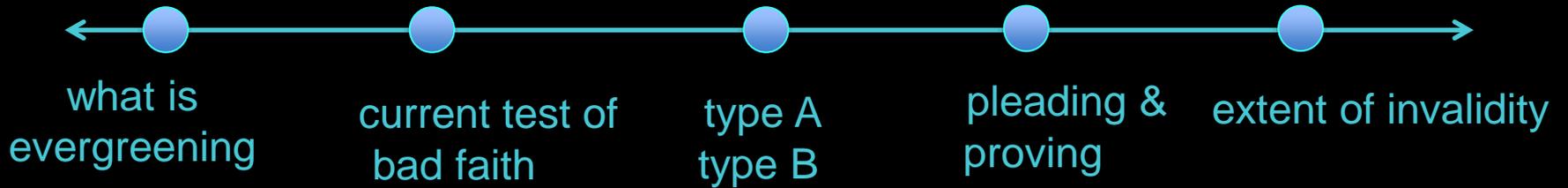


# Bad faith & Evergreening



**Simon Malynicz KC**

# presentation outline



# The “hurt” of a bad faith allegation

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***“Nothing can be more hurtful to an honourable man than that he should be accused of bad faith.”***

-Mahatma Gandhi



# What is “evergreening”



## Current test of bad faith generally

### *Lidl v Tesco*, Court of Appeal, Arnold LJ

- 4 CJEU cases : *Lindt*, *Malaysia Dairy*, *Koton*, *SkyKick*
- Many General Court cases: *Psytech*, *pelicantravel.com* , *Target Ventures Group*.  
*Hasbro* is retained EU law,

# Current test of bad faith generally *(contd)*

- Autonomous concept – but acutely fact sensitive
- Modified concept of “dishonesty”
- Date of assessment
- Presumption of innocence/presumption of validity

# Current test of bad faith generally (*contd*)

- Evidential burden may shift to propleitor to provide plausible explanation
- Overall assessment – acutely fact sensitive
- Intention judged objectively

# Current test of bad faith generally

## *The test*

where it is apparent from **relevant and consistent indicia** that the proprietor of an EU trade mark has filed the application for registration of that mark **not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark**, in particular the essential function of indicating origin

# Generally two kinds of cases (or a mixture of the two)

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**“TYPE A - Appropriation”** cases – e.g. former distributor, company director, former member of a pop group, trade mark “squatters” and “trolls”

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**TYPE B - “Abuse of the register”** cases – duplicate marks, “carpet-bombers”; “ghost” marks, overwide lists of goods/services, creators of “trade mark thickets”; re-filing (‘evergreening’) to avoid end of grace period; trade mark “bullies”

# Pleading bad faith

***Lidl v Tesco, CA***

***Monopoly, GC***



\*Permissible inference – Lidl, CA

***Is there ever an innocent reason to evergreen?***

## Proving bad faith

### *Lidl v Tesco, Joanna Smith J* *Monopoly, GC*



\*Say nothing?

\*Cross-examination

\*No evidence?

# Extent of invalidity



# Thank you for listening

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