

# Kluwer Trademark Blog

## UK IPO to Gleissner: UK no place for bad faith

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*A string of recent UK IPO decisions indicates that the Tribunal is willing to take a holistic and pragmatic view to an alleged bad faith filing.*

Many readers will be familiar with Michael Gleissner, the infamous modern day trade mark troll. Gleissner's conduct has been scrutinised in a plethora of trade mark and domain name decisions globally. Cases to date have involved registering famous third party trade marks and domains and cancelling well-known brands' marks or hijacking their domains.

### Bad Faith in the UK

Section 3(6) of the Trade Marks Act 1994 (TMA) prevents the registration of a UK mark where the application is made in bad faith. This is in contrast to the position under the European Union Trade Mark Regulation (EU) 2017/1001, which only provides for cancellation of EUTMs post-registration.

The Tribunal will not make a bad faith finding lightly and there is a rebuttable presumption of good faith. Once an opponent has established a prima facie case of bad faith, it is for the applicant to rebut this.

There is no definition of 'bad faith' under the TMA, but established case law provides clear guidance. The Tribunal will need to be satisfied that the applicant exhibited dishonesty or dealings falling short of the standards of acceptable commercial behaviour. This is an objective test based on reasonable and experienced people in the particular area. The applicant's subjective intention is irrelevant. The Tribunal will also consider whether the applicant knowingly supplied untrue or misleading information and exhibited ill intent e.g. registering a sign without intending to use it simply to prevent a third party from entering the market.

### Decision – O-036-18 – ALEXANDER

Paper Stacked Limited successfully opposed Gleissner's application for ALEXANDER based on bad faith and non-distinctiveness, given that it was a common first name. Gleissner appealed to the Appointed Person (AP).

Gleissner alleged that the Tribunal had erred in finding bad faith on the basis that the applicant for a trade mark has a five year period within which to put the mark to genuine use before it is capable of revocation. The AP rejected this on the basis that this period of non-use immunity was qualified in the face of bad faith by the applicant, especially given the implausibility of Gleissner's intention to legitimately use the mark in the first place.

The AP upheld the Tribunal's decision and took into account the written observations that had been filed by the Tribunal. These included Gleissner's connection to 100 live UK IPO cases and nearly 20% of final decisions in November 2017.

#### Decision O/409/18 – TRUMP TV

Trump International Limited (Michael Gleissner, sole director) applied for TRUMP TV in Classes 38 and 41. The application was opposed by DTTM Operations LLC, a Donald Trump-related entity, based on a number of earlier rights in the "TRUMP" brand as well as bad faith.

The Tribunal found bad faith. Whilst the circumstances of the case at hand were distinguishable from other cases involving Gleissner, TRUMP was a clearly distinctive and well-known name, plus account was given to previous decisions involving Gleissner. Gleissner's failure to defend his motives or put forward a positive case combined with a blanket denial of the similarity of the marks (TRUMP v TRUMP TV) compounded a prima facie case of bad faith.

The Tribunal deemed Gleissner's position "indefensible", demonstrating "a flagrant degree of cynicism". Gleissner and his in-house legal team would have been aware of this, given their experience of trade mark matters. As such, the Tribunal exercised its discretion and awarded off-the-scale costs to both Trump's UK and US representatives totalling more than £13,000.

#### Decision O-424-18 – SNOOP

Snoop International Limited (Michael Gleissner, sole director) applied for SNOOP in Classes 14 and 26. Snoop Dogg opposed the application based on bad faith and several earlier rights in "SNOOP"-related marks.

Gleissner argued that a finding of bad faith pre-registration was oppressive because a trade mark applicant should have a reasonable time after registration to show an intent to use the mark. The Tribunal gave this short shrift, highlighting that Gleissner had seventeen months to begin using and provide evidence to counter the allegations, which he had again failed to do.

The Tribunal again found bad faith due to a lack of rebuttal from Gleissner once the burden shifted to him to show that he had not acted in bad faith, including a lack of reason for filing the mark or his intentions as to use.

#### Take-homes

These decisions are encouraging for parties facing bad faith applicants, especially those involving

Gleissner. The Tribunal is clearly now taking more account of the body of decisions against Gleissner, although it is important to remember that each case is to be judged on its own merits and a previous finding of bad faith cannot simply be transferred to the proceedings in question.

The ability to oppose a trade mark cost effectively, pre-registration based on bad faith can prove useful leverage for brand owners with concurrent proceedings against a party elsewhere. Not only does it serve as a statement of intent to the other side, but a UK bad faith decision may also provide some influential value in proceedings elsewhere.

The TRUMP TV and SNOOP cases would also be suitable for Company Names Tribunal (CNT) complaints. CNT complaints can be brought where a company's name is the same or sufficiently similar to one in which the applicant has goodwill. Whilst complaints do not appear to have been filed against Snoop International Limited or Trump International Limited, there would be good merits in doing so.

### What Next

With several bad faith findings having now been handed down against Gleissner-related entities, it remains to be seen whether anything will be done by aggrieved private parties or government bodies such as the UK IPO to get Gleissner barred from filing applications at the UK IPO. Doing so is not an inexpensive or simple matter, but the collective interests of the UK IP community at large would seemingly benefit from this. In the meantime, brand owners should remain robust and comprehensive in defending cases involving Gleissner, including strictly enforcing cost awards, utilising multiple proceedings (where possible) and considering a referral to professional bodies such as Chambers of Commerce.

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