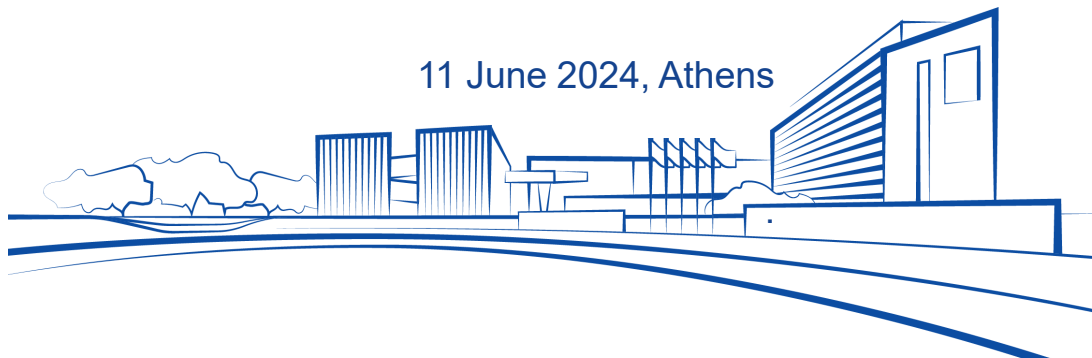


Boards of Appeal´s contribution to coherence and consistency

Session with IP Practitioners

Janka Budovičová

11 June 2024, Athens





Convergence Projects

Boards of Appeal's contribution

EUROPEAN COOPERATION PROJECTS

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

CP13 - Trade mark applications made in bad faith

CP13. Κακόπιστη υποβολή αίτησης σήματος

Common Practice

<https://www.tmdn.org/#/practices/2537136>

CP13 Common Practice

Why was the CP13 Common Practice needed?



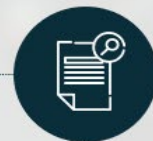
The **concept of bad faith** in trade mark applications is **not defined, delimited or described** in EU trade mark legislation



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



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



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

SCOPE:

- Agreement on a **common understanding** of the **general notion of bad faith** in trade mark applications.
- Agreement on a **common understanding** of **other concepts, including terminology**, related to the assessment of bad faith **and some scenarios**.
- Agreement on **common factors for the assessment of bad faith** in trade mark applications.

CP13 Common Practice

1 Key notions that appear in bad faith cases



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

2 The general notion of bad faith in trade mark applications



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

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



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

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



- Mandatory factors
- Non-mandatory factors

5 Scenarios of bad faith in trade mark applications



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

CP13 Common Practice

Publication and implementation



www.tmdn.org



Publication date



22/03/2024



Implementation date (max. 3 months after publication)



22/06/2024

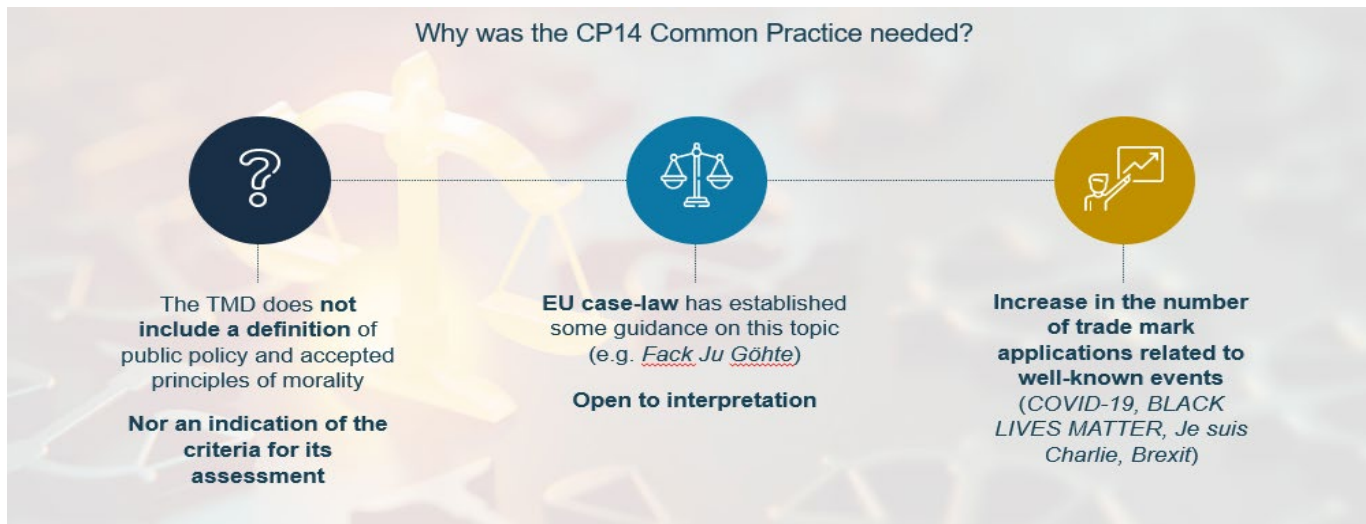
CP14 - Trade marks contrary to public policy or to accepted principles of morality

CP14. Σήματα που αντίκεινται στη δημόσια τάξη ή στα χρηστά ήθη

Common Practice

<https://www.tmdn.org/#/practices/2547782>

CP14 Common Practice



SCOPE:

- A **common understanding** of the concepts of **public policy and accepted principles of morality** and other related concepts.
- **Common criteria** for assessing Article 4(1)(f) TMD.
- **Illustrative examples** of the criteria and the groups of signs identified.

CP14 Common Practice

1 Common understandings of



- Public policy
- Accepted principles of morality

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



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

3 Overlap between public policy and accepted principles of morality

4 Freedom of expression

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



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

CP14 Common Practice

Publication and implementation



www.tmdn.org



Publication date



19/04/2024



Implementation date (max. 3 months after publication)



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



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

Boards of Appeal Case-law Research Reports




CONCISTENCY CIRCLES

- **Support Boards in decision making practice and operations**
- **BoA Case Law Research Reports** (case law analysis → trade mark and design topics)
- **Detect divergences**
- **Identify trends in substance and procedural matters.**
- **Identify possible referrals to the Grand Board**
- **Legal consultations**



BoA Case Law Research Reports – stakeholders involvement



Network of Appeal Bodies of EU IPOs	<ul style="list-style-type: none">• Consultation and discussion with Appeal Bodies of EU IPOs
Judges Quality and Assurance Legal Panels (J-QALPP)	<ul style="list-style-type: none">• Consultation and discussion with IP judges from EU countries
General Consistency Meetings of BoA	<ul style="list-style-type: none">• Internal consultation and discussion with BoA experts

Boards of Appeal Case-law Research Reports



Boards of Appeal Case-Law Research Reports

The Boards of Appeal Consistency Circle Goods and Services has prepared a **new** report - [Acceptability of restrictions of goods and services \(substance\)](#) – which analyses the substantive requirements of restrictions.

At the same time, the Case Law Research Report - [Clear and precise definition of goods and services and implications in relative grounds proceedings](#) - has been **amended**. Section 3.5 focusing on clarity and precision in restrictions, has been removed, as this area is analysed in detail in the new report mentioned above.

[Publications](#)

<https://www.euipo.europa.eu/en/the-office/boards-of-appeal/publications/research-reports>

21
reports
published

75
translations
published

4 new
reports
in the pipeline



Boards of Appeal Case-law Research Reports – Absolute Grounds

Deceptiveness of marks designating geographical origin	March 2023	EN ES DE FR IT
Descriptiveness of a sign suggesting the subject matter of advertising services	June 2024	EN
Descriptiveness of marks designating geographical origin	December 2022	EN ES DE FR IT
Evocation of geographical indications in absolute grounds	June 2023	EN ES DE FR IT
Lack of distinctiveness of marks designating geographical origin	March 2023	EN ES DE FR IT
The distinctive character of slogans	October 2021	EN ES DE FR IT
Trade marks contrary to public policy or accepted principles of morality	October 2021	EN ES DE FR IT

<https://www.euipo.europa.eu/en/the-office/boards-of-appeal/publications/research-reports>

Boards of Appeal Case-law Research Reports – Relative Grounds

Acceptability of restrictions of goods and services (substance)	June 2023	EN
Clear and precise definition of goods and services and implications in relative grounds proceedings	October 2022	EN ES DE FR IT
Complementarity of goods and services	June 2024	EN
Global assessment of the likelihood of confusion between trade marks in cases where their similarity essentially resides in a weak or non-distinctive element	December 2023	EN
Likelihood of confusion in the case of single-letter signs	November 2023	EN ES DE FR IT
Similarity between beers and other beverages	July 2022	EN ES DE FR IT
Similarity between foodstuffs/drinks and services for providing food and drink	March 2022	EN ES DE FR IT
The neutralisation principle	July 2022	EN ES DE FR IT

<https://www.euipo.europa.eu/en/the-office/boards-of-appeal/publications/research-reports>

Boards of Appeal Case-law Research Reports – Designs

Title of procedure ↑	Date	Languages
Designer's degree of freedom (Article 6(2) CDR)	June 2023	EN
Identification of the features of a design under Article 8(1) CDR	January 2022	EN ES DE FR IT
Identification of the product	October 2022	EN ES DE FR IT
Proof of a technical function of a design under Article 8(1) CDR	January 2022	EN ES DE FR IT
The informed user (Article 6(1) CDR)	March 2023	EN ES DE FR IT

<https://www.euipo.europa.eu/en/the-office/boards-of-appeal/publications/research-reports>

Boards of Appeal Case-law Research Reports – Procedure and Registry

Title of procedure ↑

Date

Languages

Res judicata - The scope of re-examination of the appeal following annulment by the EU courts

October 2022

[EN](#) [ES](#) [DE](#) [FR](#) [IT](#)

<https://www.euipo.europa.eu/en/the-office/boards-of-appeal/publications/research-reports>

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THANK YOU!