

ECTA Daily



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Sozos-Christos Theodoulou appointed new ECTA president

Sozos-Christos Theodoulou will be the new president of the European Communities Trade Mark Association (ECTA).

On Thursday 15 June at ECTA's 37th Annual Conference in Athens, past president Ruta Olmane announced Sozos would take on the role at the end of her two-year term.

Sozos-Christos was previously second vice-president of ECTA and has worked within the management of the association for a number of years.

Mladen Vukmir will take on the role of second-vice president of ECTA.

A practicing lawyer in Cyprus, Sozos-Christos has a range of experience, including work in trademark filing and prosecution, domain name disputes, anti-counterfeiting activities and various other intellectual property related matters.

Sozos-Christos is also an associate lecturer at the law school of the University of Central Lancashire, Cyprus and an honorary consul of France in Larnaca, Cyprus.



Incoming EU trademark directive could impact all EU states, says ECTA panellist

When it comes to the EU's Trade Mark Directive EU member states are "embarrassed adolescent kids with overly helpful parents", according to a panellist at the European Communities Trade Mark Association's 37th Annual Meeting in Athens.

The panellist referred to the EU Intellectual Property Office and EU Commission as "a mum and dad who are doing everything for them and

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Great opportunities

As new ECTA president, Sozos-Christos Theodoulou will have a lot on his plate, but with responsibility and challenge comes great opportunity

Congratulations on your new position as president of ECTA. What are your plans for the association going forward?

Thank you for your kind words. It is, indeed, both an honour and a challenge for me to take over the helm of such a prestigious association as ECTA. This is especially true for someone coming from a small EU member state like Cyprus!

After four years of being one of the two vice-presidents of the association, the time has come for me to become president. Coming to your question on my plans going forward, allow me first to explain how things work at ECTA: for some years now, ECTA has established a rolling six-year strategic plan, which is regularly reviewed and adapted every two years by each incoming president. This means that, after a process of evaluation, the president-to-be must introduce his/her additions to the outgoing

president's strategic plan to the ECTA Council for approval. This is what I am preparing for, right now.

At this point, I wish to congratulate and to thank my colleague, Ruta Olmane, for her good presidency over the past two years.

With regard to my plans, I will continue to support the progress of the five pillars (develop membership benefits, broaden ECTA's expertise, reinforce external partnerships, strengthen the internal organisation and broaden the financial basis). During the next two years, ECTA is expected to materialise quite a few projects. First of all, we need to bring into life our system of better internal and external communication (known as Organica), so that all tasks, correspondence and news may be managed in an easier and more structured way. Then, I would like to approach the University world, academics and students alike, in an effort to

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“It’s always worth travelling
20 hours for ECTA”

One face many attendees of the ECTA 37th Annual Conference in Athens may recognise is that of Juan Berton Moreno, partner at Argentinian law firm, Berton Moreno Ojam. Juan has been attending ECTA conferences for 17 years. His first was in 2002 in Helsinki, and he hasn’t missed a single one since.

Juan travels nearly 20 hours from Argentina every single year, just to attend ECTA’s Annual Conference in Europe.

Now, sitting on ECTA’s publications committee, Juan says that ECTA is a “great place to share ideas and have quality time with colleagues”.

He explains: “ECTA’s conferences are a mixture of very good clients and friends from Europe. You have lots of time to talk and share some quality moments. It’s different from other big conferences—there’s a lot more space to exchange ideas and have quality time with colleagues.”

He adds: “There are new and trendy topics, and I can take those ideas home with me.” Juan says, for example, that in a session today, he was learning about domain names and various issues in Europe that he can use to help his firm back in Argentina. He also recognises that the number of attendees from Latin America at ECTA is growing, and that this is down to the global reach of ECTA conferences, and the association’s interest in looking beyond the continent in which it is based.

“ECTA keeps me coming back. It’s only my first 17 years at ECTA and I hope to see many more.”



Bad faith – do you have a case?

Bogdan Ivanišević and Zorana Brujić of BDK Advokati explain how rightsholders should approach bad faith cases

The concept of bad faith is anchored in Article 4(4)g of the EU Directive 2008/95. Since the idea of bad faith is a concept of European law, it must be interpreted uniformly in all EU countries. The European Court of Justice (ECJ) confirmed this in June 2013, in its judgment in the Malaysia Dairy case. The Directive does not define ‘bad faith’. Instead, courts have laid down certain criteria for establishing bad faith, which will be described below.

Case law, however, consistently admonishes that a finding of bad faith must be made by taking all relevant factors into account. Therefore, you should carefully examine the position and the role of the other party, business relations (if any) between your company and the other party, factors indicating that the other party knew about your mark, similarity of the trademarks, and other relevant factors. If you manage to make a case for several of the factors described below (one probably does not suffice), you arguably have the case. The fact that the other party knew or must have known that you used an identical or similar mark is an indication of bad faith. However, this is just a first step in proving bad faith. In some instances, the knowledge will be obvious, since you have or used to have a business relationship with the other party. In other cases, in order to convince the competent authority that the other party knew about your trademark, you need to prove that you have used your mark—the longer the better. If you convince the competent authority that your trademark was widely used in the relevant territory, you are likely to succeed in the argument that the other party knew of your trademark.

Intention is a subjective factor, and it may be proved by objective circumstances, such as actions of the other party. It is important to prove that the intention to harm you existed at the time when the other party filed the trademark application. The most common case of a bad faith intention is when the other party has tried to prevent you from marketing the products. A typical indication of the intention to harm is when the other party does not use its registered trademark. Even better for you, the other party does not even have a commercial interest to use the trademark. The lack of plausible commercial logic for registering a trademark was the key factor on which the General Court based its decision in a case in 2017.

Another argument you may wish to use is that the other party did not use the sign in the period before applying for its registration as a trademark. Even though this could not in and of itself prove bad faith, the lack of prior use narrows the scope of potential arguments that the other party could invoke to argue that it acted in good faith. The likelihood of confusion between the marks is a helpful argument to prove the intention to harm you, as the general court reiterated in several cases, such as PayPal in 3027, SA.PAR in 2013 and pelicantravel.com case in 2012.

This factor was explicitly singled out by the ECJ in the landmark Lindt case in 2009. In the court’s opinion, the degree of protection should be proportionate to the reputation of a mark. However, it is not necessary to prove that your mark is famous or that it has a high repute. It is in any event advisable to offer evidence of mark’s recognisability, such as market surveys and opinion polls.

Even if your trademark expired and you failed to renew the registration (for whatever reason) you can oppose the registration of the same or similar trademark by the other party if you can prove its intention to free ride. You should be able to show that your trademark still enjoys a surviving reputation. Secondly, you must prove that the other party wishes to free ride on your mark’s reputation. As the General Court put it in the Simca Europe case in 2014: “registration of the sign at issue was deliberately sought in order to create an association with the earlier marks and to take advantage of their reputation on the motor vehicle market, even to compete with those earlier marks if they were re-used by the intervener in the future.” Having a previous business relationship with the other party can constitute a strong argument in favor of proving bad faith, especially if business cooperation ended in a non-amicable manner. In this case it is necessary to document the chronology of events which led to the trademark application or registration by the former business partner. As the General Court put it in the SA.PAR. case, “the fact that the applicant applied for registration of the trademark at issue, for which no earlier use has been demonstrated, only a few months after the start of the corporate dispute between it and the intervener ... warrants particular attention ... in order to assess whether the applicant acted in bad faith”.

If your current business partner applies for a trademark you are using or which you have intended to use or apply for, it could be considered a strong indication of bad faith. This is also applicable to the situation in which a company’s representative or a member of the board of directors applies for such a trademark. This was confirmed by the General Court in the Silicium España Laboratorios case. A typical case of such breach of trust is when distributor applies for a trademark similar or identical to his supplier’s, without the supplier’s authorisation.

It is always useful to do a research on the other party and check whether he owns or has applied for other trademarks. If yes, take a look at these trademarks and try to find out whether they have something in common (for example similar graphic solutions or similar goods). If not, you may have an encounter with a ‘serial trademark applicant’ or ‘trademark troll’: a person who is registering trademarks, which they do not intend to use in order to threaten others with filing a lawsuit for trademark infringement and to try to extort money from them. This is typically the case with application for trademarks which are evocative of the goods or services for which they are sought to be registered, since in this case there are higher chances that someone else will use such a mark. If you have received an offer from the other party

to transfer the trademark to you against certain consideration, (which is higher than the cost of registration) there is a strong indication that he acted in bad faith. The General Court brought a decision in the Luceo v Lucea LED bad faith case in 2016 based solely on this argument.

Start by inspecting the elements which exist in every trademark infringement case: are the trademarks similar? Are the goods/services similar? Does the similarity lead to likelihood of confusion? If the answer is yes, you should move on to analysing other elements. Firstly, whether the other party knew or must have known that you used the same or a similar trademark.

The essential issue here is collecting enough evidence of use of your trademark, in order to convince the competent authority that there was no chance that the other party had not known of your trademark. Then you should proceed to the most difficult part of proving the malicious intention of the other party.

Remember, objective circumstances are used to prove the intention. You can use evidence such as e-mails and publicly available information about the other party in order to bring its actions within the province of bad faith.

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Intellectual Property

Trademark
Copyright
Patent



Cyber Law
Design
Trade Secrets
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Litigation
Entertainment Law
Advertising
Data Protection

