



CITMA Webinar – The Perils of Co-existence Agreements

Michael Edenborough QC, Serle Court

genesis

- **often concluded to settle complex disputes**
 - but with a particular set of facts in mind
- **often concluded and then filed away**
 - but issues may arise years later
- **often should be very subtle**
 - but often patience / time is expiring / limited

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overall view

- **UK IPO guidance 2 Dec 2008 Fact Sheet**
- **co-existence agreements arise from there being a crowded market for goods and services**
- **same mark can be used without a problem, e.g. POLO**
 - maybe a conflict: LoC or unfair advantage, &c.
 - maybe avoid: geography, trade channels or product type
- **response: ignore, litigate, compromise**
- **self determined rather than judicially imposed**
- **co-existence (live together) vs separation (live apart)**
- **agreed peace – but maybe a false dawn, e.g.**
 - changing circumstances: territory / product / format

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co-existence *vs* separation

- not usually actual co-existence
- rather, separation on agreed (detailed) terms
 - by format of signs
 - goods / services (beware of ancillary gds, svs conflict)
 - distribution channels
 - geographically
- but anti-competitive issues *vs* genuine concerns
- and reduction in distinctiveness

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parties

■ do they exist?

- trading names
- unincorporated
- dissolved

■ correct party

- switched names
- holder of relevant rights / doer of activities
- capable of holding property

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subsequent and other parties

- heirs
- corporate restructuring
- forced insolvency
- licensing
- assignments
- third parties

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type of agreement

■ bare promise

- unenforceable at common law
- terminable on notice

■ contract

- requires consideration, &c (Ch8, fn21)

■ deed

- in writing and executed as such (Ch8, fn20)

■ specific foreign requirements

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property involved

■ trade marks

- UK, EU, foreign registrations, Brexit clones
- applications

■ other rights

- copyrights
- designs rights (un/reg)
- goodwill
- domain names and gTLD (and variants)
- pure permissions (*e.g.* number plate, telephone Nos.)

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rights, obligations and consequences

- full and partial title
 - different warranties
- other rights
 - to sue and recover for past infringement
 - to bring oppositions / invalidations / cancellations
 - to bring revocations
 - to claim priority
- undertakings not to sue / oppose / &c.
- collateral asset compromised, *i.e.* cannot mortgage

miscellaneous

- permissible grey areas, *e.g.* variants
- future changes to territory / gds, svcs / marks
- if a breach, where to sue (jurisdiction)
 - interim relief: same place or anywhere
 - damages not an adequate remedy to aid interim relief
- applicable governing law (Scotland, NI, EU (!?))
- ADR mandatory / optional / excluded (arb / med)
 - review mechanism of terms and compliance
- notification requirement of competitor activity – co-operation
- effective date (post / retro – *intra se* effect)
- termination and auto end date *vs* renewable (auto, requested)
- surviving clauses, *e.g.* confidential information

“Just say NO” – Nancy Regan

- if obvious, then don't need
- if not obvious, then high risk of failure
 - limitations on sign format unknown by marketing as the agreement will be kept by the lawyers in a drawer
 - limitations on goods / services overtaken by technology or classification issues, unless very specific
 - different LoC issues in each jurisdiction, so pan-EU (or worse, pan-world (*e.g.* pronunciation, meaning / alliteration) unlikely to be the same

some of the IP Juniors at Serle Court



Thomas Elias (2008)



Adrian de Froment (2013)



Stephanie Wickenden (2014)



Stephanie Thompson (2017)

Michael Edenborough QC

- **contact details:**
 - Serle Court, 6 New Square, Lincoln's Inn, WC2A 3QS, UK
 - (t) + 44 (0)20 7242 6105
 - (e) MEdenborough@SerleCourt.co.uk
- **MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)**
- **all areas of intellectual property law and practice: in particular, trade marks / geographical indications and passing-off, copyright / moral rights and designs, and patents and confidential information**
- **instructed in over 50 matters before the General Court and the Court of Justice of the European Union; over 275 matters before the UK IPO; and over 60 appeals before the Appointed Person**