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Editorial

Welcome to our first newsletter of 2024. May we take this opportunity to wish you all a happy, healthy and prosperous New Year.

As we look ahead to the year to come, this newsletter touches on developing topics such as the growing metaverse sector, changes in UK law concerning acquiescence, and well known marks. We also cover infringement proceedings at the CJEU and UK High Court, as well as providing an update on the ongoing invalidation proceedings between the NBA and Pizza Texas Bulls.

We also take this opportunity to note that the UK address for service rule changes have now come into effect, as of 01 January 2024. Any party wishing to rely on or enforce a UK comparable trade mark or a re-registered design in UK contentious proceedings, must now appoint an address for service residing in the UK. Failure to do so could result in delays, or even, in the worst case scenario, loss of rights. If you are still to appoint a UK address for service for these rights, or if you have any questions relating to the same, do contact your usual D Young & Co advisor.

Gemma Kirkland, Editor

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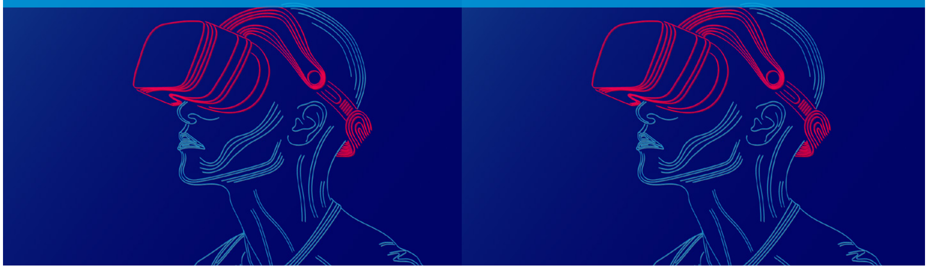
Protection / enforcement

The (EU) metaverse
Trade mark protection and enforcement

The metaverse sector is expected to be worth $800 billion by as early as 2024



The metaverse is a rapidly evolving space, and with it comes new challenges for trade mark protection and enforcement. In the real world trade marks protect brands by preventing others from using confusingly similar signs for similar goods or services. But in the metaverse, where virtual goods and services can be easily copied and distributed, trade mark protection can be more difficult to enforce.

If you are unfamiliar with these terms our articles “Brand enforcement in the metaverse - time for a re-think?” and “Nice classification: virtual goods and NFTs” contain helpful information (see “useful links” at the top of page 03).

As a recap, the metaverse is a collective term for digital, 3D worlds of experience in which people come together to play, shop, meet colleagues or attend concerts. It is anticipated to reach one billion people by the end of the 2020s. The market potential is immense: the metaverse sector is expected to be worth $800 billion by as early as 2024. It is likely that there will be virtual 3D online markets with customisable avatars consuming almost all the goods and services we also use in the real world, from virtual clothing to education and social events. With the help of non-fungible tokens (NFTs) digital objects can be uniquely assigned to an owner. They represent a new form of digital deed that relies on blockchain technology and, *inter alia*, provide proof of ownership and provenance of the underlying digital asset.

Registration

There are still steps that companies can take to protect their brand in the metaverse. One important step is to register trade marks for virtual objects. Trade marks are divided into 45 classes of goods or services. Accordingly, their scope of protection is determined. However, classification is not always easy in the metaverse due to its vague nature and the lack of clarity about the nature of digital assets and related services, which may not have counterparts in the real world. Further, it is still unclear whether registrations for physical goods will also protect against virtual imitations.

Due to the increasing number of trade mark applications at the EU Intellectual Property Office (EUIPO) with terms relating to “virtual goods” and “non-fungible tokens (NFTs)”, the EUIPO issued initial guidelines on classification. Virtual goods and NFTs are to be treated as digital content or images (class 9). Services related to such goods are to be treated according to the established practice for the classification of services.

In the most recent (12th) edition of the Nice Classification, which took effect on 01 January 2024, the term “downloadable digital files authenticated by non-fungible tokens (NFTs)” was included in class 9 as well as certain other classes updated, that is:

- class 25: “clothing authenticated by non-fungible tokens (NFTs)”
- class 35: “retail services relating to downloadable digital image files authenticated by non-fungible tokens (NFTs)”; and
- class 42: “providing online non-downloadable computer software for minting non-fungible tokens (NFTs)“.

Useful links

Brand enforcement in the metaverse: time for a re-think?: dycip.com/brandenforcement-metaverse

Nice classification: virtual good and NFTs: dycip.com/virtualgoods-nfts

Non-fungible tokens and the Metaverse, EUIPO: dycip.com/euipo-nonfungibletokens

Nice Classification 12th edition (PDF): dycip.com/wipo-niceclassification-12

Virtual goods	Real-world goods
(Downloadable) virtual clothing in class 9	Clothing in class 25
(Downloadable) virtual handbags in class 9	Handbags in class 18
Retail of virtual clothing in class 35	Retail of clothing in class 35

In this context it needs to be kept in mind that the terms "virtual goods/services" and "NFTs" are both not sufficiently clear when used alone. The term "virtual goods" must therefore be further specified by function, purpose and nature, indicating the content to which the virtual good relates (for example, downloadable virtual good, namely virtual clothing). Also "virtual services" must be further specified according to the nature and intended purpose of the service, taking into account its impact in the real world (for example, simulated travel services provided in virtual environments for entertainment purposes). For NFTs, the type of digital item authenticated by an NFT must be specified. In order to illustrate this, please see the classification examples in the table above.

Leaders in this context are the online gaming platforms such as Roblox, Fortnite and Second Life, where players can experience life through a 3D, personalised avatar, wearing their favourite brands and buying digital outfits in virtual stores. In particular, famous fashion brands (such as Nike, Gucci, and Balenciaga) have discovered this new market and are working with gaming platforms offering digital wearables for avatars. Nike, for example, has brought its virtual mini-game "Nikeland" to Roblox, and runs its own virtual items store on the gaming platform.

Protection and enforcement in the metaverse

In addition to registering trade marks, brand owners should be vigilant about monitoring the metaverse for potential infringements. This includes monitoring websites, social media accounts, and other online platforms and marketplaces that are using confusingly similar signs in the virtual world. Most of these gaming platforms, like traditional online marketplaces, offer mechanisms for reporting and taking down IP right infringements.

But is a virtual shoe or handbag a (physical) shoe or handbag which would constitute a trade mark infringement? Hermès faced a situation where a digital designer was selling over 100 virtual "MetaBirkins", inspired by its famous Birkin bag, on a metaverse marketplace. Having not extended the trade mark protection to virtual goods, it nevertheless won in the first substantive US decision on the scope of trade mark protection in the virtual world (Hermès International v Mason Rothschild, Case 1:22-cv-00384-JSR). The use was recognised as an infringement of the Hermès trade mark rights for physical goods.

Returning to the EU, and in the absence of case law, there are arguments for both sides, and maybe better ones for the assumption that virtual goods and corresponding physical goods can be recognised as being competitive or complementary and thus confusingly similar, even if the trade mark owner is not yet active in the metaverse.

Nevertheless, owners of well-known brands seem to be in a better position since trade mark protection is not restricted to the use of the sign for similar goods: the rights can be invoked on the basis of exploitation of reputation and dilution. However, the same questions apply, namely whether brands can leverage their real world reputation relating to virtual goods and services (which should be answered affirmatively).

In relation to the protection and enforcement of trade marks in the metaverse, there is one particular point to be cautious about, namely the relevant territory (EU member state). It is not yet clear what scope national trade marks will have in the borderless virtual universe. In a recent decision the General Court (13/07/2022, T-768/20, The standard (fig.), EU:T:2022:458) provided further guidance and ruled that only the place of use of the mark is relevant (including advertising and offering for sale) and not the place of provision of the goods/services. In the digital environment it will be crucial that the virtual goods/services, even if provided "abroad" in the metaverse, are targeting consumers in the EU, and that the advertising and offering for sale occurs in the relevant territory.

Author:
Gabriele Engels

In short

Companies can protect their trade marks in the virtual world, even if the products or services are not physical. However, as things currently stand, a number of questions are unanswered regarding the enforcement of trade marks protecting real-world goods against unauthorised use in the virtual world.

Companies should not rush to file trade marks covering virtual goods when they may have no genuine intention to use their mark online in that way. However, when they are planning to use it in the virtual universe, or want to prevent potential infringements, the metaverse should be part of their trade mark strategy. It is vital to review the territorial scope of the existing trade mark portfolio and extending the trade mark protection to virtual goods and services. Further, trade mark owners should take proactive steps to monitor and enforce their IP rights, including monitoring marketplaces and third party applications.

Acquiescence

The knowledge requirement for acquiescence Court of Appeal guidance

Case details at a glance
Jurisdiction: England & Wales
Decision level: Court of Appeal
Parties: Industrial Cleaning Equipment (Southampton) Limited and Intelligent Cleaning Equipment Holdings Co Ltd & Killis Limited
Citation: [2023] EWCA Civ 1451, [2023] WLR(D) 511
Date: 06 December 2023
Decision: dycip.com/2023-ewca-civ1451

The Court of Appeal has provided further guidance on the knowledge requirement for acquiescence in the UK, and in doing so has departed from retained EU law.

Brief background

Industrial Cleaning Equipment (Southampton) Ltd (ICE UK) has been using the ICE brand in relation to the sale and rental of cleaning machines in the UK for many years. Intelligent Cleaning Equipment Holdings Co Ltd, a British Virgin Islands company (ICE BVI), started importing small quantities of cleaning machines bearing the mark ICE into the UK in 2014. ICE UK became aware of some use of the ICE mark on the market in the UK by ICE BVI in July 2014.

ICE BVI filed international registrations for ICE in 2015. The international registrations were registered at the EUIPO in 2016. ICE UK was not aware of these registrations until July 2019, but filed its own UK trade mark in October 2015.

Despite several rounds of correspondence between the parties no resolution was reached, and a claim was issued on 24 May 2021 (just under five years after registration of ICE BVI's international registration (EU) marks).

First instance

The judge found that ICE BVI's trade marks were invalid on the basis of passing off, and that ICE BVI were infringing ICE UKs trade marks in the UK.

ICE UK had not acquiesced to ICE BVI's marks, in particular because (following Budvar C-482/09) the five-year period for acquiescence only started running when ICE UK became aware of ICE BVI's registrations, which was in July 2019.

Appeal

The two main points on appeal were:

- Does the owner of an earlier right need to know about the use **and registration** of later trade marks for the statutory acquiescence period to start running; and
- In the case of international registration (EU) marks, does the period of acquiescence run from the World Intellectual Property Organization (WIPO) registration date, or from the date of grant of protection at the European Union Intellectual Property Office (EUIPO).

In answer to the first question, the Court of Appeal held that knowledge of use of the registration is all that is required to start time running in relation to statutory acquiescence. In doing so, the Court of Appeal departed from CJEU case law, which was justified on the basis that:

- This point was not the dispositif (that is, the Court of Justice of the European Union's (CJEU) formal answer to the question) in Budvar C-482/09, as knowledge of the registrations was not in issue.
- There is mixed judicial precedent on this point even in the EU. Cases such as Ghibli and the EUIPOs own guidelines, suggest knowledge of the registration is not required; and
- Departing from Budvar did not create issues in relation to legal certainty, as few trade mark proprietors would have based their commercial strategy on this point.

In answer to the second question, the Court of Appeal held that acquiescence in relation to EU international registrations runs either from acceptance of the registration by the EUIPO, or from publication of the statement of grant of protection by the EUIPO (the Court of Appeal did not need to decide which in this case as it did not make a difference to the outcome). Ultimately the appeal was dismissed.

Key lessons

1. There is a new test for acquiescence in the UK. The owner of the earlier right only needs to be aware of the use of a registration, not the fact of it, for the five-year period to start running.
2. This is perhaps not surprising following other recent cases (including Combe), in which there has been increasing emphasis on knowledge of use as being the critical factor in acquiescence. This raises the question of whether we will ultimately move towards a position of "constructive knowledge" in the UK, that is, in the future, will it be enough to say that the owner of the earlier right has acquiesced to a registration because they should have known that the same was being used?
3. The five-year period for acquiescence starts from actual date of registration, which in the context of international registration (EU) marks is when registration is granted by the EUIPO.
4. A separate, but helpful, point of clarification is that statutory acquiescence is also a bar to passing off claims.

Disclaimer: D Young & Co acted for the successful claimant/respondent Industrial Cleaning Equipment (Southampton) Limited (ICE UK) in this claim. This article is an academic summary of the case, not a statement on behalf of D Young & Co or ICE UK.

Author:
Peter Byrd

Useful links

[2023] EWHC 411 (IPEC):
dycip.com/2023-ewhc-411ipec

Budvar C-482/09 (Budějovický Budvar, národní podnik v Anheuser-Busch Inc):
dycip.com/c-482-09

Ghibli (R 1299/2007-2 Cristanini v Ghibli SpA) EUIPO Trade Mark Guidelines, 4.5.3. Acquiescence:
dycip.com/acquiescence-euipo-guidelines

Combe [2022] EWCA Civ 1562, [2023] Bus LR 532, [2022] WLR(D) 477 (Combe International LLC and Combe International Limited v Dr August Wolff GMBH & CO KG Arzneimittel and Acdoco Limited):
dycip.com/2022-ewca-civ1562

Not an easy win
easyGroup loses infringement claim and EASYOFFICE trade marks

Case details at a glance
Jurisdiction: England & Wales
Decision level: Court of Appeal
Parties: easyGroup Ltd v Nuclei Ltd & Ors
Citation: [2023] EWCA Civ 1247
Date: 27 October 2023
Decision: dycip.com/easygroup-oct2023

A legal battle spanning two decades reaches an end, as the Court of Appeal issues its decision on whether the use of EASY OFFICES infringed easyGroup's registered rights in EASYOFFICE.

Background
The appellant, easyGroup Limited, owned various trade mark registrations for the mark EASYOFFICE (both word and figurative), in the UK and EU, for services in classes 36 and 43, which broadly covered the rental of office spaces. Since 2000, the respondents, Nuclei Limited and others, had brokered serviced office spaces under a brand called EASY OFFICES. easyGroup sued Nuclei for trade mark infringement in accordance with section 10(1) of the Trade Marks Act 1994 (identical mark for identical goods/services), and section 10(2) of the Trade Marks Act 1994 (likelihood of confusion). Nuclei counterclaimed for revocation of the easyGroup's trade marks on the basis that the easyGroup had not made use of them.

First instance
The first instance judge concluded that Nuclei had not infringed easyGroup's EASYOFFICE marks. First, the judge found that the services covered by the trade mark registrations were different to those provided by Nuclei, so the section 10(1) of the Trade Marks Act 1994 claim failed. The judge also found that there was no likelihood of confusion, and she particularly relied on the fact that there was an absence of evidence of confusion, noting that the parties had been trading side by side for five years. Even if there was confusion, the judge held that such confusion should be tolerated given the honest concurrent use by Nuclei. Thus, the section 10(2) of the Trade Marks Act 1994 claim also filed. Finally, in relation to the revocation counterclaim, the judge found that easyGroup had not sufficiently proven a real commercial exploitation of the EASYOFFICE registrations, and so the revocation claim succeeded.

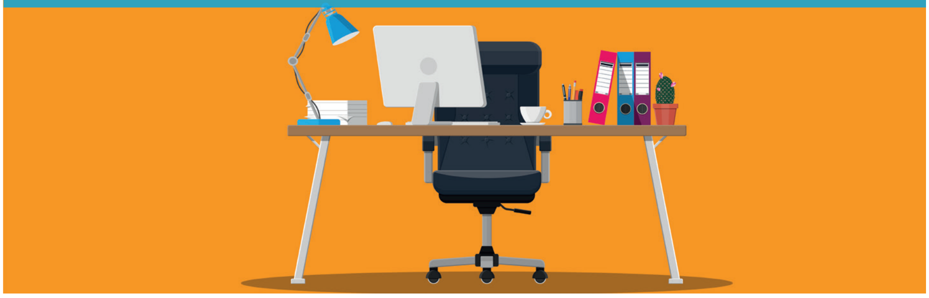
Trade mark infringement
Dealing with the section 10(1) of the Trade Marks Act 1994 claim first, L J Arnold found that the services provided by Nuclei were identical to the services covered by easyGroup's registrations. However, he considered that the marks EASYOFFICE and EASY OFFICES were different. In a section 10(1) of the Trade Marks Act 1994 claim it is not a matter of whether the marks are confusingly similar, but rather whether the differences between the marks would go unnoticed. The marks differed visually and aurally, as EASYOFFICES had an additional letter and an additional syllable and the marks were conceptually different, in that EASYOFFICES was plural rather than singular. Such differences would not go unnoticed by consumers.

Turning to the section 10(2) of the Trade Marks Act 1994 claim, easyGroup argued that the judge had failed to recognise that there had been relatively little opportunity for confusion to occur. However, L J Arnold stated that the judge's overall assessment as to the likelihood of confusion was one that was open to her, and she was entitled to find that, given the long period of honest concurrent use and the lack of evidence of actual confusion, there was no infringement. The judge clearly took the view that confusion should have been relatively straightforward to detect given the online nature of both businesses, and that such evidence would have emerged during the long period when the two businesses had traded side by side.

Revocation
In its appeal, easyGroup argued that the judge should have found that there was use of the trade marks, and that the judge's approach amounted to penalising easyGroup for the previous success of easyOffice, when it should have counted in its favour. L J Arnold disagreed, and confirmed that the judge was correct to find that there was insufficient evidence of use. He noted, in particular, that advertising evidence alone would rarely be sufficient to constitute genuine use of a trade mark. Further, easyGroup had not adduced any evidence as to the numbers of visitors to its website or the numbers of page views. As easyGroup is an experienced operator it should have been more than able to prove genuine use of its trade marks.

Author:
Kamila Geremek

easyGroup sued Nuclei for trade mark infringement of its mark EASYOFFICE



In short
This case is a reminder that the Court of Appeal will take into consideration the absence of confusion evidence when considering a likelihood of confusion. If there has been co-existence for an extended period it may be an uphill battle to convince judges that an infringement has occurred. The case also highlights the importance of collating sufficient evidence of use, which includes sales data, website visits, and viewership details, as advertising evidence alone will rarely be enough to convince judges that you have used your trade mark.

"Closely connected" How close is too close?

Case details at a glance
Jurisdiction: European Union
Decision level: CJEU
Parties: i.a. Beverage City & Lifestyle GmbH / Beverage City Polska Sp. z o.o. v Advance Magazine Publishers Inc
Citation: C 832/21
Date: 07 September 2023
Decision: dycip.com/beverage-city

Useful links
Regulation (EU) No 1215/2012, 12 December 2012: dycip.com/euregulation-no1215-2012

Judgment of the Court (second chamber) on joined cases C-24/16 and C-25/16, 27 September 2017: dycip.com/c-24-16-c-25-16

In a preliminary ruling the Court of Justice (CJEU) provided further guidance on "close connection" under Art. 8(1) of the Brussels I bis Regulation (Regulation No 1215/2012), and found an exclusive distribution agreement between the defendants to be sufficient.

Legal context
Art. 8(1) of the Brussels I bis Regulation reads: "A person domiciled in a Member State may also be sued: (1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings […]"

The parties
Advance Magazine Publishers is the owner of a number of European Union trade marks (EUTMs) containing the word element "Vogue", which allegedly enjoy a reputation in the EU. Beverage City Polska, based in Poland, manufactures, advertises and distributes an energy drink under the name "Diamant Vogue". Beverage City & Lifestyle had an exclusive distribution agreement for Germany with Beverage City Polska. Despite the similarity in the company names, the two entities are purely connected by the exclusive distribution agreement.

Background
Advance Magazine Publishers brought an action for trade mark infringement before the Regional Court of Düsseldorf against Beverage City Polska (and its managing director), and Beverage City & Lifestyle for:

- injunctive relief throughout the European Union; and
- information, disclosure of accounts and declaration of liability for damages, which were later limited to Germany.

The Regional Court of Düsseldorf upheld the action. Beverage City Polska and its managing director appealed. It argued that German courts would not have the international jurisdiction in the action against them, since they had operated and delivered goods to their customers exclusively in Poland.

The appeal court referred the case to the CJEU to decide whether international jurisdiction could stem from Article 8(1) of the Brussels I bis Regulation, and the close connection of the claims, due to the exclusive distribution agreement.

Previously, the CJEU had only confirmed such a close connection where the defendants belonged to the same corporate group (see judgment of 27 September 2017, Nintendo, in cases C 24/16 and C 25/16).

Decision
The CJEU reiterated that closely connected claims require the same situation of fact and law for the divergence to be irreconcilable.

The requirement of same situation of law was satisfied, since the case concerned "the protection of […] exclusive right over EU trade marks" (para. 31).

With regard to the same situation of fact, the CJEU echoed the advocate general's opinion that "the claims concerned relates primarily to the relationship between all the acts of infringement committed rather than to the organisational or capital connections between the companies concerned" (para. 37).

The CJEU then confirmed a close connection based on the exclusive contractual relationship of customer and supplier. This would make it more foreseeable that such infringements would happen in the future. Furthermore, the close cooperation between the companies was demonstrated through the operation of two websites, which belong to one of the co-defendants and through which the potentially infringing goods were sold.

CJEU rules "closely connected" includes exclusive distribution agreements

Author:
Yvonne Stone

In short
This decision expands on its previous decisions in relation to closely connected claims and extends this to exclusive distribution agreements. This has practical implications: if an EUTM owner can establish that claims against multiple defendants domiciled in different EU member states are closely connected, the relevant EU court can issue a pan-EU ruling on the infringement.

A broad interpretation of "closely connected" could, in theory, circumvent the rules of jurisdiction laid out in Art. 125 of Council Regulation (EC) No 207/2009 of 26 February 2009 of the European Union trade mark (EUTMR). It will therefore be interesting to see if such a connection can also be established through other contractual relationships.

Infringement / passing off

VETSURE or PETSURE?
A pet insurance providers' dogfight

Case details at a glance
Jurisdiction: England & Wales
Decision level: High Court
Parties: TVIS Limited & Howserv Limited Services and Ors
Citation: [2023] EWHC 2589 (Ch)
Date: 18 October 2023
Decision: dycip.com/tvis-v-howserv

In a recent ruling by the UK High Court involving the pet insurance brands VETSURE and PETSURE, deputy judge Mr Ian Karet highlighted the narrow scope of protection for descriptive trade marks in competitive business sectors, such as the insurance industry, and the pivotal role of consumer perception in the context of infringement proceedings.

When submitting evidence of consumer confusion, a careful approach is essential.

Background
TVIS Limited, the claimant in this case, has been operating under the VETSURE brand since 2009, providing pet insurance services. The VETSURE and VETSURE PET INSURANCE marks were registered across various classes, *inter alia* for "insurance, and medical and veterinary services". The defendant, Howserv Limited Services, entered the pet insurance market in 2020 under the PETSURE name. Howserv registered its PETSURE mark in classes related to "animal dietary supplements, pet insurance, and animal healthcare services". The crux of the dispute lay in TVIS' allegations of trade mark infringement, passing off, and the validity of Howserv's PETSURE registration (under Sections 5(2), 5(3), and 5(4)(a) of the Trade Marks Act 1994).

Invalidation claim
It was determined that the average consumer in this case would be a pet owner, who would therefore be familiar with insurance providers using the suffix "sure" to mean "insurance" in relation to their services.

The High Court first examined whether the PETSURE mark was invalid for being confusingly similar to the earlier VETSURE mark. The High Court identified that while VETSURE and PETSURE shared phonetic and visual similarities they were conceptually distinct: "vet" and "pet" cater to different facets of animal care. This distinction (along with the shared element "sure") being descriptive of insurance-related services, led to the conclusion that there was no likelihood of confusion among consumers.

Turning to the grounds of reputation, the High Court recognised VETSURE's established reputation. However, it noted that the mark's descriptive nature limited its distinctiveness. Despite acknowledging VETSURE's reputation, the High Court found it insufficient in context of the significant size of the pet insurance industry in the UK. Moreover, the presence of similar descriptive names in the market led to the finding that PETSURE did not unfairly benefit from or dilute the VETSURE mark.

Moreover, the court found that TVIS failed to establish the necessary elements for a passing-off claim. While acknowledging VETSURE's goodwill, there was no actionable misrepresentation or consumer deception identified.

Trade mark infringement
The High Court therefore ruled out an infringement of the VETSURE trade mark by PETSURE, under Sections 10(2) and 10(3) of the Trade Marks Act 1994. The evidence presented by TVIS to support its claim of widespread consumer confusion consisted of instances of alleged confusion, including customer service call transcripts and documentation errors. The judge emphasised that these instances were more reflective of administrative oversights, rather than a widespread misunderstanding by consumers regarding the origin of the services. The judge further categorised these instances as either mistakes or misnames, rather than confusion about trade origin. Notably, the High Court found most instances to be administrative in nature, with only one case of potential confusion, which was deemed insufficient to establish a pattern. These findings were critical in refuting the claim of widespread consumer confusion.

The High Court did not place significant emphasis on TVIS' assertion that Howserv launched PETSURE with full knowledge of the VETSURE name. It was suggested that PETSURE's naming was more aligned with Howserv's existing business, STAYSURE, rather than a deliberate attempt to infringe on the VETSURE name.

Conclusion
This case serves as a reminder that the distinctiveness of a trade mark is a decisive factor, and that even at first sight similar trade marks used for identical services can coexist without risk of confusion when the earlier right is weakly distinctive. Reputation may not even help in such cases. It highlights the necessity for clear and distinctive trade marks in competitive business sectors, such as the insurance sector.

Author:
Sophia Karim

In short
In competitive industries, choosing a distinctive trade mark over a descriptive one can be crucial for a broad scope of legal protection and differentiation from competitors. When submitting evidence of consumer confusion, a careful approach is essential. Evidence such as call transcripts should be interpreted cautiously to avoid misjudgments about consumer perception.

Information

D YOUNG&CO INTELLECTUAL PROPERTY

And finally...

Well-known marks

Bulls bounce back
Mixed success in Pizza Texas Bulls appeal

The UK High Court has found that a hearing officer made an error of law in invalidation proceedings brought by the National Basketball Association (NBA).

Background

The NBA applied to have the contested mark invalidated on a variety of grounds relating to its own registered and unregistered marks for the Chicago Bulls basketball franchise logo, however all grounds were unsuccessful.

Appeal

The appeal brought by the NBA related only to its section 56/Article 6bis well-known mark claim. The NBA contended this claim related only to two unregistered marks known as the device marks, and that the hearing officer had erred by treating these together with its various UK registered trade marks, rather than separately.

Article 6bis confers protection on marks which are well-known in the UK, regardless of whether there is any related business or goodwill. The NBA should have been able to rely on evidence of use of the device marks outside the UK (notably in the US where use was far more extensive) in showing the marks were well-known in the UK.

Article 6bis allows for the proprietor of a well-known trade mark to restrain use of an infringing mark on the basis of confusing similarity and/or detriment to reputation.

Decision

The judge agreed with the NBA and found the hearing officer had failed to treat the device marks separately. However, when addressing whether, in light of the additional evidence at the NBA's disposal, there was a likelihood of confusion, the judge still found there to be very limited overlap in the services for which the competing marks are used, hence this ground of appeal failed.

The judge declined to reach a decision regarding the detriment to reputation ground brought in the context of Article 6bis, and remitted this for hearing by a different hearing officer.

For a report of the initial decision, including images of the contested marks and device marks, see our article, "Bulls shoot and miss: UKIPO rejects invalidity proceedings brought by the NBA": dycip.com/pizzatexasbulls-chicagobulls

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