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What Lies Ahead? The End of EU Law Supremacy and its Impact on UK Trade Mark Law

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Introduction

The Retained EU Law (Revocation and Reform) Act 2023 (**REULA**) drastically changes the relationship between retained European Union (**EU**) law and “domestic” UK law. REULA ends the supremacy of EU law, which had been in stasis following the European Union (Withdrawal) Act 2018 (**EUWA**).¹ In the case of retained direct EU legislation, REULA goes even further by inverting this supremacy, meaning that retained direct EU legislation must now be read compatibly with domestic law.²

This causes a degree of uncertainty in relation to trade mark law given that the Trade Marks Act 1994 (**TMA**) was enacted in order to implement an EU Directive.³ This raises a number of questions, including how English courts will interpret retained EU law that conflicts with domestic law and the extent to which courts are likely to exercise the new power to depart from retained case law. This chapter will examine: (i) the pre-REULA position and the changes introduced by REULA; (ii) indicative guidance on the effect of REULA in the context of trade mark law; and (iii) a recent trade mark case where a departure from case law of the Court of Justice of the European Union (**CJEU**) was at issue.

At a recent conference at University College London, Court of Appeal Judge, Arnold LJ, stated that parties to legal proceedings would generally be reticent to “start from scratch” in settled areas of trade mark law post-REULA. This is especially relevant to particular areas where there has been significant CJEU case law, such as the test for likelihood of confusion.⁴ However, Arnold LJ remarked that this may not be the case where “fault lines” already exist between EU and UK jurisprudence.⁵ This view is broadly consistent with the Supreme Court’s recent obiter comments in *Lifestyle Equities CV and another v Amazon UK Services Ltd and others*.⁶ Although neither REULA nor EUWA applied to this case, the Supreme Court remarked that “UK trade mark law remains rooted in EU legal principles”. This suggests that whilst the supremacy of EU law may have ended, it remains fundamental to UK trade mark law, and will continue to play a leading role in future trade mark law decisions by UK courts.

The Pre-REULA Position and How it is Changed by REULA

EU law supremacy

The supremacy of EU law became part of the domestic legal fabric when the UK joined the European Community by virtue of section 2 of the European Communities Act 1972.⁷ The two most notable elements of EU law supremacy for the purposes of this chapter are: (i) the disapplication rule; and (ii) indirect

effect. The disapplication rule was established in *Factortame*⁸ and provides that where a conflict between EU law and the national law of a Member State (for these purposes, the UK) arises, the former overrides the latter and the latter must be disapplied. As noted by Lord Bridge in his judgment:

*“Under the terms of the Act of 1972 it has always been clear that it was the duty of the United Kingdom court, when delivering final judgment, to override any rule of domestic law found to be in conflict with any directly enforceable rule of Community law.”*⁹

Indirect effect, which was established in *Marleasing*¹⁰ and applied in an intellectual property context in *Intel v CPM*,¹¹ requires that the national courts of Member States interpret domestic law in accordance with EU law, unless doing so would be *contra legem*.¹² Therefore, where domestic law and EU law conflict, the courts must interpret domestic law in a way that complies with EU law. This may involve domestic law language being compressed, expanded, and/or ignored in order to achieve such compliance.

Marleasing required lawyers and judges to consult and consider the relevant underlying Directive(s), as well as the national law implementing the relevant Directive(s), to ascertain the wider context of the legislation. In trade mark infringement proceedings, this led to a well-established practice where Counsel directly referenced the Directive in order to plead their client’s case. The supremacy of the Trade Marks Directive No.89/104/EEC (**Directive**)¹³ over the TMA is summarised by Jacob LJ at paragraph 13 of *Intel v CPM*:

“The key legislation is the Trade Marks Directive. The UK Act of Parliament implementing it is the 1994 Act. No one suggests the Act has a different meaning from the Directive. Pointlessly it renumbers and to some extent re-words the language.”

REULA

REULA entered into force on 1 January 2024,¹⁴ marking a significant step in the decoupling of UK and EU law. This was nearly 18 months after the First Reading of the Retained EU Law (Revocation and Reform) Bill (**Bill**) in the House of Commons.¹⁵ The initial iteration of the Bill included an automatic “sunset” of *all* retained direct EU legislation and EU-derived subordinate legislation by 31 December 2023, unless it was specifically saved by a Government minister.¹⁶

However, REULA as passed did not contain the sunset of all relevant retained EU law but instead revoked, either wholly or partially, some 587 instruments listed in Schedule 1 of the Act. This included seven inconsequential pieces of retained EU law relating to intellectual property. All other retained EU law remaining on the statute book was “assimilated”, becoming part of domestic law. To put this figure into context, the Government

published a dashboard of retained EU law in June 2023, which contained 2,417 pieces of retained EU law.¹⁷ This legislation may have been purged from the statute book under the first version of the Bill.

Whilst REULA marked a significant departure from the initially proposed sunset policy in the Bill, described by HHJ Tindal as a “spring clean” rather than a “sovereignty bonfire”,¹⁸ REULA will still have a marked effect on the place of retained EU law in the domestic legal landscape.

Domestic law supremacy

The most significant changes introduced by REULA are the removal of the principle of EU law supremacy from domestic law (whether it was passed before 31 December 2020 or otherwise) under section 1, and the requirement that retained direct EU law must be read compatibly with domestic law. Immediately prior to REULA, Parliament was sovereign in relation to any legislation passed *after* 31 December 2020 (also known as Implementation Period (IP) Completion Day) under section 5(1) EUWA, when the period to implement the Withdrawal Agreement ended. Prior to this date, EU law supremacy, comprising the disapplication rule and indirect effect, continued to apply to pre-Brexit domestic legislation and retained EU law, including the TMA, which was last substantively amended on 1 January 2019 by the Trade Marks Regulations 2018.

Under section 22(5) REULA, EU law supremacy will continue to apply to events occurring before 1 January 2024. Therefore, the courts would apply the principle of EU law supremacy to any alleged trade mark infringement that took place before this date. However, following the introduction of REULA, the principle of EU law supremacy no longer applies to events occurring on or after 1 January 2024, meaning that the disapplication rule and indirect effect cease to have effect from this date. This is irrespective of when the relevant legislation was passed (section 3(1) REULA). Therefore, business owners and intellectual property lawyers should be mindful that for any alleged trade mark infringement occurring on or after 1 January 2024, domestic law supremacy will apply.

The five R's: restatement, relaxation, revocation, replacement, and repeal

Sections 9–16 REULA introduce a number of new statutory powers that allow the Government to restate, relax, revoke, replace, and repeal retained EU law, which is now described as “assimilated law” under section 5 REULA. Therefore, retained EU law is now on an even footing with other domestic law. Sections 9–10 REULA relax the restrictions set out in EUWA to amend assimilated law, particularly the power to amend what was direct EU legislation (see sections 9(6)(2) and (3) REULA). Under sections 11–13 REULA, the restatement power permits the Government to restate retained EU law in different terms, thereby allowing it to resolve any identified ambiguities or anomalies, though this does not extend to restating the principle of EU law supremacy. Section 14 REULA allows the Government to revoke secondary assimilated law, being retained EU law that is not primary legislation.

Departing from retained case law and referencing

Whilst commencement regulations have not yet been passed to bring section 6 REULA into force, it is important to consider the potential effect of section 6 once the requisite regulations are introduced. Section 6 REULA amends section 6 EUWA to make it easier for the Court of Appeal and the Supreme Court to depart from assimilated law. Under section 6(5) EUWA, in deciding whether to depart from retained EU law (including

CJEU decisions), the Supreme Court and Court of Appeal were required to apply the same test as they would apply in departing from their own case law. Following the introduction of REULA, section 6(5) EUWA has been replaced and the higher courts will consider (among other things): (i) the fact that decisions of a foreign court are not (unless otherwise provided) binding; (ii) any changes of circumstances which are relevant to the retained EU case law; and (iii) the extent to which the retained EU case law restricts the proper development of domestic law.

The “*among other things*” wording included in section 6(3) REULA points to a non-exhaustive list of statutory factors that the higher courts must now consider when assessing whether to depart from assimilated law. The Court of Appeal studied some of these factors in declining to depart from retained EU case law when considering the interpretation of “communication to the public” in *TuneIn*.¹⁹ In that case, Arnold LJ stated that to do so would create considerable legal uncertainty because the CJEU had developed a significant body of jurisprudence on the issue of communication to the public of copyright works over the course of 25 judgments, including four Grand Chamber judgments.²⁰ In addition, section 5ZA REULA introduces a new test for the higher courts when deciding whether to depart from their own retained domestic case law. This includes the extent to which retained domestic case law is influenced by retained EU case law that the court has departed, or would depart, from.

Retained EU case law has been fundamental to the higher courts in deciding domestic case law in a trade mark context. The approach taken by the Court of Appeal in *TuneIn* suggests that the Court of Appeal may be slow to depart from retained domestic trade mark case law, but it will always depend on the circumstances. We consider this further in our analysis of *ICE v ICE* below, where the Court of Appeal *did* depart from retained EU law. Nevertheless, if the higher courts decline to depart from retained EU law, this position will reinforce itself. This is because once retained domestic case law has been followed post-REULA, the normal rules of precedent will apply.

Finally, REULA introduces a new referencing power enabling a lower court or tribunal (which includes the UK Intellectual Property Office)²¹ to refer a point of assimilated case law of general public importance to a higher court. In turn, the higher court can consider whether to overturn the relevant retained case law. The higher courts can also decide whether to refuse a reference from a lower court or tribunal, though it must accept a reference made by the Attorney General who can also refer cases to the higher courts.

Indicative Guidance on the Effect of REULA on Trade Mark Matters

*E-Accounting Solutions v Global Infosys (AdvanceTrack)*²²

In *AdvanceTrack*, HHJ Tindal includes a useful *obiter* discussion about how his judgment would have differed if REULA had applied. The case concerned the Defendant’s “keyword use” and “ad text use” of the Claimant’s “ADVANCE TRACK” trade mark in Google adverts.

HHJ Tindal recalled that the TMA was enacted to implement a series of EU Directives, including the Trade Marks Recast Directive (EU) 2015/2436 (**Recast Directive**), as well as to provide a much-needed update to the Trade Marks Act 1938. Accordingly, the courts were required to interpret the TMA in a way that was consistent with EU Directives under the principle of indirect effect (*Duke v Breckland*).²³

The Claimant's use of the Defendant's trade mark in the Google adverts occurred following EUWA (the advert was active between 31 March and 24 May 2021). As the TMA had not been amended since IP Completion Day, HHJ Tindal held that the principle of EU law supremacy still applied. Therefore, the High Court was bound by the principle of indirect effect and had to apply the retained EU case law that had built up around the use of a party's trade mark in keyword adverts. This position was supported by Counsel for both the Defendant and the Claimant.

HHJ Tindal states that given the “*seismic changes to EU-derived legislation on the horizon*”, it would be “*unsatisfactory – and productive of uncertainty*” not to consider whether there would have been any variation in his decision under domestic statutory interpretation principles rather than the principle of EU law supremacy. He considered that it would give lawyers and business owners an indication as to how REULA may impact keyword advertising from 2024 onwards. He further commented that providing such analysis was useful in case he and Counsel were incorrect to interpret section 10 TMA in accordance with the relevant EU case law.

Whilst indirect effect ceased to have effect in relation to acts occurring after 1 January 2024, HHJ Tindal argues that this does not mean that EU law has become obsolete. This is on the basis that if domestic legislation was enacted to implement a Directive, as in the case of the TMA, then the Directive(s) will be relevant under ordinary principles of domestic statutory interpretation. This point is further explored when the Judge examines Lord Hodge's “*seminal passage*” on statutory interpretation in *R(PRCBC) v SSHD*.²⁴ When interpreting statute, courts are seeking to uncover the meaning of the words used by Parliament, and such meaning can be determined by identifying the wider context in which the relevant language operates. Lord Hodge states that external aids have an influential, albeit secondary, role in identifying the wider context of a particular statute. “External aids” include the Explanatory Notes of a particular statute, which can assist with a purposive interpretation of the applicable language.

HHJ Tindal relied upon *Brent LBC v Risk Management Partners*²⁵ when discussing whether EU Directives amount to external aids that can be used to guide domestic statutory interpretation. Lord Hope held in *Brent* that EU law, including Directives, provides the context in which domestic law was made and that this context is useful in establishing the meaning behind Parliament's words. Consequently, HHJ Tindal argued that the Recast Directive, and the CJEU's interpretation of it in the EU case law, both apply to the interpretation of section 10 TMA for the purposes of *AdvanceTrack*. However, he was careful to note that there is a significant difference between using a Directive as an (influential) external aid for domestic statutory interpretation and the principle of EU law supremacy.

Domestic statutory interpretation

Before assessing the Defendant's trade mark infringement on an ordinary domestic statutory interpretation under REULA, HHJ Tindal gave his judgment on the position under EU law supremacy, as per EUWA. Applying indirect effect, he held that the Defendant infringed the Claimant's “ADVANCE TRACK” mark by its “keyword use” of the “Advancetrack” sign under sections 10(1) and (2) TMA. The “ad text use” of the same sign also infringed under sections 10(1), (2), and (3) TMA.

The Defendant further infringed the Claimant's “ADVANCE TRACK” mark by its “ad text use” of “Advancetrack Outsourcing” under sections 10(2) and (3) TMA. In reaching this decision, HHJ Tindal applied European Court of Justice (ECJ) and CJEU jurisprudence found in *Arsenal*²⁶ and *Google France*.²⁷

On the facts, HHJ Tindal stated that, on an ordinary domestic interpretation, he would have found that the Defendant committed trade mark infringement relating to its keyword use and ad text use under sections 10(2) and 10(3) TMA. However, he noted that neither section 10(1) TMA nor the Recast Directive expressly reference the requirement for the infringing sign to “*adversely affect the functions of the trade mark*”. Indeed, this was a “*gloss*” that was added by the ECJ in *Arsenal* and further developed by the CJEU in *Google France*.

Nevertheless, he considered that a purposive interpretation of the statute under domestic law principles dictates that Parliament could not have intended to render unlawful an act that has no actual impact on a trade mark. Section 10 TMA, as amended in 2019, was intended to implement the Directive (and subsequent Recast Directive). As the Directives act as an external aid in accordance with *Brent*, and the CJEU and ECJ case law informs the interpretation of the Directives, that case law also acts as an external aid when construing domestic legislation, even absent the *Marleasing* principle. Therefore, on a purposive interpretation, the Judge considered that the Defendant would also have infringed section 10(1) TMA by its keyword and ad text use of “Advancetrack” post-REULA.

Whilst the Judge considered that the outcome would ultimately have been the same pre- and post-REULA in this case, HHJ Tindal's hypothetical REULA analysis shows the significant difference in weighting given to retained EU law using the alternative methods of statutory interpretation.

Trade Mark Case Where a Departure from CJEU Law is at Issue

Industrial Cleaning Equipment (Southampton) Ltd v Intelligent Cleaning Equipment Holdings Co Ltd (ICE v ICE)

Background

Although this was a case decided under EUWA rather than REULA, it contains an indication of the circumstances in which the Court of Appeal may consider it appropriate to depart from CJEU case law in trade mark matters.

The Claimant and the first Defendant owned registered trade marks depicting the ICE acronym in word and figurative form. The Claimant applied to register the ICE logo as a UK trade mark in Classes 35 and 37 on 23 October 2015 for the sale and rental of cleaning equipment. The mark was subsequently registered on 22 January 2016 (the **Claimant's TM**). The first Defendant owned two internationally registered trade marks, one for the word mark “ICE” and the other for a figurative mark depicting the “ICE” logo for floor cleaning machines in Class 7. The first Defendant applied to register the two marks via the Madrid Protocol, designating a number of territories including the EU. The international trade marks were registered at the World Intellectual Property Organization (WIPO) on 18 June 2015 based on an earlier application in the United States. The word mark was registered as 1256685 (**685**) and the figurative mark was registered as 1260671 (**671**) (together, the **First Defendant's TMs**).

685 was accepted by the EU Intellectual Property Office (EUIPO) on 24 May 2016 and published on 25 May 2016, whilst 671 was accepted on 14 June 2016 and published on 15 June 2016. Following Brexit, the First Defendant's TMs were automatically converted into UK trade marks. The claim form was issued on 24 May 2021, after the Claimant filed invalidation actions at the EUIPO on 12 November 2019 in respect of the First Defendant's TMs. The Claimant admitted that it was aware of the Defendant's use of the ICE acronym from July 2014 onwards but denied having knowledge of the Defendant's TMs before 26 July 2019.

Decision at first instance

The High Court held that the Defendant infringed the Claimant's TM and that the Defendant's trade marks were invalid under section 48 TMA and Article 61 of the European Parliament and Council Regulation 2017/1001/EU. The Judge applied the CJEU decision in *Budvar*²⁸ and rejected the Defendant's statutory acquiescence defence on the basis that the five-year period started running from the time that the Claimant had knowledge of both the use of the later trade mark and its registration.

Court of Appeal decision

The Defendants appealed to the High Court decision on two grounds: (i) the Claimant was not required to be aware of the registration of the First Defendant's TMs in order for the five-year acquiescence period to start, only its use; and (ii) in respect of an international mark, time begins running from the date of the international registration date, not the date that the trade mark is protected in the EU. The Defendants invited the Court of Appeal to depart from *Budvar* under their first ground of appeal.

Budvar was retained EU case law under section 6(3) EUWA and the Court of Appeal had the power to depart from it under section 6(5) EUWA. Arnold LJ stated that *Budvar* was different to *TuneIn* (as discussed above), in that the decision in *Budvar* was a "bald conclusion", whereas there was a great body of CJEU jurisprudence on the meaning of "communication to the public". In departing from *Budvar*, Arnold LJ held that it contradicted the EUIPO Guidelines and the General Court case law.

The EUIPO Guidelines²⁹ state that statutory acquiescence requires that a later sign must be registered as an EU trade mark for a period of five years and that this requirement is "independent of the invalidity applicant's knowledge" regarding its use. This position is supported by the General Court's decision in paragraph 31 of *I Marchi Italiani Srl*,³⁰ in which it held that the proprietor of the earlier trade mark need only be aware of the use of the later mark after its registration. It is not a requirement for the proprietor of the earlier mark to be aware of the later mark's use and registration for the purposes of acquiescence, as in *Budvar*.

Arnold LJ posited that requiring knowledge of both registration and use in order for time to run would incentivise proprietors of earlier trade marks to refrain from checking the register in order to delay the date on which time begins to run. Therefore, Arnold LJ decided to depart from *Budvar* and allowed the Defendants' first ground of appeal.

However, the Judge ultimately dismissed the appeal as the Defendants failed on the second ground of appeal: it was the date of protection in the EU rather than the international registration that mattered. The date of registration in the EU was between 24 and 25 May 2016 for 685, and 14 and 15 June 2016 for 671. As the claim form was issued on 24 May 2021, i.e., the final day to prevent acquiescence from accruing, the Claimant had not acquiesced to the Defendants' use of the First Defendant's TMs.

It remains to be seen following REULA in what circumstances the higher courts will exercise their power to depart from assimilated law. Notably, Arnold LJ stated in the judgment that the higher courts have been guided by the principle that this power should be exercised with great caution. It is, therefore, highly likely that the higher courts will continue to be guided by this principle in the future.

Conclusion

The introduction of REULA is one of a number of significant moments in the UK's departure from the EU. The fact that domestic law supremacy will apply to acts occurring on or after 1 January 2024 means that its effects will unfold gradually, supporting the observation that Brexit is a process, not an

event. Businesses, brand owners, and their legal advisors should be mindful of the possibility for future divergence between UK and EU trade mark law and the impact this will have on their trade mark registration and protection strategies in the relevant jurisdictions. Whilst EU law will retain its relevance insofar as it can be used as an external aid, this is markedly different to the principle of EU law supremacy. Nevertheless, in light of Arnold LJ's recent views on the matter and the Supreme Court's obiter comments in *Lifestyle Equities CV and another v Amazon UK Services Ltd and others* (as outlined in the Introduction), it appears likely that EU law will remain of significant importance to future UK trade mark law decisions.

Endnotes

1. "Inverted supremacy", "weaker precedent" and other uncertainties brought about by the Retained EU Law (Revocation and Reform) Act 2023, *European Intellectual Property Review*, p. 4; section 5 EUWA.
2. Section 3 REULA.
3. "Inverted supremacy", "weaker precedent" and other uncertainties brought about by the Retained EU Law (Revocation and Reform) Act 2023, *European Intellectual Property Review*, p. 6.
4. Arnold LJ, "Are you Ready for REULA? The Conscious Uncoupling of UK and EU Intellectual Property Law", see 1:23:08–1:25:49 (<https://www.ucl.ac.uk/laws/events/2024/jan/recording-are-you-ready-reula-conscious-uncoupling-uk-and-eu-intellectual-property>).
5. *Ibid.*
6. *Lifestyle Equities CV and another v Amazon UK Services Ltd and others* [2024] UKSC 8.
7. Please see section 2 of the European Communities Act 1972; Lord Bridge at p. 13 in *Factortame* (No.1).
8. *R v Secretary of State ex p. Factortame Ltd* (Case C-213/89) EU:C:1990:257.
9. *R v Secretary of State for Transport Ex Parte Factortame Limited and others*.
10. *Marleasing* (Case C-106/89) EU:C:1990:395.
11. *Intel v CPM* [2007] EWCA Civ 431, para. 13.
12. *Dansk Industri (DI) v Estate of Karsten Eigil Rasmussen* (Case C-441/14) EU:C:2015:776; [2-16] Pens. L.R. 1 at para. 17.
13. This was the version of the Trade Marks Directive in force at the time, but it is now the (Recast) Directive 2015/2436.
14. Section 3 REULA.
15. Retained EU Law (Revocation and Reform) Act 2023, First Reading on 22 September 2022.
16. Sections 1–2 of the Retained EU Law (Revocation and Reform) Bill (as introduced) (Bill No.156), c. 1.
17. Retained EU Law Public Dashboard (<https://www.gov.uk/government/publications/retained-eu-law-dashboard>).
18. HHJ Tindal, "Are you Ready for REULA? The Conscious Uncoupling of UK and EU Intellectual Property Law", see 36:40–36:44 (<https://www.ucl.ac.uk/laws/events/2024/jan/recording-are-you-ready-reula-conscious-uncoupling-uk-and-eu-intellectual-property>).
19. *TuneIn Inc v Warner Music UK Limited, Sony Music Entertainment UK Limited* [2021] ECA Civ 441, para. 73 (*TuneIn*).
20. Para. 83 of *TuneIn*.
21. Arnold LJ, "Are you Ready for REULA? The Conscious Uncoupling of UK and EU Intellectual Property Law", see 40:32–41:09 (<https://www.ucl.ac.uk/laws/events/2024/jan/recording-are-you-ready-reula-conscious-uncoupling-uk-and-eu-intellectual-property>).
22. *E-Accounting Solutions Ltd (t/a Advancetrack) v Global Infosys Ltd (t/a GI Outsourcing)* [2023] EWHC 2038 (Ch).

23. *Duke v Breckland* [2023] EWHC 1569 (TCC), para. 43.
24. *R(PRCBC) v Secretary of State for the Home Department v United Nations High Commissioner for Refugees*, paras 29–31.
25. *Brent LBC v Risk Management Partners Limited* [2011] UKSC 7, 2011 WL 291802, para. 25.
26. *Arsenal FC v Matthew* [2003] Ch 454 (ECJ).
27. *Google France v Louis Vuitton* [2011] Bus LR 1.
28. Case C-482/09 *Budějovický Budvar np v Anheuser-Busch Inc* [2011] ECR I-08701.
29. Part D (Cancellation) Section 2 (Substantive Provisions) of its Guidelines for the Examination of European Trade Marks.
30. Case T-133/09 *I Marchi Italiani Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*.



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- Application for a Trade Mark
- Absolute Grounds for Refusal
- Relative Grounds for Refusal
- Opposition
- Registration
- Registrable Transactions
- Revocation
- Invalidity
- Trade Mark Enforcement
- Defences to Infringement
- Relief
- Appeal
- Border Control Measures
- Other Related Rights
- Domain Names
- Current Developments