



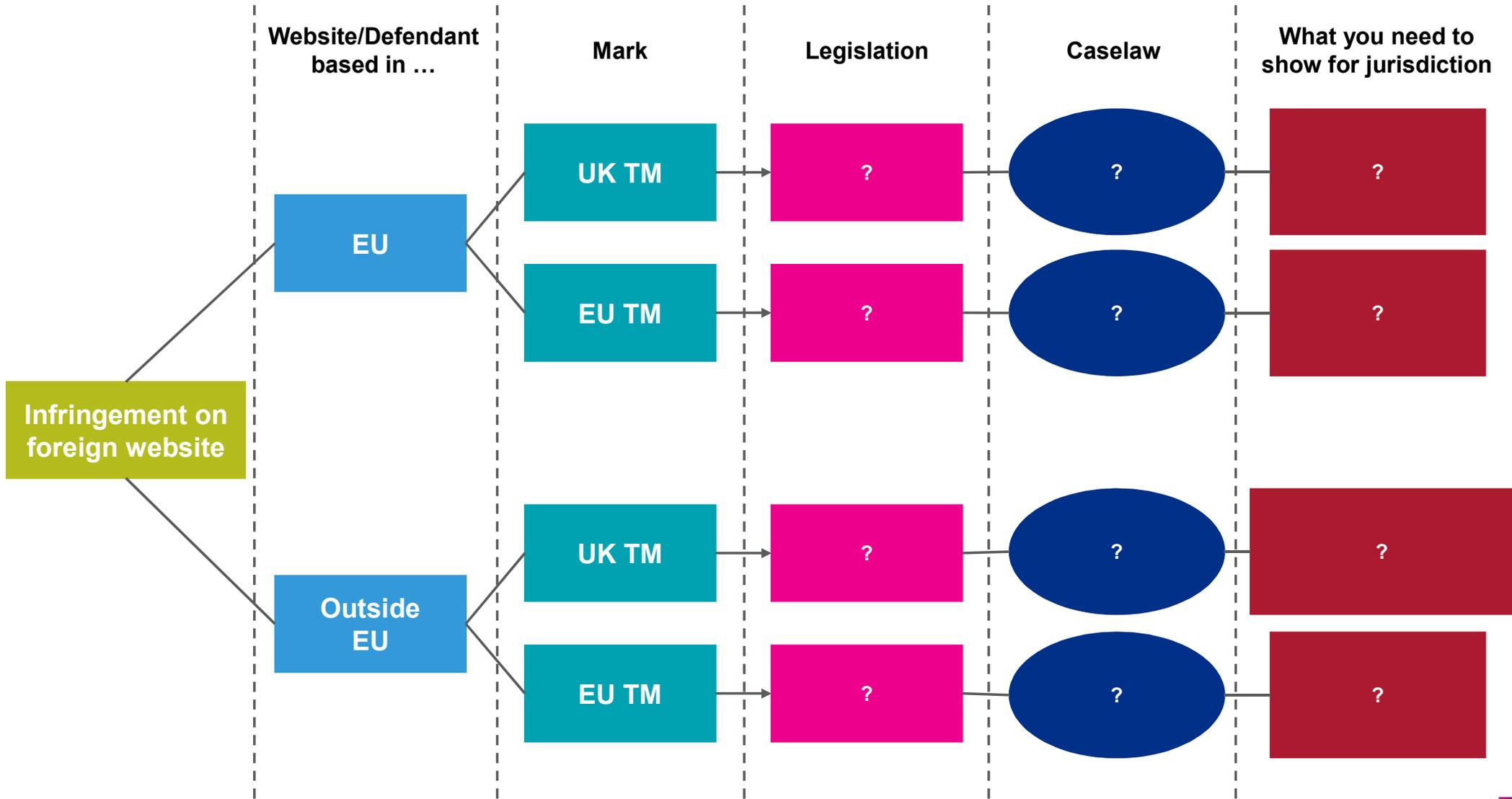
RPC

# How are the rules on jurisdiction and national-based trade mark infringements playing out in the UK courts? When can a website be said to "target" the UK/EU?

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Partner, RPC

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# EU Defendant/UK Mark 1

- An alleged tortious act in the UK
- Brussels Regulation
- Article 4 (1): sue in place of domicile
- ***Article 7(2) in matters relating to tort...in the courts of the place where the harmful events occurred or may occur***
- Article 24(4) in proceedings concerned with the registration or validity of trade marks...the courts of the Member State of registration.

# EU Defendant/UK Mark 2

*...where the harmful events occurred or may occur...*

- AMS Neve v Heritage Audio [2016] EWHC 2563

## *Heritage Audio 1073*

*“The name says it all . First introduced by Neve in 1970 it has been reproduced by many others since then, most notably BAE Audio and AMS-Neve. We are proud to introduce what, to our knowledge, is the most historically accurate reproduction ever made using the same exact components, specifications and, equally important, same time consuming construction techniques, our 1073 looks and sounds as good as a Rupert Neve era 1073 module, and will last as long.”*

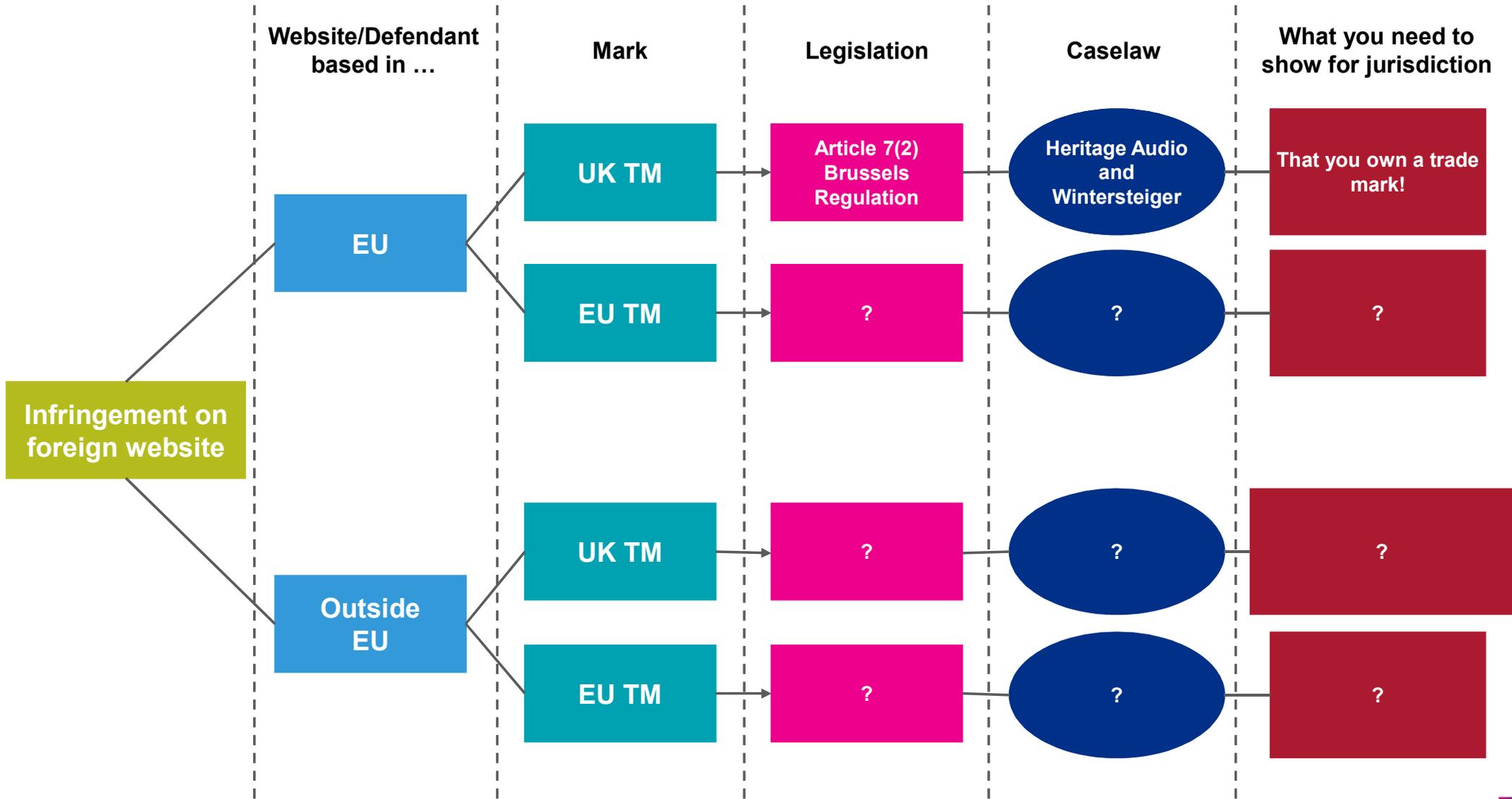


# EU Defendant/UK Mark 3

*...where the harmful events occurred or may occur...*

- AMS Neve v Heritage Audio [2016] EWHC 2563
- Mines de Potasse d'Alsace [1976] – river effluent
- Wintersteiger v Products 4U [2012] – ski equipment online
- Pinckney v Mediatech [2014] - jewellery
- Coty v First Note Perfumes [2014] - perfume



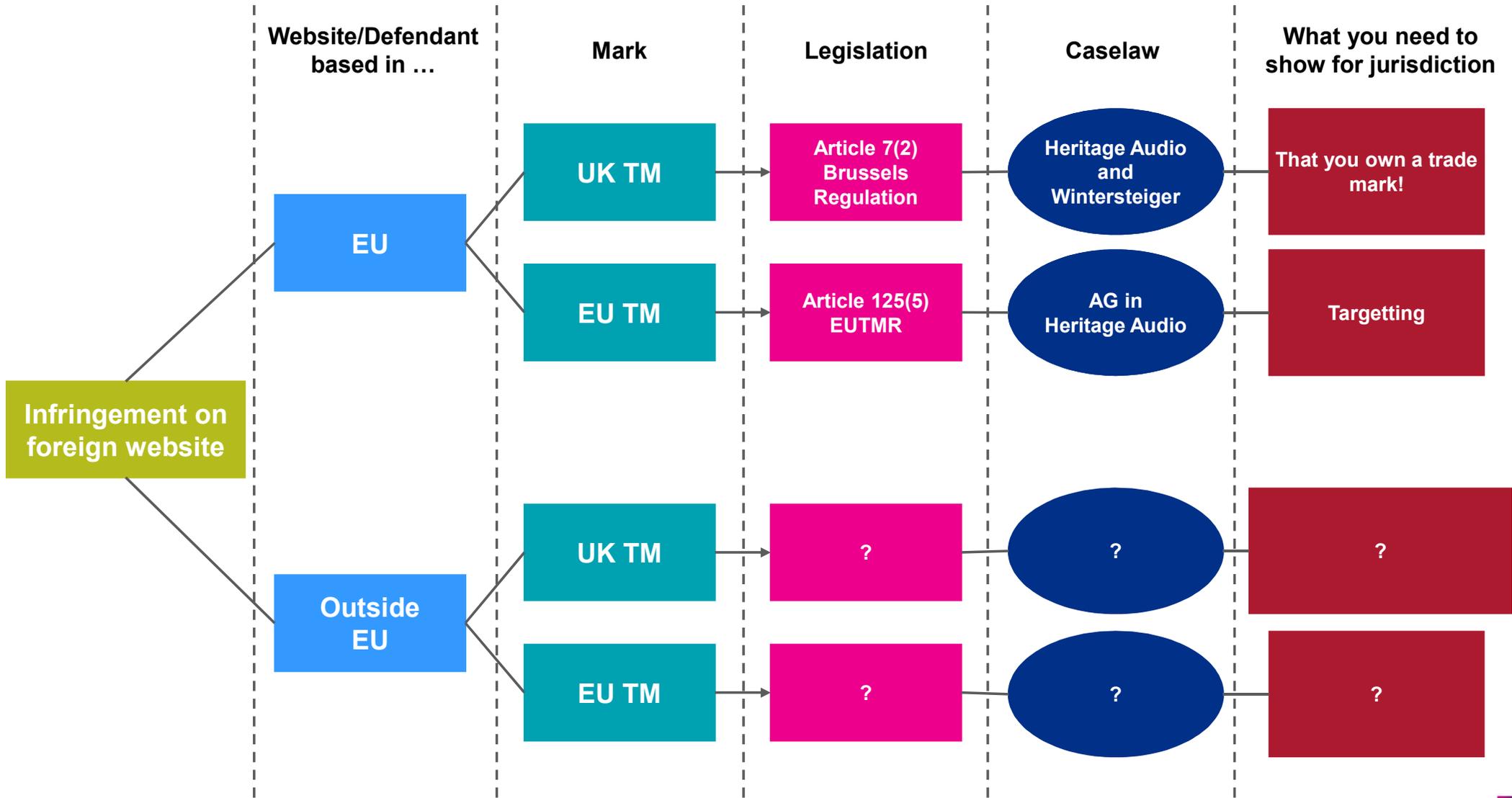


# EU Defendant/EU Mark 1

- An alleged infringement in the UK
- EUTMR: Article 125(1) – if defendant is domiciled in the EU, in its country of domicile
- Article 125(3) If the defendant is not domiciled in the EU, in the claimant's domicile.
- If neither the defendant nor the claimant is domiciled in the EU, in Spain.
- Proceedings may also be brought in the Member State in which the act of infringement has been committed or threatened.

# EU Defendant/EU Mark 2

- *“in which the act of infringement has been committed or threatened*
- Heritage Audio: IPEC, applying Coty - just where the act is committed
- CoA – “the claimant might be forgiven for thinking...”
- AG on a referral – “targeting”

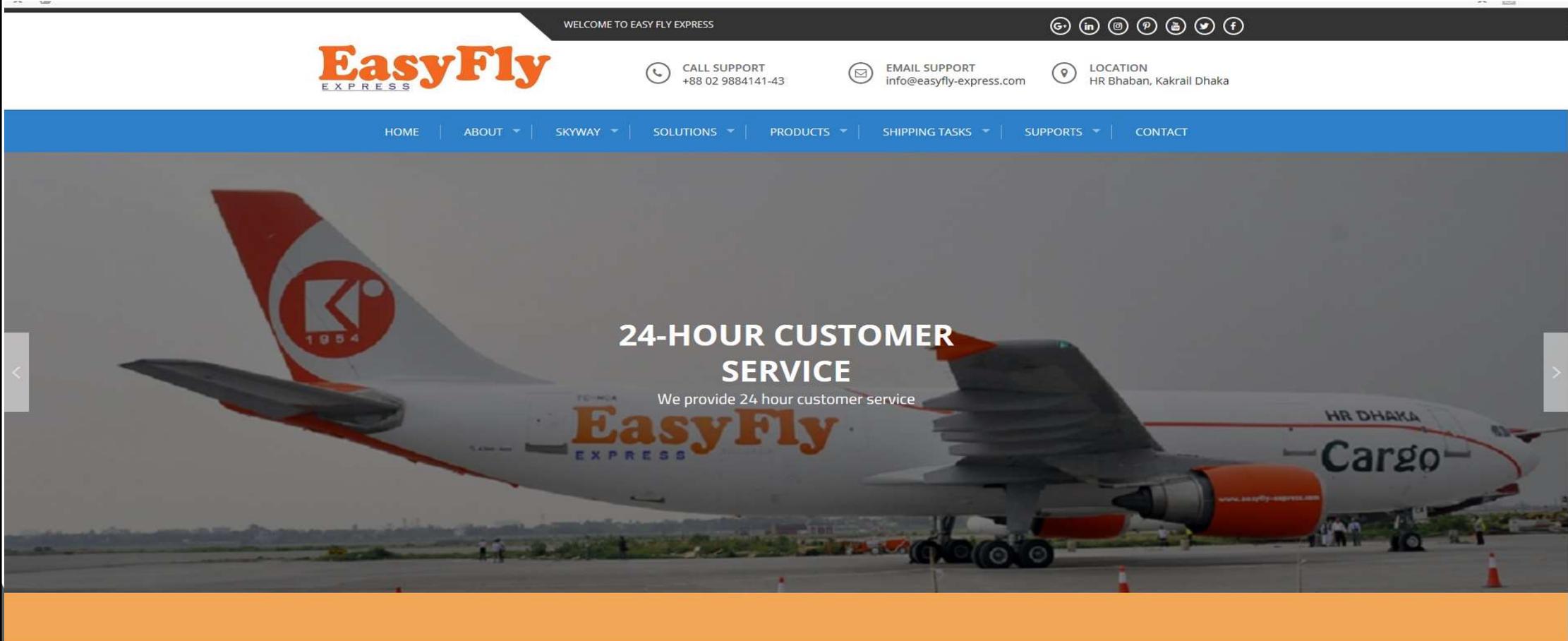


# Non EU Defendant/UK Mark 1

- An alleged infringement in the UK
- Permission to serve out of jurisdiction
  - Real prospect of success on the merits
  - Good arguable case within the jurisdictional gateways – para 3.1 of PD 6B
- Gateways:
  - Injunction sought in the jurisdiction
  - Damage suffered in the jurisdiction
  - Enactment allows proceedings to be brought here

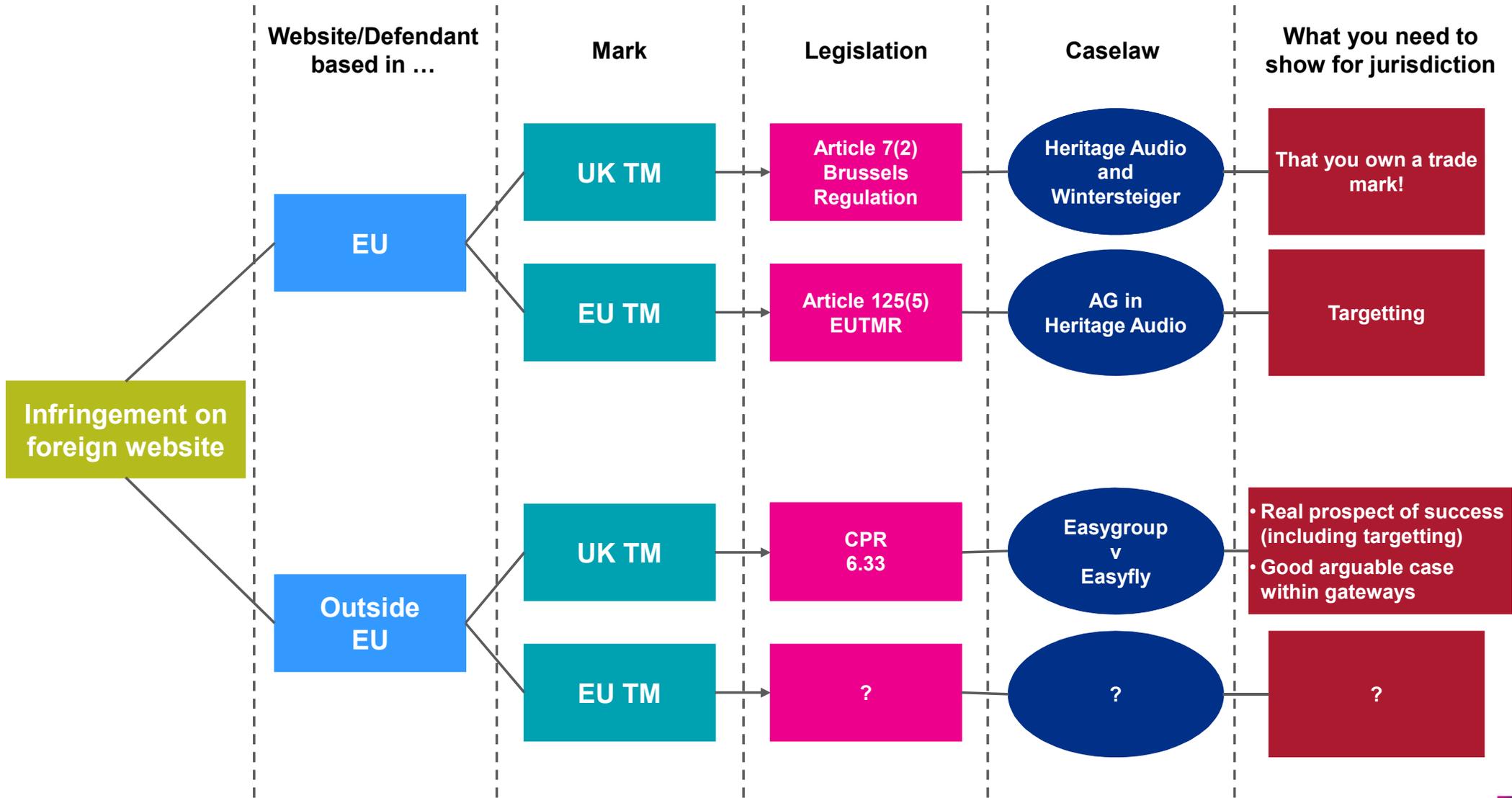
# Non EU Defendant/UK Mark 2

## Easygroup v Easyfly [2018] EWHC 3155



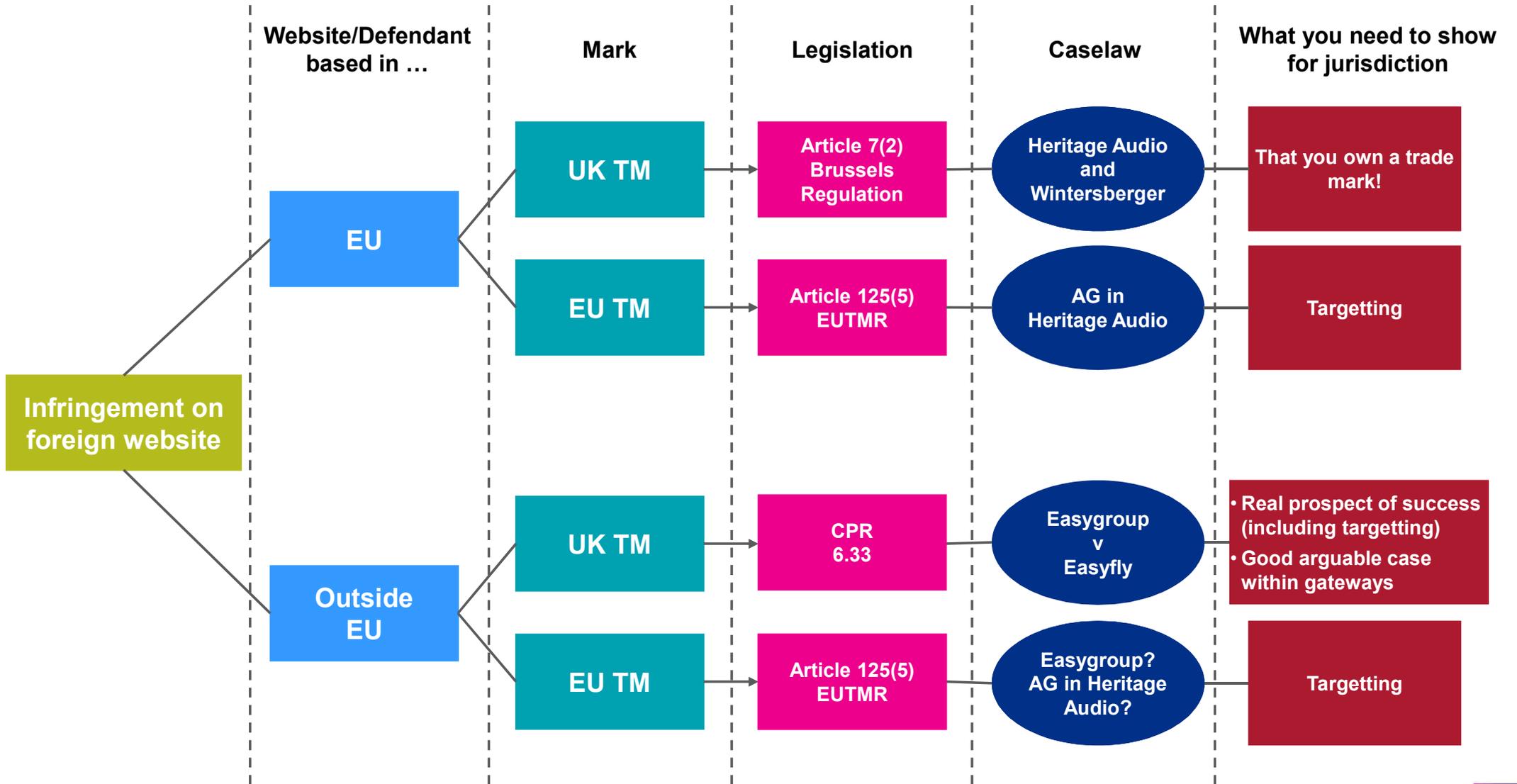
# Non EU Defendant/UK Mark 3

- Real prospect of success on the merits
- Need to look at targeting



# Non EU Defendant/EU Mark

- Treated the same as UK Mark – i.e. real prospect of success + gateways
- Is that right? Either way you get to targeting.



# Targeting 1

intention to target  
UK visits to website  
look and feel of website  
travel plans  
international clientele  
soliciting custom  
currency  
language  
targeting UK consumers  
objectively targeted  
characteristics of goods  
telephone numbers  
UK on map/list  
top level domain  
website accessibility  
advertising puff

# Targeting 2

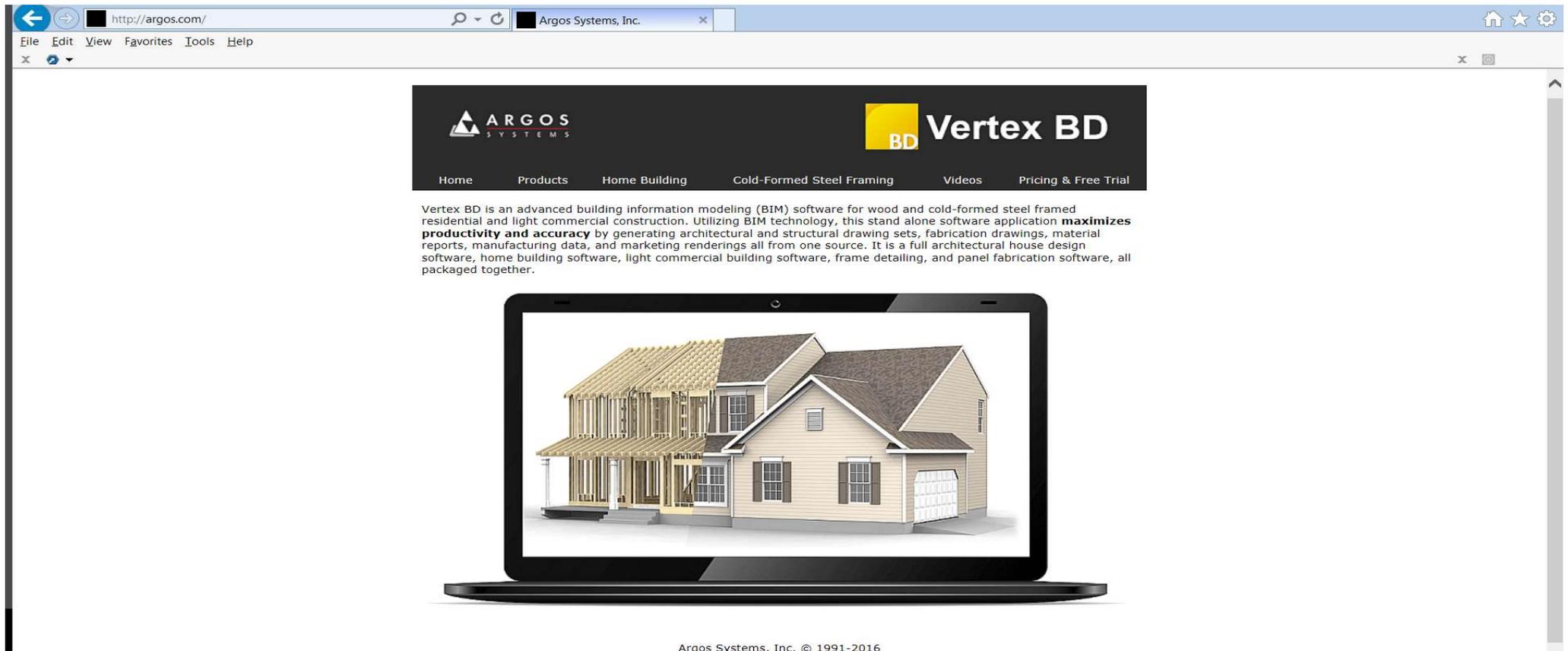
## Easyfly:

**“Our network provides a global reach for customers in Africa, Europe, North America, South America, the middle East, South East Asia and North Asia”**

**“We foresee greater business opportunities lying ahead in the international air-cargo market as well...”**

# Targeting 3

## Argos Limited v Argos Systems Inc [2018] EWCA 2211



The screenshot shows a web browser window with the URL <http://argos.com/>. The page features the Argos Systems logo on the left and the Vertex BD logo on the right. Below the logos is a navigation menu with the following items: Home, Products, Home Building, Cold-Formed Steel Framing, Videos, and Pricing & Free Trial. The main content area contains a paragraph of text describing the Vertex BD software as an advanced BIM application for residential and light commercial construction. Below the text is a 3D rendering of a house, split into two parts: one showing the wooden frame and the other showing the finished exterior with siding and a garage.

ARGOS SYSTEMS

BD Vertex BD

Home Products Home Building Cold-Formed Steel Framing Videos Pricing & Free Trial

Vertex BD is an advanced building information modeling (BIM) software for wood and cold-formed steel framed residential and light commercial construction. Utilizing BIM technology, this stand alone software application **maximizes productivity and accuracy** by generating architectural and structural drawing sets, fabrication drawings, material reports, manufacturing data, and marketing renderings all from one source. It is a full architectural house design software, home building software, light commercial building software, frame detailing, and panel fabrication software, all packaged together.

Argos Systems, Inc. © 1991-2016



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