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10th Edition

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What Next for ‘Bad Faith’ in Trade Mark Law?



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Introduction

Ask a trade mark lawyer to explain bad faith to you and you might not receive the most succinct answer. Despite the fact that bad faith is expressly referred to in the Trade Marks Act 1994 (“**TMA**”) in the UK, in Regulation (EU) 2017/1001 of the European Union Trade Mark (“**EUTM Regulation**”) and Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks (“**TM Directive**”), there is no definition of what actually amounts to bad faith in that legislation. What is the legal test for bad faith? How do you prove bad faith? Rights can be revoked on the basis they were applied for in bad faith, yet in the UK and Europe at least, we have no statutory explanation of what that means.

The fact there is no clear definition is surprising when one considers that bad faith is a key concept in trade mark law and helps prevent the abuse of trade mark registrations intended to harm or prevent third parties from legitimately using certain marks (rather than intended to identify the origin of goods or services; the key function of a trade mark). The difficulty for legislators is that bad faith arises in a number of different contexts and what may constitute bad faith can differ according to the facts. Trickier still, is the fact that bad faith appears to vary from one territory to another. Yet bad faith is an extremely useful tool for brands facing copycats, opportunists seeking to take advantage of the fame of another mark or even as against other brand owners pushing the boundaries of their own rights. This chapter discusses what bad faith is, how and when it arises, the issues facing brand owners and what 2021 might have in store for this important concept in trade mark law.

Bad Faith in the UK

In the UK, the TMA states that trade marks shall not be registered to the extent they are applied for in bad faith.¹ This is a ground for refusal of registration, and may be raised in an opposition. Bad faith is also a ground for invalidity of a registered trade mark.² Unusually in the context of invalidity, in the case of bad faith, the Registrar themselves may apply to the court for a declaration of invalidity of the trade mark registration.³

Another feature of UK trade mark law is that when applying for trade marks at the UK Intellectual Property Office, the applicant must state that the trade mark is being used, by the applicant (or with the applicant’s consent), in relation to the goods or services covered by the application, or that the applicant has a *bona fide* intention that the mark will be so used.⁴

Finally, a trade mark owner (party A) cannot rely on acquiescence as a defence against a claim by an earlier rights holder (party B) if party A’s trade mark application was made in bad faith.⁵

Bad Faith in the EU

In the EU, bad faith is not a ground for opposition. It is, however, a ground for invalidity where the applicant was acting in bad faith when filing the trade mark application.⁶

Much like in the UK, the owner of a later trade mark cannot rely on acquiescence against an earlier rights owner if the later trade mark was filed in bad faith.⁷

Meaning of Bad Faith

Although the UK withdrew from the European Union on 31 December 2020, trade mark law principles deriving from case law of the Court of Justice of the European Union (“**CJEU**”) as at that date continue to apply in UK law unless/until altered by the Court of Appeal or Supreme Court. Accordingly, at the time of writing, the discussion below applies equally to both the UK and the EU.

Defining bad faith has proved challenging. Is it a concept of dishonesty? How much knowledge is required? Is it an objective or subjective test? The English court at least had previously considered that the concept of bad faith required dishonesty or “conduct falling short of acceptable commercial behaviour”.⁸

In *DAAWAT Trade Mark* [2002] RPC 12, Mr. Hobbs QC (sitting as an appointed person) considered that the concept of bad faith had moral overtones. In that sense, invalidity could arise regardless of whether the applicant had done anything that was otherwise unlawful. In this case, the applicant of the trade mark knew a third party had significant goodwill for the DAAWAT mark in India and that it had plans to launch in the UK since the applicant had visited the third party on numerous occasions and attempted to do business with it. On the facts of this case, a crucial element was that there was a past relationship between the parties, and the applicant knew the mark was in use and the proprietor intended to use it in the UK. This was key in the finding of bad faith.

In *Hotel Cipriani SRL v Cipriani (Grosvenor Street)* [2008] EWHC 3032 (Ch), the High Court held that the correct approach to bad faith was to decide: a) what the defendant knew; and b) in light of that knowledge, was the defendant’s conduct “dishonest by ordinary standards of honest people”. What the defendant thought of their own actions was not relevant.

Hotel Cipriani was reconsidered in light of the decision of the European Court of Justice (“**ECJ**”) – as it then was called – in C-529/07 *Chocoladefabriken Lindt & Sprüngli v F. Hauswirth*. In this case, Lindt had registered the appearance of its famous gold bunny with a red bow. Lindt used this registration against Hauswirth who were also selling gold bunnies with red bows. Hauswirth had been selling its products in Austria since 1962

and counterclaimed that Lindt had made its application in bad faith because Lindt had known that Hauswirth was already using a similar mark for the same goods at the time of Lindt's application. The ECJ did not give a definition of bad faith. However, it said that the national court must take into account all relevant factors when considering bad faith. In particular:

- a) Did the applicant know or must it have known that a third party was using the mark for the same goods or services?
- b) Was the applicant's intention to prevent that third party using its existing mark?
- c) What degree of legal protection was enjoyed by the third party's sign and the sign for which registration is being/ was sought?

Mere knowledge that a third party is using or intends to use a mark is not of itself sufficient for bad faith.

Later decisions of the EU General Court have considered and attempted to further define the concepts from *Chocoladefabriken Lindt & Sprüngli*. For example, in the General Court's decision in T-795/17 *Moreira v EUIPO (Neymar Júnior – NEYMAR)*, Mr. Moreira sought to register the mark NEYMAR. He also filed for IKER CASILLAS on the same day. These marks are both the names of famous footballers playing in the Spanish *La Liga*. There was no connection between these individuals, their football careers or Mr. Moreira.

Expanding on the types of facts that may be taken into account when considering bad faith, The General Court held that other important considerations were:

- a) The origin of the mark applied for.
- b) The use of the mark since its creation.
- c) Any commercial logic behind the filing. (What was the point of the filing?)
- d) Events leading up to the filing.
- e) The intention of the applicant.

The General Court confirmed that the intention of the applicant was a subjective factor, but the assessment of that intention must be by considering the objective circumstances of the particular case. On the facts of *Moreira*, it was found that the applicant was acting in bad faith and his conduct had departed from accepted principles of ethical behaviour of honest commercial and business practice.

Different Contexts in Which Bad Faith Can Arise

As is evident from the case law above, bad faith can arise in a number of different circumstances, but the common theme is that the objective of the protagonist found to be acting in bad faith was to deprive a third party of using a right that they either had already been using, or perhaps shortly anticipated using. However, there are other contexts in which bad faith can arise.

Evergreening

A contentious issue amongst brand owners is that of evergreening. Evergreening is a term used to describe the process of re-filing trade marks for the same/similar goods and services every five years or so, to ensure that the owner always has a trade mark registration that is not old enough to be vulnerable to revocation for lack of genuine use. This means the brand owner can use the most recent registration in enforcement actions, even if that mark has not been used for certain goods and services.

There is no provision of UK or EU trade mark law that – in terms – prevents a brand owner from filing a new application for coverage it already has. As a result, it has been left to

arguments of bad faith to challenge these types of registrations. The argument being that the mark was applied for to shut out third parties as opposed to serving the core purpose of a trade mark, to identify goods/services of its owner. However, in practice, this is sometimes difficult to prove.

Until recently, there had only been a handful of EUIPO decisions which discussed bad faith in an evergreening situation.⁹ However, those decisions were in circumstances where the later filed mark was almost identical to the original registration and was filed almost exactly five years afterwards, plus a pattern of behaviour could be clearly demonstrated. These cases are at the more extreme end of the scale. In addition, the non-binding nature of EUIPO decisions meant no clear principle emerged.

More interesting was the approach taken in an EU case called *Kreativni Dogadaji v Hasbro*.¹⁰ This case concerned filings of trade marks protecting the world famous board game Monopoly. Kreativni challenged the invalidity of Hasbro's EUTM registration for Monopoly in classes 9, 16, 28 and 41 (the "Contested Registration") on the basis of bad faith. In particular, Kreativni argued the Contested Registration covered identical goods and services to Hasbro's registration for Monopoly filed several years earlier. Kreativni acknowledged the Contested Registration also covered additional goods and services to those previously applied for, i.e. that the later registration was not identical to the earlier registration.

At first instance, the invalidity application was rejected in its entirety on the basis that "*protecting the same mark over a period of fourteen years is not, per se, an indication of improperly and fraudulently extending the five year grace period [for non-use] indefinitely*". The EU Cancellation Division held the onus to prove bad faith was on the applicant and they could not declare a registered mark invalid on the limited evidence provided.

Kreativni took a chance card, appealed the decision and, unusually for EUIPO proceedings, the Board of Appeal ("BoA") case was heard at an oral hearing (including cross-examination of witnesses). Oral hearings almost never take place at the EUIPO Cancellation Division or BoA. The BoA partially annulled the Cancellation Division's decision. The BoA held that where the Contested Registration covered identical goods and services to Hasbro's earlier registrations, such goods and services had been applied for in bad faith as:

- a) Hasbro knowingly re-filed the Contested Registration covering goods and services for which Hasbro already had registrations.
- b) Hasbro admitted that one of the advantages of this strategy was that it would not have to prove genuine use of the mark in opposition proceedings.
- c) Hasbro had not given up their earlier registrations.
- d) There was "*no other commercial logic as regards the reason for such a filing strategy*".

For the goods and services that had not previously been applied for by Hasbro, the BoA held that Hasbro's activities "*did not depart from accepted principles of ethical behaviour or honest commercial and business practices*". Hasbro's conduct was found to improperly extend the five-year grace period. The Contested Registration was, however, valid for those goods and services that had not previously been specified by Hasbro in its earlier registration.

In this case, little evidence was filed to rebut the presumption that trade mark applications are made in good faith until proven otherwise. It was thought that this decision might have opened the flood gates for bad faith revocation actions and for the use of oral hearings. To date, neither prediction seems to have come to pass, though the decision is still fairly recent and is subject to a pending appeal.

Lack of intention to use/overly broad specifications

Is an application with an overly broad specification made in bad faith? If the applicant has no genuine intention to use the mark or to explore plans to use the mark for goods and services included in the trade mark application, has the application been made in bad faith? These were some of the questions before the court in *Sky v Skykick*.¹¹

Sky brought an action against Skykick for trade mark infringement. Skykick counterclaimed that Sky's marks were invalid for a number of reasons. Five questions were sent to the CJEU for consideration. The ones of particular note in relation to bad faith were:

- Can it constitute bad faith to apply to register a trade mark without any intention to use that mark in relation to the goods/services applied for?
- If the answer to the above question is yes, is it possible to conclude an application was made partly in good faith and partly in bad faith with respect to the different goods and services applied for?
- Is s32 (the intention to use requirement – mentioned above) of the TMA compatible with the TM Directive?

In response, the CJEU ruled:

- Registering a trade mark without any intention to use it for the goods and services covered *can constitute bad faith* if the intention of the filing was to undermine third parties or obtain an exclusive right for purposes other than the functions of a trade mark.
- If the lack of intention to use only applies to part of a trade mark specification then only part of the specification can be held invalid for bad faith.
- The intention to use requirement under UK Trade Mark law is not precluded by the TM Directive but of itself cannot be a ground for invalidity.

The case then went back to the English court and the Judge held (amongst other things) that some of Sky's trade marks were partially invalid due to bad faith (e.g. in relation to bleaching preparations, insulation materials and whips). There was either no, or no satisfactory, evidence provided by Sky that they had ever intended to use their marks in relation to certain goods and services. Sky were invited to withdraw part of their infringement claim to avoid the need for a determination of bad faith in relation to certain parts of their trade marks beyond "selected goods and services" – which they subsequently did.

Although some of the marks were found partially invalid and part of the infringement claim withdrawn, ultimately Skykick were still held to infringe. The difficulty with bad faith in a context like this is that it only works as a complete defence if the mark/s relied on are found invalid in relation to all goods/services relied on for the infringement claim. That will not be the case where, as here, the brand owner was relying on registrations in respect of its core goods and services in addition to wider goods and services included in the trade mark specifications. Sky could have avoided some of the arguments over invalidity by having a more targeted infringement claim.

Opportunistic applications by parties unconnected to the brand

Some bad faith trade mark applications are simply made by opportunistic individuals attempting to capitalise on someone else's success/fame or even insolvency. A well-known brand in administration can be the subject of "cheeky" trade mark applications in an attempt to benefit from the name of the brand, or even to hold buyers of distressed brands to ransom.

In 2016, an applicant named Mr. Michael Gleissner filed a trade mark application in the UK for 'Trump TV' in the name of Trump International Ltd. The company had no connection with the then US President Donald Trump. The mark was successfully opposed by DTTM Operations LLC, a company responsible for handling part of Mr. Trump's trade mark portfolio on the grounds of bad faith.¹² In 2019, the UK High Court dismissed Mr. Gleissner's appeal against a UKIPO Hearing Officer's decision that his application to register Trump TV had been made in bad faith. Henry Carr J noted at the start of his judgment, "*attempts to register well-known trade marks by parties who have no connection with such marks are a global problem*". And indeed, they remain a global problem today. The Judge went on to say "*Mr. Gleissner's assertion of an intention to use the mark is, in my judgment, not credible. . . . the evidence gives no details as to how the business would operate, how revenue would be generated, what markets and demographic would be addressed, nor in what geographical regions or on what platforms the service would operate. Nothing is said about when the planned business was or would be launched*".

Bad Faith Around the World

The protection against bad faith applications differs around the world. The test for bad faith is formulated in different ways and available in different contexts. Not all countries permit bad faith as a ground for opposition or invalidity. That said, some territories have a different version of protection such as unfair competition.

It has historically been easier in some territories than others to obtain and maintain trade mark applications which on the face of it appeared to have been made in bad faith. However, the landscape has been changing due to recent reforms. For example, for decades, trade mark squatters were exploiting the first-to-file and sub-classification systems in China to take advantage of the reputation of international brands. They were profiting by pre-emptively registering trade marks of these brands (in classes and sub-classes of goods and services which are important to the brand owners as well as those which are less relevant) and selling the registrations to the brand owners when they entered the Chinese market. This led to mounting pressure from foreign governments, companies and chambers of commerce, and within the China National Intellectual Property Administration ("CNIPA") itself, to tackle the problem of bad faith filings in China.

Whilst China had a concept of bad faith, there was a perception among many Western brand owners that China was a difficult territory to litigate in successfully. In November 2019, Chinese trade mark law was amended to include a new provision under Article 4 which refuses bad faith trade mark applications where no intention to use can be shown. As a result, in China, bad faith is now one of the absolute grounds of refusal in the examination of trade mark applications by the CNIPA.¹³ Bad faith is now also a ground for opposition and invalidation actions in China.¹⁴

China took further steps to deter bad faith applications by including a new provision that a trade mark representative should not represent an applicant if it knows, or should know, that the applicant is acting in bad faith and has no intention to use the trade mark. It has also introduced warnings, fines and other administrative penalties against bad faith applicants and their trade mark representatives. Courts can also impose punishments if trade mark litigation is initiated in bad faith.

In the past, bad faith applications were more often only refused on relative grounds when a brand owner had already registered its marks in the same sub-classes. This gave brand owners a heavy burden of regularly watching and monitoring applications, filing defensively and initiating opposition and invalidation actions in China in order to guard against trade mark squatting. Today, with a clear power for the CNIPA to reject bad faith applications at the examination stage, the CNIPA has been

active in rejecting applications when suspicious behaviour is observed (for example, where the trade mark applicant has filed a high volume of applications within a short period of time, and/or the applicant has a history of filing marks which are identical or similar to other famous brands, etc.).

It may still be too early to tell how effective the amendments are in curbing bad faith applications in China, so brand owners are encouraged to remain vigilant. Nevertheless, at the very least the amendments add an extra layer of protection to the CNIPA's initiative in recognising rights of brand owners.

Challenges in Bad Faith Actions

As is evident from the above, the concept of bad faith can arise in a variety of contexts and is very fact specific. It is not a harmonised concept around the world and can vary from territory to territory. This is particularly difficult for brands operating in a global marketplace. The internet provides the opportunity to reach a greater audience covering a larger number of territories, but it also makes it easier for others to copy successful brands from other jurisdictions. This can be a common issue for new brands that have a quick rise to fame. New businesses rarely have the funds to pay for protection in a large number of jurisdictions and a typical approach is to file in the countries a business is confident it will operate in. However, this can lead to copycats in other territories where the brand owner might want to operate later on. As was previously the issue in countries like China where there is a first to file system, this can be particularly problematic.

Due to the nature of bad faith, finding evidence can be challenging with a need to find historic documents and sources. Arguments often require a creative solution. Oral and witness evidence can be crucial to show that an applicant's behaviour fell below the ordinary standards of honest people or businesses. The need to cross-examine witnesses on their intentions leads to greater costs in oppositions and litigation. Quite apart from that, there can be challenges in obtaining the relevant evidence in the first place, particularly where there is no process of "disclosure/discovery" in intellectual property offices. In addition, and as always, both courts and the intellectual property offices can be unpredictable in their decisions.

So how can someone mounting a bad faith challenge prove what a trade mark owner's intentions were at the time of filing? After all, those documents will reside with the trade mark owner and only they can truly know their own intentions. Luckily, it is still ultimately an objective test and some of the successful actions have been as a result of providing publicly available documents such as filed accounts, press reports and website screenshots from the time the trade mark owner filed its applications. These sources have been combined to point to what the company openly stated its intentions were and then asking why unrelated goods or services were included in filings made at that time. The UK Court and EU BoA, at least, have shown themselves ready to infer bad faith when the trade mark owner has no positive commercial explanation (consistent with the functions of a trade mark) for covering certain goods/services in its trade mark applications.

A further consideration is the appropriate forum in which to bring bad faith actions. For example, the UKIPO has no disclosure process, meaning it may be harder to obtain documents. In contrast, the High Court of England & Wales has procedures that allow for early disclosure of documents, and the general disclosure obligations extend to documents which are detrimental to a party's case.

The threshold for demonstrating bad faith is of itself questionable. Many commentators felt that the CJEU decision in *Skykick* left the bar relatively high, but that is in contrast to decisions such as *Kreavtívni Dogadaji v Hasbro* where relatively little evidence was filed on the part of the applicant. In addition, in *Skykick* itself, once the case returned to the referring Court, the Judge was prepared to make a finding of bad faith in the absence of certain evidence from Sky as to why it had made filings for certain goods and services that were on the face of it very distant from its core business.

What To Look Out For Next

The expectation is that bad faith will increasingly appear as both a ground of attack against potentially abusive filings and as a defence in litigation. Certainly, there seems to be an increase in bad faith arguments in pre-action correspondence. Although there is a high evidential burden in theory, the practical reality is that the courts will take into account all of the commercial and factual circumstances when assessing the evidence available. This may mean, in some circumstances, that providing bad faith with limited evidence is achievable if the applicant/defendant can point to enough facts to raise a presumption of bad faith.

Although there has certainly not been a dramatic increase in oral hearings at the EUIPO's BoA, there has been a greater suggestion in early correspondence in disputes that such a hearing may be necessary, particularly where the rationale of a filing strategy is in question.

For brands trying to prove their registrations were not filed in bad faith, paper trails may be key. It may not always be preferable to record decisions around refiling. However, if there is a genuine or unusual commercial circumstance or reason for a refiling, or for filing a mark in unconventional areas for the business then it is worth recording these reasons as they may be useful evidence in future when defending against a bad faith application.

Although bad faith is increasingly in the spotlight, not least thanks to opportunistic individuals capitalising on global misfortunes, so far it does not seem to have affected brands' filing strategies. Wider specifications are still being sought and the practice of re-filings has not discontinued, although in some cases more caution has been exercised. Those filing with what might be said to be over-broad specifications need to be mindful of the risk of oppositions based on bad faith in countries where this is possible, such as the UK. In addition, registrations should be evaluated carefully for potential vulnerabilities to bad faith counterclaims being made before they are relied on in cease-and-desist letters and, all the more so, in litigation.

Impact of Brexit

It would be remiss not to mention the impact of Brexit on this topic. As mentioned above, for the UK, impact of EU case law derived principles in this area to change, the right case with the right facts would have to get as far as a decision to that effect by the Court of Appeal or Supreme Court. Bad faith issues rarely get that far because they are infrequently a complete answer to a claim: the arguments; and often being reduced in scope by the claimant amending its claim to cease reliance on the vulnerable aspects of its trade mark specification (and indeed this may well be pleaded more carefully in future in any event). The authors of this chapter believe it will likely be some time before an occasion arises for the law on bad faith in the UK to be substantially re-considered.

Bad faith in a global pandemic

And finally, what about the impact of a global pandemic? Online sales were already rising year on year pre-pandemic, but the current COVID-altered world has made the use of online marketing and sales an absolute necessity for brands and businesses. This represents both a blessing and a curse for brand owners. On the one hand, it is easier for copycat brands, counterfeiters and other opportunistic individuals to spot successful brands who may not be properly protected in a specific territory, and so vulnerable. The internet, being naturally global, has given rise to more than its fair share of jurisdictional questions relating to trade marks, being inherently territorial.

However, with so many people spending more time online, brand owners with a good fan base are often alerted to issues regarding third parties taking advantage of their brands much quicker. This can assist in stopping use quickly and cleaning up trade mark registries as part of that process. All this has to be balanced against tougher trading conditions, leading to inevitable budget cuts for legal departments and therefore for brand enforcement programmes.

Unfortunately, a number of businesses, particularly in the retail sector, have gone into a form of insolvency. This has also presented the opportunity for trade mark and domain name squatters to try and take advantage by registering marks and domains that may otherwise have been opposed or blocked, and this can in turn make the business less attractive to potential buyers. Insolvency practitioners are increasingly alert to this vulnerability.

Endnotes

1. S3(6) TMA.
2. S47(1) TMA.
3. S47(4) TMA.
4. S32(3) TMA.
5. S48(1) TMA.
6. Article 59(1)(b) EUTM Regulations.
7. Article 61 EUTM Regulations.
8. *Gromax Plasticulture v Don & Low Nonwovens* [1999] RPC / Knoll Ag's Trade Mark [2003] RPC.
9. R 1260/2013-2 KABELPLUS / CANAL PLUS – here the proprietor of the mark was ordered to provide proof of use, despite the mark being less than five years old because the EUIPO held the later marks had been filed to circumvent the proof of use requirements.
10. *Kreativni Dogadaji v Hasbro* R 1849/2017-2.
11. *Sky plc and Others v SkyKick Companies* [2020] EWHC 990 (Ch).
12. *Trump International Limited. v DTTM Operations LLC v Comptroller General of Patents, Designs and Trade Marks* [2019] EWHC 769 (Ch).
13. Article 4 Trademark Law as part of the amendments in November 2019.
14. Amended Articles 33 and 44 Trademark Law.



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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 *World Trademark Review* as one of the World's Leading trade mark 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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