawa 2019, p.172

¹⁸⁴ Judgment of the Supreme Administrative Court of 4 July 2019. II GSK 2477/17, LEX nr 2691972, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522785668/1/ii-gsk-2477-17-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%202477~2F17;&cm=SFIRST>

¹⁸⁵ Judgment of the Supreme Administrative Court of 14 June 2017, II GSK 2871/15, LEX nr 2332864, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522426560/1/ii-gsk-2871-15-stwierdzenie-zlej-wiary-w-zgłoszeniu-znaku-towarowego-wyrok-naczelnego-sadu...?pit=2023-01-22&keyword=II%20GSK%202871~2F15.&cm=SFIRST>

¹⁸⁶ Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 132, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

the contested trademark was cooperating with the counterparty and knew about the use of the mark and by filling the application violated the principle of honest commercial practice based on the respect for rights of others. Additionally, PPO established that due to abovementioned cooperation parties were in business relationship of special attitude to a trust. In the case II GSK 3680/15 court held that the proprietor of contested trademark was fully aware at the time of filling the application of the actual use of the mark by his employer therefore, the application for the disputed mark was made in bad faith and was contrary to fair commercial practices and the principles of fair competition.¹⁸⁷ In the decision of 9 December 2015 PPO held that applicant by filing trademark application acted in a bad faith, being aware that the opposing party has been using the trademark for many years due to business cooperation.¹⁸⁸ In the decision I. Sp.459.2014 of PPO found bad faith and established that applicant by previously purchasing goods from counterparty and by working in the same business sector, at the date of application knew that contested trademark was used by counterparty.¹⁸⁹ In the case VI SA/Wa 1917/08 court held that a trademark application in bad faith takes place when it is made despite knowledge or ignorance, resulting from lack of diligence, about the existence of someone else's right or interest, which may be violated by it, and with the intention of harming these interests.¹⁹⁰ In the case II GSK 1912/14 court confirmed that the mere fact that applicant know of the use by other party of a sign registered as a trademark abroad is not in itself a sufficient to prove bad faith of the person making such an application.¹⁹¹ Furthermore, in the case II GSK 1701/17 court confirmed that the mere fact that applicant knew about the existence

¹⁸⁷ Judgment of the Supreme Administrative Court of September 14, 2017, II GSK 3680/15, LEX No. 2427721, accessed on 22.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522521417/1/ii-gsk-3680-15-elementy-konstrukcyjne-uzasadnienia-wyroku-sadu-administracyjnego-wyrok-naczelnego...?keyword=Wyrok%20NSA%20z%20dnia%2014%20wrze%C5%9Bnia%202017%20r.,%20II%20GSK%203680-2F15,%20LEX%20nr%202427721&cm=SFIRST>

¹⁸⁸ Judgment of the Supreme Administrative Court of September 29, 2020 Case No. II GSK 3421/17, LEX No. 3057636, accessed on 22.01.2023 at: <https://sip.lex.pl/#/jurisprudence/523151332/1?directHit=true&directHitQuery=II%20GSK%203421%2F17>

¹⁸⁹ Decision of the PPO of 1 October 2015., I. Sp.459.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 111, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegi%C3%B3w%20Orzekaj%C3%A1cych%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemys%C5%82owe.pdf>

¹⁹⁰ Judgment of the Provincial Administrative Court in Warsaw of February 19, 2009. VI SA/Wa 1917/08, LEX nr 989251, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521082947/1?directHit=true&directHitQuery=VI%20SA%20FWa%201917%2F08&pit=2023-01-22>

¹⁹¹ Judgment of the Supreme Administrative Court of 21 October 2015. Case No. II GSK 1912/14, LEX nr 1925736, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522019432/1?directHit=true&directHitQuery=II%20GSK%201912%2F14&pit=2023-01-22>

and use by another entity of the mark that is same or similar to the disputed mark cannot be considered as a bad faith.¹⁹²

3.2.3. Dishonest Intention

In the decision IV. Sp.68.2014 PPO held that when assessing bad faith, relevant are the circumstances existing on the date of application, taking into account the intention of the applicant.¹⁹³ In the case II GSK 1912/14 court noted that to establish bad faith the reprehensible intention of applicant from the point of view of the principles of honesty is significant.¹⁹⁴ In the decision III. Sp.234.2015 it is clearly stated by PPO that to establish bad faith, filling the application should be associated with the intention to infringe rights or interests of others.¹⁹⁵

3.2.3.1. Exploitation of Renown and Well-Known Trademarks

In the decision of 10.10.2012 no. DT DT-V/Z372755/443-11/25/msr where bad faith was found PPO emphasized that applicant of contested trademark at the time of filing the application was certainly aware of the existence and use of the product bearing identical mark therefore applicant's action is unfair to the manufacturer who ensured the market position of this trademark.¹⁹⁶ In the case VI SA/Wa 1364/20 court held that the earlier mark, at the date of application of contested trademark wasn't well-known among customers nor had developed reputation on the market, which could indicate dishonest

¹⁹² Judgment of the Supreme Administrative Court of 19 October 2017, II GSK 1701/17, LEX No. 2423068, accessed on 23.0.2023 at: <https://sip.lex.pl/#/jurisprudence/522516764/1/ii-gsk-1701-17-zwiazanie-granicami-skargi-kasacyjnej-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%201701~2F17,&cm=SFIRST>

¹⁹³ Decision of the PPO of 29 July 2016, IV. Sp.68.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 158, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁹⁴ Judgment of the Supreme Administrative Court of 21 October 2015. Case No. II GSK 1912/14, LEX nr 1925736, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522019432/1?directHit=true&directHitQuery=II%20GSK%201912%2F14&pit=2023-01-22>

¹⁹⁵ Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 131, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

¹⁹⁶ Following: J. Kępiński, Zła wiara zgłaszającego znak towarowy jako przeszkoda w rejestracji znaku towarowego, Znaki towarowe i ich ochrona (R.Skubisz), C.H. Beck, Warszawa 2019, p.172

intention of the applicant therefore bad faith wasn't found. Additionally, court stated that the question whether the earlier mark has acquired recognition on reputation subsequently to the registration of the contested mark is irrelevant to assessing bad faith of the applicant at the time of filling the application.¹⁹⁷

3.2.3.2. Lack of intention to use

In the case II GSK 1912/14 court said that bad faith is found when the trademark application was made for speculative purposes without the intention to use the trademark, but in order to obtain financial compensation.¹⁹⁸ In the case II GSK 3680/15 where mark "GLASSTAR" used by plaintiff was applied for registration by defendant who was plaintiff's employee. Defendant shortly after entering into employment agreement started similar business activity and applied for contested trademark although the same mark had been used for years by his employer to mark identical goods. The applicant's intention was found to be dishonest - although he intended to use the trademark - and consequently the right of protection was invalidated on the grounds that the application for the mark was made in bad faith.¹⁹⁹ In the case II GSK 730/12 court held that bad faith can be assessed when an application for trademark registration was made for speculative purposes in order to obtain financial compensation without intention of using the mark.²⁰⁰ In the case VI SA/Wa 1612/16 court stated that bad faith exists when trademark is filed for purposes other than obtaining exclusive rights to use the mark for one's own products, as a result of which rights of others are infringed.²⁰¹ Furthermore in the case II GSK 2941/15 court held that to establish bad faith it is sufficient that the contested mark while pending in the

¹⁹⁷ Judgment of the Voivodeship Administrative Court in Warsaw of 22 December 2020, VI SA/Wa 1364/20, accessed on 06.02.2023 at: <https://orzeczenia.nsa.gov.pl/doc/D43056B1DB>

¹⁹⁸ Judgment of the Supreme Administrative Court of 21 October 2015. Case No. II GSK 1912/14, LEX nr 1925736, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522019432/1?directHit=true&directHitQuery=II%20GSK%201912%2F14&pit=2023-01-22>

¹⁹⁹ Judgment of the Supreme Administrative Court of September 14, 2017, II GSK 3680/15, LEX No. 2427721, accessed on 21.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522521417/1/ii-gsk-3680-15-elementy-konstrukcyjne-uzasadnienia-wyroku-sadu-administracyjnego-wyrok-naczelnego...?keyword=Wyrok%20NSA%20z%20dnia%2014%20wrze%20nia%202017%20r.,%20II%20GSK%203680~2F15,%20LEX%20nr%202427721&cm=SFIRST>

²⁰⁰ Judgment of the Supreme Administrative Court of September 3, 2013. Case No. II GSK 730/12, LEX nr 1558946 accessed on 22.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521652642/1/ii-gsk-730-12-wyrok-naczelnego-sadu-administracyjnego?keyword=II%20GSK%20730~2F12%20&cm=SFIRST>

²⁰¹ Judgment of the Provincial Administrative Court in Warsaw of January 25, 2017. VI SA/Wa 1612/16, LEX No. 2260767, accessed on January 23, 2023 at: <https://sip.lex.pl/#/jurisprudence/522354463/1/vi-sa-wa-1612-16-legal-interest-in-annulment-of-protection-right-of-bad-faith-of-the-applicant...?pit=2023-01-22&keyword=VI%20SA~2FWa%201612~2F16&cm=STOP>

revocation proceeding was filed again for similar goods.²⁰² While the case II GSK 756/14 court held that application for a similar or identical trademark to trademark that rights have been revoked do not constitute on itself bad faith. After trademark right is expired anyone can apply for the protection of that mark, so can the applicant of previous trademark.²⁰³

3.2.3.3. Preventing a Third Party from Entering the Market

In the decision of 9 December 2015 no. II GSK 3421/17PPO held that applicant by filing trademark application acted in a bad faith and that his intention was to takin over customers and block the possibility of applying for protection of the opponent's trademark.²⁰⁴ In the case III. Sp.234.2015 the PPO noted that filing a trademark application without knowledge and authorization of former business partner is to block the application or prevent the use by the proprietor of the mark, and thus with the intention of taking over the position of a given trademark or obtaining financial benefits might be considered as bad faith.²⁰⁵ In the case II GSK 1912/14 court said bad faith is found when trademark application is made with intend to block the use of the mark by the entity already using the mark on the market, or to eliminate a competitor with the intention of overtaking its customers. Bad faith can also be found when the trademark application was made for speculative purposes without the intention of using the trademark, but in order to obtain financial benefits from the proprietor of the mark.²⁰⁶ Nevertheless in the case VI SA/Wa 73/13 court held that the intention to foreclose competitors is not sufficient to prove bad faith.²⁰⁷

²⁰² Judgment of the Supreme Administrative Court of 23 June 2017, II GSK 2941/15, LEX nr 2325134, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522418830/1/ii-gsk-2941-15-legitymacja-do-wniesienia-skargi-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%202941~2F15,&cm=SFIRST>

²⁰³ Judgment of the Supreme Administrative Court of June 9, 2015, II GSK 756/14, LEX nr 1775157 accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521868853/1/ii-gsk-756-14-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%20756~2F14,&cm=SFIRST>

²⁰⁴ Judgment of the Supreme Administrative Court of September 29, 2020 Case No. II GSK 3421/17, LEX No. 3057636, accessed on 22.01.2023 at: <https://sip.lex.pl/#/jurisprudence/523151332/1?directHit=true&directHitQuery=II%20GSK%203421%2F17>

²⁰⁵ Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 132, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²⁰⁶ Judgment of the Supreme Administrative Court of 21 October 2015. Case No. II GSK 1912/14, LEX nr 1925736, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522019432/1?directHit=true&directHitQuery=II%20GSK%201912%2F14&pit=2023-01-22>

²⁰⁷ Judgment of Voivodeship Administrative Court in Warsaw of 10 July 2013, VI SA/Wa 73/13, accessed on 04.02.2023 at: <https://sip.lex.pl/#/jurisprudence/521705005/1?directHit=true&directHitQuery=VI%20SA%2FWa%2073%2F13>

3.2.4. Identity or Similarity of the Marks

In the case II GSK 3421/17 where trademark was invalidated on the grounds on bad faith court held that the applicant of the disputed trademark intended to impersonate brand of the objecting party by using the same colors and advertising slogan.²⁰⁸ In the decision I. Sp.459.2014 where PPO found bad faith it was noted that application of contested trademark was provided with graphical representation identical to the graphics that the opposing party has been using for many years to mark its products and applicant demanded from the opposing party compensation for the waiver of the contested right.²⁰⁹ In the decision IV. Sp.68.2014 PPO established that the applicant intended to appropriate opponent's trademark by applying for protection of a trademark identical to the contested trademark, having knowledge and awareness of the existence of the prior trademark.²¹⁰ In the decision of 04.04.2014 DT-V/Z.388465/17/edem PPO refused trademark registration due to fact that the applicant knew that third party was using identical or similar mark for identical services due to previous business negotiations and application was made without consent of that person therefore application was made in a bad faith.²¹¹ Nevertheless in the case VI SA/Wa 319VI SA/Wa 319/16/16 court held that filing application for a trademark that is similar to a mark used by a competitor is not in itself sufficient to establish bad faith.²¹²

3.2.5. Unauthorized registration

In the case III. Sp.234.2015 where bad faith was found the PPO established that the applicant of the contested trademark, having previously cooperation with the plaintiff filed

²⁰⁸ Judgment of the Supreme Administrative Court of September 29, 2020 Case No. II GSK 3421/17, LEX No. 3057636, accessed on 22.01.2023 at:

<https://sip.lex.pl/#/jurisprudence/523151332/1?directHit=true&directHitQuery=II%20GSK%203421%2F17>

²⁰⁹ Decision of the PPO of 1 October 2015., I. Sp.459.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 111, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²¹⁰ Decision of the PPO of 29 July 2016, IV. Sp.68.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 160, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²¹¹ Following: J. Kępiński, Zła wiara zgłaszającego znak towarowy jako przeszkoda w rejestracji znaku towarowego, Znaki towarowe i ich ochrona (R. Skubisz), C.H. Beck, Warszawa 2019, p. 173

²¹² Judgment of the Provincial Administrative Court in Warsaw VI SA/Wa 2617/16 LEX No. 2782829 accessed on 22.01.2023 at: <https://sip.lex.pl/orzeczenia-i-pisma-urzedowe/orzeczenia-sadow/vi-sa-wa-2617-16-wyrok-wojewodzkiego-sadu-522876525>

the application without the knowledge and authorization of the former business partner who used a sign identical with the disputed trademark to designate his goods and services.²¹³ Furthermore in the case VI SA/Wa 428/06 court held that when authorized distributor file application for the registration of a trademark which belongs to the entity that authorized the distribution but didn't grant authorization for registration is a particular example of bad faith.²¹⁴ In the decision of 29.02.2012 no. DT-V/Z.362736/17/msr PPO refused unauthorized registration of a trademark made by distributor. The PPO held that distributor acted in bad faith because he used his knowledge of the trademark and wanted to register it for himself without the consent of the producer of the goods and proprietor of the mark. The applicant requested reexamination of the case, and the PPO in the decision of 15.03.2013 no. DT-III/Z.362736/139-12/26/RL, upheld refusal stating that applicant acted in a bad faith because he abused business relationship of special attitude to a trust.²¹⁵ In another case of 23.10.202 no. DT-III/Z.331416/12/AGR PPO also refused to register trademark applied for by executive producer of the series, who was only a licensee of a German production company. PPO held that application for a trademark for which copyright owns another entity is a conduct made in bad faith.²¹⁶ Furthermore in the case II GSK 2312/14 court held that applicant of contested trademark was aware that the mark is owned by another enterprise, and despite the preparations to sign distribution agreement with that enterprise, filed an application for trademark in question. Therefore, it was the application of someone else's mark made in bad faith.²¹⁷ In the case II GSK 878/14 court held that bad faith consisted of applying intentionally for trademark that was used for years by business partner of the applicant, without the knowledge and authorization of legitimate proprietor, while being in business relationship of special attitude to a trust.²¹⁸

²¹³ Decision of the PPO of 1 October 2015., I. Sp.459.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 133, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²¹⁴ Judgment of the Voivodeship Administrative Court in Warsaw of September 6, 2006. VI SA/Wa 428/06, LEX No. 247559, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/520341255?cm=DOCUMENT>

²¹⁵ Following: J. Kępiński, Zła wiara zgłaszającego znak towarowy jako przeszkoda w rejestracji znaku towarowego, Znaki towarowe i ich ochrona (R.Skubisz), C.H. Beck, Warszawa 2019, p.172

²¹⁶ Idem.

²¹⁷ Judgment of the Supreme Administrative Court of February 10, 2016, II GSK 2312/14, LEX nr 2037087, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522130783/1?pit=2023-01-22&directHit=true&directHitQuery=II%20GSK%202312~2F14>

²¹⁸ Judgment of the Supreme Administrative Court of 3 July 2015, II GSK 878/14, LEX nr 1768246, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521861942/1?directHit=true&directHitQuery=II%20GSK%20878%2F14&pit=2023-01-22>

3.3. China

In China typical bad faith cases are divided into specific categories. In general filling trademark application with dishonest intention is considered as a bad faith. The first category of bad faith filling is obtaining registration by forging documents or seals. Conduct which results in harming public interest, disturbing trademark registration or obtaining improper benefits will also be considered as bad faith. Common problem for Chinese trademark system was filing a large number of trademark application. Due to amended in 2019 this practice now is eliminated by refusing or invalidating such a registration on a ground of bad faith with no intend to use, which was officially confirmed in the Refusal Decision No. 35000075.²¹⁹ In regard to well-known trademarks China also provides additional protection against translation and transliteration to foreign brands. Additionally Chinese system pays a lot of attention to unauthorized bad faith registrations and allows trademark agencies to fill trademark application in its own name only for intellectual property services in class 45.

3.3.1. Trademark Registration Obtained by Fraudulent or Other Improper Means

Fraudulent means refers to fabricating signature, seal, documents etc. In the decision of CNIPA from 6th February 28 Shang Ping Zi (2018) No.0000022013, trademark was invalidated on the ground that it was fraudulently acquired by using a fake business license. Other improper means refers to disturbing the order of trademark registration, harming public interest, improperly occupying public resources, or obtaining improper benefits. One of the behaviors that falls into this category is filing multiple trademarks which are identical or similar to others relatively distinctive trademarks. Another behavior falling into this category is filing multiple trademarks which are identical or similar to others' trade names, institution names, specialized names or the packaging of a well-known product and filing a massive number of trademarks with obvious lack of genuine intention to use. It was confirmed in the case Shang Ping Zi (2020) No.0000004299/4300/4302 CNIPA hold that three contested trademarks filed in different classes were identical to "Playseat" trademark, previously used by other company. Additionally, plaintiff filed

²¹⁹ CNIPA Refusal Decision No. 35000075 of 8 October 2020, accesses on 17.01.2022 at: <https://wsgs.sbj.cnipa.gov.cn:9080/tmpu/yycw/detail.html?appId=B4B52B7DFCD106EAE053640B5023DE45>

multiple trademarks which were identical to other trademarks. CNIPA noted that it was obvious bad faith behavior and constitutes other improper means and invalidated all three trademarks.²²⁰ In another invalidation case (2017) Jing Xing Zhong No.5603 against trademark No. 10619071 "UL" filed by UNIQLO, plaintiff filed more than 2000 trademarks, many of which were transferred for profit. At the same time plaintiff filed more than 40 bad faith infringement lawsuits against defendant and asked for RMB 8 million assignment fee. Court confirmed that plaintiff had no reasonable explanation for filing so many trademark applications and no real intention to use them which constitute bad faith on the grounds of obtaining registration through other improper means.²²¹ In the case no 291 [207] court compared to the 'illegitimate means' in which merely the civil rights of specific parties were infringed, to the 'other illegitimate means' which mainly concerned the acts that caused damage to the public interests, ie to the interests of general unspecified majorities. Additionally, court held that hoarding massive trademarks without intention to use them would fall within the scope of 'other illegitimate means'.²²²

3.3.2. Lack of Intention to Use

The intention to apply for a large number of trademarks for the purpose of not using them and to make profits from them falls into category of bad faith registration. Repeated application for registration of a specific trademark with a certain popularity or strong distinctiveness for the same subject, disrupting the order of trademark registration might indicate bad faith. It was confirmed in the Refusal Decision No. 26783639, where National Petroleum Corporation, holder of earlier trademark “马石油” (Mǎ shíyóu) and “酷腾” (Kù téng) raised objections to registration of “马石油酷腾” (Mǎ shíyóu kù téng) by a natural person. CNIPA stated that there is no obvious difference between two trademarks, and it is easy to cause confusion among relevant customers. In addition, CNIPA noted that defendant also applied for registration of a number of trademarks that are the same or

²²⁰ F.Giacopello, A.Huang, How does Chinese trademark law deal with bad faith? Accessed on 20.01.2023 at: <https://www.managingip.com/article/2a5cwlcmzlkxulvqjh5a8/how-does-chinese-trademark-law-deal-with-bad-faith>

²²¹ Administrative Judgment of Second Instance of Beijing High People's Court of 7 March 2018, (2017) Jing Xing Zhong No.5603, Guangzhou Compass Convention and Exhibition Service Co., Ltd. and Fast Retailing (China) Trading Co., Ltd., accessed on 20.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=kPOB9XJWQHfwCLiaixIIW0Y5t0MbHycUjB0gDCptWd8h9iaY4GVcS98vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEIRrAlwLgh5hwIJc2PWk3H0>

²²² T.LU, Chinese Supreme Court rules that hoarding trade marks in bad faith falls within the scope of 'other illegitimate means', *Journal of Intellectual Property Law & Practice*, 2019, Vol. 14, No. 4, p.263-264. accessed on 19.01.2023 at: <https://academic.oup.com/jiplp/article/14/4/263/5363236>

similar to those previously used by others and have a certain popularity, many of which have been challenged by the relevant right holders. The defendant also failed to provide the reasoning for so many applications filed. Therefore, CNIPA stated that defendant's behavior exceeds the normal production and operation needs, as defendant was natural person and trademark was declared invalid. It was established that defendant when filling the application acted in a bad faith, intended to copy and plagiarize trademarks of third parties, which disrupts the normal trademark registration management order, undermines the market order of fair competition, and violates the principle of good faith.²²³ This approach was further confirmed in the Refusal Decision No. 35000075, where defendant has applied for the registration of more than 1000 trademarks in more than 40 categories of goods and services. Large numbers of trademarks were identical or similar to third party's earlier trademarks with certain distinctiveness and the opposed party failed to give reasonable explanation for the intention to use its large number of registered trademarks. The defendant was found to act in a bad faith not for the purpose of use.²²⁴ Furthermore, in the case (2013) Zhi Xing Zi No. 41 where natural person intended to take advantage of the huge governmental promotion of Haitang Bay as holiday destination and applied for registration of many trademarks containing words “海棠湾” (Haitang Bay) and registered large number of other trademarks without any reasonable explanation or intention to use. Court held that it constitutes improper occupation of public resources therefore trademark was revoked.²²⁵ In the opposition case no. 18021136 trademark office refused registration of a graphic trademark that was extremely similar to the plaintiff's trademark, earlier registered in Spain. Additionally, it was noted that defendant has applied for registration of nearly 900 trademarks on different goods, most of which was refused because there were identical or similar to other party's prior trademarks. Therefore, trademark office held that defendant had no intention to use disputed trademark and wanted to imitate or copy third-party trademark.²²⁶

²²³ CNIPA Refusal Decision No. 26783639 of 21 February 2020, accesses on 17.01.2022 at: <https://wsjgs.sbj.cnipa.gov.cn:9080/tmptu/yyw/detail.html?appId=A2158B1A37E808C2E053640B50232D79>

²²⁴ CNIPA Refusal Decision No. 35000075 of 8 October 2020, accesses on 17.01.2022 at: <https://wsjgs.sbj.cnipa.gov.cn:9080/tmptu/yyw/detail.html?appId=B4B52B7DFCD106EAE053640B5023DE45>

²²⁵ Administrative Judgment of Supreme People's Court of 12 August 2013, (2013) Zhi Xing Zi No. 4, Li Longfeng v Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Sanya Haitang Bay Management Committee, accessed on 19.01.2023 at:

<https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²²⁶ Opposition Judgment of Trademark Office of 29 March 2018, case no. 18021136, Motoreta Moda Infantil Sociedad Limitada v Lee Eunsik, accessed on 19.01.2023 at:

<https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

3.3.3. Exploitation of Registered and Unregistered Well-known Trademarks

Registered and unregistered well-known trademarks are protected against copy and transliteration if they were already well-known before the date of application of the disputed mark, disputed mark is a reproduction, copy or translation of well-known trademark and the registration of disputed mark may damage the interest of concerned parties. This is confirmed in the case *Commercial Press Co., Ltd. v. Sinolingua Co., Ltd.* (2016) J 73 Mc No. 277, where Beijing Intellectual Property Court granted protection of unregistered well-known trademark and ordered compensation on the ground of bad faith. Commercial Press since 1957 has continuously published very famous version of Xinhua Dictionary. Sinolingua (the defendant) started to produce and sell its own Xinhua Dictionary which design was similar in terms of cover design, including the title and edition text, the graphic used, and the color to the plaintiff's famous product. Court held that upon the use, Xinhua Dictionary published by the Commercial Press became an unregistered well-known trademark therefore defendant was ordered to immediately cease using the unregistered well-known trademark. Additionally, court held that taking comprehensive consideration of the nature and subjective intention of the alleged infringer defendant was acting in a bad faith therefore ordered it to pay compensation of RMB 3mln. Court stated that the use of a design that is similar to the one of well-known product caused confusion and misidentification of the relevant public has a certain degree of subjective bad faith.²²⁷ In the case *Chateau Lafite Rothschild V. Trademark Review and Adjudication Board and Nanjing Gold Hope Wine Industry* (2016) ZGFXZ No. 34, Supreme People's Court invalidated trademark that was similar to an earlier registered well-known trademark and cause confusion for the relevant public due to the origin of the goods. Chateau Lafite (plaintiff) is a proprietor fo a trademark "LAFITE" and defendant applied for registration "Chateau Lafei (拉菲庄园)" in the same class covering partially the same goods of alcoholic beverages. Because prior mark was registered as Latin letters and lacked Chinese translation, in various media it has been transliterated as Chinese characters 拉菲 (Lā fēi), which is exactly the same as contested trademark. Court ruled that contested trademark violates prior trade name and it is similar to previously used well-

²²⁷ Judgement of Beijing Intellectual Property Court of 28 December 2007, (2016) J 73 Mc No. 277, Court Commercial Press Co., Ltd. v. Sinolingua Co., Ltd., accessed on 17.01.2022 at: <https://www.wipo.int/wipolex/en/text/578530>

known trademark. On the part of applicant, the court found malicious intention to counterfeit and hitchhike and established existence of bad faith therefore invalidated contested trademark to protect the legitimate prior rights and the public interest.²²⁸ In the other case Michael Jeffrey Jordan v. Trademark Review and Adjudication Board and Qiaodan Sports Co., Ltd. (2016) ZGFXZ No. 27 the trademark “乔丹” (Qiáodān) was filed in the class 28, mainly for sport equipment by QIAODAN Company. Michael Jordan (called in China 乔丹- Qiáodān) filled a cancellation request on the grounds of infringement of personal name. Court held that defendant was not only fully aware of the appellant’s popularity and that of his name 乔丹 (Qiáodān) but also registered a large number of trademarks closely related to the appellant’s name and took unfair advantage of well-known trademark without incurring the relevant costs, which violates the principle of good faith and exhibit obvious bad faith conduct during the registration of disputed trademark. Court noted that violation of personal name may not only infringe legitimate rights but also cause damage to legitimate interests of the relevant public.²²⁹ In the case (2014) Shang Biao Yi Zi No. 00085 (IBM) trademark office refused registration of a mark that was very similar with the registered well-known trademark, noting that here was subjective intention of copy and imitation in the disputed trademark and that approval of the application for registration of the disputed trademark would mislead the consumers, which would further result in damage on the business reputation of the plaintiff.²³⁰ In the case (2014) Zhe Zhi Zhong Zi No.11 “Cartier/卡地亚” due to strong distinctiveness was granted protection against bathroom products using the identical trademark.²³¹ Except for well-known trademarks, China provides also protection against preemptive registration of other’s trademarks that are already used and have a certain influence. It was confirmed in the case (2019) Beijing 73 Chu Chu No. 1374 where plaintiff’s company launched “陌

²²⁸ Administrative Judgment of Supreme People's Court of the People's Republic of China of 23 December 2016, (2016) ZGFXZ No. 34, Chateau Lafite Rothschild V. Trademark Review and Adjudication Board and Nanjing Gold Hope Wine Industry, accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577981>

²²⁹ Administrative Judgment of Supreme People's Court of the People's Republic of China of 7 February 2013, (2016) ZGFXZ No. 27, Michael Jeffrey Jordan v. Trademark Review and Adjudication Board and Qiaodan Sports Co., Ltd., accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577926>

²³⁰ International Business Machines Corporation (IBM) v Foshan Shunde Huineng Electromechanical Equipment Co., Ltd., (2014) Shang Biao Yi Zi No. 00085, Trademark Office of the State Administration for Industry and Commerce, accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²³¹ Civil Judgment of Second Instance of Zhejiang Higher People’s Court, of 15 April 2014, (2014) Zhe Zhi Zhong Zi No.11 Tia International Co., Ltd. v Zhejiang Beile Sanitary Ware Technology Co., Ltd., accessed on 19.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXSK4/index.html?docId=IACsLhhe9uAmc1NjBVwwnVW7ssvW0MN6iRnenVlvzSJGQ1sPy9Od8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEnRxr+O4eass/LXZYDOI7kO>

陌" Momo Social App which was a dating application and had high popularity and influence. Defendant who's commercial activity also was related to online dating applied for registration of a trademark "陌陌" (Mò mò). Court held that defendant acted in a bad faith because as a competitor in the same industry should be aware that "陌陌" (Mò mò) trademark was previously used and had a certain influence.²³²

3.3.4. Unauthorized Registration of a Trademark

Unauthorized trademark registrations by the principal or representatives also falls into category of bad faith registration. Bad faith might be found if the trademark that is identical or similar to the principal's or represented person trademark is applied for the same or similar goods and services and when it was applied for by the agent or representative without authorization. It was confirmed in the case (2016) Jing Xing Zhong Zi No. 1896 Chinese company which also has a branch in Germany performed agency services for the defendant - German company (the proprietor of internationally registered trademark "FRUH KOLSCH 及图" of a German Beer). Another Chinese company, who undergone training program and was granted training certificate from the defendant submitted in China the application for registration of trademark "FRUH KOLSCH SEIT 1904及图". Court noted that applicant of the contested trademark on its website published information that it performs agency business for defendant. Therefore, court held that both Chinese companies took part in bad faith registration of the contested trademark.²³³ In the opposition case no 19638921 Trademark office refused registration to trademark "高山别庄" (Gāoshān bié zhuāng) which is identical with the plaintiff's earlier service mark. Shareholder of the defendant had business relationship with the plaintiff therefore should

²³² Administrative Judgment of First Instance of Beijing Intellectual Property Court of 4 April 2019, (2019) Beijing 73 Xing Chu No. 5797, Beijing Momo Technology Co., Ltd. v the Trademark Accreditation Commission of the State Administration for Industry and Commerce, accessed on 18.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=r05t/O+YDgZygSQqwVW EBAWvQ2ZVqJifvM4VaDDNMr6858wS0J4HFd8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMb rY4PEmmH0jNQvT+dOu3TNJ44LQs>

²³³ Administrative Judgment of The High People's Court of Beijing of 31 May 2016, (2016) Jing Xing Zhong Zi No. 1896, Jiangsu Xianghe International Investment Co., Ltd. V Trademark Review and Adjudication Board of the State Administration for Industry and Commerce and Cölner Hofbräu P. Josef Früh KG, accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

have known of the existing prior service mark. Trademark office held that defendant filed the application for the registration in a bad faith without authorization.²³⁴ In the case (2018) Zui Gao Fa Xing Zai No.22 (Andis) the court held that counterparty knew of the existence of unregistered trademark due to business negotiation, therefore had an obligation to protect the interest of the business with which they were cooperating. Court deemed that such negotiations fall under Article 15 and that filling a trademark application for the trademark used by business partner is a violation of good faith principle.²³⁵

3.3.5. Preemptive Registration of Unregistered Trademark by Related Parties

Furthermore, in similar circumstances it is possible to prevent preemptive registration of unregistered trademark by related parties, provided that prior mark was used before application of disputed trademark, there is a business or other relationship between parties and other party clearly knows of prior mark. In the case (2016) No.1441, foreign company outsourced OEM production of washing powder “CHOPPIES” to Chinese supplier, which later applied for the registration of the same word mark in China. Beijing Intellectual Property Court held that applicant who had business relationship with the plaintiff knew of existence of trademark therefore applying for the same mark for the same or similar goods violates the principle of good faith.²³⁶ In the case (2015) Gao Xing (Zhi) Zhong Zi No. 3601, plaintiff registered a trademark “MEGAPULSE” which was previously used by defendant’s company, and of which use plaintiff was aware due to indirect transactions with the defendant. Trademark was applied for registration for the same or similar goods

²³⁴ Opposition Judgment of Trademark Office of 23 May 2018, Case no 1963892, High Mountain Resort Shangri-La Hotel Co.,Ltd. V Hangzhou Sanwu Technology Co.,Ltd., accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²³⁵ Administrative Judgment of the Supreme People’s Court, of 31 October 2018, (2018) Zui Gao Fa Xing Zai No.22, Andes Company is with the Trademark Review and Adjudication Commission of the State Administration for Industry and Commerce of the People's Republic of China v Ningbo Beilun Bofa Hairdressing Supplies Co., Ltd., accessed on 9.01.2021 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=2YiuMbrGvESPnq2N2kIE+d+uYyahOj84YBEgTCymbLSePuhMfVpRON8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PElyAo2wDSxMhne5olC2OpKB>

²³⁶ Administrative Judgment of First Instance of Beijing Intellectual Property Court, (2016) No.1441, Pace Co., Ltd. v the Trademark Review and Review Committee of the State Administration for Industry and Commerce, accessed on 17.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=o338YswRw5w2CgO6tgMCnBNgAt4LAaJgsS91JFmYmC5n0mLU7uGM2N8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEntVPBl7s3zgb7ewJQNHmN>

as goods produced by defendant under the same unregistered trademark. Therefore, court held that application concerning contractual relationship was made in bad faith.²³⁷

3.3.6. Trademarks Applied for Registration by Trademark Agency

In the civil ruling no (2015) 1272 Supreme People's Court found that trademark practitioners who set up a trademark agency had applied for over 1000 trademarks, large percentage of which were similar to trademarks famous in China. Court held that by doing so they had committed dishonest acts by pursuing illegitimate interests and had violated the principle of good faith that the trademark agencies should abide by. Additionally, one of the practitioners was a shareholder of the other trademark agency that via its online trademark supermarket was selling many trademarks.²³⁸ In China trademark agencies are only allowed to file trademarks under their own name in relation to a trademark agency related service, in subclass 4506 "Intellectual Property Service". This is confirmed by the invalidation of trademark application number 7679143 "创新工场 Innovation-Dream Works" filed by a trademark agency and covering research and development.

3.3.7. Other Prior Rights

In the case (2016) ZGFXZ No. 27 Supreme People's Court ruled that contested trademark which is transliteration of the name of famous basketball player violates prior legitimate right to name therefore was applied for in a bad faith.²³⁹ Furthermore, in the case Shang Ping Zi (2009) No. 29925 court held that registration of a trademark "乔治·阿玛尼" (Qióozhì āmǎní), which is transliteration of the name Giorgio Armani in Chinese-speaking countries and regions, is violation of prior right and hereby revoked the disputed

²³⁷ Administrative Judgment of The High People's Court of Beijing of 11 January 2016, (2015) Gao Xing (Zhi) Zhong Zi No. 3601, Yancheng Cross Electronics Co., Ltd. V Trademark Review and Adjudication Board of the State Administration for Industry and Commerce and Shanghai Qinling Wine Co., Ltd accessed on 19.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=8gSbm+bn46MJeeDEkiDp o1Cs47Cd/Ah+yvJ0DJTi2ms7hDL5qZ1+798vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PE IINWIYPibxLqYnhrluli2P>

²³⁸ T.LU, Chinese Supreme Court rules that hoarding trade marks in bad faith falls within the scope of 'other illegitimate means, *Journal of Intellectual Property Law & Practice*, 2019, Vol. 14, No. 4, p.264. accessed on 19.01.2023 at: <https://academic.oup.com/jiplp/article/14/4/263/5363236>

²³⁹ Administrative Judgment of Supreme People's Court of the People's Republic of China of 7 February 2013, (2016) ZGFXZ No. 27, Michael Jeffrey Jordan v. Trademark Review and Adjudication Board and Qiaodan Sports Co., Ltd., accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577926>

trademark.²⁴⁰ The same approach is found in the case (2016) J 73 Mc No. 277 where court held that contested trademark which was transliteration of the name of French winery which sold its products in China constituted violation of trade name and was filed in bad faith.²⁴¹ Furthermore, in the case (2015) Shang Biao Yi Zi No. 0000055470 court held that the distinctive part of the contested trademark is identical with plaintiff's company name. Therefore, court deems that the defendant behavior violated the principle of good faith and application for registration of contested trademark constitutes infringement of the plaintiff's right to company name. In the case (2015) Gao Xing (Zhi) Zhong Zi No. 3963 (Mothercare) court on the basis of prior copyright registration declared invalid contested trademark, which was very similar in appearance and detail design to the copyrighted work. Court held that has subject of prior copyright has been released in public through trademark application, actual use and publicity. Therefore, is quite possible for the owner of the disputed trademark to access the works.²⁴² The same approach was further confirmed in the case (2020) Zhejiang 01 Min Zhong No. 10430 (Peppa Pig) where court established that application for registration of the disputed trademark, which was almost identical to prior copyrighted work constituted infringement to prior copyright, was made in a bad faith.²⁴³

²⁴⁰ Judgment of Trademark Review and Adjudication Board of the State Administration for Industry and Commerce of 3 November 2009, Shang Ping Zi (2009) No. 29925, GA Modeline S.A. v Hangzhou Xinchun Trading Co., Ltd., accessed on 9.0.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²⁴¹ Administrative Judgment of Supreme People's Court of the People's Republic of China of 23 December 2016, (2016) ZGFXZ No. 34, Chateau Lafite Rothschild V. Trademark Review and Adjudication Board and Nanjing Gold Hope Wine Industry, accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577981>

²⁴² Second Instance Administrative Judgments of the Trademark Review and Adjudication Commission of the State Administration for Industry and Commerce of the People's Republic of China of 25 December 2015, (2015) Gao Xing (Zhi) Zhong Zi No. 3963, Ou Yongwei v Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Mothercare Limited, accessed on 17.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=rT0YKZx+DhT9tnmm4/fSjjaA8dn3mjJf7VEKtWh1rx6MaD9UiYNKGAN8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PElw1+R+5lIFxFavb5zDqADc>

²⁴³ Civil Judgments of Second Instance of Trademark Infringement Dispute of Intermediate People's Court of Hangzhou City, Zhejiang Province of 17 December 2021, (2020) Zhejiang 01 Min Zhong No. 10430, Shide Plastic Toy Factory v Entertainmentone UK Limited, accessed on 17.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=dv6wNnAVYW/IBtx7oMtbvRBCUNFdv1amQjutpv4zl09gmhN3R5l8dt8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEkf9X0lYFx4gxO7LrjLXL2>

4. Common Standard of Bad Faith in Trademark Law

As already mentioned in the introduction part of this thesis economic cooperation between China and European Union, including Poland, is constantly growing.²⁴⁴ Therefore due to the development of trade in goods and services between these regions and the exchange of information in the process of globalization, the protection of intellectual property is becoming increasingly important. However, the territorial nature of trademark law causes some differences in local legal systems which might result in difficulties in effective protection of trademarks at all stages of the supply chain. One of the greatest threats in this regard might be the registration of trademarks in bad faith thus deep understanding of what is considered in given jurisdiction as a bad faith appears to be a very important reference point. Analysis of the provision of the trademark laws as well as the relevant case-law regarding bad faith filings conducted in previous chapters give the background for further comparison study. This chapter constitute an attempt to indicate a common standard of bad faith. Common standard which reflects shared and consistent interpretation could enhance cooperation and facilitate trade by removing barriers of legal protection, promote common understanding of the notion of bad faith, increase legal certainty improve fair competition and at the same time make global trade exchange easier for industry and consumers. Furthermore, the research process of framing common standard by comparative study may lay the foundation for further improvements. All the conclusions presented in this part of the thesis are based on the analysis made in previous chapters.

4.1. General Overview

The bad faith, as provided in the relevant materials referred to in this thesis, lack of international or local definition. Although several provisions of European, Polish, and Chinese trademark law refer to the notion of bad faith, none of the legal systems analyzed in this thesis provide a legal definition of this concept. Nevertheless, the guidelines and relevant case-law discussed in previous chapters shed some light on how bad faith might be interpreted. The common standard is to assess the existence of bad faith at the time of

²⁴⁴ China-EU - international trade in goods statistics, accessed on 07.02.2023 at: https://ec.europa.eu/eurostat/statistics-explained/index.php?title=China-EU_-_international_trade_in_goods_statistics

filling an application for trademark registration. While in Poland and in China it is possible to raise an opposition proceeding on the ground of bad faith against trademark registration, there is no legal instrument that allows the opposition of EUTM registration on the ground of bad faith as such. In all analyzed jurisdictions although trademark registered in a bad faith can be invalidated after obtaining registration. Furthermore, in EU and in Poland there is no time limit to claim bad faith and to request invalidation however China impose time limit for invalidation proceedings of five years from the date of registration if the trademark stands in the violation of Article 13 paragraph two and three, Article 15, Article 16 paragraph one, Article 30, Article 31, or Article 31 of the Trademark Law of the PRC. Only the owners of a well-known trademarks are not bound by five-year time limit. In EU, Poland and China bad faith is considered as a subjective element and applicant's awareness of acting in a bad faith is a relevant factor for the judgment.²⁴⁵

4.2. Relevant Factors for Determining Bad Faith

It is commonly established that the existence of a bad faith should be assessed taking into consideration all the factors relevant for each individual case. None of the legal system provide closed catalogue or checklist of factors for establishing bad faith. Nevertheless, current EUIPO Trade Mark Guideline provides concise list of factor which might or which might not indicate the bad faith. Chinese Guidelines for Trademark Examination and Trial 2022 discuss bad faith in a very detailed manner providing many examples of typical fillings falling into this category. In all analyzed jurisdiction identity or similarity of the marks is considered as relevant factor which might indicate bad faith. In EU if there are no other relevant factors, similarity, or identity of the marks itself is not sufficient to establish bad faith.²⁴⁶ Respectively the same approach is recognized in Poland where to establish bad faith, identity, or similarity of marks should be accompanied by other

²⁴⁵ See more: Judgment of the Court (First Chamber) of 11 June 2009, C-529/07 *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, ECLI:EU:C:2009:361, paragraph 42.
Decision of the PPO of 1 March 2016., III. Sp.234.2015, *Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP*, t. I, *Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018)*, Warszawa 2020, p. 131, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>
Judgement of Beijing Intellectual Property Court of 28 December 2007, (2016) J 73 Mc No. 277, *Court Commercial Press Co., Ltd. v. Sinolingua Co., Ltd.*, accessed on 17.01.2022 at: <https://www.wipo.int/wipolex/en/text/578530>

²⁴⁶ Judgment of the General Court (Eighth Chamber) of 1 February 2012. *Carrols Corp. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, ECLI:EU:T:2012:39, paragraph 59-60.

relevant factors.²⁴⁷ In China identity or similarity of the marks often relate to earlier marks with certain influence, or strong distinctiveness, or other prior rights (e.g. where trademark was almost identical to prior copyright its application was considered to be made in a bad faith²⁴⁸). Awareness of prior use of the mark is also relevant factor when assessing bad faith. In the EU awareness of prior use might be presumed to exist based on business relations, reputation of a sign, or general knowledge. Nevertheless, knowledge of prior use of the mark is not sufficient in itself to establish bad faith and the applicant's intention also should be considered.²⁴⁹ Polish case law also established that to conclude bad faith applicant's intention and additional circumstances should be found.²⁵⁰ In China awareness of prior use of the mark constitute bad faith if it is accompanied by dishonest intention (e.g. if applicant had business relation with proprietor of the mark²⁵¹ or if mark is well-known²⁵²). Unfair intention is of significant importance for the assessment of bad faith. Case law in the EU and Poland define unfair intention as filing a trademark application is to obtain protection for purposes other than falling within the functions of a trademark.²⁵³ In China unfair intention is additionally defined as fraudulent or other improper means, where fraudulent refers to fabricating documents and other improper means refers to disturbing the order of trademark registration, harming public interest, improperly occupying public resources, or obtaining improper benefits. It is commonly recognized that registering a trademark without any intention to use it might constitute a bad faith. In the EU however it is additionally required that applicant intended to either infringe, in a manner inconsistent with honest customs, the interests of third parties or to obtain, even

²⁴⁷ Judgment of the Provincial Administrative Court in Warsaw of 27 July 2016, VI SA/Wa 319/16, LEX nr 2097733, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522191429/1?pit=2023-01-22&directHit=true&directHitQuery=VI%20SA~2FWa%20319~2F16>

²⁴⁸ Civil Judgments of Second Instance of Trademark Infringement Dispute of Intermediate People's Court of Hangzhou City, Zhejiang Province of 17 December 2021, (2020) Zhejiang 01 Min Zhong No. 10430, Shide Plastic Toy Factory v Entertainmentone UK Limited, accessed on 17.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=dv6wNnAVYW/IBtx7oMtbvRBCUNFdv1amQjupv4zl09gmhN3R518dt8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEkef9X0IYFx4gxO7LrjLXL2>

²⁴⁹ Judgement of the Court (Fifth Chamber) of 27 June 2013, C-320/12 - Malaysia Dairy Industries v Ankenævnet for Patenter og Varemærker pkt. 40, ECLI:EU:C:2013:435, paragraph 44.

²⁵⁰ Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 132, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²⁵¹ Opposition Judgment of Trademark Office of 23 May 2018, Case no 1963892, High Mountain Resort Shangri-La Hotel Co.,Ltd. V Hangzhou Sanwu Technology Co.,Ltd., accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²⁵² Judgement of Beijing Intellectual Property Court of 28 December 2007, (2016) J 73 Mc No. 277, Court Commercial Press Co., Ltd. v. Sinolingua Co., Ltd., accessed on 17.01.2022 at: <https://www.wipo.int/wipolex/en/text/578530>

²⁵³ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 88.

without reference to a specific third party, an exclusive right for purposes other than those related to the functions of the trademark.²⁵⁴ Similarly in Poland bad faith exists when trademark is filled for purposes other than obtaining exclusive rights to use the mark for one's own products, as a result of which rights of others are infringed.²⁵⁵ In China lack of intention to use is often associated with a large number of trademark application applied for by one applicant often in many classes.²⁵⁶ On the contrary in the EU the broad registration of the trademark (cluttering trademark classes) is not relevant for establishing bad faith and cannot constitute a ground for invalidation.²⁵⁷ Lack of intention to use trademark which constitute bad faith is found when it was registered for speculative purpose of obtaining financial compensation (e.g derive economic benefits from opposing proceedings, inflated assignment fee)²⁵⁸ or when registration aims to prevent third parties from entering the market.²⁵⁹ Additionally repeated filling of the same, already registered but not put into use trademark for the same or similar goods shortly before five-year grace period expires in EU constitutes bad faith.²⁶⁰ This practice is called evergreening and it aims to avoid consequences of revocation of a mark due to non-use. In Poland however court held that such a registration of revoked trademark does not constitute bad faith on

²⁵⁴ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 77.

²⁵⁵ Judgment of the Provincial Administrative Court in Warsaw of January 25, 2017. VI SA/Wa 1612/16, LEX No. 2260767, accessed on January 23, 2023 at: <https://sip.lex.pl/#/jurisprudence/522354463/1/vi-sa-wa-1612-16-legal-interest-in-annulment-of-protection-right-of-bad-faith-of-the-applicant...?pit=2023-01-22&keyword=VI%20SA~2FWa%201612~2F16&cm=STOP>

²⁵⁶ CNIPA Refusal Decision No. 26783639 of 21 February 2020, accesses on 17.01.2022 at: <https://wsjgs.sbj.cnipa.gov.cn:9080/tmpu/yyw/detail.html?appId=A2158B1A37E808C2E053640B50232D79>

²⁵⁷ Judgment of the Court (Fourth Chamber) of 29 January 2020, C-371/18 Sky plc and Others v Skykick UK Limited and Skykick Inc, ECLI:EU:C:2020:45, paragraph 71.

²⁵⁸ See more: Judgment of the General Court (Ninth Chamber) of 7 July 2016, T-82/14 Copernicus-Trademarks Ltd v EUIPO Maquet GmbH, ECLI:EU:T:2016:396, paragraph 145.

Judgment of the Supreme Administrative Court of September 3, 2013. Case No. II GSK 730/12, LEX nr 1558946 accessed on 22.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521652642/1/ii-gsk-730-12-wyrok-naczelnego-sadu-administracyjnego?keyword=II%20GSK%20730~2F12%20&cm=SFIRST>

CNIPA Refusal Decision No. 35000075 of 8 October 2020, accesses on 17.01.2022 at: <https://wsjgs.sbj.cnipa.gov.cn:9080/tmpu/yyw/detail.html?appId=B4B52B7DFCD106EAE053640B50232DE45>

²⁵⁹ See more: Judgment of the General Court (Third Chamber) of 16 June 2015, t-306/13 Silicium España Laboratorios, SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2015:382, paragraph 71.

Decision of the PPO of 1 March 2016., III. Sp.234.2015, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 132, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

CNIPA Refusal Decision No. 26783639 of 21 February 2020, accesses on 17.01.2022 at: <https://wsjgs.sbj.cnipa.gov.cn:9080/tmpu/yyw/detail.html?appId=A2158B1A37E808C2E053640B50232D79>

²⁶⁰ Judgment of the General Court (Fifth Chamber) of 13 December 2012, T-136/11 pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM), ECLI:EU:T:2012:689, paragraph 27.

itself since after revocation anyone can apply for protection of revoked mark.²⁶¹ Furthermore, all analyzed systems provide protection against bad faith fillings of renown and well-known trademarks. In EU, Poland and China protection of renown trademarks goes beyond the principle of specialty, while well-known trademarks are protected only against use for identical or similar goods. Additionally, due to linguistic features China provides protection against translation and transliteration. In EU case-law three typical behaviors regarding bad faith exploitation of renown and well-known trademarks can be distinguished, namely: free riding, dilution and tarnishment. Taking unfair advantage of distinctive character or the reputation of an earlier mark is classified as free riding and constitute bad faith.²⁶² It usually occurs when third party attempt to register sign which is identical or similar to earlier mark with reputation.²⁶³ Dilution take place when distinctiveness is whittled away by illegitimate use of a mark on dissimilar product.²⁶⁴ It may happen when sign identical or similar to an earlier mark is registered for slightly different goods e.g. computer-linked goods and services and marketing or telemarketing services.²⁶⁵ Degrading the image and prestige of earlier mark is called tarnishment.²⁶⁶ It was established when identical or similar sign was used for completely different goods and its likely to cause negative associations with earlier mark e.g sportswear and tobacco products.²⁶⁷ Similar approach is found in Polish case-law where taking advantage of reputation of earlier mark is also considered as bad faith²⁶⁸ and in China where reputation of a registered and unregistered well-known is protected against confusion and misidentification of the relevant public.²⁶⁹ The protection is also provided for marks that are already used and have certain influence.²⁷⁰ In Europe, languages are based on

²⁶¹ Judgment of the Supreme Administrative Court of June 9, 2015, II GSK 756/14, LEX nr 1775157 accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/521868853/1/ii-gsk-756-14-wyrok-naczelnego-sadu-administracyjnego?pit=2023-01-22&keyword=II%20GSK%20756~2F14,&cm=SFIRST>

²⁶² Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 56.

²⁶³ Judgment of the General Court (Fifth Chamber) of 8 May 2014, T-327/12 Simca Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2014:240, paragraph 56.

²⁶⁴ Idem. Paragrapf 74.

²⁶⁵ Judgment of the Court (First Chamber) of 27 November 2008, C-252/07 Intel Corporation Inc. v CPM United Kingdom Ltd. ECLI:EU:C:2008:655, paragraph 29.

²⁶⁶ Judgment of the General Court (Fifth Chamber) of 22 March 2007, T-215/03 Sigla v European Union Intellectual Property Office (EUIPO), ECLI:EU:T:2007:93, paragraph 67.

²⁶⁷ Decision od 12 April 2012, R297/2011-5 „KAPPA”, paragraph 38. Accessed on 12:02.2022 at: [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf)

[lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/41_part_c_opposition_section_5_trade_marks_with_reputation_article_8_5_eutmr_tc_lr2_en.pdf)

²⁶⁸ Following: J. Kępiński, Zła wiara zgłaszającego znak towarowy jako przeszkoda w rejestracji znaku towarowego, *Znaki towarowe i ich ochrona* (R. Skubisz), C.H. Beck, Warszawa 2019, p.172

²⁶⁹ Judgement of Beijing Intellectual Property of 28 December 2007, (2016) J 73 Mc No. 277, Court Commercial Press Co., Ltd. v. Sinolingua Co., Ltd., accessed on 17.01.2022 at: <https://www.wipo.int/wipolex/en/text/578530>

²⁷⁰ Administrative Judgment of First Instance of Beijing Intellectual Property Court of 4 April 2019, (2019) Beijing 73 Xing Chu No. 5797, Beijing Momo Technology Co., Ltd. v the Trademark Accreditation Commission of the

alphabets while Chinese is based on characters, so it is difficult for Chinese speakers to understand brand names written in the alphabetic system. Therefore, every foreign brand has its Chinese version, which easily could be the subject of a bad faith trademark application. Translation of a mark which violate prior rights and is similar to previously used well-known trademark constitute bad faith.²⁷¹ This type of bad faith conduct is often associated with filling multiple applications of different well-known trademarks. In EU the commercial logic underlying the filling of the application are relevant for establishing bad faith.²⁷² In China lack of commercial logic might be associated e.g with filling a massive number of trademark application with no logical explanation for filling so many trademarks.²⁷³ Unauthorized registration of trademark itself in EU is considered as sufficient to establish bad faith.²⁷⁴ Existence of contractual relationship between parties prior to date of application is not required to indicate unauthorized registration, existence of indirect relationship is enough. It applies to situations where one of shareholders attempt to register company's mark²⁷⁵, or where one of the business partners intend to register mark similar to earlier trademark used in the cooperation in order to benefit from the reputation of earlier mark while circumventing the contractual obligations²⁷⁶, or where distributor attempt to register trademark which belongs to third party.²⁷⁷ Similar approach

State Administration for Industry and Commerce, accessed on 18.01.2023 at:

<https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=r05t/O+YDgZygSQqwVW EBAWvQ2ZVqJIfvM4VaDDNMr6858wS0J4HFd8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PEmmH0jNqvT+dOu3TNJ44LQs>

²⁷¹ Administrative Judgment of Supreme People's Court of the People's Republic of China of 23 December 2016, (2016) ZGFXZ No. 34, Chateau Lafhateau Lafite Rothschild V. Trademark Review and Adjudication Board and Nanjing Gold Hope Wine Industry, accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577981>

²⁷² Judgment of the Court (Fifth Chamber) of 12 September 2019, C-104/18 P Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ v European Union Intellectual Property Office, ECLI:EU:C:2019:724, paragraph 25.

²⁷³ Administrative Judgment of Second Instance of Beijing High People's Court of 7 March 2018, (2017) Jing Xing Zhong No.5603, Guangzhou Compass Convention and Exhibition Service Co., Ltd. and Fast Retailing (China) Trading Co., Ltd., accessed on 20.01.2023 at:

<https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXS4/index.html?docId=kPOB9XJWQhfwCLiaixll W0Y5t0MbHycUjB0gDCptWd8h9iaY4GVcS98vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PElRrAlwLgh5hwIJc2PWk3H0>

²⁷⁴ Invalidity Decision of 14 September 2015, Decision No 9805 C, Balbpharm Industria De CCosmeticos LTDA v 3B.Solutions (BALBCARE)

²⁷⁵ Judgment of the General Court (Third Chamber) of 16 June 2015, t-306/13 Silicium España Laboratorios, SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECLI:EU:T:2015:382, paragraph 71.

²⁷⁶ Order of the Court (Tenth Chamber) of 11 May 2017, C-639/16 P, Foodcare sp. z o.o. v European Union Intellectual Property Office, ECLI:EU:C:2017:367, paragraph 5 (point11, 12, 13 and 14).

²⁷⁷ Judgment of the General Court (Second Chamber) of 16 May 2017, T-107/16 Airhole Facemasks, Inc. v European Union Intellectual Property Office, ECLI:EU:T:2017:335, paragraph 28,34, 37 and 41.

is found in Poland, where previous business cooperation²⁷⁸, distribution cooperation²⁷⁹, or even preparation to sign distribution agreement²⁸⁰ is sufficient to establish unauthorized registration in bad faith. China shares the same approach towards unauthorized registrations, however, distinguishes more specific circumstances. Chinese case-law provide examples of unauthorized registration by principal or representative²⁸¹ or business partner²⁸². Furthermore, in China precontractual negotiations are sufficient to invoke this premise²⁸³. Additionally in China trademark agencies or entities providing services related to intellectual property are only allowed to fill trademark application in their own name in subclass 4506, while such a regulation doesn't exist in EU or in Poland. Additionally, violation or infringement of prior rights other than trademark rights (e.g prior right to name²⁸⁴, trade name²⁸⁵, copyright²⁸⁶) in China also is considered as bad faith.

²⁷⁸ Decision of the PPO of 1 October 2015., I. Sp.459.2014, Orzecznictwo Kolegiów Orzekających ds. Spornych UPRP, t. I, Znaki towarowe i wzory przemysłowe (wybrane orzeczenia z lat 2009–2018), Warszawa 2020, p. 133, accessed on 22.01.2023 at: <https://uprp.gov.pl/sites/default/files/2022-05/Orzecznictwo%20Kolegiów%20Orzekających%20ds.%20spornych%20UPRP.%20Tom%20I%20Znaki%20towarowe%20i%20Wzory%20przemysłowe.pdf>

²⁷⁹ Judgment of the Voivodeship Administrative Court in Warsaw of September 6, 2006. VI SA/Wa 428/06, LEX No. 247559, accessed on 23.01.2023 at: <https://sip.lex.pl/#/jurisprudence/520341255?cm=DOCUMENT>

²⁸⁰ Judgment of the Supreme Administrative Court of February 10, 2016, II GSK 2312/14, LEX nr 2037087, accessed on 24.01.2023 at: <https://sip.lex.pl/#/jurisprudence/522130783/1?pit=2023-01-22&directHit=true&directHitQuery=II%20GSK%202312~2F14>

²⁸¹ Administrative Judgment of The High People's Court of Beijing of 31 May 2016, (2016) Jing Xing Zhong Zi No. 1896, Jiangsu Xianghe International Investment Co., Ltd. V Trademark Review and Adjudication Board of the State Administration for Industry and Commerce and Cölner Hofbräu P. Josef Früh KG, accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²⁸² Opposition Judgment of Trademark Office of 23 May 2018, Case no 1963892, High Mountain Resort Shangri-La Hotel Co.,Ltd. V Hangzhou Sanwu Technology Co.,Ltd., accessed on 19.01.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²⁸³ Administrative Judgment of the Supreme People's Court, of 31 October 2018, (2018) Zui Gao Fa Xing Zai No.22, Andes Company is with the Trademark Review and Adjudication Commission of the State Administration for Industry and Commerce of the People's Republic of China v Ningbo Beilun Bofa Hairdressing Supplies Co., Ltd., accessed on 9.01.2021 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXSK4/index.html?docId=2YiuMbrGvESPnq2N2kIE+d+uYyahOj84YBEgTCymbLSePuhMfVpRON8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PElyAo2wDSxMhne5olC2OpKB>

²⁸⁴ Judgment of Trademark Review and Adjudication Board of the State Administration for Industry and Commerce of 3 November 2009, Shang Ping Zi (2009) No. 29925, GA Modefine S.A. v Hangzhou Xincheng Trading Co., Ltd., accessed on 9.0.2023 at: <https://www.jpo.go.jp/news/kokusai/tm5/document/index/bad-faith-examples-2017.pdf>

²⁸⁵ Administrative Judgment of Supreme People's Court of the People's Republic of China of 23 December 2016, (2016) ZGFXZ No. 34, Chateau Lafhateau Lafite Rothschild V. Trademark Review and Adjudication Board and Nanjing Gold Hope Wine Industry, accessed on 17.01.2023 at: <https://www.wipo.int/wipolex/en/text/577981>

²⁸⁶ Second Instance Administrative Judgments of the Trademark Review and Adjudication Commission of the State Administration for Industry and Commerce of the People's Republic of China of 25 December 2015, (2015) Gao Xing (Zhi) Zhong Zi No. 3963, Ou Yongwei v Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Mothercare Limited, accessed on 17.01.2023 at: <https://wenshu.court.gov.cn/website/wenshu/181107ANFZ0BXSK4/index.html?docId=rT0YKZx+DhT9tnmm4/fSjJA8dn3mjJf7VEKtWh1rx6MaD9UiYNKGAN8vNnCaLh4wludEw2/swlA9Ijn9FHf5A/uKQPHmHdn8sSWMbrY4PElw1+R+5lIFxFavb5ZDqADc>

Table 2: Comparison table of EU, Polish and Chinese system concerning bad faith filings

	EU	Poland	China
General Overview			
Time when bad faith is legally identified.	At the time of filing an application.	At the time of filing an application.	At the time of filing an application.
The earliest stage when bad faith is taken up.	Invalidation.	Opposition.	Opposition.
Time limit to claim bad faith.	No time limit.	No time limit.	Five years if the trademark stands in the violation of Article 13 paragraph two and three, Article 15, Article 16 paragraph one, Article 30, Article 31 or Article 31. Time limit do not apply to owners of a well-known trademarks.
Is bad faith considered as a subjective element?	Yes.	Yes.	Yes.
Relevant Factors for Determining Bad Faith			
Identity or similarity of signs	It is relevant factor, but on itself it cannot constitute a bad faith.	It is relevant factor, but on itself it cannot constitute a bad faith.	It is bad faith if it violates prior rights.
Awareness of prior sign	It is relevant factor, but on itself it cannot constitute a bad faith, applicant's intention also should be considered.	It is relevant factor, but on itself it cannot constitute a bad faith, applicant's intention and additional circumstances also should be considered.	It is relevant factor and constitute bad faith if it is accompanied by dishonest intention.
Dishonest intention	Relevant to establish bad faith.	Relevant to establish bad faith.	Relevant to establish bad faith.
Lack of intention to use	Use is not required at the time of application however it is relevant factor.	Use is not required at the time of application however it is relevant factor.	Use is not required at the time of application however it is relevant factor.
Financial compensation	Relevant factor to prove lack of intention to use and dishonest intention.	Relevant factor to prove lack of intention to use and dishonest intention.	Relevant factor to prove lack of intention to use and dishonest intention.
Preventing third party from entering the market	Relevant factor to prove lack of intention to use and dishonest intention.	Relevant factor to prove lack of intention to use and dishonest intention.	Relevant factor to prove lack of intention to use and dishonest intention.
Free ride	Relevant to establish bad faith.	Relevant to establish bad faith.	Relevant to establish bad faith.
Previous business relationship	Relevant to establish bad faith.	Relevant to establish bad faith.	Relevant to establish bad faith.
Unauthorized registration	Relevant to establish bad faith.	Relevant to establish bad faith.	Relevant to establish bad faith.
Refilling of a trademark application	Relevant to establish bad faith.	Lack of unambiguous approach.	Not relevant.
Lack of commercial logic	Relevant to establish bad faith.	Relevant to establish bad faith.	Relevant to establish bad faith, usually associated with filling large number of trademarks.
Cluttering trademark classes	Not relevant.	Not relevant.	In some cases, registering trademarks in many classes might constitute bad faith.
Application in the name of trademark agencies	Not relevant.	Not relevant.	Constitute bad faith if in application are indicated other sub classes than 4506.
Violation of other prior rights	Settled on a different legal basis.	Settled on a different legal basis.	Relevant to establish bad faith.

4.3. Conclusion

Territorial nature of trademark law may cause significant differences in legal systems all over the world. Those differences usually reflect varying factors such as history, cultural background, language, or economy characteristics. Thus, development and perception of intellectual property protection in Europe and China varies considerably. For many years extensive problem with bad faith trademark application in China remained unsolved. However, entry into force of the Fourth Amendment to the Chinese Trademark Law in 2019 and published in 2021 Guidelines for Trade Mark Examination and Trial aimed to eliminate bad faith practices and gradually improve the system. The analysis and comparison study of European, Polish, and Chinese legal systems presented in this thesis indicate that setting a common standard in some areas concerning bad faith filling might be possible. Abovementioned standard could take a form of international guidelines issued by WIPO, as global authority in this regard. On the basis of legislative acts and case law the guidelines could consist of a list of cases typical for finding bad faith. The description of each typical case could indicate the legal basis, interpretation and commentary for indicated legal provisions, narrow and detailed circumstances which classifies as given typical case, relevant considerations, list of relevant evidence, examples of applicable situations and several examples of case law that classifies as given typical case. Nevertheless, due to specific character of bad faith and the need of individual assessment of each case it could not be a closed catalogue. Therefore, the open catalogue will allow the space to remain open for new circumstances that may appear and qualifies as bad faith conduct, which could be later also included and described as new typical case. Similar solutions regarding assessing bad faith already exist in national systems, example of which could be Chinese Guidelines for Trade Mark Examination and Trial and American The Anticybersquatting Consumer Protection Act.

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