

D YOUNG & CO TRADE MARK NEWSLETTER^{no.87}

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The British people have voted to leave the EU. This is likely to take several years to finalise, and will have no effect on our ability to represent clients both in the UK and EU. With regard to EU trade marks (EUTMs) and registered Community designs (RCDs), we have already taken steps to ensure that we will remain able to represent clients before European Union Intellectual Property Office, the EUIPO (formerly OHIM), notwithstanding the UK's planned exit from the EU. These include both the recent opening of our Munich office and also ensuring our attorneys and solicitors are suitably qualified to act on behalf of all our existing clients.

An important question is what happens to existing EUTM registrations?

Once the UK's departure from the EU has been finalised, existing EUTMs and RCDs will no longer provide coverage in the UK. Although the position is necessarily unclear at present, it is anticipated that appropriate UK legislation will be implemented to ensure that such rights continue to have effect in the UK, for example, by converting existing EUTM rights to UK national rights enjoying the same priority/filing dates.

We continue to monitor developments closely and will provide timely updates as soon as the legislative position is addressed by the government.

For the time being, and until such time as the UK's leaving the EU has been formally recognised (which may take several years), EUTMs and RCDs should (and can) be enforced as normal. In terms of filing new marks during this transitional period, and if pan-European protection is desired for a particular brand, we recommend filing both a EUTM along with a separate UK national application. Of course we welcome discussing what is the most appropriate and effective strategy for you. Please do get in touch with any questions or concerns.

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BMW v Technosport UK court puts the brakes on car dealer's infringement action

In a recent UK court decision, BMW successfully claimed trade mark infringement and passing off against an independent car dealer that had used BMW's trade marks to promote its services.

This case examines the circumstances in which a third party, who has no contractual relationship with the brand owner, may use the brand owner's marks.

BMW

BMW, the motor vehicle manufacturer, is the owner of numerous well known trade marks including a roundel device incorporating the initials "BMW"; a figurative mark incorporating the letter "M"; and the word mark "BMW". These trade marks are registered in relation to, amongst other things, car maintenance and repair services.



Technosport London

Technosport London Ltd (TLL) is a vehicle repair and maintenance company specialising in BMW cars. It is not, however, part of BMW's authorised network of garages.

TLL had displayed the roundel device at its premises, on their van and on business cards, and had used the M logo on its website.

In addition, TLL owned a Twitter account with the name "@TechnosportBMW", and the sole director of TLL, Mr Agyeton, had worn a shirt bearing the BMW word mark.

Intellectual Property Enterprise Court

BMW claimed before the Intellectual Property Enterprise Court (IPEC) that TLL's use of the signs amounted to both trade mark infringement and passing off. The court addressed:

1. Whether the message conveyed by TLL's use of the signs went further than merely conveying that TLL was a specialist in the repair and maintenance of BMW cars using genuine BMW spare parts.

2. Whether TLL's use of the roundel device and BMW word mark took unfair advantage of the distinctive character or repute of the marks without due cause.

Message conveyed by use of signs

There are two types of dealer who specialise in the repair and maintenance of BMW cars:

- authorised dealers who have a formal licence to use BMW's trade marks; and
- independent dealers, such as TLL, who do not have such a relationship.

TLL argued that the use of the signs conveyed to the average consumer nothing more than that TLL was a specialist in the repair and maintenance of BMW cars using genuine BMW spare parts. BMW submitted that use of the roundel device and M logo was only lawful by authorised dealers, and that the average consumer had been educated to make this connection.

BMW acknowledged that there were circumstances in which a third party could use its marks without a licence. For example, TLL did not infringe BMW's word mark by advertising itself as "The BMW Specialists" on the front of its premises, as this merely indicated that TLL had particular expertise in relation to services for BMW cars, and did not affect the function of the BMW word mark. BMW asserted, however, that use of the roundel device and M logo could only be made under express licence which TLL did not have. TLL, on the other hand, sought to apply the same reasoning to its use of all BMW's signs: ie, that they merely denoted the nature of the repair services being supplied, using genuine parts.

Interflora Inc v Marks & Spencer plc

BMW referred to *Interflora Inc v Marks & Spencer plc*, in which the Court of Justice held that Marks & Spencer's use of Interflora's trade mark as a keyword and the resulting advertisement suggested that there was an economic link between Marks & Spencer and Interflora, and had therefore adversely affected the mark's function of indicating origin. It was argued that an analogy could be drawn between the average consumer's

> **Case details at a glance**

Jurisdiction: England and Wales

Decision level: IPEC

Parties: Bayerische Motoren Werke AG v Technosport London Ltd & Anor

Citation: [2016] EWHC 797

Date: 13 April 2016

Full decision: <http://dycip.com/2016ewhc797>

> **Related case details at a glance**

Jurisdiction: European Union

Decision level: Court of Justice

Parties: Interflora Inc v Marks & Spencer plc

Citation: Case C-323/09

Date: 24 March 2011

Full decision: <http://dycip.com/c-32309>

Jurisdiction: England and Wales

Decision level: High Court

Parties: Enterprise Holding Inc v Europcar Group UK Ltd & Anor

Citation: [2015] EWHC 17

Date: 13 January 2015

Full decision: <http://dycip.com/1Df0qGG>

perception of an economic link in Interflora and the message conveyed to the average consumer by TLL's use of BMW's marks.

The court accepted this analogy and found that it was likely that the average consumer would believe that the roundel device and M logo would only be displayed on and in premises of an undertaking that repairs and maintains cars if that undertaking was an authorised dealer, as "this will have been the almost invariable experience of actual consumers". Furthermore, even if the average consumer was unable to determine whether TLL was an authorised dealer, TLL's use of the signs would at the least have caused the consumer to contemplate whether this was the case, thus adversely affecting the origin function of BMW's marks.

In relation to the use of the BMW word mark in TLL's twitter name "@TechnosportBMW" and on Mr Agyeton's shirt, on the other hand, the court found that BMW had not produced sufficient evidence to show that such use implied to the average consumer that TLL was an authorised dealer.

Unfair advantage

The court went on to consider whether TLL's use of the roundel device and BMW word mark took unfair advantage of the distinctive character or repute of the marks without due cause. The reputation of the roundel device and BMW word mark was not disputed. TLL also accepted that should it be found that unfair advantage had been taken of the distinctive character or repute of the marks, there would have been no due cause for doing so.

Enterprise Holding Inc v Europcar Group UK Ltd

Mr Agyeton submitted that he had used the roundel device because it was good for business, but maintained that he was not representing TLL as an authorised dealer of BMW. Citing Enterprise Holding Inc v Europcar Group UK Ltd, the court stated that it was concerned with the objective effect of the use of the mark, not the user's subjective intention. It was held that TLL's use of the roundel device

therefore took unfair advantage of the distinctive character or repute of the mark.

Again, however, this finding did not extend to the use of the BMW word mark, as such use did not convey to the average consumer anything more than that TLL was a specialist in the repair and maintenance of BMW cars, and was not infringing.

Passing off

The success of the passing off claim relied on a finding of infringement of the marks. Thus it was found that TLL was liable for passing off in relation to its use of the roundel device and the M logo, but not in relation to the BMW word mark.

Authors:

Tamsin Holman & Natasha O'Shea



In short

The case highlights that while there will be circumstances in which unauthorised dealers may make use of trade marks in relation to genuine spare parts, brand owners may object to use of their marks which goes further than merely describing the services offered and implies a relationship with the brand owner.

Interestingly, the court in this case was prepared to allow use of the BMW word mark in a Twitter name ("@TechnosportBMW"), on the basis that it merely described the nature of the goods and services being supplied. The court appears to be more accepting of use of word marks rather than logos.

D Young & Co news

Celebrating 25 years Congratulations Sharon Sequeira!

In May 1991 Sharon Sequeira joined our trade mark support team. 25 years later we are extremely pleased to be celebrating this milestone anniversary with her.



Andrew Johnson, D Young & Co's Head of IP support services, commented: "it is a pleasure to work with Sharon. Sharon has recently completed the Institute of Trade Mark Attorneys Administrators' Course, which she passed with flying colours. This is a great achievement that demonstrates Sharon's continued commitment to the profession and high degree of IP proficiency. Well done Sharon!".

Sharon shares a wealth of knowledge and experience in managing our clients' trade mark records. Sharon and her team provide a valued trade mark support service in handling renewals and preparing applications for the UK, EU and overseas, as well as helping clients collate evidence in support of US declarations, ensuring all deadlines are entered correctly and providing trade mark schedules to clients. As well as overseeing these day-to-day responsibilities, Sharon also contributes to the EUTM Renewal Section for the CIPA/ITMA guide.

Jeremy Pennant, trade mark partner said that "at D Young & Co every employee is valued for their contribution and commitment to the firm's sustainability and success. We are very proud to be able to celebrate such a notable length of service within our trade mark group and express our thanks to Sharon for all her hard work."

Taking 'Storck' of the situation Is it back to square one?

➤ Related case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: August Storck KG v EUIPO

Citation: T-806/14

Date: 10 May 2016

Full decision: <http://dycip.com/t-80614>

Jurisdiction: European Union

Decision level: Court of Justice

Parties: August Storck KG v EUIPO

Citation: C-25/05 P and C-24/05 P

Date: 22 June 2006

Full decisions: <http://dycip.com/c-2505p> and

<http://dycip.com/c-2405p>

Lack of distinctive character is a common obstacle to securing trade mark registration for product packaging, whether as a 3D shape mark; a 2D figurative representation of a shape; or a design contained within packaging.

In this decision, the General Court (GC) upheld the Board of Appeal's refusal on the ground of Article 7(1)(b) of the European Union Trade Mark Regulation (EUTMR) to register a figurative mark for square-shaped packaging comprising the colours blue, white and grey. The applicant, August Storck (Storck) was no stranger to such refusals, having previously been denied registration for a figurative mark for the shape of a gold-coloured sweet wrapper (C-25/05 P) and a 3D mark for the shape of the sweet itself (C-24/05 P).

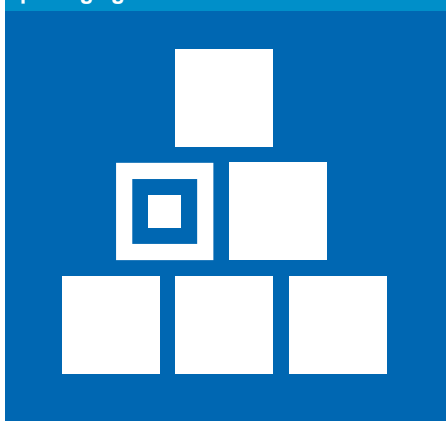
Storck had applied for an international registration (IR) designating the European Union (EU) in class 30 for "Confectionery, chocolate, chocolate products, pastries, ice-cream, preparations for making the aforementioned products, included in this class". The white and blue colours were separated by a curved diagonal line, with grey at the edges of the packaging. Finding that the colours and shape did not render the mark distinctive, the Board of Appeal considered that the sign was merely a combination of presentational features typical of the packaging of the goods concerned.

Another dimension

On appeal to the GC, Storck submitted that the Board of Appeal had incorrectly applied the criteria for distinctiveness relating to 3D marks to the application and had wrongly assumed the mark to be a 3D mark rather than a figurative mark.

Referring to an earlier CJ decision also involving Storck (C-25/05 P), the GC noted that the case law applicable to 3D marks consisting of the appearance of the goods themselves also applied in this case, as the application denoted a figurative 2D representation of the goods such that it was not unrelated to the appearance of the goods.

The GC found that Storck's square-shaped packaging lacked distinctive character



Character assessment

The GC confirmed that the relevant public was the average EU consumer with a low level of attention, which was not increased by the impact of the goods on consumer health or their pursuit of pleasure. Indeed, the products in question were of regular, speedy and low-cost consumption.

Storck's contention that the application had not been assessed on its overall impression, but rather on its individual features, was rejected and the GC confirmed the Board of Appeal's finding that the mark applied for was insufficiently distinguishable from other shapes present on the market and lacked fanciful elements:

- Square-shaped packaging is common, obvious and evidently essential to the relevant goods.
- Colours rarely inherently convey origin. The three distinct colours in this application were commonplace and would be perceived as aesthetic or presentational elements such that their combination would not enable consumers to immediately distinguish origin.
- The curved diagonal line, alleged by Storck to represent an image of a snow-covered hill against a blue sky, was not described as such in the application. This interpretation would not be obvious to the relevant consumer, or different to other packaging images on the market. Further, the affixed

image and grey edges were likely to be seen by consumers as simple, decorative patterns rather than indicators of origin.

Evidence perception

A survey of 1,000 participants conducted in Germany regarding the level of distinctiveness was previously held by the Board of Appeal to be insufficient in scope or extent to establish inherent distinctiveness across the EU. The GC confirmed this finding and observed the inappropriate nature of the evidence, noting that Germany was Storck's established and domestic market and that the majority of participants were already familiar with the mark prior to the survey. This meant inherent distinctiveness could not be proven as the evidence did not demonstrate that consumers had not merely become accustomed to the mark by virtue of its use; to be inherently distinctive, a mark must immediately indicate origin.

Storck submitted new survey evidence regarding the Austrian public's perception on the level of distinctiveness after the contested Board of Appeal decision, however this was deemed inadmissible. The GC may review the legality of Board of Appeal decisions, but not new facts. In any event, it is unlikely that the GC would have considered this additional evidence to have been sufficient in scope or extent to establish distinctive character.

Interestingly, it does not appear that Storck put forward a substantiated claim for acquired distinctiveness through use.

Author:

Jennifer Heath



In short

This case demonstrates the challenges associated with securing registration for product packaging and is a good reminder for applicants to put forward claims and to ensure the suitability of survey evidence.

Henkell's 'small' reminder for proof of use

Denoting origin is your mark's essential function

➤ Case details at a glance

Jurisdiction: European Union

Decision Level: General Court

Parties: Henkell & Co. Sektkellerei KG, Ciacci Piccolomini d'Aragona di Bianchini Società Agricola and the EUIPO

Citation: Case T-20/15

Date: 14 April 2016

Full decision: <http://dycip.com/t-20-15>

Henkell & Co Sektkellerei KG (Henkell), the producer of sparkling wine, wine and spirits in Europe owns European Union trade mark (EUTM) registration number 952770 PICCOLO for goods in classes 32 and 42, including 'wines' and 'sparkling wines'. The trade mark was registered in August 2011.

Henkell opposed registration of EUTM application number 10564573 PICCOLOMINI in the name of Ciacci Piccolomini d'Aragona di Bianchini Società Agricola (Ciacci) which sought registration for 'alcoholic beverages (except beers)' in class 33.

The trade mark relied on in the opposition was over five years old, so Ciacci requested proof of use.

Proof of use

Proof use was filed which included a statutory declaration from Henkell's marketing director referring to sparkling wines bearing the trade mark 'PICCOLO' for the years 2007-2001. Images of the products were filed along with:

- excerpts from price lists from 2007;
- export price list from 2008-2009;
- invoices showing sales from 2007-2012 into Greece, Italy and Finland; and
- an excerpt from a marketing leaflet.

The Opposition Division accepted this evidence and concluded that proof of use had been shown and upheld the opposition.

Appeal

Ciacci appealed to the Board of Appeal and claimed that:

1. 'Piccolo' formed part of internationally-used wine terminology and the average consumer would be aware of this term;
2. Consumers who did not understand 'piccolo' would not automatically believe it was a trade mark;
3. 'Piccolo' was clearly used descriptively



('piccolo' means 'small' in Italian) as it was used with other descriptive terms such as 'dry'; and

4. Henkell is by far the most dominant element, which would result in the assumption that it was the distinctive sign.

The Board of Appeal and the General Court agreed with these arguments and found that the trade mark had not been used in accordance with its essential function, which is to guarantee origin.

Factors which contributed to this decision included the opponent's house mark being the dominant element on the goods, 'piccolo' being used in close proximity with descriptive elements, and the term 'piccolo' only featuring on 200 ml (small-size) bottles.

The same was true with the invoices as 'piccolo' was being used in a descriptive manner. The opposition was refused on this basis.

Author:

Helen Cawley



In short

Trade marks should be used correctly throughout their lifetime. For those fortunate enough to have secured registration of trade marks which may be difficult to register in today's strict climate, this is even more important. Do contact us if you have any concerns about how you are using your registered trade marks or would like your use reviewed.

Mind the GAP! British American Group v GAP (ITM)

Case details at a glance

Jurisdiction: England and Wales

Decision level: High Court (Chancery Division)

Parties: Gap (ITM) Inc v British American Group Limited

Citation: [2016 EWHC 599 (CH)]

Date: 21 March 2016

Full decision: <http://dycip.com/2016ewhc599>

In a recent appeal to the High Court from a decision of the UK Intellectual Property Office (UKIPO), the judge found that the earlier trade mark GAP was confusingly similar to the sign “The GapTravel Guide”.

Background

British American Group Limited (BAGL) applied to register “The GapTravel Guide” as a UK trade mark for ‘magazine publishing’ in class 41.

Gap (ITM) (Gap), the well-known clothing retailer opposed registration of this mark based on its earlier trade mark GAP which it had registered for services in class 41 including ‘Publication of electronic books and journals online; Writing of texts [other than publicity texts]; Publication of texts, other than publicity texts; Providing on-line electronic publications, not downloadable; and Publication of books’. The mark GAP had been registered for less than five years and so Gap was not required to prove that it had used the mark.

The hearing officer dismissed the opposition and allowed registration of “The GapTravel Guide”.

Appeal

Although the opposition had included a number of grounds, the appeal was based on one relative ground for refusal, namely that due to the similarity of the marks and services applied for, there was a likelihood of confusion on the part of the public.

The average consumer

An important aspect when determining likelihood of confusion is it must be considered

through the eyes of the average consumer of the services in question. The appellant (Gap) in this case had called into question the Hearing Officer’s assessment of the average consumer, arguing that the Hearing Officer had not identified the correct average consumer. As a consequence, the Hearing Officer had not carried out the correct comparison of the marks, as he was unable to make the comparison “through the right eyes”.

The Hearing Officer had considered that the average consumer of publishing services would generally be a business in need of publication of material; and that such consumers were likely to undertake the purchasing process in a more considered fashion.

In the court’s view, this was not the correct conclusion. The judge commented that:

“the law of trade marks should take some cognisance of what traders actually think and do”

and that the concept of “the average consumer” was created to strike the right balance between various competing interests including the need to protect consumers, and the promotion of free trade in an openly competitive market”.

The judge’s view was that BAGL, who applied for “The GapTravel Guide”, was carrying out the service of magazine publishing by producing and distributing magazines,

and there was a high degree of similarity between the carrying out of that service and the magazines which are the end product of that service. Therefore the conclusion that the consumer of the product of such a service was not also a consumer of the service itself was too narrow and impractical.

The Hearing Officer had concluded that the respective specifications of the mark as applied for “The GapTravel Guide” and GAP were identical, or very similar. Neither side appealed that conclusion.

Similarity of the marks

The Hearing Officer concluded that the marks shared a low level of visual similarity, a low level of aural similarity and no conceptual similarity.

Although GAP argued that the Hearing Officer was incorrect in his conclusion in relation to all three areas of similarity, it said it was most striking in relation to conceptual similarity and only that needed to be dealt with by the court.

In the circumstances, and bearing in mind that the judge’s view was that the Hearing Officer had erred in his assessment of the average consumer, it was necessary to consider matters afresh.

Taking into account the assumed reputation of the mark GAP, what needed to be considered was whether there was a risk that the public, with the perceptions of the average consumer, would be confused into the mistaken belief that praise/criticism awarded to the travel guides, or travel guide publishing services of the applicant, were in fact the services of the opponent, Gap. The judge’s view was that there was such a risk. This was based on his view that guides and travel guides are common subject matter for magazine publishing services and the presence of ‘GapTravel’ in BAGL’s mark was not enough to remove the likelihood of confusion. It was the word “Gap” which was the differentiating factor between those guides or travel guides, and those of some third party. For these reasons, the judge allowed the appeal.

Mind the gap! Earlier mark GAP was confusingly similar to the sign “The GapTravel Guide”



Author:
Claudia Rabbitts



Tronios v BSKyB

GC broadcasts rules for acquiescence loud and clear

In this case between Tronios and British Sky Broadcasting Group plc (BSkyB, now Sky plc), the General Court (GC) reiterated that acquiescence requires actual knowledge of the use and registration of a contested trade mark, confirming that inferences to such knowledge are insufficient.

Background to the case

Tronios obtained a trade mark registration on 02 May 2001 for the word mark SKYTEC for goods in classes 9 and 11. The relevant goods were "apparatus for receiving, recording, passing on, processing and reproducing electric and electromagnetic signals including wireless microphones and systems, microphones; disc, CD and DVD players; CD and DVD recording apparatus; cables, connecting leads and connectors; digital and analogue sound processing apparatus, low and high capacity audio amplifiers; loudspeakers, cabinets for loudspeakers and accessories" in class 9.

On 23 March 2007, BSKyB sought to revoke the registration on the grounds of non-use. However, Tronios successfully defended the action by supplying evidence of genuine use of the mark on 02 April 2007: the revocation action was therefore dismissed.

On 21 March 2012, BSKyB filed for a declaration of invalidity, relying on registrations for SKY covering identical class 9 goods, including UK registrations dating from 1995. BSKyB claimed a likelihood of confusion under Art. 8(1)(b) European Union Trade Mark Regulation (EUTMR), and unfair advantage/detriment to distinctive character or repute under Art. 8(5) EUTMR.

Tronios argued that BSKyB had acquiesced (it had knowingly tolerated the use of the SkyTec mark, for over five years) and was therefore precluded from invalidating its registration. Tronios argued that BSKyB must have had the requisite knowledge at least some days before the filing of the revocation action, almost five years earlier, and by 21 March 2007 at the latest. Tronios also submitted evidence of sales and advertising relating to its SkyTec branded goods, indicating that both marks were on the market for several years.

An unsuccessful revocation action should be followed by well-timed invalidation action filing



The Cancellation Division rejected the acquiescence claim, upholding the invalidation in its entirety. Tronios' trade mark registration was invalidated in respect of class 9 goods based on a likelihood of confusion with BSKyB's UK registration for SKY under Art 8(1)(b) EUTMR.

Tronios appealed to the Board of Appeal with the following arguments:

1. The marks had coexisted for almost eleven years, if counted from the date of registration through to the date of the declaration of invalidity.
2. BSKyB admitted to patrolling trade marks containing the element 'sky'. No action was taken to challenge the use of the SKYTEC mark, and as such, they should bear the consequences of acquiescence (by being prohibited from challenging Tronios' longstanding use and registration).
3. Tronios had filed applications for SKYTEC around the world, including the UK, and it could reasonably be presumed that BSKyB was aware that Tronios would have (and had) used the SKYTEC mark.

4. It could reasonably be presumed that BSKyB had knowingly tolerated the registration and use of SKYTEC for more than five years prior to the request for invalidity.

However, the Board of Appeal upheld the Cancellation Division's decision, stating that the circumstances of the case did not support a finding of acquiescence: the revocation was filed on 21 March 2012 but BSKyB was only furnished with evidence of Tronios' use of the SkyTec mark as part of the revocation action on 02 April 2007. There was a period of less than five years between the two dates (albeit by a matter of days).

GC requirements for acquiescence

Tronios further appealed to the General Court (GC), reiterating that the marks had coexisted in the UK, and that BSKyB must have been aware of the use of SKYTEC several days before applying to revoke the registration. Tronios tried to present new evidence before the GC, in support of the argument that BSKyB could be presumed to have had the requisite knowledge.

Continued on page 08...

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And finally...

Continued...

Tronios v BSKyB GC broadcasts rules for acquiescence loud and clear

The GC outlined four conditions that must be satisfied before the five-year period starts running in the context of acquiescence (see *Budějovický Budvar C-482/09*):

1. The later trade mark (in this case, SKYTEC) must be registered.
2. The application resulting in the later trade mark (SKYTEC) must have been made in good faith.
3. The later trade mark (SKYTEC) must be used in the member state where the earlier trade mark (SKY) is protected.
4. The proprietor (BSkyB) of the earlier trade mark (SKY) must be aware of the use of that trade mark (SKYTEC) after its registration.

The GC agreed with the Board of Appeal's finding that it was for Tronios to submit evidence that BSKyB had actual awareness of the use of the SKYTEC mark.

It could only be deduced with certainty that BSKyB had become aware of the use on receipt of Tronios' evidence of use on 02 April 2007. The fact that the marks co-existed in the market could not lead to a finding that BSKyB was aware of that use. The additional evidence adduced before the GC was inadmissible.

Author:
Flora Cook



In short

This decision provides a reminder about the requirements for acquiescence: the burden of proof is on the proprietor of the later mark to show that the holder of an earlier mark was actually aware of, and tolerated, the use of a later mark.

The GC decision is useful in that it supports the position that no negative inference can be drawn where an earlier rights holder does not file actions for revocation and invalidation simultaneously. The key is to make sure an unsuccessful revocation action is followed by the well-timed filing of an invalidation action.

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