

Navigating the Future of IP

Trade Mark Trends 2024: UK and EU Case Review in the Brexit Era

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Contents

01 Status of EU law in UK (and vice versa)

02 Directors' Liability – now harder in the UK?

03 Lookalikes – a range of strategies

04 Bad faith and easyGroup



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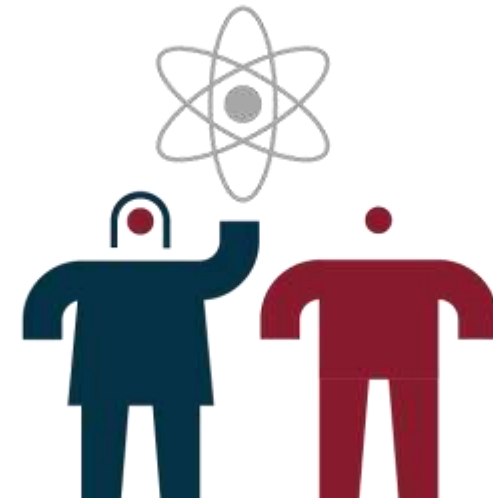
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1

EU law in the UK



Status of EU Law in UK

- "Retained" EU law now "assimilated"
- EU case law:
 - CoA and SC can depart in limited circumstances (EUWA)
 - But section 6 REUL on pause
- Use of a UKTM in the EU counts if prior to 1 January 2021 – only ~12 months left
- EEA exhaustion in UK but not vice versa
- Difficult choices e.g. unregistered designs and databases

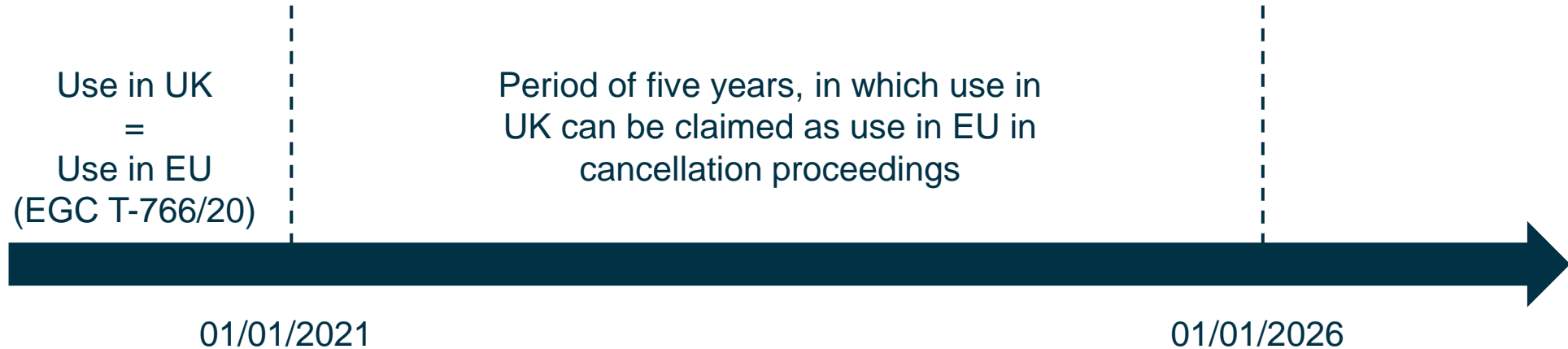


REUL = Retained EU Law
(Revocation and Reform)
Act 2023

EUWA = European Union
(Withdrawal) Act 2018

Status of UK Law in EU

- Observing landmark cases, e.g. Getty Images v Stability AI
- After 2025, use of an EUTM in the UK prior to 1 January 2021 no longer falls within the relevant period of time



- Utilizing European General Court ruling “**The Standard**”?

Status of UK Law in EU – EGC: “The Standard”

- EUTM **The Standard** registered for hotel services (i.a.)
- Owner provided evidence for hotel services in the US and for advertising and contracting in the EU
- EUIPO: hotel services were only provided in the US, therefore trade mark was only used in the US
- EGC: a service trade mark is not only used where the service is provided **————→** advertising for services in the EU constitutes trade mark use for those services in the EU or goods offered to EU

Status of UK Law in EU – EGC: “The Standard”

Transfer of case law to services in the UK:

- Services only provided in the UK
- Services also advertised in the EU
- Or goods offered to EU

→ advertising / offer under the contested trade mark to EU customers can be sufficient for trade mark use in the EU



Key take away:

Possibility to preserve EUTM rights through advertising in the EU

2 Directors' Liability



Directors' liability – now harder in the UK for trade mark infringement?



- Joint liability: common design / procuring an infringement
- The director "*must know the essential facts which make the act unlawful*"

"It is unjust to hold a director personally liable for acts done in the ordinary course of performing the director's role which cause the company to commit a tort, if the director has not acted wilfully or knowingly."

NB other IP rights may be different (e.g. copyright)

Directors' liability in Germany / the EU



- Interim: sufficient to have knowledge of infringement and not have prevented it
- Restrictive again: involvement through positive action or omission in breach of duty, mere knowledge not sufficient

→ rebuttable presumption: decisions typically reserved for director were initiated by them, e.g. general advertising presence

information, compensation, removal, omission

- “Störerhaftung” (Breach of Duty of Care – Intermediary liability) if the director intentionally and adequately contributed to the infringement in any way → breach of reasonable inspection obligations
- Liable for indirectly contributing, e.g. internet service providers, website hosts, operators of online marketplaces

removal, omission

3 Lookalikes

VOTE PLEASE!



Example 1: Lidl's logo copied by Tesco's clubcard?

The "original" (trade marks)



The Wordless Mark



The Mark with Text

The infringement?



Example 2: Thatchers' cloudy lemon cider vs Aldi's "Taurus" cloudy cider lemon?

The "original" (trade mark)



The infringing product?



Example 3: M&S's light-up gin copied by Aldi's light-up gin?

The "original" (registered designs)



The infringing product?



Example 4: Exploitation of the reputation of “Jägermeister”?



Low degree of similarity between signs can be sufficient for necessary link for exploitation of reputation (Art. 8(5) EUTMR)

Example 5: Unfair Imitation of “KERRYGOLD” products?



Unfair imitation if it creates deception of origin, the imitation itself is not sufficient (Sec. 4 No. 3 UWG [„Unfair Competition Act“])

4 Bad faith and easyGroup



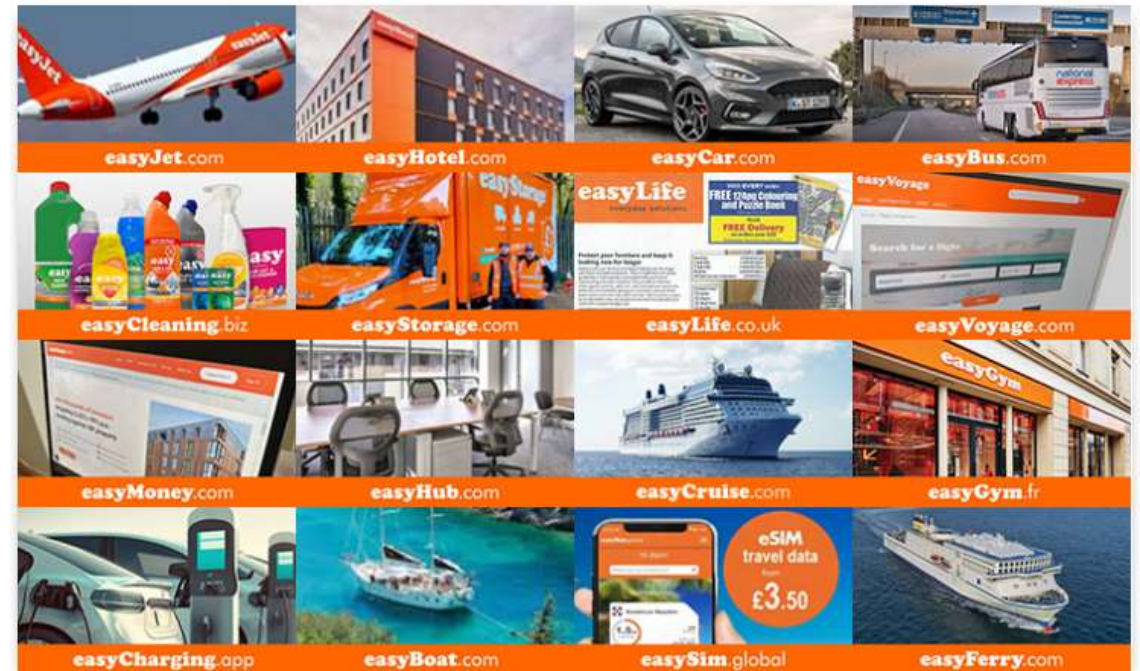
The "easy family" – easy.com

Our top 100 most active **easy** brands

easy.com	easyEnergy.com	easyMarketing.co.uk	easySure.de
easyAccessibility.co.uk	easyEventhireuk.com	easyMobile.com	easyTaxi.app
easyAir.com	easyEverything.com	easyMoney.com	easyTech.travel
easyAlquiler.com	easyExtras.biz	easyMusic.com	easyToolhire.com
easyArt.com	easyFerry.com	easyNet.tech	easyTrain.com
easyAtlantic.co.uk	easyFitnessclub.com	easyNetworks.co.uk	easyTransport.com
easyBike.com	easyFlights.co.uk	easyNoleggio.net	easyTravel.tech
easyBoat.com	easyFly.com	easyOffice.co.uk	easyTravelseat.com
easyBooking.holiday	easyFood.com	easyParking.biz	easyTruck.com
easyBus.com	easyFood.fr	easyPet.net	easyUpdate.net
easyCapital.finance	easyGroup.co.uk	easyPizza.com	easyValeting.com
easyCar.com	easyGuide.biz	easyPod.uk	easyValue.com
easyCasa.gr	easyGym.fr	easyPower.global	easyVan.com
easyCharging.app	easyHemp.gr	easyPR.biz	easyVet.tech
easyCinema.com	easyHire.biz	easyProperty.com	easyVirtual.tours
easyCinema.gr	easyHistory.info	easyRamp.biz	easyVois.com
easyCleaning.biz	easyHoliday.com	easyRentacar.com	easyVols.com
easyClick.it.biz	easyHose.net	easyResort.com	easyVoyage.com
easyCoach.co.uk	easyHotel.com	easyRider.biz	easyWatch.com
easyCoffee	easyHub.com	easyRoommate.com	easyWay.holiday
easyCome-easyGo.biz	easyInternetcafe.com	easyShop	easyWeb.media
easyConveyance.com	easyJet.com	easySim.global	easyWoo.com
easyCruise.com	easyJobs.com	easySky.travel	easyjmen.com
easyCurrency.com	easyKiosk.travel	easyStay.com	easyGroup.com
easyDogwalker.co.uk	easyLand.biz	easyStorage.com	easy.biz
easyDorm.com	easyLet.com	easyStudies.in	easy_group
easyEmail.org	easyLife.co.uk	easySuperapp.in	easy.co.uk

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Bad faith?



Evergreening

- Periodic re-registration to avoid revocation for non-use (*Lidl v Tesco*)
- Cf. EU case of *Athlet Ltd*



To exclude a third party

- Might be indicated by lack of intent to use
- Seminal case is *Lindt* – filing to use against existing third-party usage

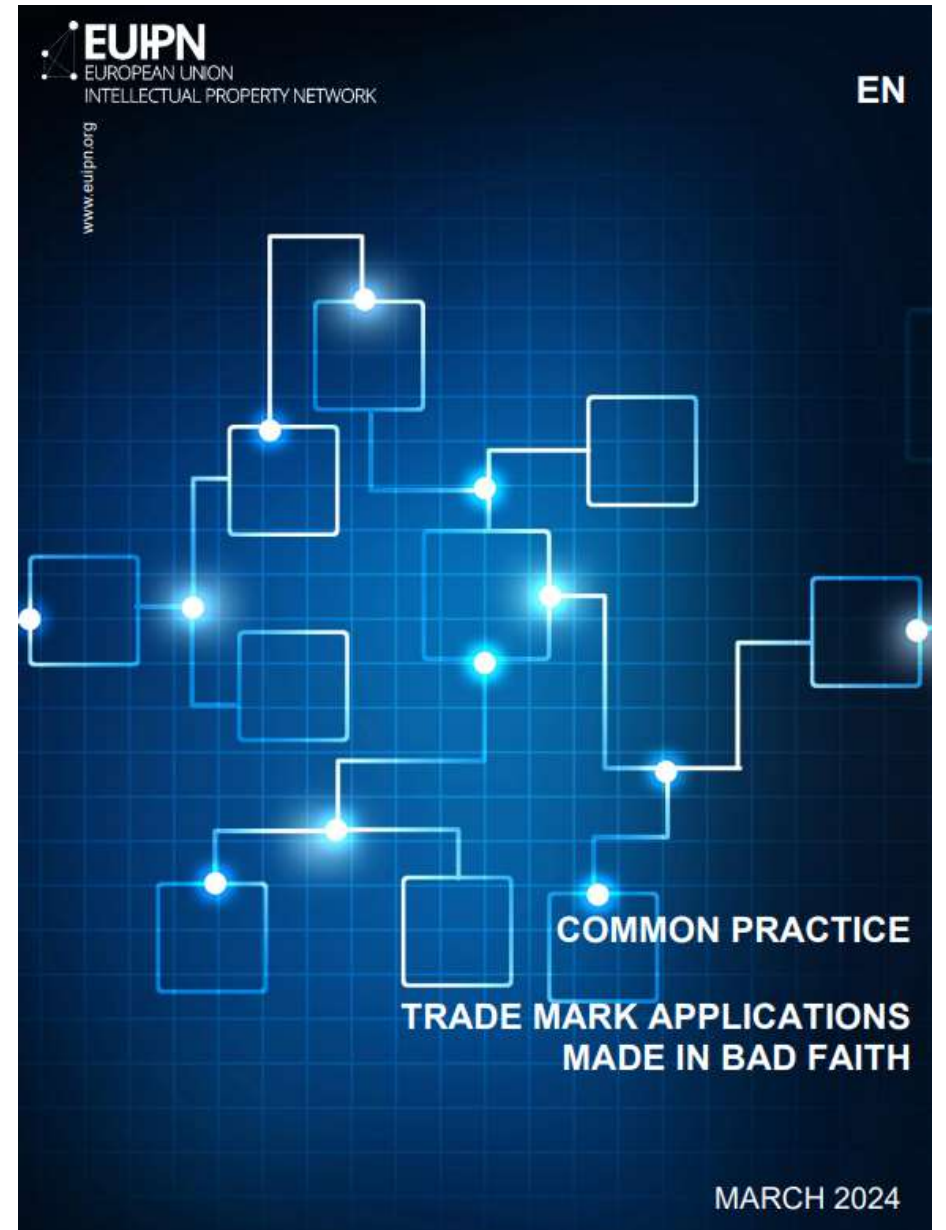
Breadth of specifications

- "Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration" (*SkyKick* at [67])




Bad faith in the EU – CP 13

- Helps to analyse the possible existence of bad faith, aims to ensure similar and predictable decisions by authorities
- Definition of key notions and common understandings of bad faith and dishonest intentions
- Non-exhaustive list of facets of bad faith
- Information on burden of proof, relevant point in time and person of applicant in cases of bad faith
- Non-exhaustive list of common factors for assessment of bad faith, especially **dishonest intention**



Bad faith in the EU – AWK FLAGSHIP



- Opposition against EUTM of one of our clients
→ counterattack against ?
- 👎 cancellation due to non-use: still in grace period for use
- 👍 cancellation due to bad faith: grace period doesn't apply
- Registered for **158 (!) retail services** with no connection to one another: medical supplies, bedding for animals, car accessories, kitchen knives, batteries, computer software, chocolate, weapons and many more
- No intention to use trade mark for all services but rather hindering third parties and blocking register
→ **bad faith (!?)**

35 Retail of third-party pre-paid cards for the purchase of multimedia content; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail services in relation to alcoholic beverages (except beer); Retail services in relation to hand-operated implements for construction; Retail services in relation to hand-operated tools for construction; Retail services via global computer networks related to beer; Retail services via global computer networks related to foodstuffs; Retail services in relation to food cooking equipment; Retail services in relation to chemicals for use in horticulture; Retail services in relation to hygienic implements for humans; Retail services in relation to beauty implements for humans; Retail services in relation to beauty implements for animals; Retail services in relation to hygienic implements for animals; Retail services relating to food preparation implements; Retail services via global computer networks related to non-alcoholic beverages; Retail services in relation to preparations for making beverages; Online retail services for downloadable and pre-recorded music and movies; Book club services retailing books to its members; Retail of third-party pre-paid cards for the purchase of clothing; Retail of third-party pre-paid cards for the purchase of telecommunication services; Retail of third-party pre-paid cards for the purchase of entertainment services; Retail services in relation to preparations for making alcoholic beverages; Retail services relating to audiovisual equipment; Retail services relating to alcoholic beverages; Retail services relating to horticultural products; Unmanned retail store services relating to food; Unmanned retail store services relating to drink; Retail services in relation to domestic electrical equipment; Retail services in relation to domestic electronic equipment; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to heating equipment; Retail services in relation to cooling equipment; Retail services in relation to bedding for animals; Retail services in relation to litter for animals; Retail services in relation to navigation devices; Retail services in relation to stationery supplies; Retail services in relation to pushchairs; Online retail services for downloadable ring tones; Online retail services for downloadable digital music; Retail services connected with the sale of subscription boxes containing cosmetics; Retail services connected with the sale of subscription boxes containing chocolates; Retail services connected with the sale of subscription boxes containing beers; Retail services connected with the sale of subscription boxes containing food; Retail services in relation to cups and glasses; Retail services in relation to physical therapy equipment; Online retail store services relating to clothing; Online retail store services relating to cosmetic and beauty products; Retail services in relation to downloadable music files; Retail services in relation to wearable computers; Retail services in relation to horticulture equipment; Retail services in relation to audio-visual equipment; Retail services in relation to medical apparatus; Retail services in relation to frozen yogurts; Retail services in relation to non-alcoholic beverages; Retail services in relation to information technology equipment; Retail services in relation to agricultural equipment; Retail services in relation to dietic preparation; Retail services in relation to festive decorations; Retail services in relation to recorded content; Retail services in relation to medical instruments; Retail services in relation to sex aids; Retail services in relation to sanitary installations; Retail services in relation to veterinary instruments; Retail services in relation to disposable paper products; Retail services in relation to horticulture products; Retail services in relation to mobile phones; Retail services in relation to building materials; Retail services in relation to fashion accessories; Retail services relating to fake furs; Retail services in relation to paints; Retail services relating to sporting goods; Retail services relating to flowers; Retail services relating to fruit; Retail services relating to furs; Retail services relating to candy; Retail services relating to delicatessen products; Retail services relating to automobile accessories; Retail services relating to automobile parts; Retail services in relation to safes; Retail services in relation to kitchen appliances; Retail services relating to kitchen knives; Retail services relating to horticultural equipment; Retail services relating to fragrancing preparations; Retail services relating to batteries; Retail services relating to accumulators; Retail services in relation to bicycles; Retail services relating to home textiles; Retail services in relation to clothing accessories; Retail services in relation to pet products; Retail services in relation to bicycle accessories; Retail services in relation to car accessories; Retail services in relation to gardening products; Retail services in relation to hair products; Retail services in relation to tableware; Retail services in relation to fuels; Retail services in relation to dietary supplements; Retail services in relation to furnishings; Retail services in relation to coffee; Retail services in relation to fodder for animals; Retail services in relation to ice creams; Retail services in relation to sorbets; Retail services in relation to chocolate; Retail services in relation to sporting articles; Retail services in relation to vehicles; Retail services in relation to confectionery; Retail services in relation to desserts; Retail services in relation to sun tanning appliances; Retail services in relation to construction equipment; Retail services in relation to dairy products; Retail services in relation to cutlery; Retail services in relation to seafood; Retail services in relation to games; Retail services in relation to toys; Retail services in relation to computer hardware; Retail services in relation to computer software; Shop retail services connected with carpets; Retail services in relation to smartphones; Retail services in relation to smartwatches; Retail services in relation to diving equipment; Retail services relating to bakery products; Retail services in relation to luggage; Retail services in relation to saddlery; Retail services in relation to bags; Retail services in relation to hearing protection devices; Retail services in relation to animal grooming preparations; Retail services in relation to educational supplies; Retail services in relation to metal hardware; Retail services in relation to umbrellas; Retail services in relation to weapons; Retail services in relation to art materials; Retail services in relation to works of art; Retail services in relation to refrigerating equipment; Retail services in relation to freezing equipment; Retail services in relation to earthmoving equipment; Retail services in relation to wall coverings; Retail services in relation to sewing articles; Retail services in relation to jewellery; Retail services in relation to yarns; Retail services in relation to cleaning preparations; Retail services in relation to threads; Retail services in relation to cookware; Retail services in relation to lubricants; Retail services in relation to clothing; Retail services connected with stationery; Retail services in relation to furniture; Retail services relating to food; Retail store services in the field of clothing; Retail services in relation to teas; Retail services in relation to cocoa; Retail services in relation to cleaning articles; Retail services in relation to sporting equipment; Retail services in relation to fabrics; Retail services in relation to headgear; Retail services in relation to heaters; Retail services in relation to musical instruments; Retail services in relation to foodstuffs; Retail services in relation to sanitation equipment; Retail services in relation to toiletries; Retail services in relation to printed matter; Retail services in relation to gardening articles; Retail services in relation to floor coverings; Retail services in relation to lighting; Retail services in relation to footwear; Retail services in relation to time instruments; Retail services in relation to meats; Retail services in relation to water supply equipment; Retail services in relation to tobacco; Retail services in relation to beer; Retail services in relation to downloadable electronic publications.

Any questions?

