



The Significance of Bad-Faith Premises for the Strategy of Trade Mark Protection in the Light of the Latest EU Case-Law

Joanna Sitko 

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Abstract EU case-law has long considered trade mark applications made in bad faith to be dishonest practice that involves a sign used by a third party. This approach stems from the crucial factors of bad faith stipulated by the CJEU in the *Lindt* case C-529/07. However, recent CJEU case-law clearly suggests that a trade mark application can also be alleged to be in bad faith when it has nothing to do with a third-party sign but instead involves a dishonest strategy for protecting the applicant's own trade marks. The aim of this paper is to provide a comprehensive catalogue of premises for finding bad faith in the context of a trade mark application, and to analyse their importance from the perspective of business strategy for protecting trade marks. It follows from the relevant case-law that proving an applicant's bad faith where the latter is alleged not in relation to the use of a third-party sign may be rather problematic, as it is difficult to demonstrate objective circumstances to corroborate an applicant's subjective intentions, particularly when such intentions concern solely their own trade mark protection strategy. An additional difficulty comes from the CJEU's *SkyKick* case C-371/18, according to which the absence of any intention to use a trade mark does not per se constitute grounds for finding bad faith. Moreover, an allegation of bad faith may provide a basis for extending legal protection to a third-party trade mark not registered in a given territory, which may be particularly useful for businesses that export goods worldwide. However, at the same time, care must be taken to reasonably balance such protection for non-registered marks with one of the crucial premises of EU trade mark protection, which is based on the principle of "first to file" not "first to use".

Keywords Bad faith · EU trade mark · Intent to use · Monopoly · *SkyKick* · *Lindt* · *Banksy*

J. Sitko (✉)
Dr. hab.; Professor at the Faculty of Management, Lublin University of Technology, Lublin, Poland
e-mail: j.sitko@pollub.pl

1 Introduction

In the light of EU trade mark law and in line with the provisions of Art. 59(1)(b) EUTMR, acting in bad faith when filing a European Union trade mark application (an EUTM application) constitutes absolute grounds for invalidity in respect of that trade mark.¹ While there is no legal definition of an EUTM application made in bad faith as such, there is no doubt that this is an autonomous notion that should have uniform interpretation in all EU Member States. This follows not only from the preliminary ruling of the Court of Justice of the European Union (CJEU) in the *Malaysia Dairy* case² but also from the Common Practice 13 (CP13) convergence project entitled “Trade mark applications made in bad faith”, developed by the European Union Intellectual Property Network (EUIPN) in October 2022.³ As such, it is not possible to equate the notion of bad faith as applicable to trade mark law with the definitions prevailing in the civil law of the various Member States.⁴ For years, the gap resulting from the lack of a legal definition of a trade mark application made in bad faith has been documented by EU case-law, which the following paper will analyse.

The issue of the premises for finding bad faith in the context of an EUTM application has become topical recently, mainly because of the numerous rulings handed down by EU courts and the European Union Intellectual Property Office (EUIPO) that cast a new light on the problem. Indeed, one could say that there has been a trend towards extending the catalogue of what can be classified as “bad-faith” trade mark applications. Such applications have long been identified in EU case-law as those that could be construed as dishonest conduct vis-à-vis the use of the relevant sign by a third party. In other words, it has been defined as a trade mark application made with a dishonest intention to the detriment of third-party interests. This definition follows directly from the crucial premises of bad faith formulated by the CJEU in 2009 in the *Lindt* case.⁵ However, it should be mentioned that, in that case, the CJEU concurrently gave rise to a broad interpretation of bad faith, noting that all relevant factors specific to the particular case had to be taken into consideration.⁶ However, the definition of an EUTM application made in bad faith was broadened considerably 10 years later when the CJEU made a clear reference to circumstances not related to a third-party designation in the *Koton* case⁷ and then in the *SkyKick* case.⁸ According to these

¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, OJ L154, p. 1.

² CJEU, 27 June 2013, C-320/12, *Malaysia Dairy Industries Pte. Ltd. v. Ankenævnet for Patenter og Varemærker* (hereinafter *Malaysia Dairy*).

³ The first draft of the CP13 was published on 4 October 2022 and can be accessed at <https://www.tmdn.org/#/news/2275683>; the second draft can be accessed at <https://www.tmdn.org/#/news/2358359>.

⁴ Analogously: Nowińska and du Vall (2003), pp. 144–145; Skubisz (2005), p. 1342.

⁵ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli v. Franz Hauswirth GmbH* (hereinafter *Chocoladefabriken Lindt & Sprüngli*), para. 53.

⁶ See Moscona (2010), p. 49. The author notes that “[t]he CTM Regulation does not elaborate on the notion of ‘bad faith’ and so it is unsurprising that the ECJ prefers to keep it an open concept”.

⁷ CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v. European Union Intellectual Property Office (EUIPO)* (hereinafter *Koton Mağazacılık*), para. 46.

judgments, the proprietor of a trade mark files an application for registration of that mark in bad faith if it files “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”.⁹ Consequently, a new form of “bad-faith” EUTM application was identified, involving the dishonest strategy of protecting the applicant’s own trade marks.¹⁰ An analogous distinction between two categories of trade mark applications made in bad faith was introduced in the CP13 convergence project, which distinguishes between bad-faith applications made in violation of third-party rights and those aimed at abusing the trade mark registration system as such. It is worth noting that Kur distinguishes between trade mark applications made in bad faith in order to usurp a distinctive sign that is already used by a third party, and those made with a view to ensuring an unjustified monopoly position that do not target one particular person but rather aim to impede competition in general.¹¹

Regardless of the criteria applied to distinguish between the different types of bad-faith application, there is one characteristic common to all, and that is the dishonest intentions of the applicant. According to the Advocate General’s Opinion adopted by the CJEU in the *Lindt* case, the applicant’s intentions at the relevant time is a subjective factor, which must be determined by reference to the objective circumstances of the particular case.¹² This means that the CJEU decided to adopt a dualistic conception of the trade mark application made in bad faith.¹³

The purpose of the following paper is to provide, on the basis of EU case-law, a comprehensive catalogue of premises that determine whether or not a given EUTM application is made in bad faith, and to analyse the significance thereof in the context of trade mark protection strategies adopted by businesses. The article will first analyse the premise of making a bad-faith EUTM application where a similar (identical) sign is already used by a third party, and then proceed to explore cases related to dishonest strategies for protecting the applicant’s own trade marks. Such a catalogue will prove useful not only for businesses that wish to eliminate unfair market practices by other entities, but also for all those actively managing the protection of their own trade marks. Both should be aware of the circumstances that determine when a trade mark application has been made in bad faith. This will help them avoid the risk of potentially losing the rights to their own trade marks:., after all, in the event of a dispute with a market competitor, what one business might consider to be merely optimising the protection of existing trade marks might be construed by an adjudicating authority as a trade mark application made in bad faith. Such a ruling would result in that trade mark being declared invalid.

⁸ CJEU, C-371/18, 29 January 2020, *Sky plc, Sky International AG and Sky UK Ltd v. SkyKick UK Ltd and SkyKick Inc* (hereinafter *Sky et al. v. SkyKick*), para. 75.

⁹ CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 46; CJEU, C-371/18, 29 January 2020, *Sky et al. v. SkyKick*, para. 75.

¹⁰ See the cited distinction between the two categories of bad-faith applications: Sitko (2022), pp. 98–99.

¹¹ Kur (2017a), p. 540.

¹² CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 42.

¹³ See Żelechowski (2020), p. 343; Ożegalska-Trybalska (2018), p. 492; Trzebiatowski (2020), p. 756.

2 Trade Mark Applications Made in Bad Faith that Involve the Use of a Similar (Identical) Third-Party Sign

The first category of trade mark applications made in bad faith involves situations where the application is made with the dishonest intention of hindering third-party interests. Any discussion on this topic must first consider the aforementioned pioneering CJEU ruling in the *Lindt* case, which pertained to an application for the declaration of invalidity of a 3D trade mark depicting an Easter bunny wrapped in gold leaf, registered by *Chocoladefabriken Lindt & Sprüngli*. The bad faith premise cited in this ruling established the general direction that subsequent case-law related to this subject matter would take. The CJEU declared that, in the case in question, all relevant factors had to be taken into consideration in order to assess bad faith in respect of EUTM filings. In particular:

- a) the fact that the applicant knew or must have known that a third party was using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration was sought;
- b) the applicant's intention to prevent that third party from continuing to use such a sign; and
- c) the degree of legal protection enjoyed by the third party's sign and by the sign for which registration was sought.¹⁴

Based on that ruling as well as subsequent case-law, one could compile a catalogue of factors (both mandatory and non-mandatory) to be considered when determining whether bad faith can be claimed in a given case relating to the use of a similar (identical) sign by a third party. The mandatory grounds in this context include:

- 1) identity/similarity of the trade mark applied for to the third-party sign;
- 2) awareness of use of the sign by the opposing third party;
- 3) dishonest intention on the part of the applicant,

while the non-mandatory factors include in particular:

- 1) identity/similarity of goods/services;
- 2) other circumstances, e.g. the extent of reputation enjoyed by the sign, the commercial strategy involved, use of the sign prior to seeking registration, etc.

All of the above will be discussed in greater detail below.

2.1 Similarity (Identity) of Trade Mark Applied for to a Third-Party Sign

In order to consider whether a trade mark application has been filed in bad faith, the sign in question must be identical or similar to a relevant third-party sign. This premise also applies to the relative grounds for declaring a trade mark invalid because of a potential likelihood of confusion on the part of the public as to the

¹⁴ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 53.

origin of the given goods or services (see Art. 60 in connection with Art. 8 EUTMR). However, as follows from EU case-law, where a trade mark application is claimed to have been made in bad faith, the similarity (identity) of signs is considered independently of the risk of misrepresentation. This is because a likelihood of confusion does not constitute grounds for finding bad faith. As rightly observed by the CJEU, “the existence of a likelihood of confusion on the part of the public need not necessarily be established in order for Article 52(1)(b) of Regulation No 207/2009 to apply”.¹⁵

Hence, even in cases where an existing similarity does not imply any risk of misrepresentation, a trade mark application may still be claimed as having been filed in bad faith. This suggests, in turn, that the degree of similarity required for claiming that a trade mark registration has been made in bad faith is less than that required for claiming a likelihood of confusion in the context of establishing relative grounds for declaring a trade mark invalid.

2.2 Awareness of Use of a Sign by an Opposing Third Party

The second circumstance necessary for a trade mark application to be deemed as made in bad faith is awareness of previous use of the sign by a third party – in other words, whether the applicant knows or must know that a third party uses an identical or similar sign.¹⁶ Thus, knowledge, as a premise of a bad faith application, can be both real and presumed.¹⁷ Moreover, it should be borne in mind that, according to the *Lindt* case, this requirement relates only to use of the third-party’s sign on EU territory. Tsoutsanis noted, reasonably, that such an approach by the CJEU might have arisen from the fact that, in the *Lindt* case, bad faith was assessed only on the basis of prior use inside (and not outside) the EU.¹⁸ However, it is noted that the latest case-law takes a broader approach that goes beyond EU territory.¹⁹

Hence, in order to prove that a given entity has made an application in bad faith, it must be demonstrated that the entity concerned had knowledge of the relevant existing third-party sign. Such awareness can be claimed on the basis of:

- a) an existing commercial or personal relationship between the businesses concerned;²⁰

¹⁵ CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 54.

¹⁶ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 53.

¹⁷ Adamczyk (2023), pp. 149–150.

¹⁸ Tsoutsanis (2010), p. 314.

¹⁹ See GC 28 January 2016, T-335/14, *José-Manuel Davó Lledó v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (hereinafter *José-Manuel Davó Lledó v. OHIM* (DOGGIS)); GC, 29 September 2021, T-592/20, *Univers Agro EOOD v. European Union Intellectual Property Office (EUIPO)* (hereinafter *Univers Agro EOOD v. EUIPO* (AGATE)).

²⁰ GC, 11 July 2013, T-321/10, *SA.PAR. Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (hereinafter *SA.PAR. Srl v. OHIM* (GRUPPO SALINI)), para. 25.

- b) general knowledge of the use of the third-party sign including its historical use;²¹ or
- c) identity or near identity of the signs that cannot be mere coincidence.²²

The first of the circumstances that indicate knowledge of an existing sign can be illustrated by the example of the application for the GRUPPO SALINI EU trade mark and the existing SALINI EU trade mark.²³ The company that applied for the GRUPPO SALINI trade mark, SA.PAR. Srl, had a substantial holding in the share capital of Salini Costruttori SpA, the intervener that had been using the SALINI trade mark in Italy for over a dozen years. Hence, it was incontestably proven that, owing to the commercial relationship between the parties, the applicant must have been aware of the existing SALINI sign.

The second of the circumstances that demonstrate applicant's knowledge of the use of the third-party sign is that of universal awareness of the sign in question. As follows from the ruling handed down in the *Lindt* case, it is possible to presume that such knowledge by the applicant

may arise, inter alia, from general knowledge in the economic sector concerned of such use, and that knowledge can be inferred from the duration of such use. The more that use is long-standing, the more probable it is that the applicant will, when filing the application for registration, have knowledge of it.²⁴

General knowledge of a trade mark may also be rooted in historical fact. A good example of a historical trade mark that remains ingrained in social awareness is the SIMCA trade mark that was used by an automotive manufacturer between the 1930s and 1970s. The successor to the rights to that sign, GIE PSA Peugeot Citroën, remains the owner of two figurative trade marks, i.e. the French one and the international one (protected e.g. in Germany, Spain, and Italy), despite the fact that cars are no longer produced under that trade mark. The General Court found that there was still common awareness of the trade mark in 2014, i.e. in the year when registration of the contested trade mark was sought. This was confirmed by the applicant themselves in a letter sent to GIE PSA Peugeot Citroën, which stated: "I wish to preserve this exceptional trade mark for posterity".²⁵

The third circumstance that demonstrates that the applicant was aware of another entity's trade mark is the fact that the trade mark for which registration is sought is identical or near identical to a third-party sign in a way that cannot be attributed to mere coincidence. It seems reasonable to presume that this particular premise

²¹ GC, 8 May 2014, T-327/12, *Simca Europe Ltd v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (hereinafter SIMCA), para. 50 and CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 50.

²² GC, 28 January 2016, T-335/14, *José-Manuel Davó Lledó v. OHIM* (DOGGIS), para. 60.

²³ GC, 11 July 2013, T-321/10, *SA.PAR. Srl v. OHIM* (GRUPPO SALINI).

²⁴ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 39 and, similarly, CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 50; GC, 5 May 2017, T-132/16, *PayPal, Inc. v European Union Intellectual Property Office (EUIPO)* (VENMO), para. 37.

²⁵ GC, 8 May 2014, T-327/12, SIMCA.

pertains to signs that are not merely textual but also include a reproducible figurative element. After all, it is far more plausible for the same word or string of words to be independently chosen by two unrelated entities than it is for them to develop identical figurative signs.²⁶ This principle was noticed by the General Court when it considered the case of the DOGGIS trade mark.²⁷ The competing signs had been registered for the same type of business activity, specifically fast-food restaurants selling hot dogs. In this case, the Court agreed with the EUIPO's claim that "[t]he identical or nearly identical nature of the marks, combined with the earlier marks and the contested trade mark being nearly identical [...] cannot be mere coincidence".²⁸

In the context of the above considerations, some doubts may arise when considering the judgment passed down in a case regarding the EU trade mark POLLO TROPICAL CHICKEN ON THE GRILL, which was shown to be identical, both textually and figuratively, to an existing sign used by a US restaurant.²⁹ Despite the identity of the signs in question, the General Court decreed that the US entrepreneur had not been able to prove that the Spanish entrepreneur that owned the EU trade mark (and the earlier Spanish trade mark) had been aware of the existing US trade mark despite the latter having been used for three years before the Spanish trade mark registration. The Court concluded that the opening of one or even several restaurants in Florida (United States) or in other countries in South America could not be regarded as evidence of awareness on the part of the intervener of the earlier use of the US trade mark.³⁰ However, certain reservations do arise in this case as it is difficult to agree with the Court's argument that the applicant (a Spanish business) was unaware of the US business and of the POLLO TROPICO trade mark used, given the fact that the contested signs are identical not only in their wording but also in their graphics.³¹

2.3 Dishonest Intention on the Part of the Applicant

It follows from Art. 59(1)(b) EUTMR³² that the applicant's intentions at the time of filing must be taken into account. The burden of proving that an EUTM application has been made in bad faith lies with the party filing the application for a declaration of invalidity in respect of the trade mark allegedly filed in bad faith. Unless and until

²⁶ See Tsoutsanis (2010), pp. 310–311.

²⁷ GC, 28 January 2016, T-335/14, *José-Manuel Davó Lledó v. OHIM (DOGGIS)*, para. 81.

²⁸ GC, 28 January 2016, T-335/14, *José-Manuel Davó Lledó v. OHIM (DOGGIS)*, para. 60.

²⁹ GC, 1 February 2012, T-291/09, *Carrols Corp. v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (hereinafter *Carrols Corp. v. OHIM – Giulio Gambettola*) and by analogy: CJEU, 28 February 2013, C-171/12 P, *Carrols Corp. v. Office for Harmonisation in the Internal Market (OHIM)* (Giulio Gambettola).

³⁰ GC, 1 February 2012, T-291/09, *Carrols Corp. v. OHIM – Giulio Gambettola*, para. 61.

³¹ See also Kur (2017a), p. 542.

³² CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 41.

compelling evidence to the contrary is provided, it is assumed that the applicant has acted in good faith.³³

As the CJEU correctly pointed out in its judgment handed down in the *Lindt* case, the fact that the applicant knows or must know that a third party has long been using, in at least one Member State and for an identical or similar product, an identical or similar sign that is capable of being confused with the sign applied for is not sufficient, in itself, to permit the conclusion that the applicant has acted in bad faith.³⁴ In that respect, the CJEU agreed with the Opinion of Advocate General Eleanor Sharpston that, in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time of filing the application for registration.³⁵

Dishonest intentions refer primarily to cases where an application is filed solely or largely with a view to obtaining financial compensation (a speculative application) or to blocking access to the market (a blocking application).³⁶ Moreover, an application is made with dishonest intentions if it is filed with a view to benefiting from the reputation of another person³⁷ or of the earlier trade mark.³⁸

The case concerning the mutually opposed trade marks LUCEO and LUCEA LED³⁹ serves as a good example of a blocking application. Copernicus, the company applying for registration of the LUCEO trade mark, engaged in a practice described as “chains of applications”, filing applications to register the trade mark LUCEO every six months, alternately in Germany and Austria, with a view to maintaining its ability to contest the potential application of a trade mark actually used by another company. Eventually, an opportunity presented itself in the form of the LUCEA LED trade mark used by a manufacturer of surgical lamps. As soon as LUCEA LED was filed for registration as an EUTM, Copernicus filed a notice of opposition against the application for registration of the LUCEA LED trade mark and offered to sell its own LUCEO trade mark to the owner of the LUCEA LED trade mark for EUR 75,000. What was significant about the case in question was that Copernicus never intended to use the contested trade mark itself, nor was it able to name any clients interested in purchasing the LUCEO trade mark.

³³ See e.g. GC, 14 February 2012, T-33/11, *Peeters Landbouwmachines BV v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and AS Fors MW* (hereinafter *BIGAB*), para. 17; GC, 13 December 2012, T-136/11, *pelicantravel.com s.r.o. v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (hereinafter *Pelicantravel.com v. OHIM*), paras. 21, 57.

³⁴ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 40 and by analogy: CJEU, 27 June 2013, C-320/12, *Malaysia Dairy*, para. 37.

³⁵ Opinion of Advocate General E. Sharpston, 12 March 2009, *Chocoladefabriken Lindt & Sprüngli*, para. 60 and CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, paras. 37 and 40–42.

³⁶ Skubisz (2005), pp. 1344–1345, see also GC, 7 July 2016, T-82/14, *Copernicus-Trademarks Ltd v. European Union Intellectual Property Office (EUIPO)* (hereinafter *Copernicus-Trademarks Ltd v. EUIPO* (LUCEO)), para. 145.

³⁷ GC, 14 May 2019, T-795/17, *Carlos Moreira v. European Union Intellectual Property Office (EUIPO)* (hereinafter *Carlos Moreira v. EUIPO* (NEYMAR)), para. 51.

³⁸ Common Practice CP13, see also GC, 08 May 2014, T-327/12, *SIMCA*, para. 56.

³⁹ GC, 7 July 2016, T-82/14, *Copernicus-Trademarks Ltd v. EUIPO* (LUCEO).

Other examples of blocking applications include attempts to register foreign text (e.g. in Arabic or Chinese characters) that is illegible to the average European customer and translates as a general, descriptive word for the specific category of products for which trade mark registration is sought (e.g. the word “CANDY” written in Arabic or Chinese). This would prevent the export of candy by other European producers that were attempting to sell on the Arabic or Chinese markets and therefore placing the word “candy” on the packaging simply as a description of the type of product. Under such circumstances, a customs authority would likely withhold the goods at the border because of an alleged trade mark infringement, without investigating in detail whether or not the word is a description of the type of product concerned, given the word’s incomprehensibility for a European customer.

The dishonest intention of benefiting from the reputation associated with a third-party name is well illustrated by a case pertaining to the NEYMAR trade mark applied for by Mr. Carlos Moreira for clothing, footwear, and headwear in class 25. The General Court upheld the EUIPO’s decision by adjudicating that the NEYMAR trade mark had been registered in bad faith solely for the purpose of exploiting the Brazilian footballer’s popularity. The Court described this purpose as ‘free-ride’ on the intervener’s reputation”.⁴⁰ This shows that alleging that a trade mark application has been filed in bad faith may prove to be an effective legal strategy not only for holders of rights to existing trade marks, but also for celebrities seeking to protect their names against illegal exploitation by third parties, as clearly follows from the judgment handed down in the NEYMAR case.⁴¹

Dishonest intentions of a similar nature were also found in the SIMCA case, where the General Court concluded that the fact that an applicant used the SIMCA trade mark for electric bicycles was insignificant because the applicant’s bad faith was not based on the fact that the applicant did not have a genuine interest in marketing the goods covered by that trade mark, but rather resulted from the fact that the applicant intended to free-ride on the reputation of a trade mark that was registered by another party and known on the relevant market.⁴²

However, in the context of the aforementioned case-law, the exact meaning of the terms “trade mark with a reputation” and “free-riding on a reputation or parasitism” need to be considered. The issue here stems from the fact that the concepts of a trade mark with a reputation and parasitism appear in relation to relative grounds for invalidity of a trade mark, whereas the aforementioned notion of exploiting the reputation of another party’s trade mark in the context of bad faith is based on a premise that constitutes absolute grounds for invalidity of a trade mark. Some rulings pertaining to trade mark application made in bad faith contain references to definitions of aforementioned terms given in judgments relating to the infringement of trade marks with a reputation handed down pursuant to Art. 5(3)(a) EUTMD⁴³ (relative grounds for declaring a trade mark invalid for

⁴⁰ GC, 14 May 2019, T-795/17, *Carlos Moreira v. EUIPO* (NEYMAR), para. 51.

⁴¹ Giannino (2019), pp. 589–590.

⁴² GC, 8 May 2014, T-327/12, *SIMCA*, para. 74.

⁴³ Directive 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ L 336/1.

infringement of a trade mark with reputation). For instance, in a case concerning an application for a declaration of invalidity of the trade mark NEHERA, the General Court made a clear reference to the definition of parasitism given in the CJEU ruling handed down in the *L'Oréal* case⁴⁴ pertaining to the infringement of a trade mark with reputation. The General Court observed that

[t]he concept of unfair advantage being taken of the reputation of a sign or a name covers a situation in which a third party rides on the coat-tails of a formerly renowned sign or name in order to benefit from its power of attraction, its reputation and its prestige and, without any financial compensation and without having to make any efforts of its own in that regard, to exploit the commercial effort expended by the proprietor or user of that sign or of that name in order to create and maintain the image of that sign or of that name.⁴⁵

Moreover, the same Court also referred to the definition of a trade mark with reputation given in the *Chevy* case,⁴⁶ and observed that, in 2013, the NEHERA trade mark was not known “to a significant part of the relevant public”.⁴⁷ The doubts discussed have recently been settled in the CP13 convergence project, according to which the concept of exploiting trade mark reputation – i.e. one of the factors indicative of a possible bad-faith application – is not the same as the concept referred to in Art. 5(3)(a) EUTMD. Hence, in determining whether a trade mark application was sought in bad faith, one cannot require evidence of reputation, as is needed in the event of the infringement of a trade marks with reputation on the basis of Art. 9(2)(c) EUTM. According to the CP13 convergence project, parasitism – in the context of dishonest intentions, which constitute one of the factors indicative of bad faith in a trade mark application – means “to free-ride on the reputation, including surviving/residual reputation, of an earlier right; or to benefit from an earlier right regardless of its degree of recognition on the market”.⁴⁸

The consequences of this particular understanding of parasitism in the context of bad faith are discussed in the conclusions below.

⁴⁴ CJEU, 18 June 2009, C-487/07, *L'Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v. Bellure NV, Malaika Investments Ltd, trading as 'Honey pot cosmetic & Perfumery Sales' and Starion International Ltd*, para. 49.

⁴⁵ GC, 6 July 2022, T-250/21, *Ladislav Zdút v. European Union Intellectual Property Office (EUIPO)* (hereinafter *Ladislav Zdút v. EUIPO* (NEHERA)), para. 65.

⁴⁶ CJEU, 14 September 1999, C-375/97, *General Motors Corporation v. Yplon SA* (CHEVY), para. 31. In the case, the CJEU decreed that: “[...] in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers” (author’s emphasis); on the definition of a trade mark with reputation see also Sitko (2017), pp. 332–335.

⁴⁷ GC, 6 July 2022, T-250/21, *Ladislav Zdút vs. EUIPO* (NEHERA), para. 49.

⁴⁸ Part 2.5.1 of CP13.

2.4 Identity (Similarity) of Goods (Services)

The issue of identity or similarity between goods associated with a contested trade mark has long been somewhat ambiguous. It follows from the reasoning presented in the *Lindt* case that, for a trade mark application to be made in bad faith, the trade mark should be used for “an identical or similar product (...) with the product for which the contested trade mark is used”.⁴⁹ However, this premise was not included in the EUIPO Guidelines as one of the circumstances that determine bad faith in an EUTM application.⁵⁰ This issue has also been treated somewhat inconsistently in case-law. For instance, the EUIPO Board of Appeal confirmed that, despite similarity between the conflicting trade marks and the fact that the intervener was aware of the existence of the appellant’s trade marks, the intervener had not acted in bad faith within the meaning of Art. 52(1)(b) of Regulation No. 207/2009,⁵¹ because the goods and services for which the earlier trade marks were registered were neither identical nor similar to the services in class 39 for which the contested trade mark registration was sought. A contrary position was adopted by the CJEU in a case concerning an application for a declaration of invalidity based on Art. 52(1)(b) of Regulation No. 207/2009, where it ruled that “there is no requirement whatsoever that the applicant for that declaration be the proprietor of an earlier mark for identical or similar goods or services”.⁵²

The most recent case-law clearly tends towards the conclusion that bad faith can occur even though there is no similarity between the goods and services. This was confirmed in, for example, the ruling handed down by the General Court in the case pertaining to the EUTM “LIO”. The Court decreed that the applicant had acted in bad faith even though the relevant trade mark had been registered for products such as clothing accessories, bags, wallets, phone cases, decorative figurines, etc., while the opposing third-party mark had been used for clubs and restaurants. Nonetheless, despite the dissimilarity of the goods and services, the General Court concluded that goods falling into the category of advertising gadgets, for which the contested EUTM was registered, were used also by the Lio club for marketing purposes and constituted elements of its commercial expansion strategy.⁵³ An analogous solution was adopted by the CP13 convergence project, which states that the relevant authorities may compare the goods/services of the contested mark with the goods/services that a claimant could be expected to be interested in marketing. Moreover, it follows from said document that, when considering goods/services, account should be taken of the field of activity in the context of which the claimant has acquired its reputation/is known as well as the usual commercial practices in the

⁴⁹ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 53.

⁵⁰ EUIPO Guidelines, <https://guidelines.euipo.europa.eu/1935303/1950066/trade-mark-guidelines/1-introduction>.

⁵¹ Council Regulation 2009/207 of 26 February 2009 on the Community trade mark, OJ L 78, 24.3.2009, pp. 1–42.

⁵² CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 53.

⁵³ GC, 19 October 2022, T-467/21, *DBM Videovertrieb GmbH v. European Union Intellectual Property Office (EUIPO) (LIO)*.

relevant market sector.⁵⁴ Thus, it does not follow from the CP13 convergence project that the goods/services for which the opposing trade marks are used must be similar or identical.

2.5 Other Circumstances

Other factors to be considered when determining whether a trade mark registration was sought in bad faith include inter alia the extent of a trade mark's reputation. This is clearly indicated in the CJEU's judgment in the *Lindt* case, where the Court held that consideration might be given to the extent of the reputation enjoyed by a sign at the time of the filing of the application for its registration as an EUTM; the extent of such reputation might justify the applicant's interest in ensuring broader legal protection for the sign.⁵⁵ Johnson observed that a broad interpretation of this suggestion would allow proprietors to seek broader protection for trade marks with a reputation than for those without. But applying this to the specification of goods would seem to endorse some sort of defensive trade mark, which could not be right.⁵⁶ However, the solution adopted by the CJEU seems justified as, according to the CJEU, account must be taken of the degree of legal protection enjoyed not only by the sign for which registration is sought but also by the third party's sign.⁵⁷ Thus, Tsoutsanis is right to note that the CJEU appears to take a balanced view in which "the key issue is not *when* the signs have been used but rather to *what degree*".⁵⁸ Consequently, it may be that a trade mark will not be invalidated (on the basis of an allegation of bad faith) even when the opposing sign was used on the market first, if the contested trade mark has become more recognisable on the market than the opposing sign.⁵⁹

In the *Lindt* case, the CJEU also stressed that

the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitors' freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.⁶⁰

Moreover, other circumstances may be taken into account in the context of bad-faith applications, such as "the earlier use of [the word or initials of the contested

⁵⁴ CP13 Convergence Project, pp. 13–14.

⁵⁵ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, paras. 51, 52.

⁵⁶ Johnson (2018), p. 957.

⁵⁷ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, para. 53.

⁵⁸ Tsoutsanis (2010), p. 326.

⁵⁹ Adamczyk (2023), p. 159.

⁶⁰ CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*, paras. 50.

mark] in business as a mark, in particular by competing undertakings”,⁶¹ as well as the origin of the contested trade mark and its use prior to registration.⁶² The commercial strategy/logic of the business, which might entail seeking registration, as well as the chronology of events leading to the filing, might also affect the ultimate evaluation of whether there is bad faith.⁶³

An interesting illustration of the importance of business logic is provided by the case pertaining to the AGATE trade mark. A Bulgarian company, *Univers Agro EOOD*, successfully registered this EUTM for car tyres. A Chinese trading company, *Shandong Hengfeng Rubber & Plastic Co. Ltd*, which owned the Chinese figurative mark AGATE and used it on tyres exported to Bulgaria, filed an application for a declaration of invalidity in respect of the EUTM. It was soon found that *Univers Agro EOOD* could not produce any evidence of use of the contested trade mark or of company sales of tyres under any other trade mark. Moreover, given the short period of time that had elapsed between the filing of the EUTM application and the drastic measures taken to defend the trade mark after registration, it was reasonable to consider that the trade mark applicant had well prepared themselves to target the distributor of the Chinese tyres and already knew about its use of the Chinese mark AGATE. All these circumstances confirmed that the trade mark applicant’s intentions were “not a preliminary attempt to prevent any infringement of [its] freshly registered mark, but a planned endeavour with the goal of taking advantage of the [intervener’s] failure to protect [...] its Chinese mark ‘Agate’ in Bulgaria”.⁶⁴

3 Trade Mark Applications Made in Bad Faith that Involve a Dishonest Strategy for Protecting the Applicant’s Own Trade Marks

It follows from recent European case-law that a trade mark application can be considered to have been made in bad faith not only when the application involves the use of a given trade mark by a third party, but also where no other entity is involved, that is to say where the application is made with a view to implementing a dishonest strategy aimed at protecting the applicant’s own trade marks.⁶⁵ Such applications are made with the dishonest intention of obtaining rights to a trade mark for purposes other than those related to the primary functions of a trade mark, in particular its function of indicating origin. According to the ruling handed down in the *Koton* case,

the absolute ground for invalidity [...] applies 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

⁶¹ GC, 8 May 2014, T-327/12, *SIMCA*, para. 39.

⁶² GC, 14 February 2012, T-33/11, *BIGAB*, para. 21.

⁶³ CJEU, C-104/18 P, *Koton Mağazacılık*, para. 63.

⁶⁴ GC, 29 September 2021, T-592/20, *Univers Agro EOOD v. EUIPO (AGATE)*, para. 73.

⁶⁵ See Sitko (2022), p. 89.

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.⁶⁶

The same circumstances were reiterated by the CJEU in the *SkyKick* case.⁶⁷ Latterly, EU case-law has identified a number of situations that might suggest that a trade mark application has been made in bad faith as a result of a dishonest strategy for protecting the applicant's own marks. The following examples will be discussed below:

- 1) filing of repeat applications for an identical trade mark for identical goods or services;
- 2) applying for a trade mark for an excessively broad range of goods or services that goes beyond the current or planned scope of the applicant's business activity;
- 3) applying for a trade mark with a view to protecting the applicant's copyrights;
- 4) applying for a trade mark with a view to extending the period of patent protection.

3.1 Filing of Repeat Applications for an Identical Trade Mark for Identical Goods or Services

From the perspective of those that manage trade mark protection within a company, the practice of re-filing an application for a trade mark already owned by the company is particularly important. This practice is relatively common for trade marks that have already been registered for a number of years. The potential legal benefits of this practice for the applicant will be discussed in greater detail below. However, firstly, it is important to point out that it is not illegal and therefore not an act of bad faith in itself for the same entity to file repeat applications for an identical mark for identical goods/services. For instance, a trade mark can be re-filed with a view to fine-tuning the scope of its protection.⁶⁸ However, certain circumstances may suggest that the applicant has actually acted in bad faith. For instance, the General Court decreed that, while it is not per se prohibited to file repeat applications for a trade mark, repeat filing with the sole aim of avoiding the consequences of not using a previously registered trade mark might indicate bad faith on the part of the applicant.⁶⁹ In this context, it should be clarified that, by law, the rights to an EUTM may be revoked if the trade mark is not put to genuine use within five years from its registration (see Art. 58(1)(a) EUTMR). In order to avoid that risk, one has to prove genuine use of the mark, which can be time-consuming

⁶⁶ CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 46.

⁶⁷ CJEU, C-371/18, 29 January 2020, *Sky et al. v. SkyKick*, para. 75.

⁶⁸ Cf. Folliard-Monguiral (2021), p. 24.

⁶⁹ GC, 13 December 2012, T-136/11, *Pelicantravel.com s.r.o., v. OHIM*, para. 27.

and often quite difficult, given the need to present evidence for each individual category of goods/services. Under the EUIPO Guidelines, bad faith may also be found where an EUTM proprietor tries to artificially extend the grace period for non-use, for example by filing a repeat application for an existing EUTM in order to avoid the loss of rights as a result of non-use.⁷⁰

This motive, of attempting to avoid the need to prove genuine use of a trade mark, was a key factor in the case pertaining to the dispute related to the filing of repeat applications for the MONOPOLY mark. According to the ruling handed down in that case, the filing of repeat applications for an identical trade mark for identical goods/services is considered an act of bad faith when it is done with a view to avoiding the need to prove genuine use of a trade mark rather than for the purpose of exercising the trade mark's distinguishing function.⁷¹ The General Court adjudicated that repeat applications for the word mark MONOPOLY had been made in bad faith for goods and services that were identical to those previously listed under identical trade marks by Hasbro Inc. Bad faith was not found for the remainder of the goods and services. Interestingly, in this particular case, the applicant, Hasbro Inc., itself admitted that its actions were motivated by the desire to avoid the need to prove genuine use of the trade mark in the event of a counterclaim by the party against which Hasbro Inc. had raised an opposition. As such, from the perspective of trial strategy, the holder of the rights to the MONOPOLY trade mark demonstrated a certain insouciance. Indeed, if the owner of the MONOPOLY trade mark had not openly admitted its motivation for filing repeat applications, it would probably have secured the re-registration of its trade mark. This follows from the aforementioned fact that the General Court does not consider the filing of repeat applications for a trade mark as an act of bad faith in itself. Hence, a person filing an application for a declaration of invalidity in respect of a competitor's re-filed trade mark must demonstrate that the underlying purpose of such re-filing was dishonest, e.g. that it was an attempt to avoid the need to prove genuine use of the trade mark. And this can prove rather difficult, unless, of course, the trade mark applicant confirms it personally. However, it does seem that in such a case one can also invoke indirect evidence of dishonest intentions. In this context, the trade mark applicant's activity may provide certain indirect evidence, for example if they invokes the repeat registration (instead of the former one) in a dispute with another party, which allows them to avoid having to prove genuine use of the trade mark in the event that the opposing party alleges lack of genuine use.

Nonetheless, it is rightly emphasised in the doctrine that *each* repeat application for the same trade mark for the same goods initiates an additional five-year grace period for the trade mark applicant.⁷² It seems incorrect, therefore, to automatically

⁷⁰ EUIPO Guidelines Part D Cancellation, Section 2 Substantive provisions, Chapter 3 Absolute Grounds for Invalidity, para. 3.3.2.1, Factors likely to indicate the existence of bad faith, 3.e.

⁷¹ GC, 21 April 2021, T-663/19, *Hasbro Inc. v. European Union Intellectual Property Office EUIPO and i Kreativni Dogadaji*, paras. 43, 50, and 55.

⁷² See Folliard-Monguiral (2021), p. 23.

treat this practice as an example of bad faith, as the five-year extension of the grace period is, in fact, an immanent attribute of repeat applications and is not, as such, prohibited by law.⁷³

One very particular aspect of repeat trade mark filings can be observed in the context of pharmaceuticals, where the product approval procedures involved are very time-consuming. With this in mind, repeat applications for trade marks should not always be considered as acts of bad faith, for example where it is impossible to conclusively prove that an applicant's lack of intention to use a trade mark for medicines that are subject to ongoing clinical trials is dishonest.⁷⁴ However, if, over a sufficiently long period, the applicant does not take steps to obtain permission for putting the medicine on the market, such repeat applications can no longer be considered legitimate.⁷⁵ Another important situation pertaining to repeat applications for trade marks relates to what are referred to as "revitalising" applications. According to the ruling of the General Court in the case concerning the PELIKAN trade mark, a repeat application for a trade mark that has been modified, even slightly, to achieve a more up-to-date look, is not considered an act of bad faith. According to the GC, modernisation of a trade mark constitutes normal business practice.⁷⁶

3.2 Applying for a Trade Mark for an Excessively Broad Range of Goods or Services

Another situation considered in EU case-law in the context of dishonest strategy for protecting one's own trade marks has been that of applying for a trade mark for an excessively broad range of goods and services, such as in the case brought against the Sky group companies, where it was claimed that SKY trade marks had been filed in bad faith. According to the claimants – the SkyKick group of companies – SKY trade marks had been filed in bad faith for categories of goods and services for which they were not used and for which the trade mark proprietors – Sky group companies – had no intention of actually using them. In the claimants' opinion, this was proven by the prior profile of the respondents' activity. Indeed, the actual range of goods and services for which the SKY marks had been registered was very broad and covered the general categories of class 9 and class 38 of the Nice Classification.⁷⁷ In the ruling handed down in the case, the CJEU concluded that

a trade mark application made without any intention to use the trade mark in relation to the goods and services covered by the registration constitutes bad faith [...] if the applicant for registration of that mark had the intention of either undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third

⁷³ See also Bohaczewski (2022), p. 328.

⁷⁴ Sitko (2014), pp. 670–671.

⁷⁵ See Skubisz (2005), p. 1349.

⁷⁶ GC, 13 December 2012 r., T-136/11, *Pelicantravel.com s.r.o., v. OHIM*, para. 36.

⁷⁷ The Nice Agreement of 1957 Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

party, an exclusive right for purposes other than those falling within the function of a trade mark.⁷⁸

It follows from the cited reasoning that, in order for there to be bad faith, besides the absence of any intention to use the trade mark, one of two circumstances specified must also occur, i.e. the infringement of third-party interests or an application for registration for purposes other than the essential functions of a trade mark. Hence, the lack of any intention to use a trade mark – at the time of applying for it – does not in itself constitute grounds for classing a given application as an act of bad faith.⁷⁹ Said circumstance (the lack of any intention to use the trade mark) may indicate a bad-faith application only if there is simultaneously proof of a specific dishonest purpose for the application. The conclusion reached by the CJEU in that case seems justified, since neither use of a trade mark nor intention to use the same constitutes conditions for a trade mark registration under EU law, as opposed to e.g. US trade mark law.⁸⁰ The EU legislators give the proprietor of an EU trade mark a five-year period to make genuine use of the trade mark so as to avoid the potential consequences of non-use, i.e. revocation of the trade mark (see Art. 58(1)(a) EUTMR). As such, the applicant is not obliged to use or to have specific intentions to use the trade mark at the time of filing the application. The CJEU was also correct to conclude that bad faith could not be found on the basis that, at the time of applying for registration, the applicant was not conducting any business activity within the range of goods and services covered by the registration.⁸¹ It cannot be ruled out that an applicant's initial intentions might change over time. Even though it might not have intended to use the trade mark for the entire range of goods and services indicated in the application, that intention might change over the years of business activity, and the legislators provide a five-year period for such events. A trade mark can be revoked only if it is not put to genuine use over an uninterrupted period of five years (see Art. 58 EUTMR).

Furthermore, it should be noted that any lack of intention to use the trade mark on the part of the applicant must be proven by the party that files the application for a declaration of invalidity in respect of that trade mark. This tends to be rather difficult as intention to use a trade mark or lack thereof is an inherently subjective factor. The CJEU is therefore right in insisting that such subjective circumstance (dishonest intention) should be proven on the strength of the objective facts of the case.⁸² Such objective circumstances would seem to include evidence that supports the claim that the application for the trade mark in question was filed for reasons other than those related to the functions of a trade mark.

⁷⁸ CJEU, C-371/18, 29 January 2020, *Sky et al. v. SkyKick*, para. 81.

⁷⁹ Phillips (2003), p. 460. The author formulated an analogous opinion many years before the *SkyKick* case, i.e. Stumpf (2014), p. 227, who believes that the EUTM system does not require applicants to have the intention of using the mark at the time of filing. Thus, lack of intention to use does not constitute grounds for finding bad faith.

⁸⁰ See *inter alia* Dinwoodie and Janis (2005), pp. 321–322.

⁸¹ CJEU, 29 January 2020, C-371/18, *Sky et al. v. SkyKick*, para. 78.

⁸² CJEU, 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli*.

The case pertaining to the SKY trade marks eventually reached the Court of Appeal of England and Wales, which sought a preliminary ruling from the CJEU on certain issues. The Court concluded that failure to use the trade mark in all possible subcategories within a given main category of goods or services could not, in itself, be seen as indicative of bad faith on the part of the applicant.⁸³

3.3 Applying for a Trade Mark with a View to Protecting One's Copyright

Another circumstance considered in EU case-law from this particular perspective of bad-faith trade mark applications entails seeking trade mark registration with a view to protecting one's copyright. This issue has been analysed recently in several cases considered by the EUIPO with respect to a number of applications filed by Full Colour Black Limited for a declaration of invalidity in respect of EUTMs registered by Pest Control Office Limited, a company set up by a popular street artist known as Banksy. The proceedings pertained to trade marks depicting some of Banksy's best-known murals, including "Flower Thrower",⁸⁴ "Bomb Hugger",⁸⁵ and "Love Rat".⁸⁶ The EUIPO Cancellation Division cancelled all the contested trade marks. The adjudicating authority concluded that the right to a trade mark could not be used for protecting the proprietor's other rights (in this case, copyright). During the proceedings it was established that neither Banksy nor the official applicant (Pest Control Office Limited) intended (at the time of filing) to use the trade mark to designate goods or services. According to the EUIPO, this was not affected by the fact that the owner had in fact started to use the trade marks: only one month after the date of filing of the application for a declaration of invalidity in the case of the Flower Thrower, and one month prior to the filing of the relevant applications for invalidity in the case of the other two trade marks. This was because the proprietor of the trade marks had admitted to having started using the trade marks solely to avoid the legal consequences of non-use. The authority considered this incompatible with fair practices.

Pest Control Office Limited appealed against only one decision, concerning a trade mark depicting a gorilla with an advertising board – "Sandwich-Board-Wearing Monkey". The EUIPO Board of Appeal (BoA), finding no bad faith, had not agreed with the first-instance authority, the EUIPO's Cancellation Division, and had reversed the latter's ruling.⁸⁷ The BoA observed that "[a] creative work is eligible for protection as a trade mark, at least in principle, irrespective of whether or not that term has entered the public domain under copyright law",⁸⁸ and stated

⁸³ Court of Appeal of England and Wales, 26 June 2021, [2021] EWCA Civ 1121 [*Sky plc v. Skykick UK* [2018] EWHC 155 (Ch) at [197]].

⁸⁴ EUIPO Cancellation Division, 14 September 2020, No. C 33843.

⁸⁵ EUIPO Cancellation Division, 19 June 2021, No. C 39921.

⁸⁶ EUIPO Cancellation Division, 19 June 2021, No. C 40000.

⁸⁷ EUIPO BoA, 25 October 2022, R 1246/2021-5, *Pest Control Office Limited v. Full Colour Black Limited*.

⁸⁸ EUIPO BoA, 25 October 2022, R 1246/2021-5, *Pest Control Office Limited v. Full Colour Black Limited*, para. 41.

that Full Colour Black Limited had failed to conclusively prove that the trade mark proprietor had no intention of using the trade mark at the time of filing. That conclusion was further supported by the fact that the statement on the lack of any intention on the part of the proprietor to use the trade mark did not pertain to this particular case, but was given in the case concerning the “Flower Thrower” trade mark. Moreover, the BoA pointed out that Banksy could take advantage of a five-year grace period from the date of filing to put the trade mark to genuine use,⁸⁹ as, according to the case-law, an EUTM proprietor was not obliged to know at the time of filing when it would start to use its trade mark. This was why there was a five-year grace period. Said conclusion is in keeping with the reasoning expressed in the aforementioned *SkyKick* case.

The decision issued by the BoA in the case discussed seems appropriate given the right to cumulative protection of intellectual property rights and the grace period of five years allowed for putting a trade mark to genuine use. However, at the same time, it is expected that the trade mark’s validity will be difficult to maintain once the five-year period expires if it is used only as a work of art, decoration, or ornament, rather than as a trade mark, i.e. a sign that allows goods originating from one provider to be distinguished from those sold by others.

Kur mentions yet another interesting aspect of bad faith touching upon the spheres of copyright and trade mark protection. In her opinion, bad faith could be found in a trade mark application that consisted of book titles for printed matter if it were filed by a publisher in an attempt to exclude others from publishing a book that had fallen into the public domain.⁹⁰ In this case, a finding of bad faith seems justified, as the aim of such an application is to monopolise someone else’s creative work by gaining trade mark protection. Considerable attention has already been devoted in the literature to analyses concerning copyright and trade mark law measures employed to obtain cumulative protection of works, including various specific aspects of this issue.⁹¹ However, while cumulative protection of one’s own work is generally permissible, exploiting trade mark law with a view to monopolising other people’s artistic creations once they have entered the public domain is rather dubious. Particularly since, in the latter case, one could be accused of seeking to register a trade mark in bad faith or in violation of public policy or accepted principles of morality, as illustrated in the case-law examples discussed below.

The doctrine rightly accepts that, when a public domain work is registered as a trade mark, allegation of bad faith would actually require proof of some link between the work in question and the activity of the other entities involved.⁹² A good example of such a link was provided in a case settled by a French Court,

⁸⁹ EUIPO BoA, 25 October 2022, R 1246/2021-5, *Pest Control Office Limited v. Full Colour Black Limited*, paras. 74, 75.

⁹⁰ Kur (2017a), p. 543 and the judgment of the BGH (German Federal Supreme Court) of 5 December 2000, I ZB 19/00, *Winnetou*, cited therein.

⁹¹ See Senftleben (2017), pp. 689–691; Szczepanowska-Kozłowska (2013), p. 499; Stanisławska-Kloc (2018).

⁹² Bohaczewski (2022), p. 333.

pertaining to two graphics depicting François Rabelais that had been registered as trade marks on behalf of one entrepreneur.⁹³ The images were created on the basis of a famous portrait of the writer painted in 1601 by Léonard Gaultier and had long been used by various entrepreneurs from the Chinon region of France for promoting their winemaking businesses. In this case, the trade marks were declared invalid on the grounds that the applications had been filed in bad faith. This seems justified, as registration of those trade marks by just one entrepreneur would block the use of graphics that have already been used by other wine producers in the Chinon region.

A similar issue was analysed in a case relating to the invalidity of a trade mark registered by the Oslo Municipality.⁹⁴ The Municipality sought to register trade marks that depicted sculptures by the renowned Norwegian artist Gustav Vigeland. The Municipality attempted to register the trade marks immediately after the copyright protection period for the sculptures had expired. However, in this case, the monopolisation of the works of art as trade marks was analysed in terms of absolute grounds for invalidating a trade mark, i.e. whether maintenance of the trade mark was consistent with the principles of morality and public policy. In this case, the EFTA Court considered, *inter alia*, that “[t]he registration as a trade mark of a sign which consists of works for which the copyright protection period has expired is not in itself contrary to public policy or accepted principles of morality within the meaning of Art. 3(1)(f) of Directive 2008/95/EC”. However, in some circumstances (mentioned in the judgment), it might be justified to declare such a trade mark invalid. Although, in this case, Kur recommended a solution based on an assessment of bad faith as a complement of the invocation of public order or principles of morality,⁹⁵ it seems that in such a case (concerning an application for a trade mark consisting of a work whose copyright protection has expired) it would be difficult to prove bad faith following the *Koton* case premises (repeated in the *SkyKick* case) if the applicant did actually use its trade mark to designate its own goods or services.⁹⁶ According to the *Koton* and *SkyKick* cases, such conduct on the part of the applicant would rather be regarded as filing a trade mark without any intention either of undermining the interests of third parties or of obtaining, without even targeting a specific third party, an exclusive right to a trade mark for purposes other than those falling within the functions of a trade mark.⁹⁷ Moreover, it should be borne in mind that, in the *SkyKick* case, the CJEU confirmed that trade mark applicants were not required “to indicate or even to know precisely” what use they would make of the trade mark in the five-year period following registration. Therefore, Senftleben noted that, instead of effectively barring the acquisition of trade mark rights *ex ante* – before damage is done to the process of cultural follow-on invention – bad faith could serve as a weapon against trade mark trolls and cultural heritage grabbing

⁹³ Paris District Court, 16 January 2020, No. 18/04810, Darts-ip (reference to the judgment following Bohaczewski (2022)), p. 332.

⁹⁴ EFTA Court, 6 April 2017, Case E-5/16, Municipality of Oslo (“*Vigeland*”); see Senftleben (2017).

⁹⁵ Kur (2017b), Sec. 3(a) and (d).

⁹⁶ Senftleben (2020), pp. 409–410. The author makes similar remarks on the basis of the *SkyKick* case.

⁹⁷ CJEU, 12 September 2019, C-104/18 P, *Koton Mağazacılık*, para. 46.

only after the true intention of the trade mark owner had become manifest.⁹⁸ However, it seems that an allegation of bad faith would be justified if a given work of art (for which the copyright protection period had expired) were to be used by various entrepreneurs in their commercial activity, and the registration of such a work as a trade mark on behalf of one person would block its use by others (as happened, *inter alia*, in the François Rabelais case).

3.4 Applying for a Trade Mark with a View to Extending Patent Protection

An interesting question in the context of dishonest strategy for protecting one's own trade marks arises from cases pertaining to trade mark registrations sought with a view to extending patent protection that has expired. Such cases are extremely rare, as the respective scopes of patent protection and trade mark protection are entirely different. However, it is not impossible for the appearance of a given patented product to meet the relevant trade mark registration requirements, and for the characteristic features of the invention to be monopolised simply by registering its appearance as a trade mark. According to the doctrine, such an application would be made in bad faith if the registration of the trade mark were to restrict competitors' freedom of choice as to the shape and appearance of their goods in technical or commercial terms, to the effect that the proprietor of the mark would be able to prevent competitors from using a similar or identical sign.⁹⁹ Hence, it seems that seeking to register a trade mark for the depiction of a solution that constitutes the object of expired patent protection would constitute an act of bad faith, as the aim of such activity would be contrary to the actual function of a trade mark. In essence, the aim of such a trade mark application would be to prolong time-limited patent protection. Such a situation has already been encountered in a case examined by a French court,¹⁰⁰ and is likely eventually to also emerge on EUIPO or CJEU dockets. However, it seems that the issue of extending patent protection by registering an EUTM ought to be considered differently from the issue of accumulating copyright and trade mark protection, as illustrated by the *Banksy* case. In particular, applying for a trade mark in order to extend expired patent protection may constitute an abuse of the law and an attempt to circumvent it.

4 Conclusions

4.1 Conclusions Regarding Trade Mark Applications Made in Bad Faith that Involve the Use of a Similar (Identical) Third-Party Sign

With regard to the first part of this paper, which dealt with cases of bad-faith trade mark applications that involve the use of a sign by third party, one can conclude as

⁹⁸ Senftleben (2020), p. 409.

⁹⁹ Żelechowski (2021), p. 119.

¹⁰⁰ Paris District Court, 22 February 2018, No. 14/05292 and the Paris Court of Appeal of 25 June 2021, No. 18/15306 (*Ceram Tec*).

follows. Alleging, as absolute grounds for invalidating a trade mark, that the trade mark was applied for in bad faith could provide a basis for the legal protection of a third-party mark not registered in a given territory.¹⁰¹ As such, it could, therefore, become a business strategy for protecting non-registered trade marks. According to the relevant case-law, such a sign need not be used on the territory where the protection is sought as long as it has been used on another territory (see e.g. the DOGGIS and AGATE cases). It is sufficient to demonstrate that at the date of filing the trade mark application in bad faith, the applicant knew or must have known that another party was using a similar (identical) trade mark and that the application was made with dishonest intentions, as discussed in Sect. 2 above.

Hence, alleging bad faith as an absolute ground for invalidity of a trade mark might serve as an important instrument of trade mark protection for businesses that export their goods worldwide. It represents an option for protecting trade marks in countries where they are not registered. Naturally, as an alternative “weapon” in such cases, the owner of a non-registered trade mark could seek to protect its sign as a well-known trade mark or might claim the transfer of a trade mark registered in the name of a dishonest agent.¹⁰² However, in the former case, one has to demonstrate common knowledge of the trade mark in the relevant territory rather than knowledge of the trade mark in question only by the contested applicant.¹⁰³ Meanwhile, in the latter case, one has to prove a business relationship between the applicant and the proprietor of the trade mark: this might cover all kinds of relationship based on some form of contractual arrangement, where one party represents the interests of another, regardless of what such a contract is called or how it is classified in law.¹⁰⁴ Moreover, as for an alternative way of protecting non-registered signs, it should be borne in mind that the proprietor of a non-registered trade mark or of a sign used in the course of trade of more than mere local significance can seek protection under Art. 8(4) EUTMR, provided that, pursuant to the law of the Member State governing the sign in question, rights to the sign were acquired prior to the date of filing the EUTM application or the date of the priority claimed for the EUTM application, and that the sign confers on its proprietor the right to prohibit the use of a subsequent trade mark. However, such an option is not provided by the law of every Member State.

At the same time, it is important to ensure a reasonable balance between protecting non-registered marks by invalidating trade marks on the grounds of bad

¹⁰¹ See Kur (2013), pp. 808–809: “In jurisdictions where trademarks are only protected on the basis of prior registration, i.e. where earlier signs cannot rely on prior use, or on protection based on recognition in trade, refusal or cancellation of trademarks filed in bad faith can become a functional equivalent to protection of unregistered signs used by domestic competitors”.

¹⁰² See also Kur (2013), p. 807. According to Art. 6^{bis} of the Paris Convention, trade marks that are known to belong already to a person entitled to the benefits of the Convention must be protected in other Member States even without having been registered there. Article 6^{septies} of the Paris Convention grants protection against the unauthorised registration of a trade mark by an agent or representative.

¹⁰³ See Art. 8(2)(c) EUTMR with relation to Art. 6^{bis} of Paris Convention and see Bodenhausen (1968), who noticed that it was not necessary for a person who had applied for a trade mark registration that conflicted with an earlier well-known trade mark to possess knowledge of the existence of said well-known mark in the given territory of a trade mark application, p. 92; Kur (2013), pp. 794–798.

¹⁰⁴ See Art. 13 and Art. 21(1) EUTMR and Baud and Fortunet (2015), p. 473.

faith on the one hand, and the overall system of trade mark protection adopted in the EU on the other. Specifically, one has to bear in mind that EU law grants priority to the trade mark application, and not to use of the trade mark as is the case in the US law. Finding bad faith in every application where an opposing trade mark has been put to prior use by a third party, and the applicant has been aware of the existence thereof, would, in fact, be equivalent to prioritising trade mark use, and, by extension, would rule out any subsequent registration. Hence the obligation to prove the premise of dishonest intentions should be seen as positive in the context of a trade mark application that conflicts with a third-party non-registered sign. This is because the premise of bad faith must not effectively alter the whole system of trade mark protection from the principle of “first to file” to that of “first to use”. Bad faith as a ground for invalidity of a trade mark may only serve as a corrective measure within the existing system.

Hence, as underlined by the General Court in the case pertaining to the BIGAB trade mark, “[...] the mere use by a third party of a non-registered mark does not preclude an identical or similar mark from being registered as a Community trade mark for identical or similar goods or services”.¹⁰⁵ For this reason, in the case of a trade mark previously used but not registered by a third party, a business may apply in good faith for the same trade mark even if aware of the existing sign, provided that no dishonest intentions on the part of the applicant can be proven. This is an important conclusion for entrepreneur that, planning their business strategy, would like to register a trade mark that is similar or identical to an existing but non-registered third-party sign. Specifically, such an entrepreneur need not be concerned about the risk of conflict with a non-registered sign of whose existence they are not aware. However, if it is proven that they did know or should have known of the prior use of a similar or identical sign on the relevant market, and they nonetheless filed an application for an analogous mark, such a registration might be subject to invalidation, provided that it is proven to have been sought with dishonest intentions. The case-law analysed indicates that, on principle, a trade mark application is made in good faith if the applicant’s awareness of the existing analogous sign is due not to a personal or commercial relationship with the other entity, but solely to its knowledge of the market, and if the applicant has already put the contested trade mark to genuine use. In the light of EU trade mark law, the business that first applied for registration is granted priority over the one that first used the trade mark but did not register it. After all, an allegation of bad faith cannot serve as a protective measure for all businesses that fail to duly secure formal protection for their own trade marks.

4.2 Conclusions Regarding Trade Mark Applications Made in Bad Faith that Involve a Dishonest Strategy for Protecting One’s Own Trade Marks

In the context of the deliberations presented in the third part of this paper and pertaining to trade mark applications that involve dishonest strategies for protecting one’s own trade marks, a few relevant conclusions can be reached. Firstly, it seems

¹⁰⁵ See also GC, 14 February 2012, T-33/11, BIGAB, para. 16.

that finding a trade mark application to have been made in bad faith is becoming increasingly recognised as a popular tool for eliminating competitors on the market. This is a result mainly of the fact that bad-faith applications fall into the category of absolute grounds for invalidating a trade mark. As such, the scope of persons who can invoke that ground is much wider than for relative grounds, as the person concerned does not have to be the owner of the conflicting sign.¹⁰⁶ One example is the aforementioned *Banksy* case, since the applications for a declaration of invalidity in respect of Banksy's trade marks were filed against his company by a business that benefited economically from exploiting Banksy's artwork, that is to say Full Colour Black Limited. The latter manufactures postcards that depict the artist's works. Similarly, the application for a declaration of invalidity filed against the trade mark in the *SkyKick* case was brought against a competitor operating in the same industry. However, in this particular case, the allegation of bad faith constituted a form of defence against an attack by a competitor. An allegation of bad faith can be a very potent "weapon" as it is not subject to statutes of time-limitation, whereas, in the case of relative grounds for invalidity, a five-year grace period applies (Art. 61 EUTMR).

Secondly, the judgments discussed in the third part of this paper indicate that, when managing the protection of their own trade marks, businesses ought to take into account the negative consequences associated with the risk of invalidation of their trade marks if they file an application for any reason other than one related to the primary functions of a trade mark, in particular that of indicating origin. An application made for any such dishonest reason may be claimed to have been filed in bad faith. One should be particularly cautious when planning repeat applications for the same trade mark for the same goods/services if this is done solely for the purpose of avoiding the potential requirement to prove genuine use of the trade mark in question. However, it is notable that such dishonest intentions need to be conclusively proven by the applicant for a declaration of invalidity in respect of the trade mark, which might prove difficult unless the trade mark applicant themselves admits to having acted on such dishonest intentions.

Thirdly, the question arises whether the latest EU case-law has effectively extended the notion of a trade mark application filed in bad faith. While this seems to be the case in theory, a new aspect of a bad-faith application (relating to a dishonest strategy for protecting the applicant's own trade marks) is hard to apply in practice. This is borne out by the court rulings discussed in the third part of this article. The lack of intention to use the trade marks (for all or some goods or services) in the cases of *Banksy* (assessed by the EUIPO BoA) and *SkyKick* was not sufficient for finding bad faith. In the case of the MONOPOLY trade mark, the rightholder helped support the finding of dishonest intention by admitting that its re-registration was motivated by the desire to avoid the need to demonstrate genuine use of the mark (absence of such a declaration would seriously restrict evidence, since re-registration per se is not prohibited by law). Arguably, saying "much ado

¹⁰⁶ See Vos (2015), p. 684. The author rightly observed that, according to Art. 63(1) EUTMR, a claim for cancellation on absolute grounds can be made by any natural or legal person or any trade or consumer associations, whereas relative grounds can be invoked only by persons entitled to file for opposition (i.e. proprietors of conflicting signs).

about MONOPOLY and *Banksy*”, as a travesty of one of Shakespeare’s works, would accurately convey the situation described. It would seem, therefore, that, in the context in question (i.e. dishonest strategies for protecting one’s own trade marks), actually proving bad faith may be a very difficult task, mainly because it would not be easy to provide actual objective evidence to support a claim concerning the applicant’s subjective intentions. If, on the other hand, the lack of intention to put the mark to actual use is related to dishonest intentions concerning a third-party sign, the task would seem somewhat more feasible. In such cases, one is likely to encounter specific actions taken by the applicant towards the relevant third party, i.e. either measures of a speculative nature (e.g. proposing financial compensation) or of a blocking nature (i.e. preventing market access by an entity whose development strategy is targeted at expanding its market presence to new countries). There may also be some indication that an applicant wishes to benefit from the reputation associated with a third-party name. Thus, it seems that the first category of trade mark applications made in bad faith described in this article will continue to be more relevant for business strategy for protecting trade marks.

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