Brexit: what's left?

WINSTON TAYLOR.

White Paper Conference: 12 November 2026

NOVEMBER 2026

Agenda

1. ***EUIPO v. Nowhere* (Ape Tees) (ECJ)** – date for assessing prior rights
2. ***Parabolica v. Tesla* (HC) –** date for assessing refiled UK marks
3. **REUL Act 2023 & loss of supremacy of EU law**
4. **Where are we diverging?**



EUIPO v. Nowhere (Ape Tees)

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C-337/22 P — ECJ, 5 February 2026

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The ECJ ruling

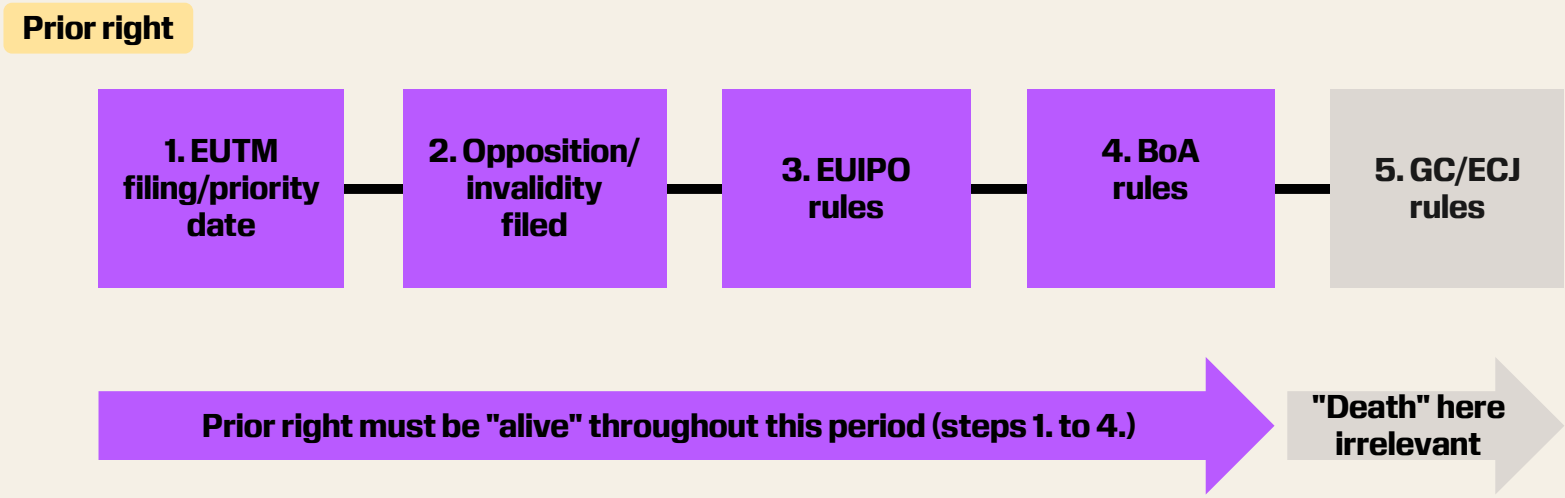
- **Prior rights relied on in opposition/invalidity actions must remain "alive":**
  - not just at the priority/filing date of the mark under attack, but also
  - at the date the EUIPO (including Board of Appeal) rules

1st ECJ ruling following inconsistent BoA/GC rulings

- **Broad - applies:**
  - **To all prior rights** – TMs, designs, unregistered rights etc
  - **To all actions** - opposition / invalidity, EUIPO / EU member state
  - **If prior right "dies" for any reason** – revocation, (invalidity), non-renewal, expiry, surrender or member state leaves EU

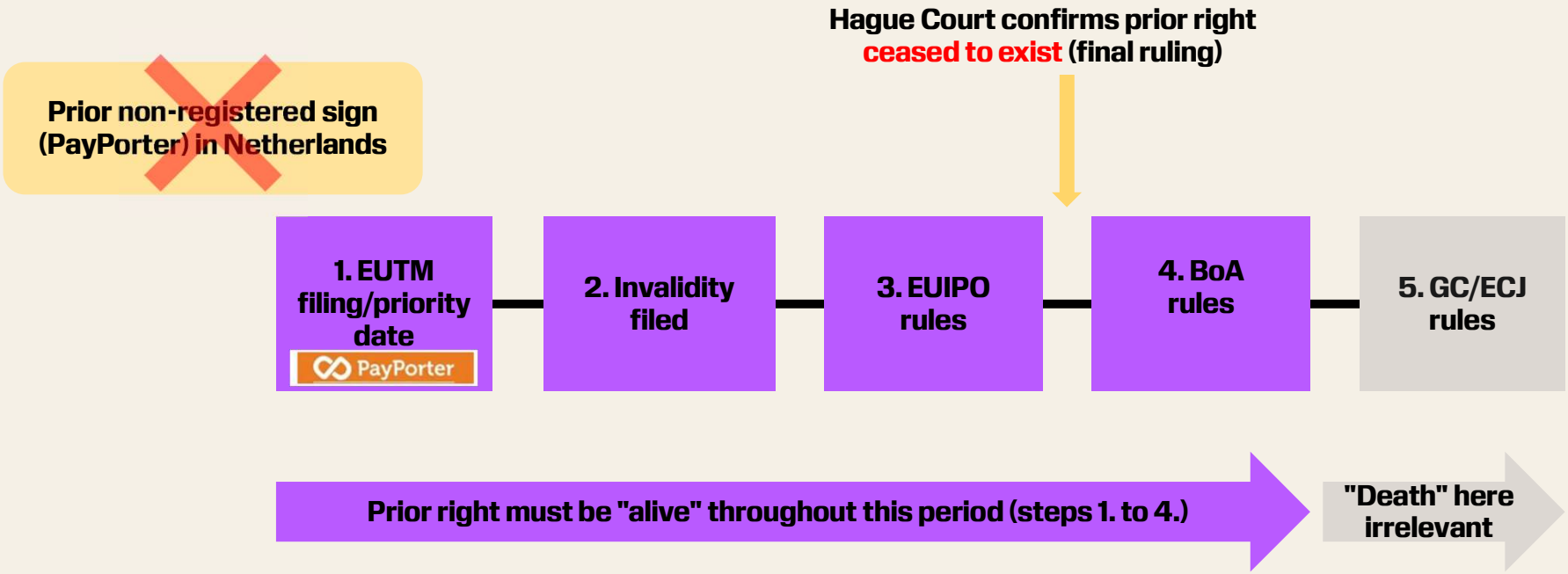


Illustration



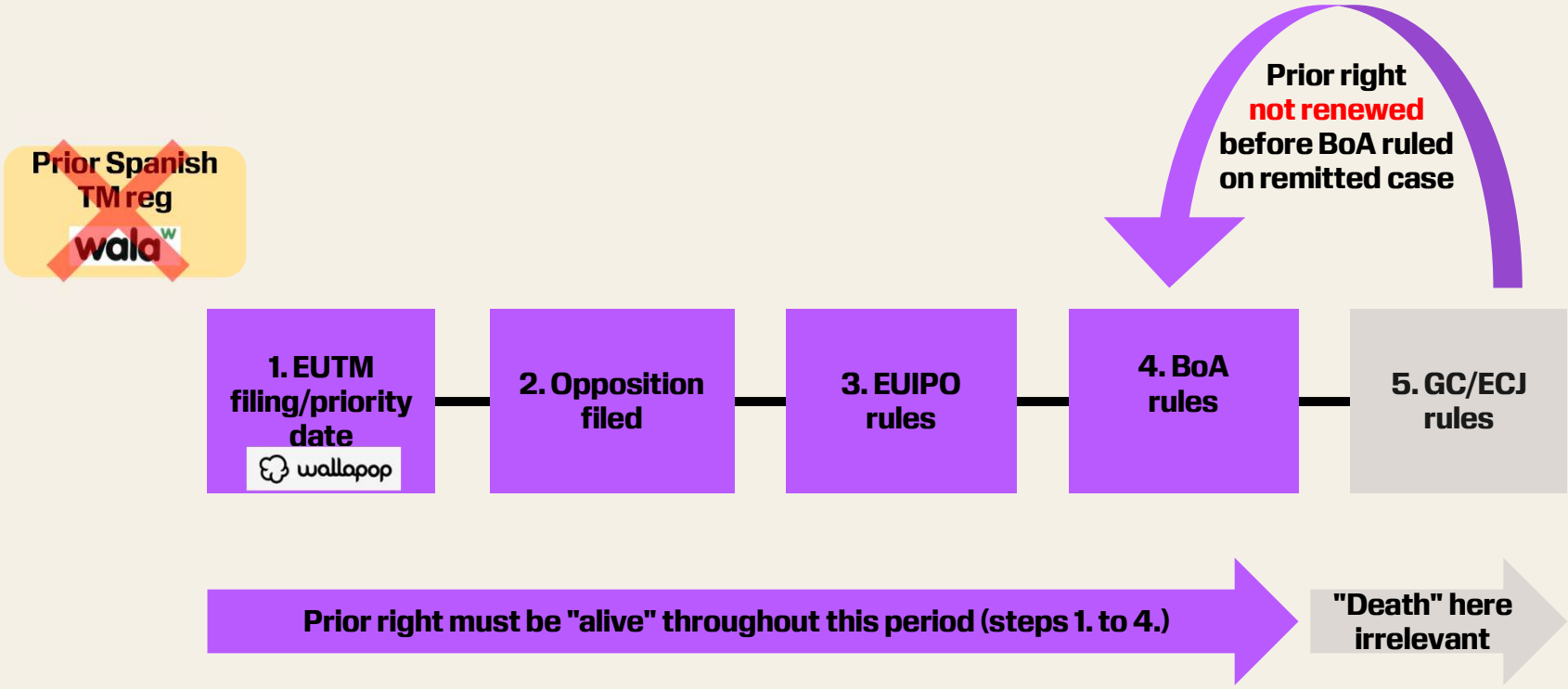
See also *Communigate* (BOA) – change of prior French company name

Example 1: *PayPorter* (BoA)



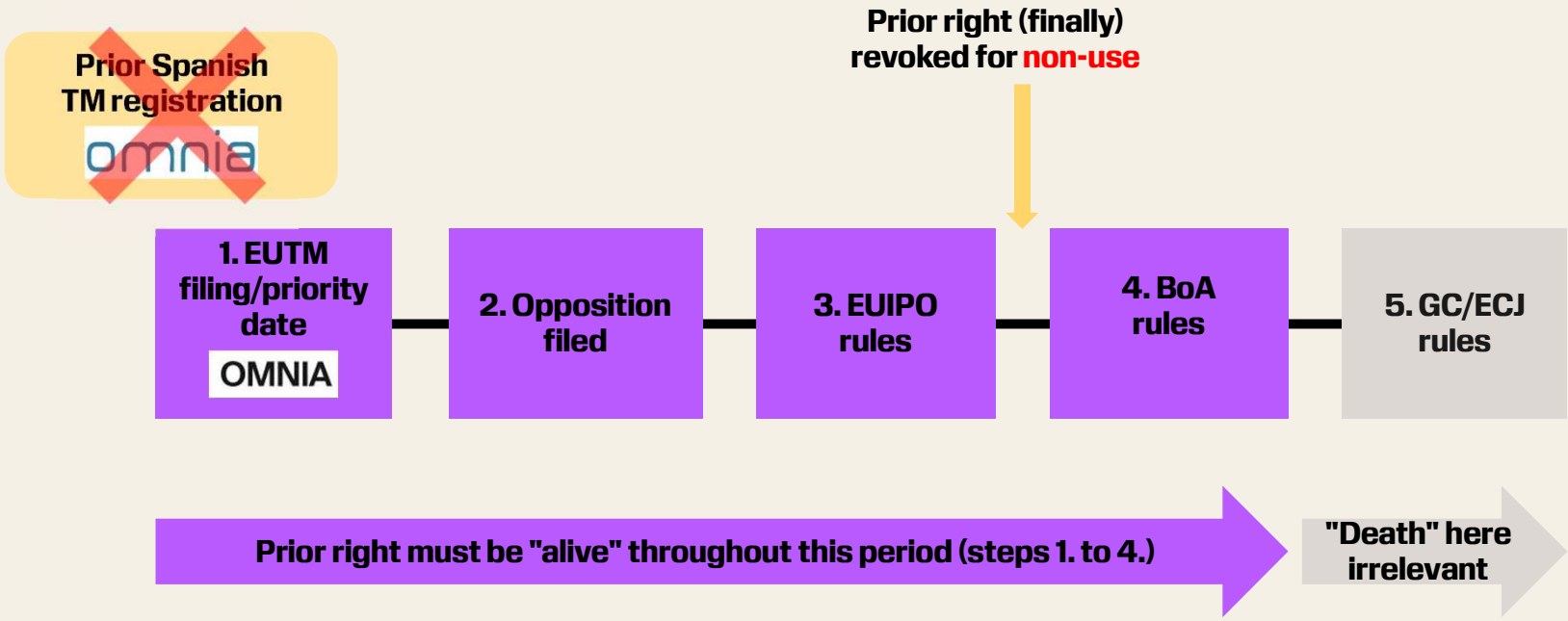
See also *Style & Taste* (design registration not renewed) & Design Cati (failure to prove renewal)

Example 2: *Unipreus* (GC)



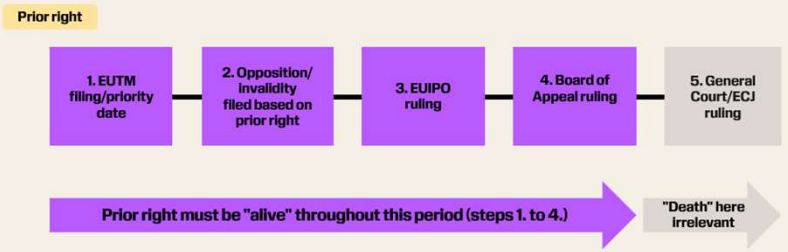
See also Baccarat (BoA) - partial revocation
Rolling proof of use period?

Example 3: Privacy Infrastructure (BoA)



Practical implications

1. **Prior rights holders**
   - Ensure prior right stays "alive" to BoA ruling (including if remitted back)
   - Main risk is revocation for non-use - take care if no/sporadic/declining use
   - Check unregistered rights used
2. **Defendants to opposition/invalidity - look for opportunities to "knock out" prior rights**
   - Counter-attacks for revocation + requests for suspension of main action
   - Speculative appeals to drag out the main action
   - Challenging whether prior unregistered rights used sufficiently
3. **Some difficult tactical decisions**

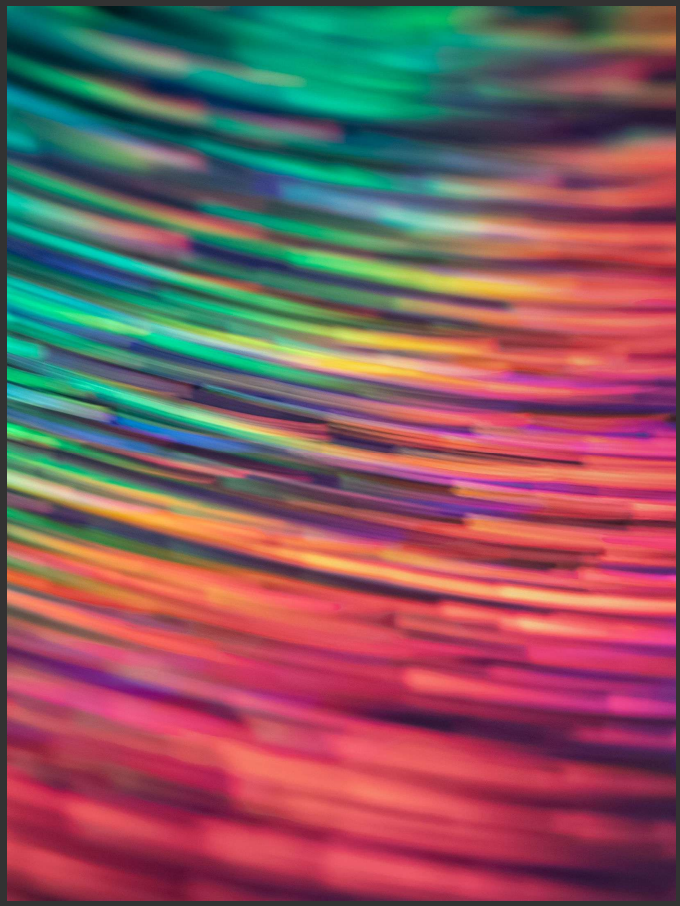


Unanswered questions

1. What if application to revoke filed after BoA ruling but with request for revocation to take effect from a date before BoA ruling?
2. What if GC remits back to BoA but the remittal relates only to a different prior right (that hasn't "died")?
3. What role will the EUIPO / CJEU play in "policing"?
   - BoA must verify prior right before ruling (*Anheuser-Busch*, *Ape Tees*)
   - Will it act of own volition if it spots a problem?
4. What about infringement actions – damages/AoP but no injunction?
5. Does enhanced distinctiveness / reputation also have to persists to decision date?
   - Current practice says it does - *Shopify* ECJ decision pending

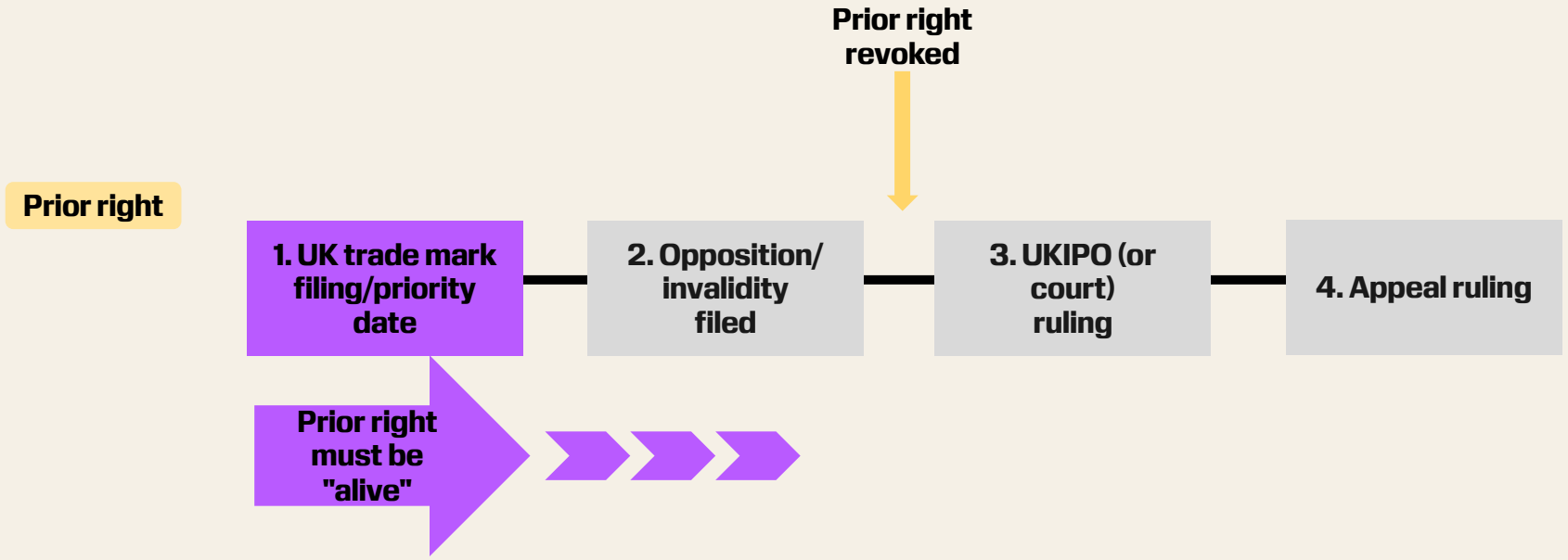
Contrast: the U.K. position

- Generally, prior right need only be alive at the priority/filing date of the mark under attack
  - Subsequent revocation of prior right is irrelevant (*Riviera*)
  - Exception – action does fail if prior right lapses through non-renewal (*Transpay*) or surrender (*Sundip*) during the action - positive acts
- Never tested in court but… soon?



If prior right not renewed or surrendered – falls away (unclear on timing)

Usual UK action



Parabolica v. Tesla

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High Court of England and Wales, [2026] EWHC 386 (Ch) — 2026

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The High Court ruling

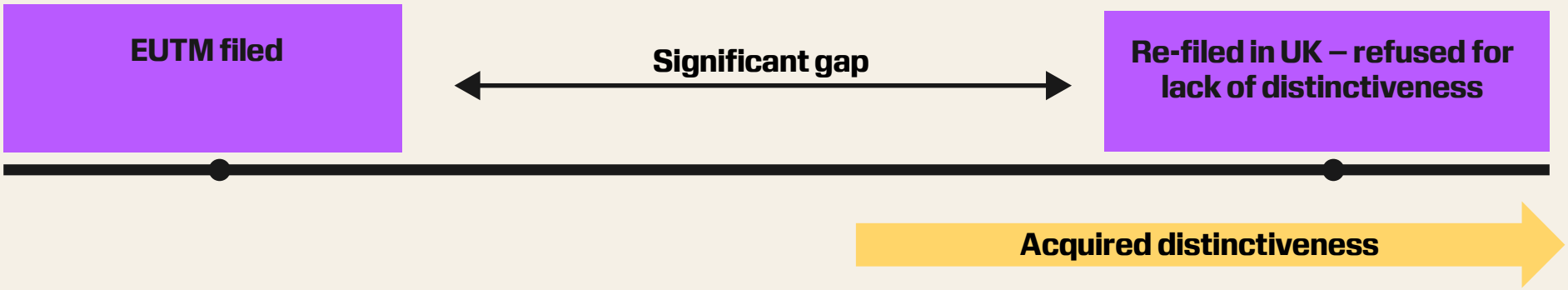
- Those with EUTMs pending at Brexit had 9-month period in which to file in the UK and claim the priority/filing date of the parent EUTM - 15,000 filed
- HC confirmed that **priority/filing date of parent EUTM** is not only relevant to assessing:
  - Relative grounds, **but also**
  - Absolute grounds – (overturns UKIPO practice)
- Important if significant gap between two dates, especially for **bad faith** and **acquired distinctiveness**

Parabolica: facts



- UKIPO found bad faith at UK filing date – on appeal, HC says wrong date
- UKIPO yet to rule on whether bad faith at EU filing date – new evidence/arguments
- Re-filed UK application might now be accepted when it would not have been previously

Example: acquired distinctiveness



Re-filed UK application will now be refused - when it would previously have been accepted - as no acquired distinctiveness at EU dates - s.47(1) proviso does not apply until mark registered

Practical implications

- Change of date relevant if:
  - You are still prosecuting a refiled UK application (late objections)
  - You are in a dispute (in / out) involving a refiled UK application/registration

Search records (no special prefix)

- Rare (15,000) but keep in back of head – *Fifth Avenue v Commodore*
- A large gap between the EU and UK filing dates can make a difference:
  - Evidence must relate to EU, not UK, dates
  - Could change assessment of merits - Brexit strikes again!

Supremacy of EU law

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REUL Act 2023

- **The following abolished (1 Jan 2024 onwards)**
  - Supremacy of EU law
  - General principles of EU law (fundamental rights, proportionality etc)
  - 'Rights, powers and liabilities' (TFEU/free movement etc)

- New principle of **domestic supremacy** of retained direct EU law e.g.
  - Retained Community Design Reg (RDA 1949 & CDR 2005)
  - Retained Customs Reg

Must, so far as possible, be read as compatible with all domestic enactments and is subject to all domestic enactments so far as incompatible with them

Loss of supremacy

"...what matters is the language of the Directive." Jacob J in *British Sugar v James Robertson*

What matters is the language of the TMA 1994 "...the Directive is only an 'external aid' ... it cannot displace the meanings of a word conveyed by a statute, that, after consideration of that context, are clear and unambiguous and which do not produce absurdity." HHJ Tindal (obiter) in *E-Accounting v Global Infosys*

- Where **"fault lines"** already exist between UK and EU case law – paraphrasing Arnold LJ at Are you ready for REULA? UCL, 22 Jan 2024 – not in practice
- Where **wording** of 1994 Act and EUTMD differ (e.g. recitals)
- Where EU takes / has taken a **purposive approach** to construction

Forced departure?

Divergence

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Divergence

- **Courts keen to stay aligned with EU law**
  - Copyright - *TuneIn v Warner* (CA) (comm to public), *AGA v UK Innovations* (CA) (s. 51), *Roadget v Whaleco* (HC) (*Peterson* applied despite post-Brexit)
  - *Thatcher's v Aldi* (CA) (unfair advantage), *Iconix v Dream Pairs* (SC) (post-sale confusion)
- **Where we have departed**
  - *Industrial Cleaning v Intelligent Cleaning* (CA) (acquiescence) – BUT v. specific circumstances
  - *Nowhere v EUIPO* (Ape Tees) (ECJ) (prior right must stay "alive")
  - [*SkyKick v Sky* (SC) (bad faith – broad terms)? EUIPO considering]

Where we might diverge

- **Fault lines** - without due cause, partial revocation (spec amends), use includes no use for infringement, 3D marks
- **CJEU interprets law purposively** e.g. link (reputation), adverse effect on functions of TM
- **Wording differs especially recitals** – freedom of expression (*INTER IKEA*) and artistic expression (*Hermes*)
- **Legislative changes -** EU/UK design reforms (1st disclosure etc), Digital Services Act (including safe harbour voluntary own-initiative investigations), craft and industrial GIs
- **Loss of interpretive effects -** e.g. exhaustion of rights (loss of free movement principle)

- **Departure seems rare**

Key take aways

1. Ape Tees says prior right must stay alive until EUIPO (including BoA rules)
   - Look for opportunities and threats especially revocation for non-use
   - Keep eye on developments
2. Check if prosecuting a re-filed UK mark or involved in a dispute (in / out) involving one
   - Absolute grounds now assessed at parent EU date – might affect evidence and merits
3. Remember REULA 2023 and loss of supremacy of EU law
4. (Remember loads of EUTM and UKTM registrations now vulnerable to revocation for non-use)

Questions



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