

What is the potency of the
new/recast defences?

The recast/new defences in outline

- Own name limited to natural persons
- Intervening right – Defendant's own registered trade mark
- Non-use of earlier mark as a defence rather than counterclaim

Own name defence – the previous legislation e.g. CTMR

Article 12

Limitation of the effects of a Community trade mark

A community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

(a) his own name or address;

...

- provided he uses them in accordance with honest practices in industrial or commercial matters.

The "own name" of non-natural persons

- *Anheuser-Busch*
- Striking a balance between competing interests
- *Hotel Cipriani* – covered trading names not just formal corporate name

The decisive importance of the own name defence in real cases

- *BDO v Unibank*
- *Maier v Asos*
- The heavy lifting is done by the “honest practices” proviso – *Redd v Red*

The new legislation

- Art 14(1)(a) EUTMR confines defence to “the name or address of the third party, where that third party is a natural person;
- Section 11(2)(a) TMA 1994 no infringement by “the use by an individual of his own name or address”

Discussion

- No transitional provisions
- Whether the change in the law was valid as a matter of EU law
 - *SkyKick (Pre-Trial Reference)*, *Birss J*; *SkyKick Arnold J*
- The distinction between natural persons and non-natural persons as a matter of principle
- Max Planck justifications

Intervening rights

- Section 11(1) Trade Marks Act 1994 has gone (a registered trade mark provides a defence to infringement)
- Amended by Trade Mark Regulations 2018 and replaced with new s 11(1), (1A), (1B)
- Article 16 EUTMR covers the EU position

For both EU and UK marks

- Key provision is that if earlier mark could have been revoked for non-use when the later mark was filed
- Defence will apply even if the earlier mark had started to be used by the time the use of the later mark was commenced.

For EU marks only

- If owner of earlier mark expressly consented to later mark (even if not consented to use)
- If previously unsuccessful declaration of invalidity and omitted the earlier right now relied upon

For UK marks only

- Earlier mark had not acquired a distinctive character at date of filing
- Or had not acquired a particularly distinctive character to increase likelihood of confusion
- Or had not acquired a reputation to supported extended form infringement (dilution/free-riding/tarnishment)

Discussion

- New provisions – difficult to assess practical significance this early
- Benefit in filing UK national as well as EUTMs

Non-use of the earlier mark as a defence rather than counterclaim

- Article 127(3) EUTMR – a defence as to the merits to say that the earlier mark could have been revoked at time infringement action brought
- New section 11A TMA 1994 – “The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.”

Discussion

- What is the purpose/benefit of this?
- Almost always tactical benefit in bringing counterclaim anyway (risk to proprietor of loss of right/torpedoes)