



## **2017 - Study Question**

### **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. "Bad faith" may also arise in other situations, e.g. no intention to use the mark, an application 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 investigated 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.