

The interaction of trade mark and passing-off proceedings in the UK and before OHIM

Michael Edenborough QC

serle court

setting the scene

**simple passing-off or TM proceedings in
the UK or before OHIM**

-versus-

**multiple proceedings involving UK TMs
and passing off rights and CTMs in the UK
and before OHIM**

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executive summary

first in time wins?

not always

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UK passing-off proceedings

- senior user **STOPS** the junior user (*Croom's TM Application* [2005] RPC 2 at [45])
- relevant date is the date of first allegedly wrongful use by the junior user (*Cadbury Schweppes* [1981] RPC 429 at 494)
- **BUT** junior user's goodwill may swamp the senior user and then prevails (*Active4life* [2011] ETMR 36)
- need goodwill not reputation in the UK (*Starbucks (HK) v British Sky Broadcasting Group* [2015] UKSC 31)

UK TM proceedings

- *prima facie*, in TMs, the reverse is true
- so senior registrant **CANNOT** stop junior registrant, but is **NOT** stopped in turn (TMA 1994 s 11(1)) (*quaere* compatible with Dir 2005/95 art. 6)
- **BUT** TMA 1994 s 47(6) (invalid *ab initio*), and so removes the junior registration and then prevails

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UK TM and passing-off proceedings Pt I

- senior registrant **PREVAILS** over junior user (**SAVE** for TMA 1994 ss 11, 12 and 13 defences, and TMA 1994 ss 46 and 47 challenges)
- similarly, in the reverse scenario: junior registrant **LOSES** to a senior user
 - generally, TMA 1994 s 47 invalidation of the junior registration
 - **BUT** if only local use, then TMA 1994 s 11(3), and senior user only has a defence, and **CANNOT** stop the junior registrant

UK TM and passing-off proceedings Pt II

- the normal TM infringement case:
 - senior registrant **STOPS** junior user
- **BUT** *Camelot* [2004] RPC 9
 - senior TM registrant with no use can be **STOPPED** by junior user as passing-off
 - equally true for CTM (*Pinterest v Premium Interest* [2015] EWHC 738 (Ch))
 - *quaere*: junior user infringes senior registrant

Statutory acquiescence: stalemate

- TMA 1994 s 48
- earlier registrant or user has knowingly acquiesced for 5 yrs in the use of a junior registered trade mark (*Budweiser* Case C-482/09 [2012] RPC 11; [2013] RPC 12 – HCU issue)
 - may **NOT** seek invalidity
 - may **NOT** oppose the use
- similarly, the junior registrant **CANNOT** stop the use by the senior registrant or user

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UK rights and CTMs

- senior UK TM or passing-off right **PREVAILS** over junior CTM (Reg 207/2009 art. 53.1 – invalidates the CTM)
 - **BUT** acquiescence (CTMR arts 54 and 110)
 - **AND BUT** if senior user is merely of local significance (*Tresplain* Case C-76/11 P [2012] ETMR 22), then only affects that locality and can **STOP** use of senior CTM there (CTMR art. 111)
- junior UK TM or passing-off right **LOSES** to a senior CTM (Reg 207/2009 art. 9 (**SAVE** for defences arts 12 and 13, and acquiescence art. 54))

Stays: common law

- *Glaxo v Genetech* [2008] FSR 185: very wide discretion to achieve the balance of justice
- *Gucci v Shipton* [2010] EWHC 1739 (Ch): UK stays governed by SCA 1981 s 49(3): CTM action stayed, while UK TM and passing-off allowed to proceed

Stays: CTMR

- Reg 207/2009 art. 104(1)
- first seized usually **PROCEEDS**: *Kitfix Swallow v Great Gizmos* [2008] FSR 9
- **UNLESS** special reasons (*Starbucks v BSKyB Group* [2013] FSR 16, but note *EMI v BSKyB*)
- mixed claims divisible (*Samsung v Apple* [2013] FSR 8 at [44])

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■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

- All areas of IP law and practice, in particular trade marks, patents, copyright and designs. Over a 100 cases reported in the law reports 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 in all), and in the European Patent Office (Legal and Technical BoA and Opposition Division). Appeared in over 275 matters before the Registry, and over 60 appeals before the Appointed Person.
- Acted for the Comptroller-General of Patents, the Registrar of Trade Marks, the UK government, ITMA, CIPA and AIPPI UK Group.

IP Juniors at Serle Court



Dan McCourt Fritz (2007)



Gareth Tilley (2007)



Thomas Elias (2008)



Sophie Holcombe (2009)



Adil Mohamedbhai (2010)



Adrian de Froment (2013)