D YOUNG & CO TRADE MARK NEWSLETTER no.143

November 2025
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Editorial

Since our last newsletter we're delighted to share some fantastic recognition from the legal directories. Our UK trade mark practice has achieved top-tier rankings once again in both Chambers and The Legal 500, which highlights our "outstanding expertise and client service". We're equally proud to see Munich partner Yvonne Stone and London-based Senior Associate Solicitor Peter Byrd named as IP Stars Rising Stars.

The team continues to grow, with Oscar Webb recently joining us as partner from CMS. Oscar brings extensive experience advising clients across the tech, media, leisure, retail and fashion sectors. We are also delighted to welcome Associate Rechtsanwältin Emily Peller and Rechtsanwältin Sophia Hassfeld to our Munich team. We are excited about the expertise and fresh perspective that our new colleagues bring to the team.

Matthew Dick
Partner, Solicitor

Events

INTA Leadership Meeting
18-21 November 2025, Florida USA
Partners Jana Bogatz and Anna Reid will be representing the team at the November INTA Leadership Meeting.

Domain name disputes - practical considerations and recent case law
28 January 2026, Webinar
This webinar is hosted by MBL and will be presented by partner Charlotte Duly.

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Distinctiveness / bad faith

Lip tapes and lawyers
UKIPO considers weak distinctiveness, bad faith and the weight of evidence

Two recent UKIPO opposition decisions demonstrate the pitfalls and evidential hurdles when relying on marks with low distinctive character and the impact of correspondence between parties when pleading bad faith. The contrasting outcomes highlight the importance of preparing a clear strategy, persuasive evidence and proper pleadings.

Cases discussed

Thelawyer.com Limited v Legaltech ApS (O/0844/25) (Thelawyer.com) and Laura Mocanu v Joanna Komisarczyk (O/0857/25) (Mocanu).

Distinctiveness

In Thelawyer.com, the applicant applied to register "The Lawyer Hub" in classes 35, 36, 41, and 42. The opponent relied on two earlier "The Lawyer" marks in classes 9, 16, 35, 38, and 41.

The hearing officer found the goods and services to range from identical to dissimilar. the marks in contention were held to be visually, aurally and conceptually similar to a medium degree.

The distinctiveness of the earlier marks was central to the hearing officer's decision. The applicant argued that the earlier marks lacked distinctive character, and while it was not open to the hearing officer to deem registered marks as descriptive or non-distinctive, she accepted that "THE LAWYER" may possess limited distinctiveness for some goods and services within the legal sector. Nevertheless, she maintained that this assessment could vary, noting that consumers might still perceive the earlier marks as distinctive, even if they remain inherently weak.

Following a detailed review of the opponent's evidence, the hearing officer found enhanced distinctiveness for certain class 41 services among legal professionals, though not more widely. Low distinctiveness was found in relation to all other goods and services relied upon.

It followed that, in evaluating the opponent's claims of confusion, reputation and passing off, the hearing officer was prepared to find in the opponent's favour only in respect of those services benefiting from enhanced distinctiveness namely, "news reporters services; publishing, reporting, and writing of texts" in class 41. The opposition failed in relation to the remaining contested services. Had the hearing officer been unwilling to recognise enhanced distinctiveness, albeit for a limited range of services, the opposition based on earlier rights would have failed entirely.

The Mocanu case concerned the comparison of figurative marks showing a lip taping technique. On first impression, the marks appeared to be visually similar and the services were identical, both covering beauty care and treatment services for the lips in class 44.

Opponent Mocanu's figurative marks are shown left, and applicant Komisarczyk's mark above (right). Images sourced from O/0857/25.

However, the confusion claim was unsuccessful as the opponent's marks were only distinctive to a very low degree. The overlapping elements, namely the image of human lips taped with strips, which feature in the application and opponent's marks, were descriptive of the relevant services. **When the marks at issue overlap in descriptive or non-distinctive elements, the distinguishing features will become more significant and carry more weight in the comparison.** Even though such elements were comparatively smaller or had less visual impact, the hearing officer noted that the wording in the corner, gold butterfly and the exact placement of tape in the opponent's marks were not replicated in the application.

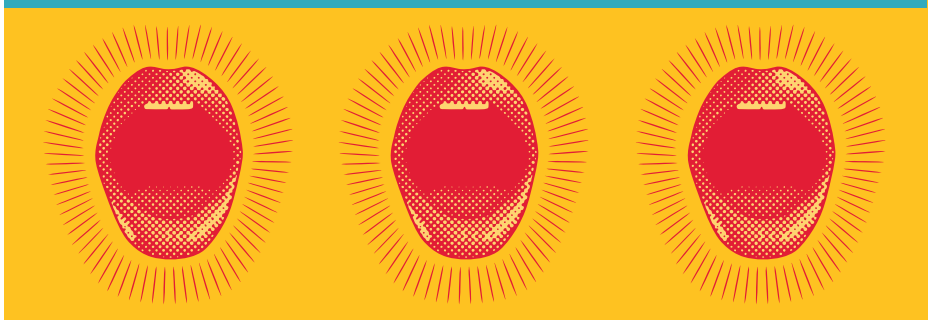
Bad faith

In Thelawyer.com the opponent submitted correspondence between the parties as

Case details at a glance
Jurisdiction: England & Wales
Decision level: UKIPO
Parties: Thelawyer.com Limited v Legaltech ApS
Citation: O/0844/25
Date: 16 September 2025
Decision: dycip.com/ukipo-o-0844-25

Jurisdiction: England & Wales
Decision level: UKIPO
Parties: Laura Mocanu v Joanna Komisarczyk
Citation: O/0857/25
Date: 18 September 2025
Decision: dycip.com/ukipo-o-0857-25

One UKIPO opposition related to "The Lawyer Hub" and another concerned lip taping



evidence of its bad faith claim. Whilst the applicant contested the admission of this correspondence due to its "without prejudice" nature, during a hearing earlier in proceedings the hearing officer decided that the material was not without prejudice and therefore admissible. The applicant's request for permission to appeal this procedural decision was refused.

Admission of this correspondence led to a finding of bad faith because the applicant stated that its intended use of "the lawyer hub" mark was to redirect consumers to its website named "the attorney hub"; thus, the application was filed primarily as a defensive measure. It was alleged that the applicant therefore admitted the application was filed as a defensive measure and a blocking mechanism rather than to put the mark to use, amounting to bad faith.

The hearing officer agreed that the application was filed not for genuine trade mark use but to secure exclusivity and extend any legitimately held protection over "The Attorney Hub." Its intended use, to capture and redirect consumers to another website, did not constitute trade mark use. Accordingly, the applicant failed to rebut the prima facie finding of bad faith, and the application was refused in full.

In Mocanu, the applicant had attended the opponent's masterclass on lip taping in November 2022, prior to the relevant trade marks being filed. As part of the course, the applicant signed an agreement not to use the opponent's marks without consent or use images of the opponent's technique without using the opponent's trade mark "LORÁN lips". A few months later, the opponent applied for the figurative marks relied upon in the opposition, and sent a text message informing the applicant that they had registered figurative trade marks and that, as a result, the applicant would now need a licence to use images of the technique. The applicant pushed back on this, noting that this was not in the agreement, which was signed before the trade marks were applied for.

The opponent relied on the applicant's knowledge of the opponent's marks, in combination with a breach of the agreement, to argue that the applicant's intention when filing the application was to cause confusion and damage the opponent's reputation. The applicant countered by arguing that the application depicts a different and novel technique, based on personal experience and attendance of more than 50 medical and aesthetic courses.

Ultimately, the hearing officer sided with the applicant, noting that mere knowledge of another party's use of a mark is not sufficient, in isolation, to establish bad faith. The hearing officer conceded that use of Dr Mocanu's "LORÁN Lips" technique without crediting the opponent would be a breach of the agreement but noted that:

- any reference to the trademarked techniques within the agreement does not cover the marks relied on in the opposition (which were filed later); and
- the application is not an image of Dr Mocanu's technique, due to the differing placement of the tapes.

Further, the application shows the result of a technique, not a technique itself (which cannot be protected under trade mark law).

This case shows the importance of proper pleading for bad faith claims; it is a serious allegation and the burden is on the opponent.

Key takeaways

A key takeaway from both cases is the challenge faced by proprietors relying on marks with low inherent distinctiveness. Even though marks can be considered similar or an earlier mark has demonstrable reputation, if the mark relied upon possesses low inherent-distinctiveness, enforcement becomes significantly harder. As shown in Mocanu, minor differences between marks can extinguish a confusion claim and this is a core issue with obtaining registration for "borderline" trade marks which only **just** get over the distinctiveness line. In such cases, it is crucial to develop a robust body of persuasive evidence capable of supporting an enhanced distinctiveness claim in order to elevate the overall distinctiveness of the mark and assist with enforcement. As shown in the contrasting outcomes of these cases, such evidence can make or break a confusion claim.

Treatment of pre-action correspondence is also highlighted in Thelawyer.com. Despite the applicant's claims that the communications were "without prejudice" and therefore inadmissible, the correspondence was admitted into proceedings as evidence, demonstrating how critical it is to clearly and appropriately label communications. This serves as a stark reminder that missteps in this respect can have significant consequences for a party's position in opposition proceedings. Had the correspondence been deemed "without prejudice", the opponent's bad faith claim would likely have failed.

Correspondence between the parties was also relevant in Mocanu, highlighting the importance of drafting clear agreements which incorporate all relevant trade marks, but it is also a reminder that mere knowledge of another party's mark is not sufficient to successfully plead bad faith.

Authors:
Abigail Macklin & Rachel Pellatt

CJEU: no room for national provisions on forfeiture of rights

EU Trademark Directive fully harmonises acquiescence

Case details at a glance
Jurisdiction: European Union
Decision level: CJEU
Parties: Lunapark Scandinavia Oy Ltd v Hardeco Finland Oy
Date: 01 August 2025
Citation: C 452/24
Link to decision: dycip.com/c-452-24

In its recent Lunapark v Hardeco judgement (C-452/24), the Court of Justice of the European Union (CJEU) has delivered a clear message: national procedural doctrines regarding forfeiture of rights have no place alongside the harmonised regime of acquiescence under the EU Trademark Directive (TMD).

The question before the CJEU

The dispute arose between two Finnish confectionery producers, both marketing sweets under the name Dracula. Lunapark filed a national application for the mark DRACULA in 2003, obtaining registration in 2009. Its competitor, Karkkimies, had long used the same name without any registration. When Lunapark finally initiated an infringement proceeding against Hardeco in 2020 (the successor of Karkkimies) the Finnish Market Court dismissed the action. It relied on an established principle of Finnish private law: a claimant must bring an action or otherwise assert their right within a reasonable time following the date on which they became aware, or should have become aware, of the facts on which the claim is based. In the present case, the Finish Court ruled that Lunapark had waited too long to act. On appeal, the Finish Supreme Court referred the question to the CJEU: Does Article 10 of the TMD preclude the application of a national principle under which the proprietor of a trade mark could forfeit the right to prohibit a sign – even in cases other than those covered by Articles 18(1) and 9(1) or (2) of the TMD – if, despite being aware of that use, the proprietor fails to seek a prohibition within a reasonable time?

Article 10 TMD grants exclusive rights to the proprietor of a registered trade mark. These exclusive rights are limited by Articles 18(1) in conjunction with 9(1) and (2) TMD, namely where the defendant owns a later registered mark that cannot be declared invalid, because the proprietor has acquiesced on the use of the defendant's later registered mark for a period of five successive years while being aware of it. In such cases, the proprietor of the earlier mark cannot take action against the registration and use of the later registered mark unless the later was applied for in bad faith. However, since Article 9(1) TMD applies only to registered later marks, and not to unregistered signs, the question arose, whether national principles can fill this gap. Unlike Article 9(1) TMD, national doctrines for forfeiture do not require the later trade mark to be registered but are based solely on whether the proprietor knew or should have known of the facts giving rise to the claim.

The dispute arose between companies both markteting sweets under the name Dracula

The CJEU's ruling

The court ruled that Article 18(1) in conjunction with Article 9(1) and (2) TMD fully harmonise the conditions under which a trade mark owner may lose the right to prohibit use due to inaction. Even though that provision only refers to later registered trade marks (not to unregistered signs) it precludes member states from introducing broader national rules, such as general principles of forfeiture. In the court's view, allowing national doctrines would undermine uniform protection and legal certainty. Therefore, in infringement proceedings concerning national trade mark registrations, no national forfeiture rule applies under any circumstances, unless the precise requirements of Article 18(1) TMD in conjunction with Article 9(1) or (2) TMD are met. As a result, the owner of a national trade mark may always act against infringing use if the defendant holds no trade mark registration, even when the owner was aware of that use.

Commentary and critique

The decision reflects an absolutist interpretation of harmonisation. But the logic falters when compared with the court's own reasoning in design law. Under Article 88(2) of the Community Design Regulation, national law applies to procedural matters not governed by the Regulation. This applies also to limitations and forfeiture of rights, as the CJEU confirmed in its decision Gautzsch/MBM Joseph Duna (C-479/12). Similarly, Article 129 EU Trademark Regulation (EUTMR) provides that national law governs trade mark matters not covered by the EUTMR. If national law is "good enough" to fill gaps for EU design rights and EU trade marks, why not for national trade marks under the Directive? To resolve this inconsistency, this judgment would also need to be applied to EU trade marks, despite Article 129 EUTMR referring to national law. By excluding national forfeiture doctrines even in cases where the Directive is silent, the CJEU is causing uncertainty rather than resolving it.

In short

Trade mark owners and practitioners should draw one practical conclusion: register early and act promptly. Registration not only confers exclusive rights but also starts the clock on the five-year acquiescence period; a critical safeguard under EU law. So, this Halloween, whether you prefer Lunapark's or Hardeco's Dracula sweets, make sure your mark is registered before the vampires, or your competitors, come for you.

Author:
Julian Graf Wrangel

Bottle labels
Copyright infringement and passing off

Case details at a glance
Jurisdiction: England & Wales
Decision level: High Court (IPEC)
Parties: Shantell Martin v (1) Bodegas San Huberto Sa, (2) GM Drinks Limited, (3) Marc Patch
Date: 24 July 2025
Citation: [2025] EWHC 1827 (IPEC)
Decision: dycip.com/2025ewhc1827-ipec

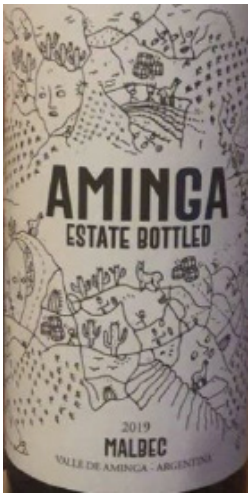
Images in this article are sourced from [2025] EWHC 1827 (IPEC).

Protection is available to artists, where the copying is substantial, and where they have generated goodwill in relation to their art. A recent decision considers some interesting points including whether artists can generate goodwill in relation to works of art, what circumstances constitute joint tortfeasorship and what level of damages might be appropriate when an artistic work has been copied and applied to a product.

Background
Shantell Martin is a world-renowned artist, known for her distinctive line drawings (most notably created for an exhibition in Buffalo, New York):

Ms Martin also designs, sells and endorses products which feature the artwork, or extracts from it, on them. She has an extensive online presence and reputation.

In 2020, GM Drinks began importing AMINGA wine from Argentina into the UK, the wine had a decorative label that was similar to (and had taken certain bits from) Ms Martin's artwork, below:



Fans of Ms Martin contacted her to express their surprise that these bottles were not attributed to her. Ms Martin contacted GM Drinks, which changed the label (twice). However, she commenced proceedings in 2022.

Proceedings
The key claims brought by Ms Martin were:

- "Primary" copyright infringement (for importing and issuing copies of a work to the public)
- "Secondary" copyright infringement (for possessing and dealing in copies of a work)
- Passing off

Ms Martin brought the claim against the winery, the importer and a director of the importer.

Decision: direct liability
On copyright infringement it was held that:

- The first label clearly copied a substantial part of the work as it reproduced the parts which were expressions of Ms Martin's intellectual creation.
- Even though the second label was an "endeavour to avoid infringement", it was not a substantial copy of the work and so was not infringing. The third label was even further away.

This meant that the importer was liable for primary infringement (importing and issuing of copies). The importer was only liable for secondary infringement for the period after they received the letter before action from Ms Martin, as liability in this regard requires knowledge of the infringement. The winery and the director of the importer were not directly liable for infringement.

On passing off it was held that:

- Ms Martin had established considerable reputation in her artistic style, which she exhibited in the UK. She also collaborated with others to apply the style on physical products sold in the UK. Therefore, she had considerable goodwill.
- There was evidence that fans had been misled, in relation to the first label.
- Damage then followed naturally.

The importer was liable for passing off. The winery and the director of the importer were not directly liable for passing off.

Decision: joint tortfeasorship
The importer was the only defendant actually committing the acts of infringement in the UK. However, Ms Martin also claimed that the winery and the director of the importer were jointly liable on the basis that they had "actual or constructive knowledge of the essential facts which made the act of the primary wrongdoer tortious". On the facts, the judge held that both were liable for copyright infringement for the period after receipt of Ms Martin's letter before action; given that they did have notice of the facts from this point on. They were not jointly liable for the passing off claim as this was not properly made out in the letter.

Remedies
The final point to be decided was the level of damages payable. In relation to copyright, no damages were awarded for innocent infringement (the period before the first letter before action). The judge was clearly not in agreement with the $200,000 claimed by Ms Martin (which she said was reflective of the fee she would normally command for this type of commission). The parties were given a short period to attempt to settle, failing which the matter will be transferred to the small claims track for the quantum to be decided.

In short
This case is a useful reminder that creatives can enforce their valuable IP where it has been copied. Importers need to be careful as they may attract liability even where they are not actually applying the infringing work to the products. It is also a reminder that liability can attach to entities that are not directly involved in an infringement, if they are complicit in any wrongdoing.

It will be particularly interesting to see the decision on damages (should the parties not settle before).

Author:
Peter Byrd

Acquiring earlier marks, fame negating confusion and (not) a family of marks argument

easyGroup v Premier Inn Hotels

Case details at a glance
Jurisdiction: England & Wales
Decision level: High Court
Parties: easyGroup Limited v Premier Inn Hotels Limited
Date: 29 August 2025
Citation: [2025] EWHC 2229 (Ch)
Decision: dycip.com/2025ewhc2229-ch

Images in this article are sourced from [2025] EWHC 2229 (Ch).

In August 2025, easyGroup's trade mark infringement claim against Premier Inn's use of signs containing "REST EASY" in relation to hotel services was dismissed by the UK High Court. The claim was brought for trade mark infringement under sections 10(2) (a likelihood of confusion) and 10(3) (reputation) of the Trade Marks Act 1994. Three interesting points were raised within this decision, summarised below.

easyGroup was able to amend its original claim to rely on an earlier mark assigned to it after the claim had been issued

easyGroup's original claim, issued in September 2023, was brought solely under s10(3) of the Trade Marks Act 1994 in respect of its easyHotel Mark and easy (figurative) mark:

In an assignment dated 24 January 2024, easyGroup acquired a registration for the word mark REST EASY APARTMENTS, registered in respect of services such as rental of apartments in class 36. The mark was acquired in settlement of a trade mark infringement claim brought by easyGroup against the former trade mark owner. The former owner had not asserted any trade mark infringement by Premier Inn. In March 2024, by amendment, a claim was added solely under s10(2) of the Trade Marks Act 1994 in respect of easyGroup's REST EASY APARTMENTS mark and its class 36 services. Notably:

- easyGroup's solicitors first wrote to Premier Inn in February 2023, before easyGroup had acquired the REST EASY APARTMENTS mark; and
- easyGroup did not rely on any use of the REST EASY APARTMENTS mark (and were not required to).

Use of a "well-known brand name" was a relevant consideration in negating a finding of a likelihood of confusion

Premier Inn was found to be using signs (shown below) using "Rest easy" alongside the words "Premier Inn" and a moon device:

The High Court noted that the judgment of Combe International v Dr August Wolff [2022] EWCA Civ 1562 had indicated that "…the fact that the start of a composite sign is a well-known brand name may avoid the risk of confusion if it was otherwise present but will not necessarily do so. It must be part of the total global assessment to be undertaken." Applying this principle, the High Court concluded that "Premier Inn is a very well-known brand name in the UK, which would negate any likelihood of confusion".

Various methods can be used to establish a reputation and enhanced distinctiveness

easyGroup attempted to illustrate a reputation and enhanced distinctiveness in its easy (figurative) mark and easyHotel mark in the following methods:

1. Survey

easyGroup was granted permission to file survey evidence. However, the High Court suggested that it did not have real value. It was stated that this was not to be seen as a criticism of the survey design, but rather "…a realistic assessment of the difficulty of designing a survey which both complies with the Whitford guidelines and provides meaningful answers." The Whitford guidelines have established rules for survey evidence in UK trade mark cases since the 1980s.

2. Use as part of composite marks

The High Court accepted that it was possible for the easy (figurative) mark to have acquired distinctiveness by use as part of easyJet or easyHotel. However, on the basis of the evidence filed, the High Court found that whilst the evidence showed that consumers associated the easy (figurative) mark with easyJet and airline travel and to a much lesser extent with easyHotel and hotels, that was not evidence that the easy (figurative) mark itself had enhanced distinctiveness, concluding "Association is not sufficient to establish enhanced distinctiveness."

3. (Not) a family of marks?

Notably, earlier in proceedings easyGroup disavowed any intention to rely on the "family of marks" principle. Nonetheless, it sought to rely on the reputation of brands within the "easy Travel Family", namely EASYJET, EASYCAR and EASYBUS, purportedly brands known for offering low-cost services in the travel sector, as a basis for saying that the easyHotel mark had gained a reputation for low-cost hotel services. easyGroup's counsel described this as "a new member of the easy Travel Family coming along and getting a sort of rocket booster effect so that they get instant fame, albeit that they do not get reputation and enhanced distinctiveness until they have started to trade". However, the High Court found this to be "…a family of marks argument, directed at establishing reputation for the purposes of the s.10(3) claim." Therefore, easyGroup could not rely on it.

In the event that the High Court was wrong on this, it found that given the lack of reputation or enhanced distinctiveness in the relevant accommodation rental services, association with the easy Travel Family could not confer on the easyHotel mark the necessary reputation and enhanced distinctiveness in the relevant services, commenting, "If it were otherwise, there would be no magic in limiting this to the easy Travel Family. It would logically apply to all of the "easy" brands as they all claim to offer low-cost, no frills service. To hold that a trade mark could obtain reputation and enhanced distinctiveness in particular services because of an association with trade marks sharing some similarity, but registered for and/or trading in different services would be to extend the protection given by trade marks well beyond the protection provided for under statute."

In short

The case serves as a useful reminder that the context of use of a sign is important when assessing trade mark infringement, and that using a very well-known brand name in conjunction with a sign of arguably relatively low inherent distinctive character (such as REST EASY) may be sufficient to obviate a lack of confusion; but not always.

Author:
Sophie Rann

Who knew air vents could be so interesting! General Court decision expands the concept of partial use

Case details at a glance
Jurisdiction: EU
Decision level: General Court
Parties: Bouwbenodigdheden Hoogeveen BV v EUIPO
Date: 09.07.2025
Citation: T-144/24
Link to decision: dycip.com/t-144-24

The applicant, Bouwbenodigdheden Hoogeveen BV (BHB) has a European Union trade mark (EUTM) registration for BIENENBEISSER covering metal building materials including "air vents" in class 6 and "building materials (non-metallic), including air vents" in class 19. In 2021, a third party filed an application for revocation of the EUTM arguing non-use.

Background

BHB provided evidence of use for metal air vents in class 6, which led the Cancellation Division of the EUIPO to revoke the contested mark for all goods, except for metallic air vents in class 6.

BHB appealed to the EUIPO's Board of Appeal and was unsuccessful, so it filed an action with the General Court. The action was limited to the revocation of non-metallic air vents in class 19.

It was undisputed that BHB had used its trade mark for metallic air vents in class 6. The question was whether this also constituted genuine use for non-metallic air vents in class 19.

BHB submitted that it made genuine use of the contested mark in connection with the homogeneous category of goods "air vents" in both classes 6 and 19. According to the applicant, the proof of use of the mark which it provided for metallic air vents meant that the registration of the mark could also be maintained for non-metallic air vents. The fact that metallic and non-metallic air vents come within two different classes of the Nice Classification does not call into question the fact that "air vents" constitute one and the same homogeneous category of goods. First, the classification system was adopted for purely administrative purposes. Second, metallic and non-metallic air vents have the same purpose and intended use, namely to prevent pests from entering spaces in brick structures, while maintaining the ventilation of those structures, with the result that those two types of air vent are interchangeable.

The General Court's decision

The General Court upheld the appeal for the following reasons:

Bouwbenodigdheden Hoogeveen BV's EUTM related to air vents

- A consumer who wishes to purchase a product in a category that has been defined particularly precisely and narrowly, which cannot be significantly divided into further subcategories, will associate all the goods belonging to that category with the contested mark, so the mark will fulfil its essential function of guaranteeing the origin of those goods or services. Therefore, if genuine use is established for some of the goods in such a homogeneous category, genuine use has to be accepted for all goods in that category.
- This approach is supported by the concept of partial use, which is to prevent a trade mark owner from losing all protection for goods which, although not strictly identical to those in respect of which genuine use has been proven, are not in essence different from them and belong to a single group, which cannot be divided other than in an arbitrary manner. Thus, a trade mark owner does not need to establish use for all the commercial variations of similar goods but merely for goods which are sufficiently distinct to constitute coherent categories.
- The determination of a homogeneous group must be based on the purpose or intended use of the goods because the consumer's choice is based on these criteria. It is decisive whether a consumer who wishes to purchase a product falling in the category of goods covered by the mark in question will associate all the goods belonging to that category with that mark. The judges found that the classification of the goods does not play a role in determining a coherent category.
- BHB had submitted evidence that metallic and non-metallic air vents have the same intended use, purpose, appearance, distribution channels and are equally effective, resistant and efficient, with the result that, when those goods were purchased, the material from which they are made plays only a secondary role in the consumer's choice.
- The court held that the Board of Appeal did not provide sufficient reason as to why these arguments were not sufficient to establish that metallic and non-metallic air vents were not part of a homogeneous group. The judges also dismissed the EUIPO's argument that BHB "chose" to file for the registration of metallic and non-metallic air vents in two different classes. BHB had to do this because the Nice Classification requires protection in two different classes, depending on the materials of the products.

Takeaway

The decision builds considerably on the principle of partial use and as a consequence, owners of marks that have been registered for goods or services in different classes but which fall into the same homogeneous category need only to establish genuine use for one of these goods in order to maintain or enforce their registration for all terms in that category. Presumably, this finding would also apply to goods or services in the same class which fall within the same clear category.

Author:
Kate Cheney

And finally...

Bad faith

UKIPO application of SkyKick Grain Connect Limited v Grayn AS

Grayn AS (the holder) was unrepresented and applied for the word mark "Grayn" as an international registration designating the UK. An opposition was filed on the grounds of bad faith, a likelihood of confusion and passing off. The bad faith claim was almost entirely successful and is the focus of this summary. The likelihood of confusion and passing off claims both failed. It was particularly noted that the bad faith claim had removed the overlapping categories.

The specification applied for spanned 66 pages and included "fire engines", "spectacle chains", "betting software" and "metallurgical laboratory services". The opponent claimed the holder had no *bona fide* intention to use the mark for such a diverse range of goods/services, and requested the specification be limited to reflect only terms for which the holder had a genuine intention to use the mark.

Grayn filed a defence and counterstatement, but did not file any other evidence. The counterstatement declared the holder had existed for a substantial period of time; had secured other registrations; and that Grayn's business offers "a unique software platform for sustainability accounting and provides sustainability consulting services".

The mere fact a holder has registrations in other jurisdictions did not justify a broad specification in the UK, and the UKIPO noted the holder did not explain whether any other jurisdictions (such as the base mark territory) operate an intent to use regime or encourage applicants to use broad terminology in specifications.

Based on how both parties had described the holder's business, the UKIPO upheld the bad faith claim in relation to all goods/services except for software for sustainability accounting and sustainability consulting services. Applying this finding to the exact terms applied for, the UKIPO proposed to limit the specification down to just two terms, and then to limit those terms further as shown by the bold:

- "accounting software **relating to environmental sustainability**"; and
- "environmental consultancy services **relating to sustainability**".

Without any other evidence or supporting materials, the UKIPO did not determine whether any ancillary goods/services were commercially reasonable.

As the UKIPO could not unilaterally limit the specification to the above, Grayn was granted a short deadline to either confirm they agreed, or to put forward alternative wording. The UKIPO has since issued a supplementary decision refusing the UK designation **in full**, as the holder did not respond.

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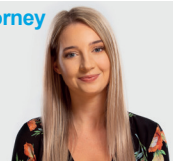

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