

# International Comparative Legal Guides



## Trade Marks 2020

A practical cross-border insight into trade mark work

### Ninth Edition

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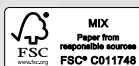
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Ninth Edition

Contributing Editor:

**Nick Aries**  
**Bird & Bird LLP**

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## From the Publisher

Dear Reader,

Welcome to the ninth edition of *The International Comparative Legal Guide to: Trade Marks*, published by Global Legal Group.

This publication provides corporate counsel and international practitioners with comprehensive jurisdiction-by-jurisdiction guidance to trade mark laws and regulations around the world, and is also available at [www.iclg.com](http://www.iclg.com).

This year, there are two expert chapters which provide an overview of online intermediary liability and trade mark infringement and the overlap between trade mark and design rights from an Indian perspective.

The question and answer chapters, which in this edition cover 48 jurisdictions, provide detailed answers to common questions raised by professionals dealing with trade mark laws and regulations.

As always, this publication has been written by leading trade mark lawyers and industry specialists, for whose invaluable contributions the editors and publishers are extremely grateful.

Global Legal Group would also like to extend special thanks to contributing editor Nick Aries of Bird & Bird LLP for his leadership, support and expertise in bringing this project to fruition.

**Rory Smith**  
**Group Publisher**  
**Global Legal Group**

# Online Intermediary Liability and TM Infringement: Stuck in the Middle With You

Bird & Bird LLP



Nick Aries



Louise Vaziri

## A Changing Landscape – Or Not?

Assessing trade mark infringement online can be complex. Not just with respect to which court has jurisdiction, but as to who is behind the infringement itself. As the primary actor can often be hard to identify or take action against, brand owners sometimes turn towards third-party intermediaries who may somehow be involved in the infringement. For example, they might be hosting the infringing content or providing a platform from which counterfeit goods have been sold. But to what extent might intermediaries find themselves liable for the infringing activity that users commit through their services, and is this changing?

As far as the trade mark infringement analysis goes, while the landscape may appear to some extent to be shifting with decisions like the recent Belgian case of *Louboutin*,<sup>1</sup> and the Advocate General's Opinion in *Coty*,<sup>2</sup> those rulings were based on particular factual circumstances, as we explore below. Moreover, *Louboutin* is just a first instance decision, now on appeal, and in the *Coty* case so far, we only have an AG's Opinion rather than a binding Court of Justice of the European Union ("CJEU") ruling. But the scope of trade mark infringement is only half the story. If, and to the extent that, an intermediary qualifies for hosting protection under the Ecommerce Directive, it will be shielded from liability notwithstanding the possibility of trade mark infringement.

So, when a trade mark is infringed with the involvement of a third-party provider, what are the relevant factors to consider when assessing the role of that intermediary?

## Assessing the Role of an Intermediary

### Primary liability

The first step for an intermediary to take is enquiring whether it is itself potentially performing direct acts of infringement ('primary' or 'direct' liability). There has been a modernisation of European trade mark legislation since the explosion of online commerce. However, neither of the relevant enactments (Directive (EU) 2015/2436 and Regulation (EU) 2017/1001) provides a liability regime for intermediaries any different from that applying to other actors. So, the assessment follows ordinary principles flowing from that harmonised European legislation, as developed by case law. Further, the concept of when an online intermediary may itself be responsible for 'using' a trade mark has been analysed in the cases of *Google France* and *L'Oréal v eBay*<sup>3</sup> and was the subject of the Belgian *Louboutin* case, all discussed below.

### Secondary liability

If there is no primary liability, the next step is to consider

whether the intermediary has nevertheless bound itself up in the acts of the primary infringer so as to be jointly liable with that infringer ('secondary' or 'joint' liability). The law in this area is not harmonised within Europe, so the legal test differs from one country to the next.

In the UK, intermediaries can potentially be joint tortfeasors with the users of their services who have conducted the infringing activity. Such liability requires that the intermediary has acted with another pursuant to a common design, or has procured the other to do the infringing act. Mere knowledge that a service is being used, or could be used, to infringe third-party rights – even knowing assistance – is not necessarily sufficient. It has traditionally been difficult to show that an online intermediary was acting in common design with an infringer.

In Germany, there is a doctrine of *Störerhaftung* which translates as 'interferer liability'. Under this doctrine, knowledge is not required; the question of liability is one of harm and causation. In France, the situation is different again. And so on.

### Safe harbours

Overlaying all this is the Ecommerce Directive (Directive 2000/31/EC), which limits the liability of intermediaries by providing certain safe harbours (for caches, mere conduits and hosts). These can offer an intermediary defence in circumstances where it might otherwise be found to have liability. As we discuss below, in the copyright context, there is an open question about whether the hosting defence can apply where an intermediary is found to be communicating works to the public. The answer to that question does not necessarily impact the matters of trade mark law.

The safe harbours apply to 'information society service providers'. These are providers of "any service normally provided for remuneration, at a distance, by electronic means and at the individual request of a recipient of services". The CJEU has, through its decisions, given guidance on which kinds of businesses qualify as a hosting intermediary. So far, various kinds of platform hosts, online auction sites such as eBay and online marketplaces such as Amazon have qualified as intermediaries. A broad approach makes sense when one considers that an overly restrictive definition might not adequately allow for emerging and evolving technologies.

### Injunctions

As a final consideration, an intermediary could find itself subject to injunctive relief in Europe even where it has no liability itself, whether primary or secondary, and even where a safe harbour applies. The Enforcement Directive (2004/48/EC) states that

“rightholders should have the possibility of applying for an injunction against an intermediary whose services are being used by a third party to infringe the rightholder’s industrial property right”. A prominent example of this is an injunction against an internet service provider, obliging it to prevent its customers accessing websites which infringe intellectual property. A number of these sorts of injunctions have been granted in the UK in the field of copyright law. Then, in the UK case of *Cartier*,<sup>4</sup> an injunction of this kind was made for the first time (in the UK, at least) in the field of trade mark law. The rights holders in that case took action in relation to the websites selling counterfeits of luxury goods, by asking the Court to impose an order on the intermediary ISPs to block their customers’ access to the websites.

### A Little More about Safe Harbours

The hosting (as opposed to caching or mere conduit) exemption is typically the most relevant as regards trade mark infringement liability. It is a precondition for hosting protection to apply that the provider does not have actual knowledge of illegal activity or information. Further, for civil liability, the provider should not be aware of facts or circumstances from which the illegal activity or information is apparent.

Knowledge that the content exists and knowledge that the content infringes the rights of third parties are two different things. The service provider must have sufficient information as to the alleged infringement by the specific content in order to be fixed with actual knowledge. General awareness is not sufficient.

If a service provider is made aware of specific infringing content, then it must act expeditiously to remove or disable access to the content or else it risks losing the exemption from liability. This has led to most online hosting intermediaries having some form of notice and take down procedure in place.

Before looking at the recent *Louboutin*<sup>5</sup> and *Coty*<sup>6</sup> decisions, it is worthwhile recapping the CJEU’s *L’Oréal v eBay*<sup>7</sup> decision on the topic of online intermediary liability, and examining some of the national cases applying its guidance.

### L’Oréal v eBay

As a reminder, *L’Oréal* took action against eBay for infringement of its trade marks occurring through various listings that infringed *L’Oréal*’s trade marks. Among other things, *L’Oréal* pointed to the fact that eBay was bidding on keywords containing *L’Oréal*’s registered trade marks and producing adverts that linked to items for sale on the eBay website that infringed *L’Oréal*’s trade marks. The UK court referred several questions to the CJEU as to the ‘use’ that eBay was making of the *L’Oréal* trade marks and its liability for that ‘use’.

#### Trade mark use

Perhaps unsurprisingly (given the prior finding in *Google France*<sup>8</sup>), the CJEU held that in the context of liability for trade mark infringement under the Trade Mark Directive and Trade Mark Regulations, an online marketplace is not ‘using’ a trade mark in circumstances where an end user has placed an offer for sale on the marketplace and that offer includes the rights holder’s trade marks. It was the seller who was ‘using’ those signs, rather than the website operator. In those circumstances, the online marketplace did not have primary liability. There might be questions of secondary liability, but eBay would be shielded from that if it came within the hosting defence.

#### Hosting defence

On the hosting defence point, the CJEU held that the Ecommerce Directive would afford the operator of an online marketplace a hosting safe harbour in circumstances where the online marketplace had not played ‘an active role’ in relation to a particular listing, of such a kind as to give it knowledge or control of that listing. Even if the online marketplace has not played an active role in relation to a given infringing listing, if it subsequently became aware of the infringement and failed expeditiously to remove it then the online intermediary could lose the benefit of the safe harbour defence.

The CJEU also clarified that injunctions could be ordered against intermediaries, notwithstanding that the intermediaries may not have any liability and/or may benefit from a safe harbour defence. Online intermediaries could be required not only to stop the infringement but also to ensure that further infringement was prevented, provided the injunction was effective, proportionate, dissuasive and did not create barriers to legitimate trade. Importantly, the order would also have to stop short of a general duty to monitor all the data of all of its customers (prohibited by Article 15 of the Ecommerce Directive).

### What Constitutes an ‘Active Role’ when Assessing the Hosting Defence?

Whilst the eBay case gave a few examples of what may or may not constitute an active role, it could not of course provide an exhaustive list.

In the eBay case, the Court acknowledged that eBay “processes the data entered by its customer-sellers. The sales in which the offers may result take place in accordance with terms set by eBay. In some cases, eBay also provides assistance intended to optimise or promote certain offers for sale”. The court considered that where a service sets the terms of remuneration and provides general information to users, this does not exempt it from the protection under the Ecommerce Directive. However, where the intermediary is providing additional services such as optimising the presentation of offers for sale or promoting those offers then it cannot be said to have taken a neutral position. The question then is how much optimisation or marketing of content amounts to playing an active role in relation to it?

It is for the national courts to apply the guidance on the distinction between ‘active’ and ‘passive’ roles provided by the CJEU. Numerous decisions in different courts across Europe have grappled with this. Below, we discuss decisions by appeal courts in Spain and France which have given consideration to the matter.

In Spain, the Madrid Civil Court of Appeal in *Telecinco v YouTube* considered if YouTube was a host provider performing an active role on the basis that:

- a) YouTube acquired licences from intellectual property rights management companies, phonogram and audio visual producers;
- b) YouTube provided a contents policy for users;
- c) YouTube took a licence from users who uploaded content; and
- d) YouTube undertook editorial and supervisory work in relation to stored content.

The court found that the first three points did not make YouTube an active host. Particularly in relation to the contents policy, this was considered to be a service condition and specifically referred to in the eBay case as a non-disqualifying factor. The licences that YouTube acquired were held to be an inherent part of the service provided and accordingly did not make YouTube active in any infringement.

Although the court acknowledged that YouTube staff did collate videos for the YouTube homepage and in category types, within that work was a large amount of automation from the system and the collation activity was only applicable to a limited amount of the content on the platform. Accordingly, the court held that this activity was insufficient to prevent YouTube benefiting from the hosting defence.

In France, in *Voyageurs du Monde v Google*, a trade mark case, the Paris Court of Appeal held that Google was not playing an active role in circumstances where users were selecting keywords using Google's automated process. Google did not intervene with the choices save to warn users of the potential consequences of selection if such term was covered by a particular right. Again, this was not sufficient to give Google knowledge or control sufficient to deem it taking an 'active' role in relation to the infringing content.

In *eBay v LVMH*,<sup>9</sup> eBay was found to be playing an active role in relation to certain infringing listings after it promoted sales of infringing perfumes, cosmetics and handbags. In this case, eBay had provided specific information to the sellers as to how to increase their sales, messaged unsuccessful bidders to look at other similar items on eBay and had offered the sellers a personal sales space to enable them to benefit from 'sales assistants' provided by eBay. This was found to constitute an active role giving eBay knowledge of/control over the infringing listings, and so depriving eBay of the hosting defence.

It is not really possible to discern trends in the cases, precisely because the analysis is always very dependent on the underlying factual scenario before the court as to exactly what the host in question is doing in relation to each specific kind of content.

### Louboutin v Amazon – Trade Mark Use by an Online Marketplace

In August 2019, the Brussels first instance court gave judgment against Amazon in relation to use of Louboutin's red sole trade mark in listings displayed on amazon.fr and amazon.de for non-Louboutin shoes. In doing so, the court held that Amazon was itself 'using' the signs found to infringe Louboutin's trade mark, and so was primarily liable. The case mainly concerns the circumstances in which infringing trade mark uses in listings uploaded by third party sellers on an online marketplace are legally attributable to the marketplace, so as to render it directly liable for trade mark infringement. However, there is also some discussion about the applicability of the hosting defence.

Amazon operates a more complicated platform than many other online marketplaces, in that when a customer makes a purchase, they may be purchasing goods:

- a) delivered and sold by Amazon;
- b) delivered by Amazon but sold by a third party; or
- c) delivered and sold by a third party but 'sponsored' by Amazon.

Three types of infringing activity were alleged: use by Amazon of the infringing signs in the listings; stocking of the goods; and delivery of the goods. In this chapter we just focus on the first act: use in the listings. The court considered that in each of the three scenarios, Amazon was itself using the infringing signs appearing in the listings, even if part or all of the listings in categories b) and c) were prepared by third-party sellers who were using Amazon as a platform to sell their goods.

The Belgian court looked at what was said in the CJEU decisions in the *Daimler* case (C-179/15), *Google France* and *L'Oréal v eBay* cases about 'use' of a sign, summarising the position as follows. Use in the course of trade in relation to goods can be attributed to any person having played an active role in committing the act which constitutes use, and having the ability to

control it directly or indirectly. An intermediary only avoids using a sign if it confines itself to offering a neutral service with regard to the act which constitutes use (here, the court gave the example of a mere host, mere warehouse keeper or mere referencing service provider). The use of a sign in advertising (as the court characterised the listings) can be imputed to any person who integrates the advertising into their own communication.

The court found that all the infringing listings (even those of third-party sellers) were part of Amazon group's own commercial communications. The judge drew attention to the fact that the listings were presented in the section called "Amazon Fashion", and were described as "our selections" and "our fashion crushes". Further, the judge considered that, although the infringing goods were the property of a third-party seller, Amazon was nonetheless promoting its *own* goods and services when it published ads for the infringing goods of third-party sellers on external platforms (e.g. Amazon purchased advertising space on the website of the Guardian and featured there its own brands Amazon and Prime next to the infringing goods, without specifying that these goods were sold by third-party sellers).

The judge also highlighted the following factual/contractual elements, in concluding that Amazon's activities amounted to active behaviour coupled with indirect/direct control of the listings of infringing goods, and that the infringing signs were integrated into Amazon's own promotional communications:

- The communications regarding the infringing goods had not only the purpose of promoting the infringing goods, but also of promoting Amazon, its services, activities and goods (e.g. on the same page where the infringing goods were offered for sale, an ad for the new Kindle – a product sold under the Amazon brand – was also featured, with the note "customers who have viewed this product, have also purchased...").
- The offer for sale of the infringing goods mentioned "Amazon business price ex VAT, payment within 30 days, create your free account" [emphasis added], "Special offers and related links", etc.
- The agreement "Sale on Amazon" with third-party sellers provides that "We [Amazon] put Your Products on sale on a particular Amazon Website on the applicable Sale Launch Date on Amazon, and proceed with the commercialization and promotion of Your Products according to our decisions".

As a result, the court held Amazon was itself 'using' the infringing signs contained in third-party sales listings.

In relation to the third-party listings (but not listings of goods sold directly by, or sponsored by, Amazon), Amazon tried to evoke the hosting defence under a national Belgian law implementing the Ecommerce Directive. The court found that because the trade mark used in the infringing third-party listings were integrated into Amazon's own commercial communications (and so could, on the facts, be attributed to Amazon itself), the platform could not properly be characterised as neutral and had gone beyond just creating the technical conditions necessary for a third party to use the signs. As a result, the hosting defence did not apply.

This is the first case we are aware of finding an online marketplace *directly* liable for the use of infringing signs displayed in the sales listings created by its users. Some commentators have suggested this may be the start of a trend. However, it is perhaps more likely attributable to the particular nature of the Amazon platform and the very specific factual circumstances outlined in the judgment. As the case is on appeal, the Belgian court of appeal will have an opportunity to review the legal conclusions, and if necessary, refer any unclear points to the CJEU.



### Coty Germany v Amazon C-567/18

In another dispute involving Amazon, Coty has issued trade mark infringement proceedings against Amazon for its provision of logistics services to a seller of perfume that infringed Coty's licensed rights to DAVIDOFF. Coty sued Amazon in Germany, alleging liability for stocking of goods for the purpose of offering or putting them on the market, under Articles 9(2)(b) of Regulation 207/2009, and 9(3)(b) of Regulation 2017/1001. The German courts held at first instance and on appeal that Amazon had not used the trade mark or stocked the goods to sell them, but had simply stocked the goods on behalf of third parties and was unaware that the trade mark rights had been exhausted.

Coty appealed to Germany's Federal Court of Justice, who referred the following question to the CJEU: Does a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of that infringement, stock those goods for the purpose of offering them or putting them on the market if it is not that person himself but rather the third party alone which intends to offer the goods or put them on the market?

Advocate General ("AG") Campos Sánchez-Bordona's opinion is somewhat discursive and hypothetical because in his view the underlying facts of the case were not completely clear. The AG reviewed the extent of Amazon's involvement and the degree of control it had over the process of putting the infringing goods on the market. The AG considered that the Fulfilment by Amazon logistics programme conducted a broad range of activities, beyond neutrally stocking and transporting goods. For example, there were additional services that covered preparation of the goods (e.g. in some cases labelling or gift wrapping), advertising, provision of information to customers, refunds and promotional activity. Amazon also receives payment for the goods sold, which it then transfers to the seller's bank account. The AG considered that this led to Amazon being very involved with the putting on the market of the infringing goods. It also did not matter in the AG's view that the logistics services that the Amazon group provides are offered by distinct Amazon entities.

The AG advised the CJEU to rule that if a subject has no knowledge that the goods which they stock are infringing and does not intend to offer or put the goods on the market themselves, then there is no liability. However, if a subject is actively involved in the distribution of the infringing goods e.g. through a service such as Fulfilment by Amazon (which permits the stocking of the goods sold by traders through Amazon and their subsequent delivery to purchasers), then they are deemed to stock the goods within the meaning of the provisions. It does not matter whether they have no knowledge of the infringing character of the goods if they could have been reasonably expected to put in place the means to detect the infringement. It would be for the referring court to determine which factual scenario applied in the case at hand.

With respect to the Ecommerce Directive, the AG confirmed that if Amazon was acting in a non-neutral way then the hosting defence would not apply, stating that this is limited to the technical process of maintaining and providing access to a communications network on which information is transmitted or temporarily stored, and could not cover the acts of physical stocking or transporting of goods. The AG also recalled from *L'Oréal and Google France* that the hosting defence does not apply to a marketplace operator playing an active role in relation to infringing offers, such as "giving assistance which entails, in particular, optimising the presentation of the offers for sale in question or promoting those offers".

Looking forward, the issues remain very open, for two reasons. The first is we must wait and see the extent to which

the CJEU follows the AG's opinion. The second is we must then also wait for the application of the CJEU decision in Germany, which will also clarify the factual basis.

### Comparison with Copyright

It is worth pausing to look around at what is happening in the field of other IP rights in the context of online intermediary liability. One of the reasonably recent copyright decisions of note dealing with intermediary liability was *Stichting Brein* (better known as "The Pirate Bay case") C-610/15. The dispute arose between an anti-piracy foundation and two internet service providers regarding an order to block access for customers to The Pirate Bay website. The Pirate Bay was an infamous peer-to-peer file sharing website. From a copyright perspective, the matter presented difficulty in that The Pirate Bay itself did not host protected works. It operated by indexing metadata of protected works that was available on multiple different users computers. A user could find, upload and download the protected work using that indexing system. Most of the works indexed were said to be unlawfully distributed works.

Initially, the case was dismissed as the Dutch court considered that only the users of The Pirate Bay were responsible for the copyright infringement, rather than the platform operators. In addition, the blocking order sought was considered disproportionate to the aim pursued. The Dutch Supreme Court sought guidance from the CJEU as to whether the operators of a website like The Pirate Bay could be regarded as making acts of communication to the public within the meaning of Article 3(1) of the InfoSoc Directive. The CJEU ruled that those operators could be regarded as making acts of communication to the public and accordingly would have direct liability for infringement. Although the users were technically responsible for making the content available, the management of the online sharing platform was an intervention that provided access to the protected works in full knowledge of the consequences.

The particular fact pattern of this case, which involved a "rogue" platform with very large-scale access to infringing works, means it is hard to discern what impact it has on copyright cases involving other intermediaries in a more regular situation. We will get guidance on this when the CJEU gives its decision in the joined *YouTube* and *Uploaded* cases (Cases C-628/18 and C-683/18), which was heard on 26 November 2019. One of the questions the CJEU is being asked to consider in those cases is whether the platforms are themselves directly liable for communicating to the public the works uploaded by users to, and accessible from, the platforms. And if so, can they still be eligible for the hosting defence. A similar question is also one of various ones raised in the *Puls 4 TV* case (C-500/19).

Staying with copyright for a moment, from a legislative perspective, Article 17 of the DSM Directive, which was adopted last year, provides that particular kinds of platforms (i.e. those qualifying as Online Content Sharing Service Providers) do commit acts of communication to the public and will not benefit from the Ecommerce Directive hosting defence. A new *sui generis* defence will apply where such a platform has used best efforts to take a licence, prevents the availability of infringing works on its platform and responds expeditiously to requests for removal of infringing content.

### Likely Trends

The concepts of actual and deemed knowledge, and 'active' versus 'passive' roles, will continue to be at the forefront of online intermediary cases. Questions of liability for trade mark use will likely focus on whether the intermediary played an active

role in relation to the trade mark infringing content. This is for two reasons. The first is that, according to *Daimler*, use of a trade mark involves “active behaviour and direct or indirect control of the act constituting the use”. Where that condition is satisfied by an intermediary, rights holders will say it follows that such intermediary must be using the sign in its own commercial communication (i.e. satisfying the test in *Google France* and *L'Oréal*), although that will rarely be the case. The second reason is that an intermediary does not qualify for the hosting defence under the Ecommerce Directive if playing an active role of such a kind as to give it knowledge of or control over the infringing content. Note that the question of trade mark use is separate from that of the applicability of the Ecommerce Directive hosting defence, applying different criteria.

In the copyright context, legislation has shifted the onus of responsibility as far as certain kinds of intermediaries are concerned, in terms of policing infringing activity on their platforms. In the trade mark context, it is too early to say whether the two cases involving Amazon discussed above represent the start of a similar shift (albeit by case law), by being more inclined to find platforms directly liable for trade mark infringement. Not only is it too early because we are just talking about two cases, but also because the *Louboutin* decision is on appeal and we still await a CJEU decision in the *Coty* case. In addition, both cases involve features of Amazon which are, in combination, somewhat unique to that platform (though there are other similar platforms in China and India that offer more involved logistics type services).

Intermediaries concerned about their liability would do well to scrutinise what services they offer the user beyond the technical, how they describe those services in marketing messages and contracts with users, how much control they exercise over the user's activity insofar as use of trade marks is concerned, how much involvement they have in the putting of goods on the market, the extent to which they might be said to be adopting third party uses of trade marks into the marketing of their own goods/services, whether their activity in relation to certain content goes beyond the normal course of providing the relevant service and might be higher risk, and so on. All of this is to be balanced against the understandable desire to offer users a broad and comprehensive set of services to be commercially competitive.

It is also worth noting that in the EU's legislative programme for 2020 there are plans to create a new Digital Services Act. In that context, the Commission has started a preliminary evaluation of the Ecommerce Directive. However, there appears to be no obvious appetite in the Commission to re-open the hosting,

caching or mere conduit defences, or to change the prohibition on Member States to introduce ‘general monitoring’ obligations for intermediaries. We have heard that DG Connect is considering whether to introduce some sort of ‘duty of care’ for digital services, although it is not clear in what form. Another possibility is said to be the introduction of a U.S.-style ‘Good Samaritan’ law, which would encourage platforms to actively guard against harmful and illegal content without any risk of losing their safe harbour immunity. However, neither of these appear in the most recent EU Works Programme communication.

### And Finally... Brexit?

At the time of writing, the UK has now exited from the European Union and is in a transition period until 31 December 2020 (subject to any additional extension of this period). The law as it stood pre-Brexit has been incorporated into English law by the Withdrawal Agreement, so the *status quo* is for now preserved. However, after the transition period, the UK courts will be free to depart from CJEU decisions if they so choose. The British government has also already confirmed it will not be implementing the DSM and that any future changes to copyright law will be dealt with as a matter of normal domestic policy. Only time, and relevant cases, will tell if the UK courts diverge from the rest of Europe on questions of online intermediary liability.

### Endnotes

1. *Christian Louboutin v Amazon Europe Core sarl & Ots* Chambre des actions en cessation du tribunal de Pentreprise francophone de Bruxelles A/19/00918.
2. *Coty Germany v Amazon*, C-567/18.
3. Note: eBay is now spelled ebay. In this chapter we use the spelling ‘eBay’, because the cases discussed relate to a period when the platform used that spelling.
4. *Cartier International AG and others (Respondents) v British Telecommunications Plc and another* [2018] UKSC 28.
5. *Christian Louboutin v Amazon Europe Core sarl & Ots* Chambre des actions en cessation du tribunal de Pentreprise francophone de Bruxelles A/19/00918.
6. *Coty Germany v Amazon*, C-567/18.
7. Case C324/09 *L'Oréal SA (and others) v eBay International AG (and others)*.
8. *Google France SARL and Google Inc. v Louis Vuitton Malletier SA* (C-236/08).
9. *eBay v LVMH* Arrêt no 483 of 3 May 2012 (11-10.508).



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Louise has worked in-house as well as in private practice and has been responsible for implementing global brand protection strategies in addition to enforcement and clearance on product design. She has particular experience with the resolution of online disputes.

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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.

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The majority of the firm's work is cross-border in nature, and it is regularly called 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.

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# Bird & Bird

# United Kingdom

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Nick Aries



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## 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”), the Trade Mark Regulations 2018 (the “Regulations”, which implement the Trade Marks Directive (2015/2436) (the “Directive”)), and the EU Trade Mark Regulation (2017/1001) (the “EUTMR”).

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

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

\* *This was a new requirement, brought following the introduction of the Regulations, which replaces the old requirement for ‘graphic representation’. However, the Sieckmann criteria still apply, meaning a mark must be clear, precise, objective, intelligible, easily accessible, durable and self-contained.*

### 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 for; 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 on the basis of 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 max 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 max file size is 2MB.

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

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

The applicant for a trade mark registration must sign a declaration that they intend to use the mark; however, no proof of use must be provided at the time of application or upon renewal.

### 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.

### 2.11 Can a trade mark acquire distinctive character through use?

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 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 three routes: a UKTM issued by the UKIPO; an EUTM issued by the European Union Intellectual Property Office (the "EUIPO"); or an international registration obtained through the Madrid Protocol designating either the UK or the EU. After Brexit, EUTMs and international registrations designating the EU will no longer cover the UK, but a new equivalent UK right is due to come into existence automatically on the day that the UK exits the EU.

### 2.15 Is a Power of Attorney needed?

No, a PoA 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 United Kingdom.

## 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 which:
  - results from the nature of the goods;
  - is necessary to obtain a technical function;
  - 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 EU or UK 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 with 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 with or similar to an earlier trade mark and the earlier mark has a reputation in the UK (or, where the earlier mark is an EUTM (pre-Brexit), it has a reputation in the EU) 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?

Once registered, UK registered trade mark rights take effect from the date of filing.

### 6.3 What is the term of a trade mark?

UKTMs 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 TM 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 counterstatement, 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 which 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 on the basis of 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 UKTM 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 (“CMC”) to determine the timetable and any evidential issues;
- disclosure; and
- exchange of evidence and any expert reports.

The Civil Procedure Rules (“CPR”) 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 which can take around 9 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’ which 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 which support or adversely affect his or another party’s case, 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. That evidence 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 unless compelled to under the EUTM Regulation. The latter point will cease to be relevant after completion of Brexit except in certain circumstances.

### 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 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; 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 which 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 which 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. Pre-Brexit, an EU-wide notice would cover the UK. After Brexit, a new notice will be required by UK Customs. 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; that there has been a misrepresentation leading to deception of the public; and that this has caused 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?

The most noteworthy developments have been via case law; see question 17.2 below.

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

In the *AMS Neve v Heritage Audio* case ((Case C-172/18) EU:C:2019:674), the Court of Appeal considered the question of where the act of infringement is committed if use on a website is (said to be) infringing an EUTM. An undertaking in Member State A (here, Spain) had placed an advertisement on a website targeted at consumers in Member State B (here, the UK): was this sufficient to confer jurisdiction in Member State B? The question is relevant to which court has jurisdiction to hear online disputes. The question was referred to the Court of Justice of the European Union (the “CJEU”) who answered that proceedings could be brought in the Member State in which the consumers to whom advertising or offers were directed were based, i.e. in this case, in Member State B. This is important as it gives full effect to Article 97(5) (now Article 125(5) of Regulation (EU) 2017/1001) and means that defendants cannot avoid the provision in an online context simply by ensuring that they set up websites in their home territories.

In the *Sky v SkyKick* case ((Case C-371/18) EU:C:2019:864) the UK Court referred questions to the CJEU as to the permissible breadth of trade mark specifications of goods and services and whether or not a registered trade mark can be invalidated on the basis that part (or all) of its specification of goods/services lacks clarity and precision. It also asked if it can constitute bad

faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services. The Advocate General opined that lack of clarity was not an invalidity ground unless it was contrary to the public interest. Likewise, applying for a mark with no intention to use it could constitute an element of bad faith, particularly if the intention was to deprive a third party from using the mark. Such bad faith would only apply to the goods or services in which bad faith existed and not necessarily the whole of a trade marks specification. The outcome of this referral will likely impact filing strategies in the UK and the EU.

In *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* ([2018] EWCA Civ 2715), Cadbury lost its trade mark for the colour purple. In a novel attempt to save its mark, Cadbury argued that it had registered a series of marks, rather than one mark with an imprecise colour description. Had Cadbury succeeded then they could have deleted a mark from the series and been left with a colour mark that was sufficiently precise. The Court of Appeal held it was possible that a series mark could be registered, even where the normal formalities had not been complied with. However, the Court was not convinced that this is what had happened here and it ruled that the registration was for a single mark that was imprecise. Accordingly, Cadbury lost their trade mark for the colour purple. The case is useful in demonstrating the flexibility of the Court when formalities have not been followed and a reminder of the high bar colour marks face if they are to constitute a sign capable of registration.

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

Brexit is a development which will have a significant impact on trade mark protection and enforcement in the UK, but, at the time of writing, the precise form and timing of Brexit is still not known. However, we expect that the UK will exit from the EU at some stage in 2020.

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

The increase in UK applications has continued. This tends to be applications alongside EUTM applications, rather than where EUTMs are already owned.

Where viable, claimants are more likely to include at least one UK registered trade mark in an infringement claim brought in the UK, rather than just relying on an EUTM registration. This is a safeguard to ensure that the UK Court will have jurisdiction to continue hearing at least part of the claim after Brexit. After Brexit, claimants seeking injunctive relief covering the UK will need to bring UK court proceedings rather than relying on a pan-EU injunction issued by a court in an EU Member State (as they might previously have done).



**Nick Aries** is a partner and co-head of our representative (non-US law) office in San Francisco. He advises on and coordinates European and UK IP law matters for US-based companies.

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

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

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

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Louise advises clients in creative industries on a range of IP issues across the life cycle of IP rights. Louise specialises in soft IP, with a particular emphasis on design, trade marks, copyright and trade secrets. She has acted in a number of significant disputes in the High Court, Intellectual Property and Enterprise Court and in proceedings before the UKIPO, EUIPO and General Court. Many of these disputes have included multi-jurisdictional and multi-forum aspects.

Louise has worked in house as well as in private practice and has been responsible for implementing global brand protection strategies in addition to enforcement and clearance on product design. She has particular experience with the resolution of online disputes.

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The majority of the firm's work is cross-border in nature, and it is regularly called 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.

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