

How potent are the “own name”, “intervening rights” & “non-use” defences for alleged infringers?

Victoria Jones

Own name defence – s.11(2)(a) TMA 1994

11 Limits on effect of registered trade mark

(2) A registered trade mark is not infringed by

(a) the use by an individual of his own name or address

provided the use is in accordance with honest practices
in industrial or commercial matters

S.I. 2018/825 (14.1.2019)

What is the extent of the own name defence?

- What does the term 'own name' cover?
- How has the requirement that use be in accordance with honest practices in industrial or commercial matters been applied?

Meaning of 'own name'

- The defence only applies if it is the individual trading under the name
- It *should* extend to any name for which the individual is known for business purposes or generally
- Unclear whether the sign complained of, and 'own name' relied on have to be identical

Use in accordance with honest practices

Uses which may fall foul of this requirement =

- Use of new names
- Use of existing names in relation to new g/s

Use in accordance with honest practices

Examples:

- Joe Lycett and ‘Hugo Boss’ X
- ‘Warrior’ [2019] ETMR 11 X
- ‘Titanic Hotel’ & ‘Titanic Liverpool’ (with sufficient notices in place)

Other relevant considerations...

- **Risk of loss of right to use own name**
(Elizabeth Emmanuel, Liz Earle, Karen Millen)
- **Passing off**

Intervening rights – s.11(1) TMA 1994

“A registered trade mark is not infringed by the use of a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)”

S.I. 2018/825 (14.1.2019)

Section 47(2A)

The registration of a trade mark may not be declared invalid on the basis of an earlier trade mark unless:

- Registration of the earlier mark was completed within last 5 years from date of application for invalidity
- Registration wasn't completed before that date, or
- the use conditions are met

Section 47(2B)

The periods for which proof of use is required under 47(2A) are:

- The 5 years preceding the date of the application for invalidity **AND**
- The 5 years ending with the date of filing of the later mark or its priority date where, at that date, the period during which the earlier mark should have been put to use under 46(1)(a) has expired
(46(1)(a) – 5 years after registration)
- **Or** proper reasons for non-use

Practical Example

- Earlier Mark 'SPARKLES' registered on **1 June 2005**
 - Filing date to register 'SPARKY' on **1 June 2015**
 - A/n for D. of invalidity of SPARKY on **1 June 2022**
 - Proof of use required for:
 - 5 years up to 1 June 2022, **AND**
 - 5 years up to 1 June 2015
- (because period under 46(1)(a) expired in 2010)

Section 47(2G)

An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection 2(H), had the application for the declaration been made on the date of filing of the application for registration of the later mark or priority date.

Section 47(2H) - reasons

- Lack of distinctiveness - s.3(1)(b)
- Descriptiveness – s.3(1)(c)
- Customary in the trade s.3(1)(d)
- No acquired distinctiveness - s.3(1)
- Not distinctive for a LoC - s.5(2)
- No reputation (5(3))

Section 48(1)

Where the proprietor of an earlier mark or other earlier right has **acquiesced for a continuous period of five years** in the use of a registered trade mark in the UK, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right –

- (a) To apply for a declaration that the registration of the later mark is invalid
- (b) To oppose the use of the later mark in relation to the goods or services in relation to which it has so been used,

Unless the registration of the later mark was applied for in bad faith.

Section 11A

Non-use as a defence in infringement proceedings

- A registered TM can only prohibit use of a sign where that TM is not liable to be revoked under 46(1)(a) or (b) at the date the infringement action is brought.
- Where the mark was registered more than 5 years before the date the action is brought, D can request proof of use
- Period is 5 years preceding date of action for infringement

Victoria Jones



T: 020 7583 8055

E: Victoria.jones@3pb.co.uk

Clerk: David Fielder

London
020 7583 8055

Birmingham
0121 289 4333

Bristol
0117 928 1520

Oxford
01865 793 736

Winchester
01962 868 884

Bournemouth
01202 292 102