



Study Questions for Sydney 2017

Bad faith trademarks

Bad faith most commonly arises in the context that a trademark is used in one or more jurisdictions, but is not registered in other jurisdictions, and someone other than the trademark owner applies for an identical or confusingly similar trademark in a jurisdiction where the trademark is not registered. This might be done to prevent the trademark owner from entering the market, with the intention of selling the trademark application to the trademark owner when the owner attempts to enter that market, or simply wishing to profit from the trademark owner's reputation. Such applications may be rejected as "bad faith" applications.

The refiling of a very similar or identical trademark by a trademark owner, or the filing of a so-called "defensive trademark", can arguably also amount to bad faith (in the sense that such marks are not used, or not genuinely used, but nonetheless obstruct the use and/or registration of a third party trademark). "Bad faith" may also arise in other situations, e.g. if an applicant has no intention to use the mark applied for, or not for all goods/services at issue; or if an application is contrary to contractual obligations.

Because of the differences in the treatment of "bad faith" trademarks between jurisdictions and the variability of the criteria for a finding of bad faith, there is a lack of predictability regarding what constitutes bad faith. This means both trademark owners and applicants for registration may need to take different approaches in different jurisdictions.

This Study Question seeks to establish the types of conduct that constitute bad faith in trademark law and how bad faith may be proved, both from the perspective of a prior user and the perspective of a third party objecting to e.g. a defensive mark or refiling. In this respect, a question to be answered will be whether a definition of bad faith as such is desirable, or whether it is preferable simply to identify circumstances that can be relevant to establishing bad faith.