

Abuse in Trade Mark Actions

Michael Edenborough QC
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serle court

Outline of talk

- **the law is practical not academic**
 - *but still need a thorough knowledge of the substantive and procedural law*
- **Black, Grey and White Letter Law**
 - *not all law is equal*
- **Abuse of Process: practice and procedure**
 - *sword or shield?*

Black, Grey and White Letter Law

- **Black Letter: (rightly) clearly clear**
 - *e.g. ratio decidendi* of a judgment
- **Grey Letter: (rightly) clearly unclear**
 - *e.g. obiter dicta*, dissenting judgment
- **White Letter: (wrongly) clearly clear**
 - assumed settled or sacrosanct
 - but actually untested

Pleadings in the TM registry

- *Omega SA v Omega Engineering Inc*: [2003] EWHC 1334 (Ch); [2003] FSR 49 (Jacob J)
 - putting use in issue in TMA 1994 s 46(1)(a)/(b)
- resulted in TPN 1/2005 entitled *Revocation (non-use) procedures, Section 46 of the TMA 1994*
 - requirement to plead expressly the date from which revocation is alleged to take effect

Pleadings in the TM registry (cont.)

■ TPN 1/2005:

- the s 46(1)(a) period
- and up to two s 46(1)(b) periods

■ Application for Revocation for non-use №. 82 673 *Sabatier*, 31st Jan 07

- multiple s 46 (1)(b) periods permissible
- but TPN 1/2005 not withdrawn

Multiple Applications for Revocation

- *Omega Engineering Inc v Omega SA*: [2004] EWHC 2315 (Ch); [2005] FSR 12 (Rimer J)
- *Henderson v Henderson* (1843) 3 Hare 100
- *Johnson v Gore Wood* [2002] 2 AC 1
 - abuse of process: multiple vexation
 - broad merits-based approach

Playing the Game

■ *Imagination Technologies Ltd v OHIM*

- *PURE DITIGAL* – digital radios
- Case T- 461/04; [2007] ECR II-122; [2008] EMTR 10
- Case C-542/07 P; [2009] ECR I-4937, [2010] ETMR 19
 - embedded point of law to avoid a reasoned order
- Max Planck Institute Report 15th Feb 2011 §2.61

Oppositions

■ *Special Effects Ltd v L'Oreal SA*

- [2007] EWCA 1;
- [2007] ETMR 51; [2007] RPC 15

Invalidations

- *Hormel Foods Corporation v Antilles Landscape Investments NV*: [2005] EWHC 13 (Ch); [2005] ETMR 54; [2005] RPC 28 (Mr Richard Arnold QC)
- *William Evans v Focal Point Fires plc*: [2009] EWHC 2784 (Ch), [2010] ETMR 29; [2010] RPC 15 (Peter Smith J)
 - resulted in TPN 6/2009 entitled *Requirement to attend hearings in relation to applications for invalidation under sections 5(1), 5(2), 5(3) and / or 5(4) of the TMA 1994*

Threats – joining legal advisors

- *Reckitt Benkiser (UK) Ltd v Home Pairfum Ltd*
(Laddie J)
 - [2004] EWHC 302 (Ch)
 - [2004] FSR 37; [2005] ETMR 94
- counterclaim to join the solicitors

Threats – without prejudice correspondence

- *Unilever plc v Procter & Gamble* [2000] 1 WLR 2436; [2000] FSR 344
- *Best Buy Co Inc v Worldwide Sales Corporation España SL* [2011] EWCA Civ 618; [2011] FSR 30

Threats – the future

- *The Law Commission's Eleventh Programme of Law Reform*
- *Reforming the law of unjustified threats in patent, trade mark and design litigation*
 - *Report March 2014*

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- All areas of IP law and practice, in particular patents, trade marks, copyright and designs. Over 90 reported cases since 2000, of which two thirds were appeals or judicial reviews. Appeared often before the General Court and Court of Justice (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases), and in the European Patent Office (Legal and Technical BoA). Acted for the Comptroller-General of Patents, the Registrar of Trade Marks, the UK government, ITMA, CIPA and AIPPI UK Group.