

**International
Comparative
Legal Guides**



Trade Marks

2024

13th Edition

Contributing Editors:

Nick Aries & Charlotte Colthurst
Bird & Bird LLP

glg Global Legal Group

Expert Analysis Chapters

- 1** **What Lies Ahead? The End of EU Law Supremacy and its Impact on UK Trade Mark Law**
Dan Breen & Nick Aries, Bird & Bird LLP
- 7** **Trade Dress Protection Continues to Evolve in the United States**
Ron DiCerbo, McAndrews, Held & Malloy, Ltd.

Q&A Chapters

- 13** **Brazil**
Ludmer Law: Eduardo Ludmer
- 21** **Cameroon**
NICO HALLE & Co. LAW FIRM: Vanessa Halle-Fonguh
- 31** **Cayman Islands**
HSM IP Ltd.: Huw Moses, Mrinali Menon & Kate Cleary
- 40** **China**
Jones & Co.: Yixian Chen & Paul Jones
- 51** **Croatia**
Korper & Partneri Law Firm: Iva Kuštrak Managić, Valentina Šokec, Josipa Bakalić & Dina Korper Žemva
- 60** **Cyprus**
Koushos Korfiotis Papacharalambous LLC: Eleni Papacharalambous & Georgia Charalambous
- 72** **France**
AtlantIP: Axel Doucerain
- 81** **Germany**
Meissner Bolte: Bettina Hart & Jeannette Lewandowski
- 92** **Greece**
Voelkel Kataliakos Roussou Law Office: Anna Roussou & Dr. Henning Voelkel
- 100** **India**
LexOrbis: Manisha Singh & Ritika Agarwal
- 111** **Indonesia**
Pillari ELK: Primastuti Purnamasari
- 120** **Israel**
Ehrlich, Neubauer & Melzer (EN&M): Adv. Yehuda Neubauer & Adv. Chamutal Niran
- 131** **Italy**
ATAX&Legal: Filippo Canu, Lara Cazzola & Marco Botteghi
- 142** **Jamaica**
DunnCox: Joanne Wood Rattray & Kelly Akin
- 152** **Japan**
Fukami Patent Office, P.C.: Yoshitake Kihara & Miki Tomii
- 160** **Korea**
Lee International IP & Law: Dong-Hwan Kim, Min-Hee Kim & Ji-Hyun Kim
- 169** **Macau**
BN Lawyers: Bruno Nunes
- 176** **Malta**
Camilleri Preziosi: Steve Decesare & Alexia Valenzia
- 185** **Mexico**
OLIVARES: Alonso Camargo, Víctor Ramírez & Santiago Pedroza
- 195** **Netherlands**
Legaltree: Marjolein Driessen
- 204** **Nigeria**
G. Elias: Fred Onuobia SAN, Similoluwa Oyelude, Japhet Eneh & Oluwatosin Jinadu
- 213** **Philippines**
V&A Law: Katrina V. Doble, Danielle Francesca T. C. San Pedro & Maria Patricia P. Cruz
- 225** **Portugal**
Inventa: Vítor Palmela Fidalgo & João Pereira Cabral
- 232** **Spain**
Arochi & Lindner: Miriam Anidjar Mogeda
- 246** **Switzerland**
Birgelen Wehrli Attorneys: Jeannette Wibmer & Christoph Birgelen
- 258** **Taiwan**
TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen
- 270** **Ukraine**
ADVANCE PARTNERS: Oleg Zhukhevych, Olga Danish & Olga Kreshchenko
- 285** **United Kingdom**
Bird & Bird LLP: Charlotte Colthurst & Nick Aries
- 294** **USA**
Fross Zelnick Lehrman & Zissu, P.C.: Karen Lim & Richard Lehv

United Kingdom

Bird & Bird LLP



Charlotte Colhurst



Nick Aries

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities are the UK Intellectual Property Office (the “UKIPO”), the High Court of England & Wales, the Court of Session in Scotland and the High Court of Northern Ireland.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Trade Marks Act 1994 (the “TMA”).

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

The mark must be a sign capable of:

- (1) being represented in a manner that enables competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor; and
- (2) distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may consist of words (including personal names), designs, letters, numbers, colours, sounds or the shape of goods or their packaging.

2.2 What cannot be registered as a trade mark?

A trade mark may be refused registration on “absolute” or “relative” grounds (see sections 3 and 4 below).

2.3 What information is needed to register a trade mark?

The application must contain: a representation of the mark; the classes of goods and services for which the mark is being applied; and administrative details such as the name and address of the applicant.

2.4 What is the general procedure for trade mark registration?

An application must first be submitted to the UKIPO. The

UKIPO will then assess whether the mark fails on absolute grounds. If it does, the examiner will issue a report detailing the reasons why. Applicants have a period of not less than one month to resolve issues raised. Following examination, the mark is published for a two-month opposition period (extendable to three months) and may be opposed based on relative grounds at this stage. Once the opposition period expires (or opposition proceedings conclude), the application will proceed to registration.

2.5 How is a trade mark adequately represented?

See question 2.1 above.

2.6 How are goods and services described?

The UKIPO uses the Nice Classification system, which groups goods and services into 45 “classes”, each of which contains a list of pre-approved terms. Although each class has its own heading, these headings should not be relied upon and applicants should list each good or service for which they wish to register the mark within each class.

2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

In the case of unusual marks such as 3D marks, this could be by way of photograph or computer-generated image and generally multiple views of the mark will be expected to be provided. However, the maximum file size that may be uploaded to the UKIPO is 20MB.

Sound marks must be submitted by an audio file reproducing the sound unless they are simple melodies, in which case they may also be represented in musical notation. The maximum file size is 2MB.

Motion marks must be submitted as video files or a series of sequential still images. The maximum file size is 20MB.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required for a trade mark to be registered or for renewal purposes in the UK. However, to file a UK trade mark application, the applicant must give a declaration that the trade mark is being used by the applicant, or with his or her consent, in relation to the goods or services applied for, or that there is a *bona fide* intention that it will be used in this way.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

UK trade marks cover England, Wales, Scotland, Northern Ireland and the Isle of Man.

2.10 Who can own a trade mark in your jurisdiction?

Any natural or legal person can own a trade mark in the UK.

2.11 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use.

2.12 How long on average does registration take?

If no objections or oppositions are raised, registration of a mark takes approximately four months. If objections or oppositions are raised, it can take considerably longer.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

At the UKIPO, a standard online application for registration of a mark in one class is £170. An additional £50 is charged per additional class in the application. This excludes associated professional fees of a law firm/trade mark attorney.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

There are currently two routes: a UK trade mark issued by the UKIPO; or an international registration obtained through the Madrid Protocol designating the UK.

2.15 Is a Power of Attorney needed?

No, a Power of Attorney is not required.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

2.17 How is priority claimed?

Priority is claimed at the application stage.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in the UK.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The following absolute grounds apply:

- the mark is not capable of distinguishing the goods and services of one undertaking from other undertakings, or the mark has not been represented in a clear and precise manner;
- the trade mark consists exclusively of a shape or other characteristic that:
 - results from the nature of the goods;
 - is necessary to obtain a technical function; or
 - gives substantial value to the goods in question;
- the mark is devoid of distinctive character;
- the mark is descriptive of the goods and services in question;
- the mark is customary in the relevant trade;
- the mark is contrary to public policy or principles of morality;
- the mark is deceptive;
- use of the mark is prohibited by law;
- the application has been made in bad faith; or
- the mark consists of or contains protected emblems.

3.2 What are the ways to overcome an absolute grounds objection?

A response to an absolute grounds objection must be filed within two months of receipt of the examination report. How the objection is overcome will depend on the objection that has been raised. Many objections focus on unclear trade mark specifications (i.e. the list of goods and services) and can be overcome by clarifying the terms included in the specification.

Alternatively, if refusal is based on the mark being devoid of distinctive character or being descriptive of the goods or services in question, the applicant may seek to prove that the mark has acquired distinctiveness over time through use of the mark alongside the relevant goods or services.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any decision from the UKIPO can be appealed to either the Appointed Person or the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

3.4 What is the route of appeal?

There are two routes: (1) to an Appointed Person; or (2) to the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The following relative grounds apply:

- (1) The sign being applied for is identical to an earlier trade mark registered for identical goods or services.
- (2) The sign is identical or similar to an earlier trade mark registered for identical or similar goods or services and there is a likelihood of confusion with the earlier mark on the part of the average consumer.

- (3) The sign is identical or similar to an earlier trade mark and the earlier mark has a reputation in the UK, and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.
- (4) The use of the sign could be prevented in the UK by virtue of any rule of law, in particular due to unregistered trade mark rights or other signs used in the course of trade in the UK, protection of designations of origin/geographical indicators or the laws of copyright.

4.2 Are there ways to overcome a relative grounds objection?

It is possible to overcome relative grounds arguments by successfully defending the opposition raised, or reaching a compromise with the opponent; for example, by amending the specification of the trade mark application so that it does not conflict with the third party's earlier rights. Note that the UKIPO does not *ex officio* raise relative grounds objections; it is down to third parties to oppose the application in question.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

4.4 What is the route of appeal?

See question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and/or relative grounds.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone may oppose a trade mark application on the basis of absolute grounds but only owners of earlier rights may oppose a registration on the basis of relative grounds.

5.3 What is the procedure for opposition?

A third party may oppose a trade mark application within two months of its publication in the Trade Marks Journal. It is possible to extend this period by a further month by filing a "Notice of threatened opposition".

The applicant is given two months from the date of notification of the opposition to file their defence.

The opponent and applicant may then submit further evidence in turn before the hearing officer issues their decision.

Cooling-off periods for the discussion of settlement and suspensions of the proceedings are available on joint request of the parties.

In most instances, a hearing officer will give their decision on the opposition based on written submissions alone, but sometimes an oral hearing will be held.

6 Registration

6.1 What happens when a trade mark is granted registration?

A registration certificate is issued.

6.2 From which date following application do an applicant's trade mark rights commence?

UK registered trade mark rights take effect from the date of filing or the date of filing of a trade mark registration from which priority is claimed.

6.3 What is the term of a trade mark?

UK trade marks are valid for 10 years from the date of filing but can be renewed indefinitely.

6.4 How is a trade mark renewed?

A trade mark may be renewed online by submitting a TM11 form at the UKIPO up to six months before or six months after the expiry date of the registration.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, such registration is possible.

7.2 Are there different types of assignment?

Assignments may be for the entire trade mark registration, i.e. for all goods/services for which the mark is registered; or assignments may be partial, i.e. for some but not all goods/services.

7.3 Can an individual register the licensing of a trade mark?

Yes, such registration is possible.

7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive. Exclusive licences give the licensee an exclusive right to use the trade mark registration to the exclusion of all others, including the trade mark proprietor. A non-exclusive licence can be granted to any number of licensees.

7.5 Can a trade mark licensee sue for infringement?

Yes, where the licence provides for this, or if the trade mark owner otherwise consents. In addition, where an exclusive UKTM licence contains a provision granting the licensee the same rights and remedies as if it had been an assignment, the exclusive licensee can bring infringement proceedings in their own name.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are necessary to prevent licensees from using marks in such a way that might make them vulnerable to revocation.

7.7 Can an individual register a security interest under a trade mark?

Yes, such registration is possible.

7.8 Are there different types of security interest?

As trade marks are considered intangible property, security usually takes the form of a mortgage or charge.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The following grounds apply:

- (1) No genuine use of the trade mark has been made by the trade mark owner or with its consent for five years following registration in relation to the goods/services for which the trade mark was registered, or there has been an interruption of such use for a consecutive period of five years, and in each case no proper reason for non-use.
- (2) As a result of acts or omissions by the trade mark owner, the mark has become the common name in the trade for goods/services for which it is registered.
- (3) As a result of the use made of it, the trade mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services.

8.2 What is the procedure for revocation of a trade mark?

The applicant of the revocation action must submit a TM26(N) form (non-use grounds) or a TM26(O) form (other grounds) to the UKIPO. The UKIPO will serve this on the trade mark owner who will have two months to file a defence and counter-statement, which will in turn be served on the applicant.

Submissions and the filing of evidence will be timetabled subsequently.

Once a hearing has taken place or the submissions have been filed and reviewed, a hearing officer will issue a decision in writing.

8.3 Who can commence revocation proceedings?

Any natural or legal person may commence revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

Where an action on the grounds of non-use has been filed, the burden of proof rests with the owner to demonstrate genuine use or show that there are proper reasons for non-use.

Additionally, where the five-year non-use period has expired, but use of a trade mark resumes at least three months before an application for revocation is made, the registration shall not be revoked. This exception will not apply to any commencement of use that occurs within three months of an application for revocation, unless there is evidence that preparations for commencement of use began before the proprietor became aware of the application.

For other grounds of revocation beyond non-use, the defence consists of arguing that the ground has not been established.

8.5 What is the route of appeal from a decision of revocation?

Appeal may be made either to the Appointed Person or to the High Court.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Registration of a mark in breach of absolute or relative grounds for refusal.

9.2 What is the procedure for invalidation of a trade mark?

A TM26(I) form should be filed to begin invalidity proceedings. Both parties will then be given opportunities to submit evidence. A hearing may be requested, following which the hearing officer will issue a decision.

9.3 Who can commence invalidation proceedings?

Any person can bring invalidity proceedings based on absolute grounds for refusal, but only a proprietor or licensee of an earlier mark can bring proceedings on relative grounds.

9.4 What grounds of defence can be raised to an invalidation action?

Acquiescence (for relative grounds) or acquired distinctiveness (for certain absolute grounds) can be raised. For other grounds of invalidity, the defence consists of arguing that the ground has not been established.

9.5 What is the route of appeal from a decision of invalidity?

Appeal may be made either to an Appointed Person or to the High Court.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A UK trade mark may be enforced against an alleged infringer of the mark in the High Court, the Intellectual Property Enterprise Court (the "IPEC") or in certain County Courts.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial steps may include:

- exchange of pleadings;
- attending a Case Management Conference to determine the timetable and any evidential issues;
- disclosure; and
- exchange of evidence and any expert reports. The Civil Procedure Rules Directive on Pre-Action Conduct sets out guidance for the parties, which includes ensuring that they understand each other's positions, and making reasonable attempts to settle the proceedings.

On average, proceedings in the Chancery Division of the High Court will reach trial between 18 months and two years from commencement, though there is a shorter trial scheme that can take around nine months. The timetable in the IPEC is usually quicker.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so, on what basis in each case?

Preliminary (or "interim") and final injunctions are available.

Preliminary injunctions require there to be a serious question to be tried, that the balance of convenience favours the claimant, and that the claimant will suffer irreparable harm to their business if the defendant's activities continue (or commence). The claimant must also act with urgency.

A Court will typically award a final injunction if infringement is established, but the Court exercises its discretion in each case.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so, how?

Yes, assuming those documents/materials fall within the scope of the "disclosure" that the Court has directed. Disclosure varies depending on whether proceedings are issued in the IPEC or the High Court and what form of disclosure the Court has ordered. E.g., if the Court orders standard disclosure, a party must disclose documents that support or adversely affect his or another party's case, and which have been retrieved following a proportionate search. A party may also apply to the Court for specific disclosure of relevant documents, where it believes that the current disclosure is inadequate.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Written submissions are made in the form of a skeleton argument. These are supplemented by oral submissions. Written evidence is provided to the Court, and will not be presented orally unless a witness is called for cross-examination.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In theory, yes, but in practice the Court is reasonably unlikely to do so.

10.7 After what period is a claim for trade mark infringement time-barred?

After the expiry of six years from the date of the last infringement unless there has been deliberate concealment, fraud, or a procedural mistake.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities exist. In general, these offences relate to dealing in counterfeit and "grey market" goods.

10.9 If so, who can pursue a criminal prosecution?

The Crown Prosecution Service or Trading Standards most commonly pursue such actions, but individual trade mark owners may also do so.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

A person aggrieved by an unjustified threat of trade mark infringement proceedings may initiate proceedings seeking a declaration that the threat was unjustified, an injunction preventing the threats from being continued, and damages in respect of any losses resulting from the threat. It is a defence to show that the threat was justified, i.e. that the acts alleged do in fact constitute infringement.

A communication contains a "threat" if a reasonable person would understand that a registered trade mark exists and there is an intention to bring infringement proceedings in relation to an act done in the UK.

Threats made about use in relation to services, rather than goods, are not actionable.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defendants can argue that the conditions for establishing liability are not present, e.g.: use was with consent; is not liable to affect the functions of the trade mark; is not "in the course of trade"; is not in relation to goods/services; and no likelihood of confusion, etc.

11.2 What grounds of defence can be raised in addition to non-infringement?

There are various grounds of defence, contained within sections 11, 11A and 12 of the TMA, including but not limited to: use of indications as to the characteristics of goods/services; use that is necessary to indicate the intended purpose of a product or service; use of an individual's own name or address, in each case in accordance with honest practices; use of a later registered trade mark that would not be declared invalid in invalidity proceedings; use where the mark asserted is liable to revocation for non-use; and use in relation to goods already placed on the EEA with the trade mark owner's consent (exhaustion). Other grounds include honest concurrent use and acquiescence/delay/estoppel.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available: declarations; injunctions; damages or an account of profits; delivery up and destruction of goods; or publication of the judgment.

12.2 Are costs recoverable from the losing party and if so, how are they determined and what proportion of the costs can usually be recovered?

Normally, the unsuccessful party will be ordered to pay the successful party's costs. These costs are usually assessed after the trial and can be subject to a detailed assessment by the Court if the parties do not agree on an amount to be paid. In a case where Court-approved costs budgets are in place and not exceeded, the successful party can expect to recover the vast majority of its costs. Note that cost recovery in the IPEC is capped at set levels.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeals are only on a point of law. Permission is required from either the first instance Judge or Court of Appeal. Such permission will be given where the Court considers that there is a real prospect of success or another compelling reason for the appeal to be heard.

13.2 In what circumstances can new evidence be added at the appeal stage?

The circumstances are very limited and normally limited to where the evidence could not have reasonably been obtained for use in the lower Court, and where the use of such evidence would have had a real impact on the result of the case.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and if so, how quickly are such measures resolved?

Yes, by filing a Customs notice. The mechanism usually resolves issues very quickly unless the importer objects to the destruction of the goods (fairly rare), in which case the trade mark owner may be required to bring Court proceedings for a declaration of infringement, which will slow the process down.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable in the UK through "passing-off" actions. The claimant must establish that: it owns "goodwill" in the mark; there has been a misrepresentation leading to deception of the public; and this has caused or is likely to cause the claimant damage.

15.2 To what extent does a company name offer protection from use by a third party?

Company names offer protection against third parties using the same or similar names, if the criteria for a passing-off claim are met (see question 15.1 above). A company can also raise a dispute with the Company Names Tribunal about a similar third-party company name.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not unless the title is registered as a trade mark, meets the conditions for a passing-off claim, or is itself protected by copyright (unlikely). There is no separate statutory regime.

16 Domain Names

16.1 Who can own a domain name?

Any legal or natural person.

16.2 How is a domain name registered?

A domain name may be registered via accredited registrars or registration service providers.

16.3 What protection does a domain name afford *per se*?

Unless passing off can be established, having a domain name itself offers very little protection against third-party use of a similar name, other than preventing others from registering the same domain name.

16.4 What types of country code top-level domain names (ccTLDs) are available in your jurisdiction?

.co.uk and .uk ccTLDs are the most commonly used ccTLDs in the UK. However, others such as .org.uk, .cymru and .wales are also available.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Nominet is the registry for .uk domains. Nominet operates an online dispute resolution service in the event of a dispute relating to a .uk domain. If the case cannot be settled by mediation, an expert independent adjudicator will make a binding decision on the dispute.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

Retained EU Law (Revocation and Reform) Act 2023

The Retained EU Law (Revocation and Reform) Act ("REUL") became law in 2023. The stated aims of the Act are to make it

easier to amend, repeal or replace EU law retained in UK statute, to make it simpler to depart from EU case law and to reduce regulatory burdens and costs on UK businesses. The initial intention was to sunset all EU law by the end of 2023, but in the end the Government decided against that. Currently only seven pieces of IP legislation are included in the revocation schedule of the Act (and these pieces of legislation were either inoperable, superseded or no longer relevant). As a result, the immediate impact on IP law is small.

However, there remains the possibility of legislative or case law changes being made further down the line. When it comes to IP in particular, a divergence from EU law is likely to be quite gradual and in areas where there are already existing variances, for example, in copyright law, rather than trade mark law, which is fairly settled and already harmonised across the EU and UK.

UK address for service in UK IPO *inter partes* proceedings

A Tribunal Practice Notice (“TPN”) published on 25 January 2023 introduced new rules for effective service in proceedings against trade marks without a valid UK address (see Tribunal Practice Notice 2/2023: Effective service in proceedings against trade marks and registered designs without a valid UK address for service here: <https://www.gov.uk/government/publications/tribunal-practice-notice-2023-effective-service-in-proceedings-against-trade-marks-and-registered-designs-without-a-valid-uk-address-for-service/tribunal-practice-notice-2023-effective-service-in-proceedings-against-trade-marks-and-registered-designs-without-a-valid-uk-address-for-service>). Accordingly, as of 1 January 2024, for new proceedings relating to comparable marks, the addresses for service will only be valid if they are in the UK, Gibraltar or the Channel Islands. This does not impact proceedings relating to comparable marks with addresses for service that are outside of those territories and were ongoing on or before 31 December 2023. This rule also does not affect comparable marks derived from international registrations which already require UK, Gibraltar or Channel Islands addresses.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Montres Breguet SA and others v Samsung Electronics Co Ltd and another [2023] EWCA 1478

This was an appeal against the High Court ruling that Samsung had infringed certain trade marks owned by the Swatch group of watchmakers by allowing consumers to download digital watch face apps (made by third-party app developers) that could be used on Samsung’s smartwatches. The main issues in the case were the extent to which Samsung could be said to be primarily liable for “using” infringing marks deployed in third-party apps hosted in the Samsung app store, and to what extent Samsung benefits from a hosting defence. Samsung appealed on the grounds that the High Court was wrong (i) to accept that Samsung had used the signs in question, (ii) that such use included use relating to smartwatches, and (iii) to reject Samsung’s hosting defence. The decision was handed down in December 2023 and all three grounds were dismissed. The case provides insight into “use” of a sign by an online app and how the hosting defence applies.

Lidl Great Britain v Tesco Stores [2023] EWHC 873 (Ch) and [2023] EWHC 1517 (Ch)

The High Court ruled that Tesco infringed Lidl’s trade mark rights in its Lidl logo (and that Tesco infringed Lidl’s copyright

and their actions amounted to passing off). The infringement claim was consolidated with Tesco’s counterclaim to invalidate various Lidl marks, some of which were subsequently invalidated on the ground of bad faith. Lidl’s main trade mark for the Lidl roundel with LIDL wording was not invalidated and this was the subject of Tesco’s infringement. The signs in question were found to be similar and the evidence sufficient to prove that consumers would draw a link between the two marks. The Judge held that consumers would link Tesco’s roundel signs with Lidl’s brand and reputation, believing that Tesco prices are comparable or price-matched with Lidl’s, giving Tesco an unfair advantage and being detrimental to the distinctive character of Lidl’s mark. This case was very evidence heavy and dependant (for example, there was clear evidence of customers and Tesco staff drawing a direct link between the two brands) and relatively legally complex. Both parties have appealed to the Court of Appeal.

Match Group, LLC v Muzmatch Ltd [2023] EWCA Civ 454

The Court of Appeal upheld a High Court decision that Muzmatch had infringed Match Group’s trade marks – Match Group being the owner of Match.com and Tinder (dating services) and Muzmatch being another dating service, specifically targeting the Muslim community. The High Court found that there was a likelihood of confusion between MATCH and MUZMATCH, that consumers would perceive MUZMATCH as a sub-brand of the mainstream Match service and Muzmatch would therefore have an unfair advantage. The Judge also considered (and dismissed) a defence of honest concurrent use by Muzmatch. In the appeal, Muzmatch argued that the Judge was wrong to hold that the defence is only available where (i) the use of the sign complained of was non-infringing use when it started, and (ii) the use started before the trade mark was registered. The decision goes into some helpful detail about the application of honest concurrent use. Ultimately, the Court of Appeal held that honest concurrent use is not a standalone defence to infringement and, since *prima facie* infringement had been found and Muzmatch had been unable to show that their honest concurrent use had no adverse effect on Match Group, the appeal was dismissed.

17.3 Are there any significant developments expected in the next year?

There are two trade mark-related Supreme Court decisions to watch out for, the background to the first of which is as follows. The Court of Appeal overturned the High Court’s ruling that various “BEVERLY HILLS POLO CLUB” UK and EU registered word and logo marks were not infringed by sales through various Amazon platforms (*Lifestyle Equities CV v Amazon UK Services Ltd* [2022] EWCA Civ 55). The platforms enabled UK and EU consumers to buy goods that had been lawfully manufactured, marketed and sold in the US with a US rights-holder’s consent. This was found to constitute “use” in the UK and so infringed the claimant’s UK trade marks. This case has been appealed to the Supreme Court, which will consider the issue of “targeting” and the circumstances in which sales to UK customers from foreign websites constitute infringement in the UK. The appeal is expected to be heard in late 2024.

The background to the second decision is as follows. The Court of Appeal overturned the High Court’s decision (*Sky v SkyKick* [2021] EWCA Civ 1121) to restrict terms within the specifications of Sky’s trade mark registrations on the grounds of bad faith, as it held that a mere lack of intention to use a

trade mark, as a solitary factor, would not amount to bad faith. Such bad faith was held to only arise when those circumstances are coupled with objective, relevant and consistent indicia of an additional positive intention that was inconsistent with the functions of a trade mark. SkyKick was granted leave to appeal to the Supreme Court on the issue of bad faith and the decision is expected imminently in 2024. The questions on appeal are: (1) what is the test for determining “bad faith” in section 3(6) of the TMA?; and (2) if such bad faith is found, what is the correct approach to determining the specification that the proprietor of the trade mark should be permitted to retain? This decision could mark the first divergence between EU and UK trade mark law post-Brexit if the Supreme Court takes a different view from the CJEU case law on analogous questions.

Another bad faith issue is being considered by the Court of Appeal following the decision in *Lidl Great Britain Ltd Stores Ltd and another v Tesco Stores Ltd and another* [2023] EWHC 1517 (Ch). The High Court found for Lidl in the case generally (in that Tesco had infringed Lidl’s rights) but at the same time various of Lidl’s wordless marks were declared invalid on grounds of bad faith on the basis of a lack of genuine intention to use the mark, ever-greening and insufficient evidence to prove good faith. This has been appealed to the Court of Appeal and was due to be heard in February 2024.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There have been a few practice developments over the last year or so that are worth noting:

- The UKIPO is enforcing the rule relating to the maximum number of rights relied upon in an opposition very strictly now (Tribunal Practice Notice 1/2018: <https://www.gov.uk/government/publications/tribunal-practice-notice-12-018/tribunal-practice-notice-12018>). The TPN came into force on 1 January 2019, but it has recently been followed much more strictly. The number of rights an opponent is allowed to rely on in an opposition is six per ground relied upon, and no more than 10 rights across all grounds.
- There has been a general increase in the number of hearings taking place, both in *ex parte* and *inter parte* proceedings. In particular, where a party requests confidentiality of evidence in contentious proceedings (under Rule 59 of the Trade Mark Rules 2008), the UKIPO considers this request in the context of the *prima facie* right for public inspection of files (section 67 of the TMA). This means it is rejecting an increasing number of confidentiality requests, resulting in more hearings being held where parties are required to go into detail about the need for confidentiality of certain evidence.
- There has been an increase in the number of parties defending oppositions without legal representation, which changes the dynamic of the opposition as the procedural aspects are not always well understood or precisely followed by lay litigants.



Charlotte Colthurst is an associate in Bird & Bird's Intellectual Property department, specialising in brand management. Charlotte has experience in assisting clients with all aspects of a brand's lifecycle, including advising on trade mark prosecution, brand expansion, and enforcement strategies. Her practice entails assessing the breadth and types of protection required, clearance searches, audits, future proofing, international expansion, targeted enforcement and dispute resolution. Charlotte also advises on the commercial and transactional aspects of IP, encompassing restructuring, assignments and licensing.

Charlotte has worked with a broad range of clients, from start-ups to long-standing brands, across a variety of sectors, including retail and leisure, health and wellbeing, fashion, travel and transport, financial services, technology, telecommunications, and entertainment.

She has been a contributor to *World Trademark Review*, *Managing IP* and the *Chartered Institute of Patent Attorneys Journal* commenting on up-to-date case law and is also a contributor to Bird & Bird's international publication, *BrandWrites*.

Bird & Bird LLP
12 New Fetter Lane
London EC4A 1JP
United Kingdom

Tel: +44 207 415 6000
Email: charlotte.colthurst@twobirds.com
LinkedIn: <https://www.linkedin.com/in/charlotte-colthurst>



Nick Aries is a partner in the firm's London office and specialises in IP disputes and advice.

Nick is adept at identifying and advising on IP issues in the digital economy, including copyright and trade mark questions raised by a multitude of online services and social media. He also advises on multi-jurisdictional IP litigation and strategy and represents clients in UK litigation. Alongside this, his practice covers transactional IP work such as licensing (particularly, brand licensing arrangements).

Nick has been recognised by *World Trademark Review* as one of the World's Leading Trademark Professionals.

Nick's UK litigation experience covers copyright infringement, trade mark infringement and passing off, breach of licence/coexistence agreement, trade secrets, and designs. Example UK cases include *Getty Images v Stability AI*, *Merck KGaA v MSD*, *Maier v Asos*, *Kenexa v Alberg*, *Codemasters Software v ACO* and *Daimler v Sany*.

Bird & Bird LLP
12 New Fetter Lane
London EC4A 1JP
United Kingdom

Tel: +44 207 415 6000
Email: nick.aries@twobirds.com
LinkedIn: <https://www.linkedin.com/in/nickaries>

Bird & Bird has led the way in protecting the ideas that have made some of the world's greatest companies successful, and today we are recognised as a global leader in intellectual property.

Particularly commended for its strength in IP strategy and litigation, it is this first-class reputation that allows the firm to attract and retain world-leading advisors and litigators.

The majority of the firm's work is cross-border in nature, and it is regularly called on to advise on ground-breaking trade mark cases. Due to its geographic spread, it provides invaluable experience on the approach and attitude of the Courts in different jurisdictions, which enables it to devise and tailor litigation strategies accordingly.

Not only does the firm have the range and depth of expertise, but with more than 1,600 specialist lawyers across 32 offices, it has numbers in force.

www.twobirds.com @twobirdsIP

Bird & Bird

International Comparative Legal Guides

The **International Comparative Legal Guide (ICLG)** series brings key cross-border insights to legal practitioners worldwide, covering 58 practice areas.

Trade Marks 2024 features two expert analysis chapters and 29 Q&A jurisdiction chapters covering key issues, including:

- Relevant Authorities and Legislation
- 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